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One Page Summaries

TRADE MARK CASE LAW^{ECJ}

Dirk Visser

PREFACE

This publication contains one page summaries of almost all recent decisions of the European Court of Justice on trade mark law. Most decisions relate to the interpretation of the Trade Mark Directive¹ and/or the Community Trade Mark Regulation². A few decisions concerning related subjects have also been included.

The relevant rule of law and a representation of the facts of most decisions is summarized in just a few sentences. This is followed by a more elaborate summary, consisting mostly of relevant quotations from the decisions. A chronological index is included at the end of this publication.

This publication is meant as a first introduction to and a brief survey of European trade mark case law. Please always consult the full texts when appropriate. The full text of all decisions (after 1996) can be found at the website of the European Court of Justice: www.curia.europa.eu.

This publication was compiled with the help of Piter de Weerd and other colleagues at Klos Morel Vos & Schaap. Decisions rendered after 1 September 2006 have not been included.

In cooperation with legal publisher deLex, a database will be created of all summaries and all full text decisions (also from before 1996). New decisions of the ECJ will be summarized and published shortly after they are handed down. See www.delex.nl for more information.

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¹ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

² Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.

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Doublemint

(descriptive marks)



ECJ 23 October 2003, case C-191/01 P,
Wrigley/OHIM; Doublemint
Article 7(1)(c) Trade Mark Regulation

A word cannot be registered as a trade mark if it designates a characteristic of the goods or services concerned in one of its possible meanings.

Wrigley filed an application with the OHIM for registration of the word combination Doublemint for goods in, inter alia, classes 3, 5 and 30 and in particular for chewing gum (without any proof of acquired distinctiveness).

'By prohibiting the registration as Community trade marks of such signs and indications, Article 7(1)(c) [Trade Mark Regulation] pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is sought may be freely used by all. That provision accordingly prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, inter alia, in relation to the identical provisions of Article 3(1)(c) [Trade Mark Directive], [Windsurfing Chiemsee, paragraph 25, Linde and others, paragraph 73]).' (Para. 31).

'In order for OHIM to refuse to register a trade mark under Article 7(1)(c) [Trade Mark Regulation], it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.' (Para. 32).



Biomild

(descriptive composite word)

ECJ 12 February 2004, case C-265/00,
Campina Melkunie/BMB; Biomild
Article 3(1)(c) Trade Mark Directive

A combination of descriptive words is also descriptive itself, unless there is a perceptible difference which can be discerned between the neologism and the mere sum of its parts.

Dutch dairy producer Campina filed an application with the Benelux Trade Mark Office (BMB) to register the composite word Biomild as trade mark for goods in classes 29, 30 and 32 (various food products including dairy products). The product marketed in the Netherlands under this mark was a 'natural' yogurt with a mild taste.

When examining whether a composite word is descriptive it does not suffice to define the descriptive nature of the elements of the combination; for the new word itself its descriptive nature has to be established.

A mark which consists of a new word which is made up by elements which as such constitute a description of the goods or services which the registration is applied for, constitutes itself also a description of the characteristics of such goods or services in the sense of Article 3(1)(c), 'unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.

For the purposes of determining whether the ground for refusal set out in Article 3(1)(c) [Trade Mark Directive] applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services referred to in the application for registration.' (Operative part.)

Postkantoor

(descriptive word)

ECJ 12 February 2004, case C-363/99, KPN/BMB;
Postkantoor
Article 3 Trade Mark Directive

Refusal to register a descriptive word. Existence of synonyms is not relevant. Registration in other countries is not relevant. A combination of descriptive words must have something extra. Disclaimers are not allowed.

Koninklijke KPN Nederland, the Dutch post office, filed an application with the Benelux Trade mark Office (BMB) for the registration of the word Postkantoor (post office) for, inter alia, paper, advertising, insurance, postage stamps, construction, telecommunications, transport, education and technical information and advice.

1 Taking into account all relevant facts and circumstances.
'Article 3 [Trade Mark Directive] [...] is to be interpreted as meaning that a trade mark registration authority must have regard, in addition to the mark as filed, to all the relevant facts and circumstances. It must have regard to all the relevant facts and circumstances before adopting a final decision on an application to register a trade mark. A court asked to review a decision on an application to register a trade mark must also have regard to all the relevant facts and circumstances, subject to the limits on the exercise of its powers as defined by the relevant national legislation.'

2 Registration in another Member State is not relevant.
'The fact that a trade mark has been registered in a Member State in respect of certain goods or services has no bearing on the examination by the trade mark registration authority of another Member State of an application for registration of a similar mark in respect of goods or services similar to those in respect of which the first mark was registered.'

3 Existence of synonyms is not relevant.
'Article 3(1)(c) [Trade Mark Directive] precludes registration of a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought, and that is the case even when there are more usual signs or indications for designating the same characteristics and regardless of the number of competitors who may have an interest in using the signs or indications of which the mark consists.'

Where the applicable national law provides that the exclusive right conferred by registration, by a competent authority in an area in which a number of officially recognised languages coexist, of a word mark expressed in one of those languages extends automatically to its translation in the other languages, the authority must ascertain as regards each of those translations whether the mark actually consists exclusively of signs or indications which may serve, in trade, to designate characteristics of those goods or services.'

4 Descriptiveness for specific goods does not result in distinctiveness for other goods.

'Article 3(1) [Trade Mark Directive] must be interpreted as meaning that a mark which is descriptive of the characteristics of certain goods or services but not of those of other goods or services for the purposes of Article 3(1)(c) [Trade Mark Directive] cannot be regarded as necessarily having distinctive character in relation to those other goods or services for the purposes of subparagraph (b) of the provision. It is of no relevance that a mark is descriptive of the characteristics of certain goods or services under Article 3(1)(c) [Trade Mark Directive] when it comes to assessing whether the same mark has distinctive character in relation to other goods or services for the purposes of Article 3(1)(b) of the Directive.'

5 A combination of descriptive words must have added value.
'Article 3(1)(c) [Trade Mark Directive] must be interpreted as meaning that a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of the characteristics of those goods or services for the purposes of that provision, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that because of the unusual nature of the combination in relation to the goods or services the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the latter case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purposes of the same provision.'

For the purposes of determining whether Article 3(1)(c) [Trade Mark Directive] applies to such a mark, it is irrelevant whether or not there are synonyms capable of designating the same characteristics of the goods or services mentioned in the application for registration or that the characteristics of the goods or services which may be the subject of the description are commercially essential or merely ancillary.'

6 Disclaimers are not allowed.

'[The Trade Mark Directive] prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic.'

7 All inadmissible marks should be refused.

'The practice of a trade mark registration authority which concentrates solely on refusing to register manifestly inadmissible marks is incompatible with Article 3 [Trade Mark Directive].' (All quotations operative part).



Chiemsee

(geographical name, acquired distinctiveness)

ECJ 4 May 1999, cases C-108/97 and C-109/97,
Windsurfing Chiemsee/Huber
Article 3(1)(c) and (3) Trade Mark Directive

A geographical name cannot be a trade mark if it may serve to designate a geographical origin. Registration based on acquired distinctiveness is possible.

Windsurfing Chiemsee owns the word and figurative mark Chiemsee for clothing and objects to the use of the name Chiemsee on clothing by Huber and Attenberger in the surroundings of the Chiemsee (the largest lake in Bavaria, Germany).

'Article 3(1)(c) [Trade Mark Directive] [...] does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods'. (Operative part.)

A geographical name may be registered as a trade mark if 'following the use which has been made of it, it has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings. Where that is the case, the geographical designation has gained a new significance and its connotation, no longer purely descriptive, justifies its registration as a trade mark.' (Para. 47).

'In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.' (Para. 51).



Have A Break

(acquired distinctiveness of a slogan)

ECJ 7 July 2005, case C-353/03, Mars/Nestlé; Have A Break
Article 3(3) Trade Mark Directive

The distinctive character of a mark may be acquired as a result of the use of that mark as part of or in conjunction with a registered trade mark.

Mars objected to the registration of the slogan Have A Break on the basis of lack of distinctive character, because this slogan had not been used separately by Nestlé, but only as part of the combination Have A Break Have A Kit Kat

Article 3(3) of the Directive contains no restriction to 'separate use', referring solely to the 'use which has been made' of the mark.

'The expression 'use of the mark as a trade mark' must therefore be understood as referring solely to use of the mark for the purposes of the identification, by the relevant class of persons, of the product or service as originating from a given undertaking.

Yet, such identification, and thus acquisition of distinctive character, may be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.' (Paras. 29-30).

'The distinctive character of a mark referred to in Article 3(3) [Trade Mark Directive] [...] may be acquired in consequence of the use of that mark as part of or in conjunction with a registered trade mark.' (Operative part).

Other cases on distinctive character of word (and figurative) marks

Article 3(1)(d) Trade Mark Directive

Article 7(1)(b), (c) and (d) Trade Mark Regulation

ECJ 29 September 2001, case C-383/99 P, P&G/OHIM; Baby-dry

According to the ECJ, Baby-dry was wrongfully refused as a Community Trade Mark for nappies under Article 7(1)(c) Trade Mark Regulation.

'As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.' (Para. 40).

Please note: It is generally assumed that this decision in effect has been rendered obsolete by the decisions concerning Doublemint, Biomild and Postkantoor.

ECJ 4 October 2001, case C-517/99, Merz & Krell/OHIM; Bravo

The Bundespatentgericht refused the word mark Bravo for stationary under Article 3(1)(d) of the Trade Mark Directive, because the word 'bravo' is for the relevant public purely an expression of applause. ECJ: 'However, registration of a trade mark which consists of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by that mark is not excluded as such by virtue of such use. It is for the national court to determine in each case whether the signs or indications have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark.' (Para. 40).

ECJ 19 September 2002, case C-104/00 P, Deutsche Krankenversicherung/OHIM; Companyline

Companyline is in the English language territory a descriptive combination which does not have a distinctive character for (a 'line' of) insurance products for undertakings ('companies'). 'What is in question here is a word mark composed of two descriptive terms, where the combination of the two compo-

nents does not embody any element of fancifulness overlaying the descriptive content of the word. The descriptive meaning is unambiguous and immediately discernible without the need for any analytical effort.' (Para. 19).

ECJ 5 February 2004, case C-150/02 P, Streamserve/OHIM; Streamserve

The Court of First Instance considered, on the one hand, that the word Streamserve was made up of a basic verb (serve) and a noun (stream) and was therefore not unusual for the consumers concerned. On the other hand, it found that the word Streamserve referred to a technique for transferring digital data from a server, enabling them to be processed as a steady and continuous stream, and that this technique did not merely constitute a field in which those goods are applied but rather one of their specific functions. Therefore, it concluded that the word Streamserve could serve to designate a characteristic of the majority of the goods listed in the application for registration [in class g] and that, therefore, in respect of those goods, the absolute ground for refusal set out in Article 7(1)(c) [Trade Mark Regulation] prevented its registration. In contrast, the Court of First Instance found that OHIM had established neither that Streamserve could be descriptive nor that it was devoid of distinctive character for goods within the categories manuals and publications.' (Paras. 14-17).

'In finding, [...], that Article 7(1)(c) [Trade Mark Regulation] pursues an aim which is in the public interest, namely that the proposed signs and indications may be freely used by all, the Court of First Instance did not fail to take account of the objectives of those provisions and accordingly interpreted them correctly.' (Para 26).

ECJ 5 February 2004, case C-326/01 P, Telefon & Buch/OHIM; Universaltelefonbuch

In German, the words Universaltelefonbuch and Universal-kommunikationsverzeichnis mean universal telephone directory and universal communications directory. They are properly formed in accordance with the grammatical rules of the German language and composed of common German words. The combinations of the words Telefonbuch and Kommunikationsverzeichnis designate the kind of goods and the intended use of the services in relation to which the application is filed and they can therefore be regarded as descriptive of those goods and services.

ECJ 16 September 2004, case C-329/02 P, Sat.1/OHIM; Sat.2

Sat.2 is a combination of a common abbreviation for satellite with a number, but can nevertheless have distinctive character

for a television channel. 'The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character.' (Para. 40).

The Community Trade Mark was registered on 6 February 2006.

ECJ 16 September 2004, case C-404/02, Nichols/Registrar of Trade Marks; Nichols
A common family name can be a trade mark.

'In the context of Article 3(1)(b) [Trade Mark Directive] [...], the assessment of the existence or otherwise of the distinctive character of a trade mark constituted by a surname, even a common one, must be carried out specifically, in accordance with the criteria applicable to any sign covered by Article 2 of that directive, in relation, first, to the products or services in respect of which registration is applied for and, second, to the perception of the relevant consumers. The fact that the effects of registration of the trade mark are limited by virtue of Article 6(1)(a) of that directive has no impact on that assessment.' (Operative part).

ECJ 5 October 2004, case C-192/03 P, Alcon/OHIM; BSS
The ECJ confirmed that the Court of First Instance had applied Article 7(1)(d) of the Regulation correctly, as it 'considered that the term BSS had, by the date of filing of the appellant's application for registration of the mark BSS, become a current generic term among the public targeted by the goods concerned, namely ophthalmologists and ophthalmic surgeons, for a balanced salt solution. That was apparent from a number of scientific dictionaries and articles, and from the fact that various companies marketed ophthalmic products under designations containing the term BSS.' (Para. 13).

'In considering that the BSS mark consisted exclusively of signs or indications which had become customary in the current language of the target public to designate the goods for which that mark had been registered, and that it had been lawfully declared invalid on that ground by the contested decision, the Court of First Instance correctly pointed out, [...], that it was not the descriptive nature of the mark that was decisive but current usage in the sectors covering trade in those goods.' (Para. 28).

ECJ 21 October 2004, case C-64/02 P, Erpo/OHIM; Das Prinzip der Bequemlichkeit
Slogans can be registered as a trade mark and no other or stricter criteria apply to their distinctive character. However, one should take into account 'the fact that average consumers

are not in the habit of making assumptions about the origin of products on the basis of such slogan.' (Para 34)
(The ECJ confirmed the decision of the CFI to quash the decision of the Board of Appeal to apply stricter criteria. See meanwhile Board of Appeal 27 January 2006 (R 392/1999-2): Trade Mark accepted and registered).



ECJ 9 March 2006, case C-421/04, Matratzen Concord/Hukla; Matratzen

In Spain, the word Matratzen can be a valid trade mark for mattresses even if it is fully descriptive for mattresses in German.

'Article 3(1)(b) and (c) of [Trade Mark Directive] [...] does not preclude the registration in a Member State, as a national trade mark, of a term borrowed from the language of another Member State in which it is devoid of distinctive character or descriptive of the goods or services in respect of which registration is sought, unless the relevant parties in the Member State in which registration is sought are capable of identifying the meaning of the term.' (Operative part).

See also: ECJ 28 April 2004, case C-3/03 P, Matratzen Concord/OHIM-Hukla.

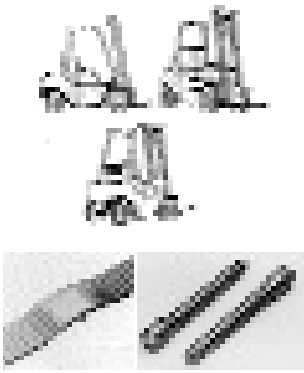


ECJ 15 September 2005, case C-37/03 P, BioID/OHIM; BioID

BioID is the abbreviation of the adjective 'biometrical' and of the noun 'identification', and thus, as a whole, means 'bio-metrical identification'. 'Therefore, that abbreviation, which is indistinguishable from the goods and services covered by the trade mark application, is not of a character which can guarantee the identity of the origin of the marked product or service to the consumer or end-user from the viewpoint of the relevant public'.

'In addition, in the light of the recurrent nature of the typographical features of the abbreviation BioID and the absence of any particular distinctive element, the characters in 'Arial' type-face and characters of different boldness do not enable the trade mark applied for to guarantee, to the relevant public, the identity of the origin of the goods and services covered by the trade mark application.

Furthermore, the two graphic elements placed after the abbreviation BioID, namely a full stop (.) and a sign (®), do nothing to enable the relevant public to distinguish, without any possibility of confusion, the products or services covered by the trade mark application from others which have another origin. It follows that those graphic elements are not capable of fulfilling the essential function of a trade mark, [...], in relation to the relevant goods and services.' (Paras. 70-72).



Linde/Winward/Rado

(shape marks, public interest)

ECJ 8 April 2003, joined cases C-53/01 to C-55/01,
Linde, Winward & Rado/DPMA
Article 3(1)(b)(c) Trade Mark Directive

When assessing distinctiveness, no stricter test applies to shape marks (three-dimensional marks), but in view of the perception of the public it may be harder to prove distinctive character. The 'public interest' should be taken into account.

Linde, Winward and Rado sought registration with the German Trade Mark Office for the shape of a forklift truck, a watch and a flashlight respectively. They were all refused.

'When assessing the distinctiveness of a three-dimensional shape of product trade mark for the purposes of Article 3(1)(b) [Trade Mark Directive] [...], a stricter test than that used for other types of trade mark must not be applied.' (Operative part, para 1).

By reason of the 'perception' of the public it can 'in practice be more difficult to establish distinctiveness in relation to a shape of product mark than a word or figurative trade mark. But whilst that may explain why such a mark is refused registration, it does not mean that it cannot acquire distinctive character following the use that has been made of it and thus be registered as a trade mark under Article 3(3) of the Directive.'

'Independently of Article 3(1)(e) [Trade Mark Directive], Article 3(1)(c) also has significance for three-dimensional shape of product trade marks.

When examining the ground for refusing registration in Article 3(1)(c) [Trade Mark Directive] in a concrete case, regard must be had to the public interest underlying that provision, which is that all three-dimensional shape of product trade marks which consist exclusively of signs or indications which may serve to designate the characteristics of the goods or service within the meaning of that provision should be freely available to all and, subject always to Article 3(3) of the Directive, cannot be registered.' (Operative part, para 2).



Henkel

(shape of packaging)

ECJ 12 February 2004, case C-218/01,
Henkel/DPMA; liquid wool detergent
Article 3(1)(b), (c) and (e) Trade Mark Directive

In case of goods that do not have a shape themselves, for instance liquids, the shape of the packaging of goods must be assimilated to the shape of the goods (within the meaning of Article 3(1)(e)). A mark which differs significantly from the norm of what is common in the industry in question, has distinctive character. The perception of the public of a shape mark is different from the perception of a word or figurative mark.

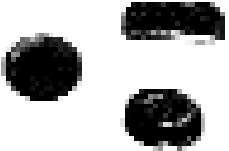
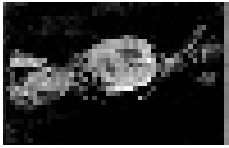
Henkel objected to the refusal by the German Trade Mark Office to register the shape mark reproduced below for liquid wool detergent

'For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packing thereof must be assimilated to the shape of the goods, so that that packing may constitute the shape of the goods within the meaning of Article 3(1)(e) [Trade Mark Directive] and may, where appropriate, serve to designate characteristics of the packaged goods, including their quality, within the meaning of Article 3(1)(c) of that directive.' (Operative part, para 1).

'In any event, the perception of the average consumer is not necessarily the same in the case of a three-dimensional trade mark, consisting of the packaging of a product, as it is in the case of a word or figurative mark which consists of a sign that is independent from the appearance of the goods it denotes. Average consumers are not in the habit of making assumptions about the origin of goods based on the shape of their packaging, in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in the case of such a three-dimensional trade mark than in the case of a word or figurative mark.' (Para. 52).

'For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the product, their distinctive character within the meaning of Article 3(1)(b) must be assessed by reference to the perception of the average consumer of such goods, who is reasonably well informed and reasonably observant and circumspect. Such a trade mark must enable such a consumer to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention.' (Operative part, para 2).

A simple derogation from the norm of what is common in the industry in question does not suffice. On the contrary, only a mark which differs significantly from the norm and thereby fulfils its essential function as origin indication, does have distinctive character.



Storck tried to obtain a Community Trade Mark registration for the shape of its Werther's Original sweets and its gold-coloured wrapper with twisted ends, reproduced below.

Werther's Original

(acquired distinctiveness of shape of a sweet)

ECJ 22 June 2006, cases C-24/05 and C-25/05, Storck/OHIM; shape of a sweet
Article 7(1), (2) and (3) Trade Mark Regulation

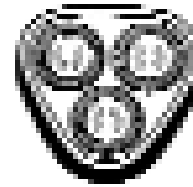
A three-dimensional mark may in certain circumstances acquire distinctive character through use even if it is used in conjunction with a word mark or a figurative mark. Evidence of acquired distinctive character is required in that part of the Community in which the sign did not, ab initio, have such character.

Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) [Trade Mark Regulation]. 'Therefore, the Court of First Instance rightly took into consideration the shapes and colours of sweets commonly used in trade in assessing whether the mark applied for is, or is not, devoid of any distinctive character.' (Para 27, case C-24/05).

'A three-dimensional mark may in certain circumstances acquire distinctive character through use even if it is used in conjunction with a word mark or a figurative mark. Such is the case where the mark consists of the shape of the product or its packaging and where they systematically bear a word mark under which they are marketed.' (Para. 59, case C-24/05).

'It follows that a mark can be registered under Article 7(3) [Trade Mark Regulation] only if evidence is provided that it has acquired, through the use which has been made of it, distinctive character in the part of the Community in which it did not, ab initio, have such character for the purposes of Article 7(1)(b). The part of the Community referred to in Article 7(2) may be comprised of a single Member State' (Para. 83, case C-25/05).

'Since, in paragraphs 85 to 87 of the judgment under appeal, following an assessment of the facts and evidence, the Court of First Instance found, first, that the mark applied for was devoid of any distinctive character, ab initio, in all of the Member States of the Community and, second, that the appellant did not establish that that mark was the subject of advertising campaigns in certain Member States during the reference period, it rightly found that the figures provided in relation to the advertising costs incurred by the appellant did not provide proof that the mark had acquired distinctive character as a result of the use which had been made of it.' (Para. 86, case C-25/05).



Philips/Remington

(shape technically dictated)

ECJ 18 June 2002, case C-299/99, Philips/Remington; three-headed shaver
Article 3(1)(e) Trade Mark Directive

A shape cannot be registered as a trade mark if its essential functional features are attributable only to a technical result. Such a shape can never acquire distinctive character by the use made of it.

Philips objected to the sale by Remington of three-headed shaving devices on the basis of shape marks.

'In refusing registration of such signs, Article 3(1)(e), second indent [Trade Mark Directive], reflects the legitimate aim of not allowing individuals to use registration of a mark in order to acquire or perpetuate exclusive rights relating to technical solutions.' (Para. 82).

'A sign which is refused registration under Article 3(1)(e) of the Directive can never acquire a distinctive character for the purposes of Article 3(3) by the use made of it.' (Para. 75).

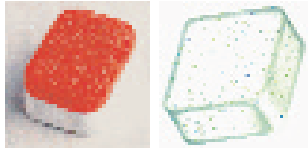
'The rationale of the grounds for refusal of registration laid down in Article 3(1)(e) of the Directive is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors. Article 3(1)(e) is thus intended to prevent the protection conferred by the trade mark right from being extended, beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competitors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark.' (Para. 78)

'Article 3(1)(e), second indent [Trade Mark Directive] must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result. Moreover, the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained.' (Operative, para 4).

'In order to be capable of distinguishing an article for the purposes of Article 2 of the Directive, the shape of the article in respect of which the sign is registered does not require any capricious addition, such as an embellishment which has no functional purpose.' (Operative, para 2).

Other cases concerning shape marks

Article 7(1)(b) Trade Mark Regulation



ECJ 29 April 2004, cases C-456/01 P, C-457/01 P and C-468/01 P t/m C-472/01 P, Henkel and P&G/OHIM; dishwasher tablets

The bicoloured dishwasher tablet of Henkel and the speckled dishwasher tablet of Procter & Gamble (see pictures) do not have any distinctive character.



ECJ 7 October 2004, case C-136/02 P, Maglite/OHIM; flashlight

The five registered Maglite flashlights lack any distinctive character. The fact that they can be considered to be 'high-quality design' does not automatically imply distinctive character.



ECJ 30 June 2005, C-286/04 P, Eurocermex/OHIM; Corona beer bottle

The shape of a bottle with a long neck in which a slice of lemon has been wedged and for which the colours yellow and green are claimed, does not have distinctive character for, inter alia, beer. (The ECJ does not give an opinion on the merits).



ECJ 12 January 2006, C-173/04 P, SiSi/OHIM; standing pouches

The ECJ confirms the opinion of the Court of First Instance that such pouches 'were devoid of any distinctive character on the ground that that form of packaging is already in general use in the Community for liquids for human consumption and that, therefore, it is not sufficiently unusual for the average consumer to perceive it, per se, as an indication of the specific commercial origin of a product within that category.' (Para. 66).



ECJ, 23 September 2004, case C-107/03 P, Procter & Gamble/OHIM; bar of soap

The Court concludes that the Court of First Instance correctly applied the criteria for the assessment of distinctiveness. As the Court of First Instance has exclusive jurisdiction to find and appraise the relevant facts, the Court of Justice does not give its opinion about the conclusion of the CFI that the claimed shape is only a slight variation on the various parallelepipedal shapes commonly used for soaps, and will not enable the relevant public to distinguish immediately and with certainty the applicant's soaps from those having a different trade origin. The concave profiles will be primarily interpreted as a functional feature making the soap easier to grip or as an aesthetic finish.



Decisions by the Court of First Instance (CFI) in which the CFI held that there was sufficient distinctive character



CFI 5 March 2003, case T-128/01, DaimlerChrysler/OHIM; Jeep-grille

Sufficiently distinctive and not technically dictated. 'The Court observes that the sign in question comprises a representation of the front part of a car having an irregular shape and with seven wide vertical openings in the centre and a circle representing the headlights of the vehicle on each side at the top. At the time when the application was filed, this shape was an unusual grille design, conveying the impression of an old-fashioned grille, in a simple configuration, which cannot be regarded as altogether commonplace in the circumstances at the time when the application was filed. Consequently the sign in question cannot be regarded as the image that naturally comes to mind as the typical representation of a contemporary grille. OHIM's finding that the sign in question is composed of features commonly used to represent a grille cannot therefore be upheld.

In those circumstances the sign in question must be considered to be capable of leaving an impression on the memory of the target public as an indication of commercial origin and thus of distinguishing and setting apart motor vehicles bearing that grille from those of other undertakings.' (Paras. 46-48).



CFI 3 December 2003, case T-305/02, Nestlé/OHIM; shape of a water bottle

The shape is truly specific and cannot be regarded as altogether commonplace. 'The elements of presentation, which make up the mark applied for, is truly specific and cannot be regarded as altogether commonplace: 'That combination [of visual elements] thus gives the bottle at issue a particular appearance which, taking account also of the overall aesthetic result, is capable of holding the attention of the public concerned and enabling that public, made aware of the shape of the packaging of the goods in question, to distinguish the goods covered by the registration application from those with a different commercial origin.' (Para. 41).



CFI 24 November 2004, case T-393/02, Henkel/OHIM; shape of a white and transparent bottle

A particular and unusual appearance. The combination of visual aspects confers on the bottle in question 'a particular and unusual appearance which is likely to attract the attention of the relevant public and enable that public, once familiar with the shape of the packaging of the goods in question, to distinguish the goods covered by the registration application from those having a different commercial origin.' (Para. 40).

Libertel

(colour marks, general interest)

ECJ 6 May 2003, case C-104/01,
Libertel/BMB; colour orange
Articles 2 and 3 Trade Mark Directive

A colour per se can be a mark, but this usually requires acquired distinctiveness. Attention should be paid to the general interest in not unduly restricting the availability of colours. For registration of a colour mark reproduction on paper and/or description of the colour is not sufficient, an internationally recognized colour code is required.

Libertel filed a colour mark application for the colour orange (PMS 144) for (mobile) telecommunication services.

'A colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of Article 3(1)(b) and Article 3(3) [Trade Mark Directive] [...], provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code.' (Operative part in 1).

'In assessing the potential distinctiveness of a given colour as a trade mark, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought.' (Operative part in 2).

'A colour per se may be found to possess distinctive character within the meaning of Article 3(1)(b) and Article 3(3) [Trade Mark Directive], provided that, as regards the perception of the relevant public, the mark is capable of identifying the product or service for which registration is sought as originating from a particular undertaking and distinguishing that product or service from those of other undertakings.' (Operative part in 3).

As a rule acquired distinctiveness is required. 'In the case of a colour per se, distinctiveness without any prior use is inconceivable save in exceptional circumstances, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific.' (Para. 66).

Heidelberger Bauchemie

(colour combinations)

ECJ 24 June 2004, case C-49/02, Heidelberger Bauchemie;
blue and yellow

Articles 2 and 3 Trade Mark Directive

A colour combination can be a trade mark, but registration requires (next to a colour example, a description and an internationally recognised colour code) a 'systematic arrangement'.

Heidelberger Bauchemie filed a colour mark application for the combination of blue and yellow (trade mark reproduction: a rectangular piece of paper, the top half of which is blue and the bottom half is yellow) provided with colour codes and a description: 'The applied for mark consists of the company colours of the applicant which are used in all conceivable forms, in particular for packaging and labels'.

'The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', as is the case with the trade mark which is the subject of the main proceedings, does not exhibit the qualities of precision and uniformity required by Article 2 of the Directive, as construed in paragraphs 25 to 32 of this judgment. Such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to repeat with certainty the experience of a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.' (Paras. 34-35).

'Colours or combinations of colours [. . .], claimed in the abstract, without contours, and in shades which are named in words by reference to a colour sample and specified according to an internationally recognised colour classification system may constitute a trade mark for the purposes of Article 2 [Trade Mark Directive] where it has been established that, in the context in which they are used, those colours or combinations of colours in fact represent a sign, and the application for registration includes a systematic arrangement associating the colours concerned in a predetermined and uniform way.' (Operative part in 1).

'Even if a combination of colours satisfies the requirements for constituting a trade mark for the purposes of Article 2 of the Directive, it is still necessary for the competent authority for registering trade marks to decide whether the combination claimed fulfils the other requirements laid down, particularly in Article 3 of the Directive, for registration as a trade mark in relation to the goods or services of the undertaking which has applied for its registration. Such an examination must take account of all the relevant circumstances of the case, including any use which has been made of the sign in respect of which trade mark registration is sought. That examination must also take account of the public interest in not unduly restricting the availability of colours for other traders who market goods or services of the same type as those in respect of which registration is sought.' (Operative part in 2).

Sieckmann

(smell marks)

ECJ 12 December 2002, case C-273/00, Sieckmann/DPM;
smell mark
Article 2 Trade Mark Directive

A sign which is not in itself capable of being perceived visually, can be registered as a trade mark, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. This is (probably) not (yet) possible for smells.

Sieckmann filed a smell mark (olfactory mark) application consisting of the chemically pure substance methyl cinnamate (cinnamon acid methyl ester), chemical formula: $C_6H_5-CH=CHCOOCH_3$, with a container with an odour sample and the statement that the colour is usually described as balm-like fruity with a hint of cinnamon.

From the perspective of register clarity due graphical representation is required. 'Article 2 [Trade Mark Directive] [...] must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.' (Operative part, para 1).

'Few people would recognise in such a formula the odour in question. Such a formula is not sufficiently intelligible. In addition, [...], a chemical formula does not represent the odour of a substance, but the substance as such, and nor is it sufficiently clear and precise. It is therefore not a representation for the purposes of Article 2 of the Directive. In respect of the description of an odour, although it is graphic, it is not sufficiently clear, precise and objective. As to the deposit of an odour sample, it does not constitute a graphic representation for the purposes of Article 2 of the Directive. Moreover, an odour sample is not sufficiently stable or durable.' (Paras. 69-71).

'In respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.' (Operative part, para 2).

Shield Mark

(sound marks)



ECJ 27 November 2003, case C-283/01,
Shield Mark/BMB; sound marks
Article 2 Trade Mark Directive

A musical stave meets the requirement of graphical representation of a sound mark, a description or an onomatopoeia does not.

Shield Mark filed several sound mark applications for the first nine notes of Für Elise of Ludwig von Beethoven and for a cockcrow.

'Article 2 [Trade Mark Directive] is to be interpreted as meaning that sound signs must be capable of being regarded as trade marks provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically.

Article 2 [Trade Mark Directive] must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

In the case of a sound sign, those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as an indication that the sign consists of the notes going to make up a musical work, or the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more.

On the other hand, those requirements are satisfied where the sign is represented by a stave divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.' (Operative part).

Other cases on refusal on absolute grounds

Articles 2 and 3 Trade Mark Directive



ECJ 28 June 2004, case C-445/02 P, Glaverbel/OHIM; glass-sheet surface

Glaverbel applied for a Community Trade Mark registration for a design to be applied to glass products for sanitary installations (see picture).

The Court of First Instance 'found that the design, which consists of countless tiny strokes applied to the surface of the sheet, no matter what its area, forms part of the appearance of the product itself and embodies obvious characteristics of the product, with the result that it is perceived primarily as a technical means of rendering the glass opaque. Moreover, it stated that the complexity and fancifulness of the design in respect of which registration was sought is attributable rather to the ornamental and decorative nature of the design's finish.

The overall complexity of the design and the fact that it is applied to the external surface of the product do not allow the design's individual details to be committed to memory or the design to be apprehended without the product's inherent qualities being perceived simultaneously. Finally, it took the view that the impression conveyed by the sign is not fixed and varies according to the angle from which the goods are viewed, the brightness of the light and the quality of the glass.' (Para. 33).

The Court of First Instance concluded that the sign does not serve as an indication of origin for the relevant public, which is composed of both professionals in the construction field and the public in general.

Statements by consumers and professionals to the effect that they do recognise the products as originating from Glaverbel do not change this. This is an assessment of the facts which is not for the ECJ to decide.



ECJ 21 October 2004, case C-447/02, KWS Saat/OHIM; colour orange

The colour orange (colour code HKS7) is not rare for seed products and seed processing machines and cannot be a mark (without acquired distinctiveness).

ECJ 7 July 2005, case C-418/02, Praktiker Märkte/DPMA; retail trade services

A mark can be registered for 'retail trade services'. The German Trade Mark Office refused to register the mark Praktiker as mark for 'retail trade in building, home improvement and gardening goods for the do-it-yourself sector'.

'The concept of 'services' referred to by the [Trade Mark Directive], in particular in Article 2, covers services provided in connection with retail trade in goods. For the purposes of registration of a trade mark for such services, it is not necessary to specify in detail the service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate.' (Operative part).

ECJ 30 March 2006, case C-259/04, Elizabeth Emanuel/Continental Shelf 128; Elizabeth Emanuel
Registration of a mark (I.C. Elizabeth Emanuel) which is identical to the name of the designer and first producer of, in this case, clothing on which this mark has been affixed 'may not, by reason of that particular feature alone, be refused registration on the ground that it would deceive the public, within the meaning of Article 3(1)(g) [Trade Mark Directive] [...], in particular where the goodwill associated with that trade mark, previously registered in a different graphic form, has been assigned together with the business making the goods to which the mark relates.

A trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark is not, by reason of that particular feature alone, liable to revocation on the ground that that mark would mislead the public, within the meaning of Article 12(2)(b) [Trade Mark Directive], in particular where the goodwill associated with that mark has been assigned together with the business making the goods to which the mark relates.' (Operative part).

Arthur & Félicie

(sign identical to mark)



ECJ 20 March 2003, case C-291/00,
LTJ Diffusion/Sadas; Arthur (& Félicie)
Article 5 (1)(a) Trade Mark Directive

A sign is identical to a trade mark if it represents all elements of that trade mark without any change or addition.

LTJ Diffusion objected on the basis of its word and figurative mark Arthur for, inter alia, clothing to the use of the mark Arthur & Félicie by Sadas, also for clothing.

'Article 5(1)(a) [Trade Mark Directive] [...] must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.' (Operative part).

'The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Article 5(1)(a) of the directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the directive.

There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question.' (Paras. 50-52).

Compare: CFI 24 November 2005, case T 346/04:
Arthur & Félicie does infringe earlier mark Arthur under '(b)'.



Puma/Sabel

(confusion and association)

ECJ 11 November 1997, case C-251/95,
Puma/Sabel; bounding feline
Article 4 and 5 (1)(b) Trade Mark Directive

The only relevant criterion in Articles 4 and 5(1)(b) Trade Mark Directive is likelihood of confusion. The addition 'which includes likelihood of association' has little significance.

Puma objected on the basis of its figurative mark representing a puma to the trade mark registration of Sabel of a 'bounding feline', for, inter alia, leather goods.

'The criterion of 'likelihood of confusion which includes the likelihood of association with the earlier mark' contained in Article 4(1)(b) [Trade Mark Directive] [...] is to be interpreted as meaning that the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion within the meaning of that provision.' (Operative part).

'The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

[...] The perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

[...] The more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.

However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion.' (Paras. 22-25).

Canon/Cannon

(similarity and reputation)

ECJ 29 September 1998, case C-39/97,
Canon/Metro-Goldwyn-Mayer; Canon/Cannon
Article 4 and 5 (1)(b) Trade Mark Directive

*Similarity of goods and services also depends on
the reputation of the earlier mark.*

Canon objected to the trade mark registration by Metro-Goldwyn-Mayer of the word mark Cannon for, inter alia, video tape cassettes.

'On a proper construction of Article 4(1)(b) [Trade Mark Directive] [...] the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion.' (Operative part).

'A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.' (Para. 17).

'There may be a likelihood of confusion within the meaning of Article 4(1)(b) [Trade Mark Directive] even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings.' (Operative part).

Lloyd/Loint's

(confusion and aural similarity)

ECJ 22 June 1999, case C-342/97,
Lloyd/Klijnsen; Lloyd/Loint's
Article 5 (1)(b) Trade Mark Directive

Likelihood of confusion by the average consumer is to be assessed globally, but mere aural similarity may suffice to assume likelihood of confusion. 'For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect'.

Lloyd Schuhfabrik objected on the basis of its word mark Lloyd, for shoes, to the registration by Klijnsen of the word mark Loint's, also for shoes.

'It is possible that mere aural similarity between trade marks may create a likelihood of confusion within the meaning of Article 5(1)(b) [Trade Mark Directive] [...]. The more similar the goods or services covered and the more distinctive the earlier mark, the greater will be the likelihood of confusion. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make a global assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings.' (Operative part).

'For the purposes of that global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998] ECR I -4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.' (Para. 26).

'In making that assessment, account should be taken of all relevant factors and, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered. It is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has a strong distinctive character.' (Operative part).



Picasso/Picaro

(likelihood of confusion)

ECJ 12 January 2006, case C-361/04, The Picasso estate/DaimlerChrysler; Picasso/Picaro
Article 8(1)(b) Trade Mark Regulation

Visual and phonetic similarity may be counteracted by an explicit conceptual difference.

The Picasso heirs objected on the basis of the word mark Picasso for, inter alia, cars to the registration of the word mark Picaro by Daimler-Chrysler, also for cars.

The marks Picasso and Picaro are visually and phonetically similar. 'From the conceptual point of view, the word Picasso is particularly well known to the relevant public as being the name of the famous painter Pablo Picasso. The word Picaro may be understood by Spanish-speaking persons as referring, inter alia, to a character in Spanish literature, whereas it has no semantic content for the (majority) non-Spanish-speaking section of the relevant public.

Such conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately.' (Paras. 55- 56).

'Where it is established in fact that the objective characteristics of a given product mean that the average consumer purchases it only after a particularly careful examination, it is important in law to take into account that such a fact may reduce the likelihood of confusion between marks relating to such goods at the crucial moment when the choice between those goods and marks is made.' (Para. 40).

'In doing so, the Court did not in any way express a general rule from which it could be inferred that, for the purposes of an assessment of the likelihood of confusion within the meaning of Article 5(1)(b) [Trade Mark Directive] or Article 8(1)(b) [Trade Mark Regulation], there is no need to refer specifically to the particularly high level of attention displayed by consumers when purchasing a certain category of goods.' (Para. 47).

Other cases concerning confusion

Article 8(1)(b) Trade Mark Regulation
Article 5(1)(b) Trade Mark Directive

ECJ 22 June 2000, case C-425/98, Marca/Adidas;
three versus two stripes

Marca sold clothing with two stripes, Adidas objected to this on the basis of its well-known three-stripe mark. 'Article 5(1)(b) [Trade Mark Directive] [...] cannot be interpreted as meaning that where:

- A trade mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public, and
- A third party, without the consent of the proprietor of the mark, uses, in the course of trade in goods or services which are identical with, or similar to, those for which the trade mark is registered, a sign which so closely corresponds to the mark as to give rise to the possibility of its being associated with that mark, the exclusive right enjoyed by the proprietor entitles him to prevent the use of the sign by that third party if the distinctive character of the mark is such that the possibility of such association giving rise to confusion cannot be ruled out.' (Operative part).

'The Court [in Puma/Sabel] did not excuse the national court from the necessary positive finding of the existence of a likelihood of confusion which constitutes the matter to be proved.' (Para. 39).

See also: ECJ 23 October 2003, case C-408/01, Adidas/Fitnessworld Trading.



ECJ 28 April 2004, case C-3/03 P, Matratzen Concord/OHIM-Hukla; Matratzen

Hukla opposed the registration of a word and visual mark as a Community Trade Mark (see picture) for mattresses by Matratzen Concord on the basis of its Spanish word mark Matratzen. (Matratzen is the German word for mattresses, but it is unknown in Spanish).

The Court of First Instance concluded that the word Matratzen was the dominant element of the trade mark applied for. It therefore held, that, from the point of view of the relevant (Spanish) public, there existed a visual and aural similarity between the two trade marks.

Finally, the Court held that, considered cumulatively, the degree of similarity between the trade marks in question and the degree of similarity between the goods covered by them was sufficiently high and that the Board of Appeal was

therefore entitled to hold that there was a likelihood of confusion between the trade marks in question.

'The Court rightly pointed out, [...], that the assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. It also held that that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.' (Para 32).

See also ECJ 9 March 2006, C-421/04, Matratzen Concord/Hukla.



ECJ 23 March 2006, case C-206/04 P, Mülhens/OHIM en Zirh; Sir/Zirh

The word mark Zihr does not infringe the word and figurative mark Sir. Aural similarity in this case is insufficient to assume infringement. 'That global assessment means that conceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately.' (Para. 35, reference to Picasso/Picaro).

ECJ 27 April 2006, case C-235/05 P, L'Oréal/OHIM – Revlon; Flex/Flexi Air

Revlon opposed the registration of the word mark Flexi Air by L'Oreal, for hair care products, on the basis of its word mark Flex. The Court of First Instance held that, notwithstanding the weak distinctive character of the earlier mark, there was a likelihood of confusion between the signs and, accordingly, between the marks covered by them.

'In that regard, the Court of First Instance cannot be criticised for not having disregarded, in its examination of the similarity of the signs in question, the element FLEX, which is common to the marks, on the ground that the earlier mark is only of weak distinctive character. In the first place, it is settled case-law that in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to determine the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed [...]. In addition, the global assessment of the likelihood of confusion must, as regards the visual, aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion.' (Paras. 39-41).

ECJ 12 October 2004, case C-106/03 P, Vedral/OHIM; Saint-Hubert 41/Hubert

Word and figurative mark Hubert (see picture) is insufficiently similar to the earlier French word mark Saint-Hubert 41 to assume likelihood 'whatever the reputation of the earlier mark and regardless of the degree of identity or similarity of the goods or services concerned.' (Para. 54).



ECJ 6 October 2005, case C-120/04, Medion/Thomson; Life/Thomson Life

Earlier mark Life versus later mark Thomson Life. Rejection of so-called German 'Präge theory'. (According to this theory upon comparison of overall impressions the most 'geprägte' (impressive, striking) element, i.e. Thomson, would mainly put the 'only co-defining' element Life in the background).

There may be confusion amongst the public between identical goods and services 'where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein.'

ECJ 1 December 2005, case C-512/04 P, Vitakraft/OHIM-Krafft; Krafft/Vitakraft

The Spanish company Krafft opposes the registration of the word mark Vitakraft on the basis of its Spanish word and figurative marks containing the word Krafft (see pictures). According to the Court of First Instance there is a risk of confusion, because to a Spanish audience the element KRAFT is the most distinctive part, because this word does not have a meaning in Spanish. This is an assessment of the facts which is not for the ECJ to decide.



ECJ, 1 June 2006, case C-324/05 P, Plus Warenhandels-gesellschaft/OHIM; Power/Turkish Power

Opposition based on older national wordmark Power against CTM application figurative mark Turkish Power. The Court emphasizes that likelihood of confusion is the only relevant criterion. There is no rule against the mere taking over an older mark as a word-element of a new mark. The question whether confusion is likely in a particular case, is not a question of law. It lies within the exclusive jurisdiction of the Court of First Instance to find and appraise the relevant facts and to assess the evidence.



Davidoff/Gofkid

(dilution and similar goods)



ECJ 9 January 2003, case C-292/00,
Davidoff/Gofkid; Davidoff/Durfee
Article 4(4)(a) and 5(2) Trade Mark Directive

Article 5(2) Trade Mark Directive (relating to dilution) also applies to use for identical or similar goods or services.

Davidoff objected on the basis of its word and figurative mark Davidoff, inter alia, smoking articles to the use of the word and figurative mark Durfee by Gofkid, for, inter alia, accessories for smokers.

'Articles 4(4)(a) and 5(2) [Trade Mark Directive] [...] are to be interpreted as entitling the Member States to provide specific protection for registered trade marks with a reputation in cases where a later mark or sign, which is identical with or similar to the registered mark, is intended to be used or is used for goods or services identical with or similar to those covered by the registered mark.' (Operative part).

'When interpreting Article 5(2) of the Directive one should not exclusively start from the wording, but also the general set-up and purposes of the regulation which this provision is part of should be taken into account. The article cannot be interpreted in such sense that known trade marks would enjoy lesser protection if a sign is used for identical or similar goods or services, than if a sign is used for dissimilar goods or services.

On this point, it has not been seriously disputed before the Court that, where a sign is used for identical or similar goods or services, a mark with a reputation must enjoy protection which is at least as extensive as where a sign is used for non-similar goods and services.' (Paras. 24-26).

See also: Adidas/Fitnessworld



Chevy

(reputation)

ECJ 14 September 1999, case C-375/97,
General Motors/Yplon; Chevy
Article 5(2) Trade Mark Directive

In the Benelux territory, reputation in a significant part (of one country of) the Benelux is sufficient

General Motors objected on the basis of its Benelux word mark Chevy for cars of the use of the Benelux word mark Chevy for cleaning products by Yplon.

'Article 5(2) [Trade Mark Directive] [...] is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory.' (Operative part).

'If, at the end of its examination, the national court decides that the condition as to the existence of a reputation is fulfilled, as regards both the public concerned and the territory in question, it must then go on to examine the second condition laid down in Article 5(2) of the Directive, which is that the earlier trade mark must be detrimentally affected without due cause. Here it should be observed that the stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it.' (Para. 30).



Adidas objected on the basis of its 3-stripe figurative mark for sportswear to the use of two stripes on sportswear by Fitnessworld.

Adidas/Fitnessworld

(dilution and embellishment)

ECJ 23 October 2003, case C-408/01,
Adidas/Fitnessworld Trading; three stripes versus two stripes
Article 5(2) Trade Mark Directive

Article 5(2) Trade Mark Directive (relating to dilution) also applies to identical or similar goods or services. Confusion is not required, it suffices that the public establishes a link. If the public perceives the sign purely as an embellishment there is no trade mark infringement.

'A Member State, where it exercises the option provided by Article 5(2) [Trade Mark Directive] [...], is bound to grant the specific protection in question in cases of use by a third party of a later mark or sign which is identical with or similar to the registered mark with a reputation, both in relation to goods or services which are not similar and in relation to goods or services which are identical with or similar to those covered by that mark. (Operative part).

The protection conferred by Article 5(2) [Trade Mark Directive] is not conditional on a finding of a degree of similarity between the mark with a reputation and the sign such that there exists a likelihood of confusion between them on the part of the relevant section of the public. It is sufficient for the degree of similarity between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a link between the sign and the mark. (Operative part).

The fact that a sign is viewed as an embellishment by the relevant section of the public is not, in itself, an obstacle to the protection conferred by Article 5(2) [Trade Mark Directive] where the degree of similarity is none the less such that the relevant section of the public establishes a link between the sign and the mark. By contrast, where, according to a finding of fact by the national court, the relevant section of the public views the sign purely as an embellishment, it necessarily does not establish any link with a registered mark, with the result that one of the conditions of the protection conferred by Article 5(2) [Trade Mark Directive] is then not satisfied.' (Operative part).

See also: Davidoff/Gofkid & ECJ 22 June 2000, case C-425/98, Marca/Adidas.



LIMITATIONS

Dior/Evora

(advertising by reseller)

ECJ 4 November 1997, case C-337/95, Dior/Evora
Article 5 and 7 Trade Mark Directive

The reseller of a branded product is allowed to use a trade mark in his advertising for resale of a product.

Evora operated a chain of chemistshops called Kruidvat, which used in an advertising leaflet reproductions of (lawfully parallel imported) trade-marked perfumes (Eau sauvage, Poison, Fahrenheit and Dune) of Dior. Dior objected to this under copyright law and trade mark law.

'On a proper interpretation of Articles 5 and 7 [Trade Mark Directive], when trade-marked goods have been put on the Community market by the proprietor of the trade mark or with his consent, a reseller, besides being free to resell those goods, is also free to make use of the trade mark in order to bring to the public's attention the further commercialization of those goods.

The proprietor of a trade mark may not rely on Article 7(2) [Trade Mark Directive] to oppose the use of the trade mark, by a reseller who habitually markets articles of the same kind, but not necessarily of the same quality, as the trade-marked goods, in ways customary in the reseller's sector of trade, for the purpose of bringing to the public's attention the further commercialization of those goods, unless it is established that, given the specific circumstances of the case, the use of the trade mark for this purpose seriously damages the reputation of the trade mark.

On a proper interpretation of Articles 30 and 36 of the EC Treaty, the proprietor of a trade mark or holder of copyright may not oppose their use by a reseller who habitually markets articles of the same kind, but not necessarily of the same quality, as the protected goods, in ways customary in the reseller's sector of trade, for the purpose of bringing to the public's attention the further commercialization of those goods, unless it is established that, having regard to the specific circumstances of the case, the use of those goods for that purpose seriously damages their reputation.' (Operative part).



BMW/Deenink

(non-official mark dealer)

ECJ 23 February 1999, case C-63/97, BMW/Ronald Deenik
Article 5 and 7 Trade Mark Directive

A non-official dealer is allowed to use a car brand to show that he is specialized in a particular brand of cars, as long as he does not give the impression that he has a commercial relationship with the trade mark owner.

Deenik was a garage owner specialized in the sale of second-hand cars of the trade mark BMW, as well as in repair and maintenance of cars of the same trade mark. He was not a member of BMW's dealer network. BMW objected to his way of advertising.

'The use of a trade mark, without the proprietor's authorisation, for the purpose of informing the public that another undertaking carries out the repair and maintenance of goods covered by that mark or that it has specialised or is a specialist in such goods constitutes, in circumstances such as those described in the judgment making the reference, use of the mark within the meaning of Article 5(1)(a) [Trade Mark Directive].

Articles 5 to 7 [Trade Mark Directive] do not entitle the proprietor of a trade mark to prohibit a third party from using the mark for the purpose of informing the public that he carries out the repair and maintenance of goods covered by that trade mark and put on the market under that mark by the proprietor or with his consent, or that he has specialised or is a specialist in the sale or the repair and maintenance of such goods, unless the mark is used in a way that may create to the impression that there is a commercial connection between the other undertaking and the trade mark proprietor, and in particular that the reseller's business is affiliated to the trade mark proprietor's distribution network or that there is a special relationship between the two undertakings.' (Operative part).

'Lastly, the condition requiring use of the trade mark to be made in accordance with honest practices in industrial or commercial matters must be regarded as constituting in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark owner, similar to that imposed on the reseller where he uses another's trade mark to advertise the resale of products covered by that mark.' (Para. 61).



Arsenal/Reed

(a badge of support)

ECJ 12 November 2002, case C-206/01,
Arsenal/Matthew Reed
Article 5(1)(a) and 6 Trade Mark Directive

Affixing trade marks of soccer clubs on shawls and the like is trade mark use in the sense of Article 5(1)(a) trade mark directive. A disclaimer at the point of sale is no remedy. Post-sale confusion is a relevant factor.

Reed sold shawls provided with Arsenal marks. In his stall a notice stated: 'The word or logo(s) on the goods offered for sale, are used solely to adorn the product and does not imply or indicate any affiliation or relationship with the manufacturers or distributors of any other product, only goods with official Arsenal merchandise tags are official Arsenal merchandise'.

'Having regard to the presentation of the word Arsenal on the goods at issue in the main proceedings and the other secondary markings on them (see paragraph 39 above), the use of that sign is such as to create the impression that there is a material link in the course of trade between the goods concerned and the trade mark proprietor.

That conclusion is not affected by the presence on Mr Reed's stall of the notice stating that the goods at issue in the main proceedings are not official Arsenal FC products (see paragraph 17 above). Even on the assumption that such a notice may be relied on by a third party as a defence to an action for trade mark infringement, there is a clear possibility in the present case that some consumers, in particular if they come across the goods after they have been sold by Mr Reed and taken away from the stall where the notice appears, may interpret the sign as designating Arsenal FC as the undertaking of origin of the goods.' (Paras. 56 and 57).

'In a situation which is not covered by Article 6(1) [Trade Mark Directive] [...], where a third party uses in the course of trade a sign which is identical to a validly registered trade mark on goods which are identical to those for which it is registered, the trade mark proprietor of the mark is entitled, in circumstances such as those in the present case, to rely on Article 5(1)(a) of that directive to prevent that use. It is immaterial that, in the context of that use, the sign is perceived as a badge of support for or loyalty or affiliation to the trade mark proprietor.' (Operative part).

The English court of reference refused to apply the decision, because the ECJ had proceeded to establish itself the facts in a different way (High Court 12 December 2002). The Court of Appeal did however follow (the establishment of facts of) the ECJ (Court of Appeal 21 May 2003).



Gerri/Kerry Spring

(indication of geographical origin)

ECJ 7 January 2004, case C-100/02,
Gerolsteiner Brunnen/Putsch; Gerri/Kerry
Article 6(1)(b) Trade Mark Directive

Likelihood of aural confusion between an indication of geographical origin and a word mark is not decisive, the point is whether the use is in accordance with honest trade practices.

Gerolsteiner Brunnen objects by reason of its word mark Gerri for mineral water to the fact that Putsch markets soft drinks in Germany with labels containing the words Kerry Spring. These drinks are produced by the Irish company Kerry Spring Water with water from the Kerry Spring and bottled in Ballyferriter, in the county of Kerry in Ireland.

'The mere fact that there exists a likelihood of aural confusion between a word mark registered in one Member State and an indication of geographical origin from another Member State is therefore insufficient to conclude that the use of that indication in the course of trade is not in accordance with honest practices. In a Community of 15 Member States, with great linguistic diversity, the chance that there exists some phonetic similarity between a trade mark registered in one Member State and an indication of geographical origin from another Member State is already substantial and will be even greater after the impending enlargement.' (Para. 25).

'Article 6(1)(b) [Trade Mark Directive] [...] is to be interpreted as meaning that, where there exists a likelihood of aural confusion between a word mark registered in one Member State and an indication, in the course of trade, of the geographical origin of a product originating in another Member State, the proprietor of the trade mark may, pursuant to Article 5 [Trade Mark Directive], prevent the use of the indication of geographical origin only if that use is not in accordance with honest practices in industrial or commercial matters. It is for the national court to carry out an overall assessment of all the circumstances of the particular case in that regard.' (Operative part).

'It follows that, in a case such as that in the main proceedings, it is for the national court to carry out an overall assessment of all the relevant circumstances. Since the case concerns bottled drinks, the circumstances to be taken into account by that court would include in particular the shape and labelling of the bottle in order to assess, more particularly, whether the producer of the drink bearing the indication of geographical origin might be regarded as unfairly competing with the proprietor of the trade mark.' (Para. 26).



The packaging of the razor-blades of LA-laboratories contained the following text: 'All handles of Parason Flexor and of Gillette Sensor are compatible with this blade'.

Gillette/LA-Laboratories

(compatibility)

ECJ 17 March 2005, C-228/03, Gillette/LA-Laboratories
Article 6(1)(c) Trade Mark Directive

Use of a trade mark is allowed if it is necessary to indicate the intended use of a good.

'Use of the trade mark by a third party who is not its owner is necessary in order to indicate the intended purpose of a product marketed by that third party where such use in practice constitutes the only means of providing the public with comprehensible and complete information on that intended purpose in order to preserve the undistorted system of competition in the market for that product.

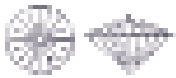
The condition of 'honest use' within the meaning of Article 6(1)(c) [Trade Mark Directive], constitutes in substance the expression of a duty to act fairly in relation to the legitimate interests of the trade mark owner.

The use of the trade mark will not be in accordance with honest practices in industrial and commercial matters if, for example:

- It is done in such a manner as to give the impression that there is a commercial connection between the third party and the trade mark owner.
- It affects the value of the trade mark by taking unfair advantage of its distinctive character or repute.
- It entails the discrediting or denigration of that mark.
- Or where the third party presents its product as an imitation or replica of the product bearing the trade mark of which it is not the owner.

The fact that a third party uses a trade mark of which it is not the owner in order to indicate the intended purpose of the product which it markets does not necessarily mean that it is presenting it as being of the same quality as, or having equivalent properties to, those of the product bearing the trade mark.

Where a third party that uses a trade mark of which it is not the owner markets not only a spare part or an accessory but also the product itself with which the spare part or accessory is intended to be used, such use falls within the scope of Article 6(1)(c) [Trade Mark Directive] in so far as it is necessary to indicate the intended purpose of the product marketed by the latter and is made in accordance with honest practices in industrial and commercial matters.' (Operative part).



Spirit Sun



Context Cut

Spirit Sun and Context Cut are word marks of Freiesleben for gems of two special cutting shapes. Hölderhoff used these marks as reference to cutting shapes of his own products in a transaction with a jewellers.

Hölderhoff/Freiesleben

(use to indicate characteristics)

ECJ 14 May 2002, case C-2/00, Hölderhoff/Freiesleben; Spirit Sun & Context Cut Article 5(1) Trade Mark Directive

If someone uses a sign solely to denote the particular characteristics of the goods he is offering for sale so that there can be no question of the trade mark used being perceived as a sign indicative of the undertaking of origin, article 5(1) of the directive does not apply.

'Article 5(1) [Trade Mark Directive] is to be interpreted as meaning that the proprietor of a trade mark cannot rely on his exclusive right where a third party, in the course of commercial negotiations, reveals the origin of goods which he has produced himself and uses the sign in question solely to denote the particular characteristics of the goods he is offering for sale so that there can be no question of the trade mark used being perceived as a sign indicative of the undertaking of origin.' (Operative part).

PARALLEL TRADE

Silhouette/Hartlauer

(European exhaustion)



ECJ 16 July 1998, case C-355/96, Silhouette/Hartlauer; Silhouette spectacles Article 7(1) Trade Mark Directive

Only if a product bearing a trade mark is put on the market within the EU (or EEA) with the consent of the trade mark owner, the right to enforce the trade mark right is exhausted.

Hartlauer imported original, obsolete spectacle frames of the trade mark Silhouette from Bulgaria (i.e. 'parallel' trade from outside the EU and EEA). Trade mark owner Silhouette opposed to the import .

'In the light of those recitals, Articles 5 to 7 of the Directive must be construed as embodying a complete harmonisation of the rules relating to the rights conferred by a trade mark. That interpretation, it may be added, is borne out by the fact that Article 5 expressly leaves it open to the Member States to maintain or introduce certain rules specifically defined by the Community legislature. Thus, in accordance with Article 5(2), to which the ninth recital refers, the Member States have the option to grant more extensive protection to trade marks with a reputation.' (Para. 25).

'Moreover this interpretation is the only one which is fully in line with the purpose of the Directive, i.e. to ensure the operation of the internal market. A situation in which some Member States may provide in international exhaustion and others only in Community exhaustion, would after all inevitably result into restrictions of the free movement of goods and services.' (Paras. 26 and 27).

'Article 7(1) [Trade Mark Directive] cannot be interpreted as meaning that the proprietor of a trade mark is entitled, on the basis of that provision alone, to obtain an order restraining a third party from using his trade mark for products which have been put on the market outside the European Economic Area under that mark by the proprietor or with his consent.' (Operative part).

See also: Sebago/G-B Unic



Class International brought a container with toothpaste bearing the mark Aquafresh from South Africa into the Community in Rotterdam. Trade mark owner Beecham seized the goods when they were in transit.

Class International

(in transit)

ECJ 18 October 2005, case C-405/03,
Class/SmithKline Beecham; Aquafresh toothpaste
Article 5(1) and (3)(c) Trade Mark Directive
Article 9(1) and (2)(c) Trade Mark Regulation

As long as parallelimported goods are in transit and no final destination within the Community has been established, there is no trade mark infringement.

The trade mark owner cannot oppose 'the mere entry into the Community, under the external transit procedure or the customs warehousing procedure, of original goods bearing that mark which had not already been put on the market in the Community previously by that proprietor or with his consent. The trade mark proprietor cannot make the placing of the goods at issue under the external transit procedure or the customs warehousing procedure conditional on the existence, at the time of the introduction of those goods into the Community, of a final destination already specified in a third country, possibly pursuant to a sale agreement.'

'Offering' and 'putting on the market' the goods, within the meaning of Article 5(3)(b) [Trade Mark Directive] and Article 9(2)(b) [Trade Mark Regulation], may include, respectively, the offering and sale of original goods bearing a trade mark and having the customs status of non-Community goods, when the offering is done and/or the sale is effected while the goods are placed under the external transit procedure or the customs warehousing procedure. The trade mark proprietor may oppose the offering or the sale of such goods when it necessarily entails the putting of those goods on the market in the Community.'

'In a situation such as the one at issue in the main proceedings, it is for the trade mark proprietor to prove the facts which would give grounds for exercising the right of prohibition provided for in Article 5(3)(b) and (c) [Trade Mark Directive] and Article 9(2)(b) and (c) [Trade Mark Regulation], by proving either release for free circulation of the non-Community goods bearing his mark or an offering or sale of the goods which necessarily entails their being put on the market in the Community.' (Operative part).

Under the Piracy Regulation, seizure of imitation goods in transit is, possible, also if these goods are in transit to outside the EU. See: ECJ 6 April 2000, case C-383/98 (Polo/Dwidua) (not included).



Stüssy

(burden of proof)

ECJ 8 April 2003, case C-244/00,
Van Doren + Q/Lifestyle; Stüssy
Article 7(1) Trade Mark Directive

The parallel importer has to prove that the goods originate from inside the EU. If there is a real risk that national markets will be partitioned, the burden of proof may, however, rest upon the trade mark owner.

Lifestyle parallel imported clothing of the trade mark Stüssy into the EEA. Van Doorne was exclusive importer and objected to this.

'A rule of evidence according to which exhaustion of the trade mark right constitutes a plea in defence for a third party against whom the trade mark proprietor brings an action, so that the existence of the conditions for such exhaustion must, as a rule, be proved by the third party who relies on it, is consistent with Community law and, in particular, with Articles 5 and 7 [Trade Mark Directive] [...], as amended by the Agreement on the European Economic Area of 2 May 1992.

However, the requirements deriving from the protection of the free movement of goods enshrined, inter alia, in Articles 28 EC and 30 EC may mean that this rule of evidence needs to be qualified. Accordingly, where a third party succeeds in establishing that there is a real risk of partitioning of national markets if he himself bears that burden of proof, particularly where the trade mark proprietor markets his products in the European Economic Area using an exclusive distribution system, it is for the proprietor of the trade mark to establish that the products were initially placed on the market outside the European Economic Area by him or with his consent. If such evidence is adduced, it is for the third party to prove the consent of the trade mark proprietor to subsequent marketing of the products in the European Economic Area.' (Operative part).

Other cases on parallel trade

Article 7(1) Trade Mark Directive

ECJ 1 July 1999, case C-173/98, Sebago/G-B Unic; Docksidis

For there to be consent within the meaning of Article 7(1) of the directive, 'such consent must relate to each individual item of the product in respect of which exhaustion is pleaded'.

ECJ 20 November 2001, cases C-414/99 and C-415/99, Zino Davidoff/A & G Imports, Levi Strauss/Tesco and Costco; Cool water & Levi's

The consent of the trade mark owner for import within the EEA may be implied. However, an 'implied consent cannot be inferred:

- From the fact that the proprietor of the trade mark has not communicated to all subsequent purchasers of the goods placed on the market outside the European Economic Area his opposition to marketing within the European Economic Area.
- From the fact that the goods carry no warning of a prohibition of their being placed on the market within the European Economic Area.
- From the fact that the trade mark proprietor has transferred the ownership of the products bearing the trade mark without imposing any contractual reservations and that, according to the law governing the contract, the property right transferred includes, in the absence of such reservations, an unlimited right of resale or, at the very least, a right to market the goods subsequently within the European Economic Area.'

'With regard to exhaustion of the trade mark proprietor's exclusive right, it is not relevant:

- That the importer of goods bearing the trade mark is not aware that the proprietor objects to their being placed on the market in the European Economic Area or sold there by traders other than authorised retailers, or
- That the authorised retailers and wholesalers have not imposed on their own purchasers contractual reservations setting out such opposition, even though they have been informed of it by the trade mark proprietor.'

ECJ 30 November 2004, case C-16/03,

Peak Holding/Axolin-Elinor; Peak Performance

'Article 7(1) [Trade Mark Directive], as amended by the Agreement on the European Economic Area of 2 May 1992, must be interpreted as meaning that goods bearing a trade mark cannot be regarded as having been put on the market

in the European Economic Area where the proprietor of the trade mark has imported them into the European Economic Area with a view to selling them there or where he has offered them for sale to consumers in the European Economic Area, in his own shops or those of an associated company, without actually selling them.

In circumstances such as those of the main proceedings, the stipulation, in a contract of sale concluded between the proprietor of the trade mark and an operator established in the European Economic Area, of a prohibition on reselling in the European Economic Area does not mean that there is no putting on the market in the European Economic Area within the meaning of Article 7(1) [Trade Mark Directive], as amended by the Agreement on the European Economic Area, and thus does not preclude the exhaustion of the proprietor's exclusive rights in the event of resale in the European Economic Area in breach of the prohibition.' (Operative part).

Paranova parallel imported medicines of Bristol-Myers Squibb from Greece and other EU countries where the prices were low and sold them with profit in Denmark. The medicines were provided with other outer packaging and/or labels.

Paranova

(repackaging)

ECJ 11 July 1996, cases C-427/93, C-429/93 and C-436/93, Bristol-Myers Squibb and Boehringer/Paranova
Article 7(2) Trade Mark Directive

Repackaging of medicines for parallel import is allowed, if this is necessary, if the product and the reputation are not prejudiced and the trade mark owner has been informed.

The trade mark owner may oppose the repackaging of a pharmaceutical product under Article 7(2) Trade Mark Directive, unless:

- 1 This would contribute to the artificial partitioning of the markets between Member States; such is the case, in particular, where the trade mark owner sells an identical pharmaceutical product in different packaging in several Member States and the repackaging is necessary in order to market the product in the Member State of importation, and also carried out in such conditions that the original condition of the product cannot be affected by it;
- 2 It is shown that the repackaging cannot affect the original condition of the product inside the packaging. In particular if only a new outer packaging is applied or a label is adhered;
- 3 The new packaging clearly states who repackaged the product and the name of the manufacturer;
- 4 The presentation of the repackaged product is not such as to be liable to damage the reputation of the trade mark and of its owner; thus, the packaging must not be defective, of poor quality, or untidy; and
- 5 The importer gives notice to the trade mark owner before the repackaged product is put on sale, and, on demand, supplies him with a specimen of the repackaged product. (abbreviated version of Operative part).

Other packaging decisions

Article 7(2) Trade Mark Directive

ECJ 11 November 1997, case C-349/95, Frits Loendersloot/Ballentine

The owner of trade mark rights may, even if that constitutes a barrier to intra-Community trade, rely on those rights to prevent a third party from removing and then reaffixing or replacing labels bearing the mark which the owner has himself affixed to products he has put on the Community market, unless:

- 1 It is established that the use of the trade mark rights by the owner to oppose the marketing of the relabelled products under that trade mark would contribute to artificial partitioning of the markets between Member States.
- 2 It is shown that the relabelling cannot affect the original condition of the product;
- 3 The presentation of the relabelled product is not such as to be liable to damage the reputation of the trade mark and its owner and
- 4 The person who relabels the products informs the trade mark owner of the relabelling before the relabelled products are put on sale.'

ECJ 12 October 1999, case C-379/97, Upjohn/Paranova; Dalacin

Upjohn put the antibiotic clindamycine in various forms on the market in the Community. In Denmark, Germany and Spain under the mark Dalacin, in France under the mark Dalacine and in the other Member States under the mark Dalacin C. ParalelimporterParanova bought the medicines in one country, repacked them and sold them in another country under the mark used there.

Such repackaging is only allowed if it is 'objectively necessary' for the parallel importer to be able to put the product on the market in another country.

ECJ 23 April 2002, case C-443/99, MSD/Paranova

'Replacement packaging of pharmaceutical products is objectively necessary within the meaning of the Court's case law if, without such repackaging, effective access to the market concerned, or to a substantial part of that market, must be considered to be hindered as the result of strong resistance from a significant proportion of consumers to relabelled pharmaceutical products.' (Operative part).

ECJ 23 April 2002, case C-143/00, Boehringer/Swingward

The trade mark owner is allowed to oppose repackaging, unless this 'contributes to artificial partitioning of the markets of the Member States'.

'A parallel importer must, in any event, in order to be entitled to repackage trade-marked pharmaceutical products, fulfil the requirement of prior notice. If the parallel importer does not satisfy that requirement, the trade mark proprietor may oppose the marketing of the repackaged pharmaceutical product. It is incumbent on the parallel importer himself to give notice to the trade mark proprietor of the intended repackaging. In the event of dispute, it is for the national court to assess, in the light of all the relevant circumstances, whether the proprietor had a reasonable time to react to the intended repackaging.' (Operative part in 3).

Parallel imports within the EEA

Articles 28-30 and 85 EC

ECJ 13 July 1966, cases 56-58/64, Grundig, Consten/EC; Gint

Grundig had transferred the trade mark Gint (acronym of Grundig International) to Consten, its exclusive distributor in France. Consten could thus counter parallel import from outside France. The agreement by which the trade mark Gint was transferred (and thus also the intended exercise of the trade mark right) was not considered lawful by the ECJ under Article 85 (old) EC, at present Article 81 EC.

ECJ 31 October 1974, case 16/74, Centrafarm/Winthrop; Negram

Trade mark owner Winthrop could not successfully oppose the import into the Netherlands by Centrafarm of the medicine Negram which was put on the market in England by (the parent company of) Winthrop.

'In relation to trade marks, the specific subject-matter of the industrial property is the guarantee that the owner of the trade mark has the exclusive right to use that trade mark, for the purpose of putting products protected by the trade mark into circulation for the first time, and is therefore intended to protect him against competitors wishing to take advantage of the status and reputation of the trade mark by selling products illegally bearing that trade mark.' (Para. 8).

ECJ 22 June 1976, case 119/75, Terrapin/Terranova

The German company Terranova opposed the registration in Germany of the trade mark Terrapin by the English company Terrapin on the basis of its own trade mark rights in the word Terranova.

'It is compatible with the provisions of the EEC Treaty relating to the free movement of goods for an undertaking established in a Member State, by virtue of a right to a trade mark and a right to a commercial name which are protected by the legislation of that state, to prevent the importation of products of an undertaking established in another Member State and bearing by virtue of the legislation of that State a name giving rise to confusion with the trade mark and commercial name of the first undertaking, provided that there are no agreements restricting competition and no legal or economic ties between the undertakings and that their respective rights have arisen independently of one another.' (Operative part).

NB: Since the Ideal Standard decision (see below) an independent origin of the rights is no longer required.

ECJ 22 June 1994, case C-9/93, IHT Danziger/Ideal Standard

After a (voluntary) full split up of trade mark rights, a consent of the trade mark owner leading to exhaustion of rights does no longer exist.

American Standard was owner of the trade mark Ideal Standard through its German and French subsidiary (Ideal-Standard GmbH and Ideal-Standard SA) in Germany and France. The French subsidiary sold this trade mark to SGF which transferred it in turn to ClCh. A subsidiary of the latter (IHT) sold products in Germany which were produced by ClCh in France under the trade mark 'Ideal Standard'. Ideal-Standard GmbH could oppose this:

'The consent inherent in any transfer is not the same consent as the one required for the exhaustion principle to be effective. This requires that the right owner is authorized in the State of import to decide – directly or not – which products can be provided with the trade mark in the State of import, and to check the quality of such products. This authority will, however, end if he loses control over the trade mark by reason of transfer to a third party which does not have any economic relationship with him.' (Para 43).

As to involuntary full split-up the same was already decided in ECJ 17 October 1990, case C-10/89, HAG II (not included).

ECJ 23 October 2003, case C-115/02, Administration des douanes/Rioglass

Rioglass sold to Jann, a company registered in Poland (at that time not an EU member state), a consignment of windscreens, lawfully produced in Spain, intended for various types of cars. Some of the windscreens, intended for use in Peugeot, Citroën or Renault models, bore the logo or trade mark of those manufacturers alongside the Rioglass's trade mark. These windscreens were transported through France and seized there for trade mark infringement.

'Article 28 EC is to be interpreted as precluding the implementation, pursuant to a legislative measure of a Member State concerning intellectual property, of procedures for detention by the customs authorities of goods lawfully manufactured in another Member State and intended, following their transit through the territory of the first Member State, to be placed on the market in a non-member country. '(Operative part).

Ansul/Ajax

ECJ 11 March 2003, case C-40/01, Ansul/Ajax; Minimax
Article 12(1) Trade Mark Directive

Genuine use is use to find a real commercial exploitation for the goods or services, excluding symbolic use.

Ajax, a producer of fire extinguishers, applied for the revocation of the trade mark Minimax for fire extinguishers of its competitor Ansul owing to non use. Ansul had ceased the use of the trade mark for sale of new fire extinguishers, but still had used it for the sale of components and extinguishing substances, for repair and maintenance, as well as on stickers bearing the text 'Ready to use Minimax'.

'Article 12(1) [Trade Mark Directive] [...] must be interpreted as meaning that there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark.

When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark.

The fact that a mark that is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.' (Operative part).

La Mer

(a real commercial purpose)

ECJ 27 January 2004, case C-259/02, La Mer
Technology/Laboratoires Goemar; Laboratoire de la mer
Article 12(1) Trade Mark Directive

When it serves a real commercial purpose, even minimal use of the mark or use by only a single importer in the Member State concerned can be sufficient to establish genuine use within the meaning of the Directive.

La Mer applied for the revocation of the trade mark 'Laboratoire de la mer' owned by Goemar, claiming that Laboratoires Goemar had not put it to genuine use during the five years preceding.

The High Court of Justice (England & Wales) held that while the sale of the products during that period had generated a very low turnover of some hundreds of pounds sterling, that situation reflected the commercial failure of the company which owned the trade mark rather than use of the trade mark solely for the purpose of maintaining its registration.

In addition, the High Court observed that Laboratoires Goemar had, shortly following that same period, recruited a new sales agent in the United Kingdom in order to boost their sales.

'[...] there is genuine use of a trade mark where it is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by that mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial use of the mark is real in the course of trade, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark. When it serves a real commercial purpose, in the circumstances cited above, even minimal use of the mark or use by only a single importer in the Member State concerned can be sufficient to establish genuine use within the meaning of the Directive.

While [the Trade Mark Directive] makes the classification of use of the trade mark as genuine use consequential only on consideration of the circumstances which pertain in respect of the relevant period and which predate the filing of the application for revocation, it does not preclude, in assessing the genuineness of use during the relevant period, account being taken, where appropriate, of any circumstances subsequent to that filing. It is for the national court to determine whether such circumstances confirm that the use of the mark during the relevant period was genuine or whether, conversely, they reflect an intention on the part of the proprietor to defeat that claim.' (Operative part).

Vitafruit

(no de minimis rule)

ECJ 11 May 2006, case C-416/04 P,
The Sunrider/OHIM; Vitafruit
Article 15 Trade Mark Regulation

A de minimis rule, which would not allow the OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot be laid down.

Espadafor Caba opposed the registration of a Community Trade Mark Vitafruit by The Sunrider on the basis of its national (Spanish) word mark Vitafrut. The Sunrider argued that Espadafor Caba had not put its trade mark to genuine use.

The sale of around 300 [cases] of 12 items each of concentrated juices of various fruits, representing sales of approximately EUR 4 800 to a single Spanish customer during the period from May 1996 to May 1997 can be regarded as genuine use.

Although the scale of the use to which the earlier trade mark was put is limited and although it might be preferable to have more evidence relating to the nature of the use during the relevant period, the facts and evidence put forward by the other party to the proceedings are sufficient for a finding of genuine use.

'[...] it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down.' (Para. 72).

The ECJ also confirmed the ruling by the CFI that 'herbal and vitamin beverages' and 'concentrated fruit juices' are similar goods.



Björnekulla sought revocation in Sweden of the trade mark Bostongurka of Procordia, because it had become a generic name in Swedish for chopped pickled gherkins.

LOSS OF DISTINCTIVE CHARACTER

Bostongurka

(perception of the end user)

ECJ 29 April 2004, case C-371/02,
Björnekulla/Procordia; Bostongurka
Article 12(2) Trade Mark Directive

In determining whether a mark has become generic, the perception of the end user is of primary importance, but the perception of all those in the trade who deal with that product commercially may also be relevant.

'In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it.

Accordingly, the relevant classes of persons comprise principally consumers and end users. However, depending on the features of the product market concerned, the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.' (Paras. 24 and 25).

'Article 12(2)(a) of the First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks should be interpreted as meaning that in cases where intermediaries participate in the distribution to the consumer or the end user of a product which is the subject of a registered trade mark, the relevant classes of persons whose views fall to be taken into account in determining whether that trade mark has become the common name in the trade for the product in question comprise all consumers and end users and, depending on the features of the market concerned, all those in the trade who deal with that product commercially.' (Operative part).

Robelco/Robeco

(use as trade name)

ECJ 21 November 2002, case C-23/01, Robelco/Robeco
Article 5(5) Trade Mark Directive

A Member State may, if it sees fit and subject to such conditions as it may determine, protect a trade mark against use of a sign other than for the purpose of distinguishing goods or services.

'Article 5(5) of [Trade Mark Directive] [...] must be interpreted as meaning that a Member State may, if it sees fit, and subject to such conditions as it may determine, protect a trade mark against use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.' (Operative part).

'Accordingly, where, as in the main proceedings, the sign is not used for the purposes of distinguishing goods or services, it is necessary to refer to the legal orders of the Member States to determine the extent and nature, if any, of the protection afforded to owners of trade marks who claim to be suffering damage as a result of use of that sign as a trade name or company name.

The Member States may adopt no legislation in this area or they may, subject to such conditions as they may determine, require that the sign and the trade mark be either identical or similar, or that there be some other connection between them.' (Paras. 34 and 35).

Levi Strauss/Casucci

(time of assessment)

ECJ 27 April 2006, case C-145/05, Levi Strauss/Casucci;
overstitching
Article 5(1)(b) Trade Mark Directive
Article 12(2) Trade Mark Directive

Likelihood of confusion must be assessed at the time when the use of the allegedly infringing sign started. If a sign is found to be infringing, it is appropriate to order cessation of the use of the sign, unless the trade mark has lost its distinctive character in consequence of acts or inactivity of the proprietor.

'Article 5(1) [Trade Mark Directive] [...] must be interpreted as meaning that, in order to determine the scope of protection of a trade mark which has been lawfully acquired on the basis of its distinctive character, the national court must take into account the perception of the public concerned at the time when the sign, the use of which infringes that trade mark, began to be used.

Where the competent national court finds that the sign in question constituted an infringement of the mark at the time when the sign began to be used, it is for that court to take such measures as prove to be the most appropriate in the light of the circumstances of the case in order to safeguard the proprietor's rights deriving from Article 5(1) [Trade Mark Directive]; such measures may include, in particular, an order to cease use of that sign.

It is not appropriate to order cessation of the use of the sign in question if it has been established that the trade mark has lost its distinctive character, in consequence of acts or inactivity of the proprietor, so that it has become a common name within the meaning of Article 12(2) [Trade Mark Directive], and the trade mark has therefore been revoked.' (Operative part).

Trade mark owner Robeco
objected in Belgium to
the use of the trade
name Robelco

Toshiba/Katun

(reference to product numbers)



ECJ 25 October 2001, case C-112/99,
Toshiba/Katun; OEM-numbers
Articles 3 bis and 7 Comparative Advertising Directive

*Use of product numbers of competitor in a catalogue
of spare parts is allowed.*

Katun sold spare parts (inter alia toner cartridges) for Toshiba photocopiers. In its catalogues it stated its products next to OEM – numbers (Original Equipment Manufacturer) of Toshiba. Toshiba objected.

- 1 'On a proper construction of Articles 2(2a) and 3a(1)(c) [Comparative Advertising Directive], the indication, in the catalogue of a supplier of spare parts and consumable items suitable for the products of an equipment manufacturer, of product numbers (OEM numbers) by which the equipment manufacturer designates the spare parts and consumable items which he himself sells may constitute comparative advertising which objectively compares one or more material, relevant, verifiable and representative features of goods.
- 2 On a proper construction of Article 3a(1)(g) [Comparative Advertising Directive], where product numbers (OEM numbers) of an equipment manufacturer are, as such, distinguishing marks within the meaning of that provision, their use in the catalogues of a competing supplier enables him to take unfair advantage of the reputation attached to those marks only if the effect of the reference to them is to create, in the mind of the persons at whom the advertising is directed, an association between the manufacturer whose products are identified and the competing supplier, in that those persons associate the reputation of the manufacturer's products with the products of the competing supplier. In order to determine whether that condition is satisfied, account should be taken of the overall presentation of the advertising at issue and the type of persons for whom the advertising is intended.' (Operative part).

Pippig/Hartlauer

(logo of a competitor)

ECJ 8 April 2003, case C-44/01, Pippig/Hartlauer
Articles 3 bis and 7 Comparative Advertising Directive

*Comparative advertising by showing the logo or shop-front
of a competitor is allowed in principle.*

The optician chain Hartlauer compared in a leaflet and in a television commercial the prices of traditional opticians, including Pippig, with its own prices. In the television commercial the shop-front with logo of Pippig was visible.

- 1 'Article 7(2) [Comparative Advertising Directive], precludes the application to comparative advertising of stricter national provisions on protection against misleading advertising as far as the form and content of the comparison is concerned, without there being any need to establish distinctions between the various elements of the comparison, that is to say statements concerning the advertiser's offer, statements concerning the competitor's offer and the relationship between those offers.
- 2 Article 3a(1)(a) [Comparative Advertising Directive], must be interpreted as meaning that, whereas the advertiser is in principle free to state or not to state the brand name of rival products in comparative advertising, it is for the national court to verify whether, in particular circumstances, characterised by the importance of the brand in the buyer's choice and by a major difference between the respective brand names of the compared products in terms of how well known they are, omission of the better-known brand name is capable of being misleading.
- 3 Article 3a(1) [Comparative Advertising Directive], as amended, does not preclude compared products from being purchased through different distribution channels.
- 4 Article 3a(1) [Comparative Advertising Directive], as amended, does not preclude an advertiser from carrying out a test purchase with a competitor before his own offer has even commenced, where the conditions for the lawfulness of comparative advertising set out therein are complied with.
- 5 A price comparison does not entail the discrediting of a competitor, within the meaning of Article 3a(1)(e) [Comparative Advertising Directive], either on the grounds that the difference in price between the products compared is greater than the average price difference or by reason of the number of comparisons made. Article 3a(1)(e) [Comparative Advertising Directive], does not prevent comparative advertising, in addition to citing the competitor's name, from reproducing its logo and a picture of its shop front, if that advertising complies with the conditions for lawfulness laid down by Community law.' (Operative part).

Siemens/VIPA

(use of identical order number)

ECJ 23 February 2006, case C-59/05, Siemens/VIPA
Article 3 bis(1)(g) Comparative Advertising Directive

In this case, the competing supplier does not take unfair advantage of the reputation of that distinguishing mark by using partly identical order numbers.

VIPA uses order numbers which are partly identical to the order numbers of the products of Siemens which they are compatible with. Siemens objects to this.

VIPA sells components which are compatible with the 'Simatic' control systems of Siemens, for which it uses an identification system which is almost identical to the one of Siemens. The first part of the character combination in the order numbers of Siemens is replaced by the word 'VIPA' followed by the core element of the order number of the original product of Siemens. This order number refers to characteristics of the product of Siemens in question and to the use thereof on the computer platform; this number must be entered into this platform to activate the control.

Comparative advertising intends to allow consumers to take as much advantage of the internal market as possible, since advertising is an important tool to create real outlets everywhere in the Community for all goods and services. Comparative advertising also has the purpose to create an incentive for competition between suppliers of goods and services in the interest of consumers.

'In the present case, if a different core element were to be used for the order numbers of goods distributed by VIPA and intended for use with Siemens controllers as add-on components, the users concerned would be required to look in comparative listings for the order numbers corresponding with the goods sold by Siemens. That would be disadvantageous, as the national court pointed out, to consumers and to VIPA. The possibility that there would be restrictive effects on competition in the market for add-on components to the controllers manufactured by Siemens cannot therefore be excluded.' (Para. 26).

'Article 3a(1)(g) [Comparative Advertising Directive], must be interpreted as meaning that, in circumstances such as those in the main proceedings, by using in its catalogues the core element of a manufacturer's distinguishing mark which is known in specialist circles, a competing supplier does not take unfair advantage of the reputation of that distinguishing mark.' (Operative part).



Gut Springenheide markets under the designation '6-Korn-10 frische Eier' pre-packed eggs. The fodder of the chickens consisted only for 60% of six types of cereals. According to the Oberkreisdirektor des Kreises Steinfurt - Amt für Lebensmittelüberwachung, this was misleading.

AVERAGE CONSUMER

Gut Springenheide

(definition consumer)

ECJ 16 July 1998, case C-210/96,
Gut Springenheide/Steinfurt

*Regulation concerning specific trade standards for eggs
In order to determine whether a statement is liable to mislead a consumer, account must be taken of the presumed expectations which it evokes in an average consumer who is reasonably well-informed and reasonably observant and circumspect.*

Article 10(2)(e) of Regulation (EEC) no. 1907/90 of the Council of 26 June concerning specific trade standards for eggs (OJ L 173, p. 5) provides that several additional statements on the packaging of eggs should not mislead.

According to the German court judging the facts 'a non-negligible part of the public could be misled by the designation '6-Korn-10 frische Eier' which is also a trade mark and by the enclosed information leaflet, since it is wrongfully suggested that the fodder of the chickens exclusively consists of six types of cereal and that the eggs have special qualities'.

'In order to determine whether a statement intended to promote sales of eggs is liable to mislead the purchaser, in breach of Article 10(2)(e) of Regulation (EEC) No 1907/90 of 26 June 1990 on certain marketing standards for eggs, the national court must take into account the presumed expectations which it evokes in an average consumer who is reasonably well-informed and reasonably observant and circumspect. However, Community law does not preclude the possibility that, where the national court has particular difficulty in assessing the misleading nature of the statement or description in question, it may have recourse, under the conditions laid down by its own national law, to a consumer research poll or an expert's report as guidance for its judgment.' (Operative part).

'In the absence of any Community provision on this point, it is for the national court, which may find it necessary to order such a survey, to determine, in accordance with its own national law, the percentage of consumers misled by a promotional description or statement that, in its view, would be sufficiently significant in order to justify, where appropriate, banning its use.' (Para. 36).

As to the question of confusion under trade mark law this criterion was adopted in the Lloyd/Loint case.

Hermès/FHT

(provisional measures)



ECJ 16 June 1998, case C-53/96, Hermès/FHT
Article 50 of the TRIPs Agreement

When provisional measures are ordered in interim proceedings, a period should be fixed within which proceedings on the merits must be initiated

In interim proceedings, FHT was ordered to cease any present or future infringement of Hermès' exclusive copy-right and trade mark rights on its ties.

Article 50(6) of the TRIPs Agreement provides that provisional measures shall, upon request by the defendant, be revoked or otherwise cease to have effect, if proceedings leading to a decision on the merits of the case are not initiated within a reasonable period, to be determined by the judicial authority ordering the measures where a Member's law so permits or, in the absence of such a determination, not to exceed 20 working days or 31 calendar days, whichever is the longer.

'A measure whose purpose is to put an end to alleged infringements of a trade mark right and which is adopted in the course of a procedure distinguished by the following features:

- The measure is characterised under national law as an 'immediate provisional measure' and its adoption must be required 'on grounds of urgency'.
- The opposing party is summoned and is heard if he appears before the court.
- The decision adopting the measure is reasoned and given in writing following an assessment of the substance of the case by the judge hearing the interim application.
- An appeal may lodged against the decision.
- Although the parties remain free to initiate proceedings on the merits of the case, the decision is usually accepted by the parties as a 'final resolution of their dispute'. (Operative Part).

See also, about the direct effect of article 50(6) TRIPs: ECJ 13 September 2001, case C-89/99, Schieving-Nijstad/Groeneveld; Route 66 (not included in in this book).

Budweiser

(trade mark versus trade name under TRIPs)



ECJ 16 November 2004, case C-245/02,
Anheuser Busch/Budejovicky Budvar; Budweiser
Articles 16 and 17 TRIPs.

A trade name may constitute a sign within the meaning of Article 16 TRIPs. A later trade mark cannot oppose an earlier trade name.

On the basis of its trade mark Budweiser, Anheuser Busch objected to the use of the trade name Budweiser Budvar by Budejovicky Budvar.

- 1 'The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs, Agreement) [...], applies in the event of a conflict between a trade mark and a sign alleged to infringe that trade mark where that conflict arose before the date of application of the TRIPs, Agreement but continued beyond that date.
- 2 A trade name may constitute a sign within the meaning of the first sentence of Article 16(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement). That provision is intended to confer on the proprietor of a trade mark the exclusive right to prevent a third party from using such a sign if the use in question prejudices or is liable to prejudice the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods.

The exceptions provided for in Article 17 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement) are intended, inter alia, to enable a third party to use a sign which is identical or similar to a trade mark to indicate his trade name, provided that such use is in accordance with honest practices in industrial or commercial matters.
- 3 A trade name which is not registered or established by use in the Member State in which the trade mark is registered and in which protection against the trade name in question is sought may be regarded as an existing prior right within the meaning of the third sentence of Article 16(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs Agreement) if the proprietor of the trade name has a right falling within the substantive and temporal scope of that agreement which arose prior to the trade mark with which it is alleged to conflict and which entitles him to use a sign identical or similar to that trade mark.' (Operative part).

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