

THE TRADEMARKS  
LAW REVIEW

Editor  
Jonathan Clegg

THE LAWREVIEWS

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LAW REVIEW

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# EDITOR'S PREFACE

I am very pleased to be able to introduce this new title from the long-established Law Review series, dedicated to issues around trademark law. Its objective is an ambitious one: to provide an annual snapshot of the law in this area across a broad range of jurisdictions, not only summarising key legal provisions but also examining recent developments and trends coming from the courts, and identifying areas of expected legal activity and legislative change going forward.

To this end, we have invited a geographically diverse group of leading trademark practitioners each to provide a chapter of commentary on their own jurisdiction. The broad structure of each chapter is similar, allowing for clear points of comparison, while leaving enough space for issues of particular relevance to a given country to be explored. Our authors have therefore all struck a balance between conveying the key elements of the trademark landscape in their respective countries, and giving a flavour of the current and commercially active issues they face. The former must necessarily be concise – this book does not in any sense aim to provide an exhaustive analysis – but each author has been encouraged to explore the latter with appropriate weight depending on what has been happening recently in his or her country.

The commercial importance of trademarks to the business community continues to grow, and the tools available for securing international protection (for example, the European Union Trademark system (EUTM) and international registration under the Madrid Protocol) are still improving and providing businesses with ever broader choices in how to develop effective international protection. For many years, there has been considerable harmonisation of trademark laws and practices across many jurisdictions, most obviously in the EU but also in other countries that have adopted new trademark laws that closely reflect the EU model. While harmonisation continues to be the direction of travel in some quarters, there are still many significant differences in the legal treatment of trademarks when viewed globally.

It goes without saying that the online environment, including social media platforms, continues to grow as a dominant force in the business world. This is reflected in a significant increase in trademark (and related) law suits around the world, whether relating to key word advertising, metatags, 'traditional' trademark infringement, unfair competition, copyright or a myriad of other legal issues. At the most fundamental level, the only mechanism for tackling legal issues that arise on the internet is on a jurisdiction-by-jurisdiction basis, but this is heavily at odds with the internet operating without reference to geographical borders. So the areas of trademark law that remain far from harmonised can dramatically increase the complexity of tackling determined international infringers. Some of these issues come through in this publication: readers will note the many references to recent and pending legal

actions surrounding the internet and social media, and the different treatment some issues receive in courts across different jurisdictions is clear to see.

The continuing efforts to increase the degree of substantive and procedural harmonisation internationally in the trademark arena are therefore certainly in the interests of the business community, and worth pursuing.

There are many other issues dealt with in the chapters of this book which are not focused on the internet, including parallel imports, registering and enforcing non-traditional trademarks, counterfeit products, and the interplay between trademarks, company names and domain names. The nature of the publication is such that not all these areas are addressed in every chapter: they arise in jurisdictions where they have been the subject of recent legal scrutiny and are therefore current issues.

Our hope is that readers will find this book a valuable resource and that – since its content is up to date, business-focused and in the form of a snapshot of each jurisdiction – one which our colleagues in the trademark field will want to consult regularly.

**Jonathan Clegg**

Cleveland Scott York

London

November 2017

# EUROPEAN UNION OVERVIEW

*Christos Chrissanthis, Xenia Chardalia and Antonia Vasilogamvrou<sup>1</sup>*

## I OVERVIEW

The European Union (EU) consists of 28 Member States. Three more countries – Norway, Iceland and Liechtenstein – form part of the European Economic Area (EEA), which is a European free trade association. These three countries apply most EU legislation. Switzerland has not formally joined the EEA, but has bilateral agreements with the EU enabling it to participate in the European Single Market. The Single Market is considered to be one of the richest worldwide, and for most consumer products, prices in the EU are substantially higher than elsewhere. The GDP for the 28 Member States of the EU in 2016 was €14.855 billion; more than half of this was generated by Germany, the United Kingdom and France. The average GDP per capita for 2016 in the 28 Member States was US\$35,632.22 (€29,794.00).

The EU has detailed legislation on trademarks. On the one hand, there is EU legislation approximating the national trademark laws of the Member States; hence the national laws of the Member States on trademarks are very similar to one another. On the other hand, the EU has created the European Union Trademark system (EUTM), which is an innovative tool of European law and is a unitary trademark right, which is acquired by way of a single, central filing with the European Union Intellectual Property Office (EUIPO) and applies to all Member States. It is worth noting that, similarly, the EU has harmonised the national laws of its Member States on industrial designs and has created a unitary design right (also acquired by a single, central filing with EUIPO) and a unitary non-registered design right, both of which extend to all Member States. The EU has also adopted legislation to facilitate the enforcement of all intellectual property rights, including trademarks and designs. This legislation facilitates the collection of evidence in cases of alleged infringement, as well as the quantification of damages.

The EU has also set up a system whereby national customs authorities can inspect and control the movement of counterfeit goods and arrest such goods passing through EU customs. There is also EU legislation obliging Member States to use special courts for cases relating to the EUTM. As a result, these courts usually have a greater level of expertise on trademark issues. EUIPO has created a network of cooperation and communication with national trademark offices in Member States, which promotes a uniform application of trademark law by all national trademark offices, which have also adopted common guidelines and policies on specific issues. Finally, the EU applies a legal regime that is favourable to

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<sup>1</sup> Christos Chrissanthis and Xenia Chardalia are partners and Antonia Vasilogamvrou is an associate at Christos Chrissanthis & Partners Law Firm.

trademark owners, preventing parallel imports from other countries into the EU. As a result, owners of EU trademarks or national trademarks in Member States can effectively partition the Single Market and apply higher prices in the EU than in other geographical markets.

There are some legal issues that are either unique to the EUTM or are not yet settled by the General Court of the European Union (GCEU) and the Court of Justice of the European Union (CJEU); these include the following:

- Requirements regarding evidence to establish acquired distinctiveness are rather demanding in the jurisprudence of the CJEU. One must prove that acquired distinctiveness exists ‘through’ the EU. This means that, in order to establish acquired distinctiveness, one has to produce evidence in relation to each and every one of the 28 Member States. Acquired distinctiveness in the majority of Member States, or even in a substantial number of Member States, does not suffice.
- Requirements regarding evidence to establish reputation (fame) are rather demanding too. EUIPO, the GCEU and the CJEU scrutinise very closely the evidence provided. It is not sufficient to prove a large volume of sales or of advertising expenditure. It must be proved that this has resulted in market penetration as well. Reputation does not depend on the volume of the advertising investment of the trademark owner, but on how efficiently a trademark has penetrated the market and become easily recognisable to consumers.
- Case law struggles with cases involving conflicts regarding marks that contain non-distinctive or descriptive elements, and court jurisprudence has not yet clarified how such cases are dealt with. Some judgments hold that in comparing the respective marks and in assessing the likelihood of confusion between them, elements that are non-distinctive or descriptive are disregarded, and that the likelihood of confusion is assessed on the basis of distinctive and unique elements only. Other judgments hold the opposite view, on the grounds that consumers who come across the marks will notice the non-distinctive or descriptive elements and may well be misled by them. A significant number of cases that are subject to litigation relate to marks that contain non-distinctive or descriptive elements.
- Case law also struggles on the issue of dilution. In 2008 and 2009, the CJEU described dilution very broadly in cases such as *L’Oréal v. Bellure*,<sup>2</sup> *Intel*<sup>3</sup> and *TDK*.<sup>4</sup> Dilution includes free riding, the lessening of distinctive value, as well as negative publicity or negative implications. However, in the cases that followed, one can identify a clear attempt to restrict the breadth of the dilution concept in way that is both practical and easy to apply by courts. So, in cases such as *Calvin Klein*<sup>5</sup> and *Kinder*,<sup>6</sup> the CJEU held that, unless the former and the latter marks are sufficiently similar, dilution cannot be established. In addition, the CJEU reasoned that, in assessing such similarity, the reputation of the earlier mark shall not be taken into account and that such reputation is assessed only at a later stage, in order to consider whether there is a likelihood that

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2 CJEU, C-487/07, 18 June 2009.

3 CJEU, C-252/07, 27 November 2008.

4 CJEU, C-197/07, 12 December 2008.

5 CJEU, C-254/09, 2 September 2010.

6 CJEU, C-552/09, 24 March 2011.

consumers might make a link between the two marks; but this consideration as to a possible link will not follow at all unless sufficient similarity is not established in the first place.

- EU law has also developed a broad concept of ‘bad faith’ in applying for trademark registration. Bad faith can be established when an application is filed without any obvious commercial justification, particularly if the trademark registration can be used to prevent free competition from other competitors.<sup>7</sup>

## II LEGAL FRAMEWORK

### i Legislation

The major EU legislation on trademarks and designs consists of the following:

- Directive 2008/95/EC, on the approximation of national laws of the Member States on trademarks. This Directive has been replaced by Directive 2015/2436/EU, but the latter has not yet been implemented in the national laws of the Member States – the deadline for implementation is 14 January 2019;
- Regulation 207/2009/EC (as amended by Regulation 2015/2424/EU) regarding the EUTM;
- Directive 1998/71/EC, on the approximation of national laws of the Member States on industrial designs;
- Regulation 6/2002/EC on community design;
- Directive 2004/48/EC on the enforcement of intellectual property rights; and
- Regulation 608/2013/EU on customs enforcement of intellectual property rights.

Moreover, the EU is party to the following international conventions regarding intellectual property matters:

- Paris Convention (1883) as amended on 28 September 1979;
- World Trade Organization (WTO) and the Protocol on Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement (1994);
- Nice Classification, established by the Nice Agreement (1957) (as amended in 1979), on the international classification of goods and services in trademark applications;
- Vienna Agreement (1973, as amended in 1985), on the classification of figurative elements of trademarks;
- Protocol Relating to the Madrid Agreement concerning the International Registration of Marks (1989) through WIPO (World Intellectual Property Organization);
- Trademark Law Treaty (1994);
- Singapore Treaty (2006), on the law of trademarks;

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<sup>7</sup> See: *Chocoladefabriken Lindt & Sprüngli AG v. Franz Hauswirth GmbH* (C-529/07, 11 June 2009) (hereinafter *Lindt & Sprüngli*); *Peeters Landbouwmachines BV v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (T-33/11, 14 February 2012) (hereinafter *Bigab*); *SA.PAR. Srl v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (T-321/10, 11 July 2013) (hereinafter *Gruppo Salini*; and *Carrols Corp. v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (T-291/09, 1 February 2012) (hereinafter *Pollo Tropical*).

- Locarno Agreement (1968, as amended in 1979), on the international classification of design rights; and
- Hague Agreement Concerning the International Registration of Industrial Designs, known as the Hague System (Geneva Act 1999).

As a result of the accession of the EU to the above international conventions, the EUTM is connected to both the Paris Convention and the Madrid Protocol. This means that an EUTM application can enjoy international priority under the Paris Convention, and trademark applications filed in other Paris Convention countries can enjoy international priority before EUIPO, when an EUTM application is filed. Moreover, an EUTM application can be the basis for an international registration with WIPO, designating other countries that have acceded to the Madrid Protocol; in addition, a trademark application filed in any Madrid Protocol country can be the basis for an international registration with WIPO, designating the EU and, hence, resulting in an EUTM.

## ii Authorities

### *Trademark registration process*

EUIPO, which is based in Alicante, Spain, is the organisation administering the EUTM registry; it receives and examines EUTM applications, oppositions, cancellations, etc.

EUTM applications are assessed by an Examiner on absolute grounds only (i.e., lack of distinctiveness, or the mark being generic, descriptive, deceptive, commonplace, etc.). Relative grounds, that is to say earlier rights, are not examined by EUIPO on an *ex officio* basis. It is up to the owners of earlier rights to invoke them by way of formal opposition proceedings. Should owners of earlier rights not initiate formal opposition proceedings, an EUTM application shall be registered, even though it may be confusingly similar to an earlier right.

EUIPO examines oppositions and cancellations in two stages. The first is an examination of the opposition or cancellation by the Operations Department of EUIPO. The second stage is carried out by the EUIPO Boards of Appeal, which examine appeals filed against decisions of the Operations Department. The time limit to file an appeal is two months from the notification of the contested decision. The Boards of Appeal review cases on both matters of fact and matters of law. The procedure for oppositions, cancellations and appeals is in writing; there is no oral hearing. The parties are given the opportunity to file written submissions and evidence, as well as a rejoinder. The average time within which a decision is issued is about 12 months from the filing of an opposition, cancellation or appeal.

The decisions of the EUIPO Boards of Appeal can be appealed before the General Court of the EU (GCEU). Judgments of the GCEU can be appealed before the Court of Justice of the European Union (CJEU). An appeal to the GCEU is referred to as an ‘application’. The GCEU and the CJEU review cases on matters of law only and do not re-evaluate the evidence and the facts.<sup>8</sup> As a result, the parties are not allowed to produce new evidence, or to submit new arguments before the GCEU or the CJEU for the first time.<sup>9</sup>

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8 Article 65(2) of Regulation 207/2009/EC and Article 58 of the Statute of the CJEU; see also case law such as GCEU, T-269/06, 19 November 2008, and T-407/08, 25 June 2010, as well as CJEU, C-182/16, 26 July 2017.

9 GCEU, T-576/12, 15 July 2014; T-258/16, 7 June 2017; T-789/14, 14 June 2016; and CJEU442/15, 22 September 2016.

The time limit to file an appeal with the GCEU is two months from notification of the contested decision. However, the rules of procedure of the GCEU provide that this time limit is extended on account of distance by 10 more days. Moreover, in the event that notification of the contested decision was effected by electronic means, it is deemed to have occurred five days after it was placed in the inbox area of the interested party.<sup>10</sup> This means that the time limit to file an appeal is extended by five more days.

The time limit for an appeal before the CJEU against a judgment by the GCEU is, again, two months from the notification of the contested judgment.

The procedure before the GCEU and the CJEU consists of a written part and an oral part, which is optional. The appeal (application) is forwarded by the GCEU or the CJEU to EUIPO, which is given two months to file a response. The written submissions of the parties must comply with certain restrictions as to the number of pages (i.e., an average of 15 pages); written submissions must also be accompanied by detailed annexes to any documents or other evidence invoked by the parties. The Court will then forward the written submissions to the other litigant party, but there are no rejoinders; so, in complicated cases, an oral hearing is usually necessary to submit counter-arguments to the written submission of the other party. After the written part of the proceedings has been closed, the Court invites the parties to submit an application for an oral hearing and to explain the reasons why an oral hearing is necessary. Unless one of the parties submits a request for an oral hearing, it is highly improbable that the Court will fix one on its own initiative. In any case, it is up to the court to decide whether the oral part is necessary.

In cases such as oppositions and cancellations, which are *inter partes* cases, an appeal to the GCEU against a decision by the EUIPO Boards of Appeal is addressed only against EUIPO and not against the other litigant party to the proceedings before EUIPO. As a result, the defendant in appeal proceedings before the GCEU and the CJEU is always EUIPO. The other litigant party to EUIPO proceedings is given the chance to intervene in the proceedings before the GCEU by filing a written response to the appeal, within two months of notification of the appeal. EUIPO is always a party to proceedings before the GCEU.

### ***Trademark enforcement***

Enforcement of EUTMs is achieved through the national courts of the Member States. Article 95 of Regulation 207/2009/EC provides that Member States shall designate in their territories a limited number of possible national courts and tribunals of first and second instance, which shall have competence to deal with infringement of EUTMs. As a result, the national courts in all Member States dealing with trademark infringement cases have developed a relatively high level of expertise in trademark cases.

### **iii Substantive law**

Infringement of registered EUTMs is established in the following cases: (1) unauthorised use by a third party in the course of trade, resulting in the likelihood of confusion, or the likelihood of association; (2) unauthorised use of a mark with reputation by a third party in the course of trade, resulting in dilution; and (3) illegitimate parallel imports, where trademark rights have not been exhausted.

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10 Article 3(4) of EUIPO Executive Director Decision EX-17-4-16 August 2017.

### ***Likelihood of confusion and likelihood of association***

Unlike US trademark law, likelihood of association is deemed to be part of likelihood of confusion and not a separate type of infringement. All types of likelihood of confusion are actionable, i.e., forward confusion, reverse confusion, post-sales confusion and initial interest confusion. The test for likelihood of confusion is a multifactor one, taking into account the level of similarity of the respective marks and goods or services, the level of consumers' attention and awareness, distribution channels, the level of recognition of the earlier mark (assessed on the basis of longevity of use, market shares, geographical expansion of use, volume of advertisement expenditure, etc.), actual confusion, as well as intent of the unauthorised user (if it can be established). Similarity of marks can be visual, aural or conceptual. Goods are similar, if they are made of the same raw materials, or serve similar needs, or are addressed to the same group of consumers. The level of similarity of the respective marks and goods or services can be low, average or high. The comparison is based on the overall impression created by the respective marks, and likelihood of confusion is appreciated globally. The analysis of likelihood of confusion always starts with determining the level of attention and awareness of consumers in connection to the goods or services concerned in each specific case. Consumers' attention is deemed to be higher in respect of pharmaceuticals, goods that are of high purchase value,<sup>11</sup> and goods or services addressed to professionals.

The rules that are more often applied in respect of likelihood of confusion are:

- likelihood of confusion is presumed in cases of identity of both the respective marks and the respective goods or services;
- likelihood of confusion is established when the earlier mark is incorporated as such in the latter;
- likelihood of confusion is assessed on the basis of dominant elements of the respective marks, while descriptive or commonly used elements are not taken into account; it should be noted, however, that this rule is not always consistently applied;
- the more distinctive the earlier mark is, the more probable likelihood of confusion is; and
- likelihood of confusion is more probable when the earlier rights consist of a series of similar marks (family of marks), which are all used in the course of trade in respect of a family of similar products; in such cases, the likelihood of confusion may be that the consumer may believe that the junior mark or product belongs to the same family.

### ***Well-known marks – dilution and bad faith***

Well-known marks, i.e., marks with reputation, enjoy additional protection, including protection against the likelihood of dilution. Reputation is assessed on the basis of market shares, volume of sales, volume of advertising investment, longevity of use, etc. (the test is again a multifactor one).

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11 CJEU, C-361/04, 12 January 2006.

The prerequisites for establishing dilution are (1) similarity between the earlier and the later marks; (2) likelihood of a link in consumers' minds between the earlier and the later marks; (3) unfair advantage in favour of the later mark from the reputation of the earlier mark, or detriment to the reputation of the earlier mark; and (4) lack of any due cause justifying such unfair advantage or detriment.

Dilution may consist of one or more of the following:

- free riding on the reputation of another, that is to say when the later mark becomes recognisable to consumers more easily, faster and using less advertising expense;
- the later mark is affixed to products of inferior quality, or there is some other negative publicity or negative connotations or implications against the earlier well-known mark; or
- there is a lessening of the distinctive value of the earlier well-known mark.

Under Regulation 207/2009/EC, well-known marks are also protected, according to Article 6 *bis* of the Paris Convention, against registration of later marks in bad faith. In addition, any mark, even if not well known, may be revoked and cancelled, if it can be established that it has been registered in bad faith. The concept of bad faith, in the context of revocation, is broader than in the context of Article 6 *bis* of the Paris Convention. For the purposes of revocation under Regulation 207/2009/EC, an application is filed in bad faith, if there is no obvious commercial justification that could reasonably justify such an application, and particularly if the trademark registration is used with the sole purpose of preventing other competitors from using the same.<sup>12</sup>

### ***Parallel imports and exhaustion of rights***

The EU has developed a legal regime that is particularly favourable to trademark owners against parallel imports from other non-EEA countries. As a result, trademark owners can partition the EU from other markets and can apply higher prices within the EEA. This is because under EU law, trademark rights are exhausted only if the trademark owner, or a party acting with his or her consent, has put the specific goods (i.e., those that have been imported in an EU Member State by a parallel importer) on the market in another EU or EEA country. The consent of the trademark owner is not assumed, but must be established on the facts. For example, the European Court of Justice (ECJ) has clarified that an authorised distributor in a non-EEA country that exports goods in a EEA country is, in principle, not acting with the consent of the trademark owner. The burden of proof is on the parallel importer. As a result, parallel imports from non-EEA countries are in principle prohibited and amount to trademark infringement, while parallel imports from EEA countries are in principle allowed, provided that it can be established that the goods were first put on the market by the trademark owner or with his or her consent. Good faith of the parallel importer is irrelevant.

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12 See: *Lindt & Sprüngli* (C-529/07, 11 June 2009), *Bigab* (T-33/11, 14 February 2012), *Gruppo Salini* (T-321/10, 11 July 2013) and *Polo Tropical* (T-291/09, 1 February 2012).

### III REGISTRATION OF MARKS

#### i Registrability

##### *Types of marks*

Any sign may be registered as an EUTM, if it can distinguish the goods or services of one business enterprise from those of another,<sup>13</sup> and if it can be represented graphically in a clear, precise, self-contained, easily accessible, intelligible, durable, objective, unambiguous and consistent way.<sup>14</sup>

An EUTM may indicatively consist of one or more of the following:

- a* words affixed to products or used in the course of providing services;
- b* letters, abbreviations, numbers, names (both first names and surnames);
- c* slogans and short phrases;
- d* colours and colour combinations; although case law suggests that registration of single colours and simple colour combinations (i.e., consisting of two or three coloured stripes) is possible only if acquired distinctiveness through use is established;<sup>15</sup>
- e* designs, including 3D designs, provided they are distinctive and not of a merely decorative nature;
- f* the shape of the product, or of its packaging, product labels and product trade dress;
- g* company names and distinctive titles used to identify the premises where goods or services are offered to consumers;
- h* surface designs, colour patterns and design patterns, provided they are distinctive; or
- i* collective marks and certification marks.

Non-traditional marks, such as sounds, tastes, smells, touch, position marks, 3D representation of a state, holograms or movement marks, are in principle registrable, provided they are distinctive and capable of being represented graphically. In practice, however, registration of such marks may not always be possible, because it is not always possible to represent them graphically in a clear, precise, self-contained, easily accessible, intelligible, durable, objective, unambiguous and consistent way.<sup>16</sup>

##### *Absolute grounds*

Absolute grounds for rejecting an EUTM application include (1) lack of distinctiveness, (2) the mark being generic or descriptive, (3) commonplace, (4) deceptive, (5) functional, either technically or aesthetically, or (6) contrary to public policy, or morality. In addition, marks are excluded from registration if they are similar to designations of origin, geographical indications, traditional terms of wines, traditional specialities guaranteed, or plant varieties, which are protected under EU law, or under international conventions to which the EU is a party.

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13 CJEU, C-321/03, 20 January 2007.

14 CJEU, C-273/00, 12 February 2002 and C-104/01, 6 May 2003.

15 CJEU, C-104/01, 6 May 2003 and C-49/02, 24 June 2004.

16 See GCEU, T-305/04, 27 October 2005 concluding that smells cannot be represented graphically.

However, sound marks can be represented graphically by way of musical notations (stave), showing a clef and musical notes (CJEU, C-283/01, 27 November 2003) or by way of an MP3 file accompanied by additional suitable graphical representation (EUIPO Decision EX-05-3, 10 October 2005).

Absolute grounds are destined to strike a fair balance between trademark rights (which are exclusive rights – legal monopolies) on the one hand, and free competition on the other hand.<sup>17</sup> Absolute grounds are assessed in view of the respective goods or services applied for (i.e., a mark may be descriptive in respect of some goods, but not of others), as well as in view of the perception of the public (i.e., whether the public perceives a mark as an indication of origin or not).<sup>18</sup> Although the same criteria are used for all types of marks, public perception may differ for certain types of marks. Because of linguistic or cultural differences among the Member States, a mark may be descriptive, or commonplace, or may lack distinctiveness in some Member States, but not in all of them. Owing to the ‘unitary’ nature of the EUTM, a mark qualifies for registration as an EUTM only if it is free of any objections based on absolute grounds in all Member States. So, if a mark is descriptive in only one Member State, it cannot be registered as an EUTM and the respective application will fail.

However, an application for an EUTM that fails because of problems in one or more Member States may be converted into applications for national trademarks in those Member States where the problems do not exist. National applications that result from this conversion shall enjoy the same priority as the application for the EUTM that failed.

Acquired distinctiveness through use is taken into account to compensate for lack of inherent distinctiveness, descriptiveness, or the fact that a mark is commonplace. However, acquired distinctiveness must exist ‘throughout the EU’ and must be evidenced in respect of every single Member State.<sup>19</sup> It is not sufficient to establish that the mark enjoys acquired distinctiveness in the majority of Member States or in a substantial part of the EU. Recently, a mark consisting of the shape of Nestlé’s ‘Kit Kat’ wafer was cancelled because, on the evidence, it enjoyed acquired distinctiveness in only 10 Member States (at a time when the EU comprised of 14 Member States).<sup>20</sup> Similarly, in another recent case before the EUIPO Boards of Appeal, Adidas failed to prove acquired distinctiveness ‘throughout’ the EU for its much disputed figurative mark consisting of ‘three parallel stripes’, since it submitted market survey reports relating to only 10 of the 28 EU Member States; as a result Adidas’ ‘three parallel stripes’ mark was cancelled, owing to lack of distinctiveness.<sup>21</sup> On the other hand, a mark may acquire distinctiveness through use, even though it was not used as such, but only as a part of a larger mark. So, in another Nestlé’s ‘Kit Kat’ case, the slogan ‘Have a Break’ was found to enjoy acquired distinctiveness, although it has been used only as part of the slogan ‘Have A Break . . . Have A Kit Kat’.<sup>22</sup>

The following are some other notable examples from case law on absolute grounds.

- The figurative and position mark of K-Swiss, consisting of ‘five parallel stripes’ appearing on athletic shoes, was refused registration for lack of distinctiveness, as being of a merely decorative nature.<sup>23</sup>
- Adidas’ much disputed figurative mark consisting of ‘three black parallel stripes before a white background’ was cancelled by the EUIPO Boards of Appeal for lack of (inherent, or acquired) distinctiveness. Interestingly, the decision noted that it was unclear

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17 See CJEU, C-191/01, 23 October 2003.

18 CJEU, C-265/09, 9 September 2010 and C-64/02, 21 October 2004.

19 CJEU, C-98/11, 24 May 2012; see also CJEU, C-215/14 16 September 2015.

20 GCEU, T-112/13, 15 December 2016.

21 EUIPO Boards of Appeal, 7 March 2017, R-1515/2016-2.

22 CJEU, C-353/03, 7 July 2005.

23 GCEU, T-3/15, 4 December 2015.

whether the mark actually used in the market by Adidas was always ‘three parallel black stripes before a white background’ or ‘two white (or other light colour) stripes before a black (or other dark-coloured) background’.<sup>24</sup>

- Louis Vuitton’s fabric design consisting of a ‘chessboard with light and dark brown squares’ was refused registration for lack of inherent distinctiveness, as being a decoration only, while the owner failed to establish acquired distinctiveness ‘throughout’ the EU, that is in all Member States.<sup>25</sup>
- Coca-Cola’s shape mark for its new plastic bottle was refused registration on the grounds of lack of distinctiveness.<sup>26</sup> The shape of the bottle was very similar to the classic Coca-Cola bottle, but lacked the vertical fluting of the classic bottle. Although Coca-Cola argued that the shape of its new bottle was an evolution of its classic bottle, its argument was not upheld by the court.
- Rubik’s Cube and Lego bricks were found to be functional and not capable of being registered as trademarks.<sup>27</sup>
- A mark consisting of rabbit-shaped chocolate with gold wrapping and a red ribbon was found to be commonplace and devoid of any distinctiveness for the market concerned.<sup>28</sup>
- A registration consisting of the shape of ‘knife handles with dents’ (which was represented as a surface with a pattern of black dots) was declared invalid, on the ground that such a shape was merely of a functional nature. The CJEU, which reviewed the case, confirmed the decision for its invalidation and clarified that a mark may be functional, even if it has some ornamental or fanciful elements, if such elements do not play an important role, and if all other essential characteristics of the mark are dictated by the technical solution to which that mark gives effect.<sup>29</sup>
- The Voss shape mark for its ‘transparent cylinder bottle with non-transparent cap’ was found to be non-distinctive and the respective registration was cancelled.<sup>30</sup>
- A mark consisting of a representation of the ‘yellow colour, including a pattern of random white dots’ was refused registration for lack of distinctiveness. The GCEU found that the white dots pattern was negligible and would be perceived by consumers as decoration only, so the dominant element of the mark in question was the yellow colour alone.<sup>31</sup>
- Word marks like ‘Biomild’ for foodstuffs such as yogurt and ‘Doublemint’ for chewing gum were found to be descriptive (biological and mild/double mint) and were refused registration. Combinations of descriptive terms in a single new word cannot escape the absolute ground of descriptiveness, unless there is a perceivable difference among the combination and its parts.<sup>32</sup>

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24 EUIPO Boards of Appeal, 7 March 2017, R-1515/2016-2.

25 GCEU, T-359, 360/12, 21 April 2015.

26 GCEU, T-411/14, 16 February 2016.

27 CJEU, C-30/15, 10 November 2016 and GCEU, T-450/09, 25 November 2014 (Rubik’s Cube) and C-48/09, 14 September 2010 (Lego bricks).

28 CJEU, C-98/11, 24 May 2012.

29 CJEU, C-421/15, 11 May 2017.

30 CJEU, C-445/13, 7 May 2015 and GCEU, T-178/11, 28 May 2013.

31 GCEU, T-143/14, 10 September 2015.

32 CJEU, C-265/00, 12 February 2004 (Biomild); C-191/01, 23 October 2003 and GCEU, T-193/99, 31 January 2001 (Doublemint).

- The following word marks have been refused registration for lack of distinctiveness: ‘eco’ (denoting ‘ecological’),<sup>33</sup> ‘medi’ (denoting ‘medical’),<sup>34</sup> ‘universal’ (denoting ‘goods fit for universal use’).<sup>35</sup>
- The mark ‘Revolution’ for financial consulting services in class 36 was found to lack distinctiveness and was refused registration.<sup>36</sup>
- The mark ‘Restore’ for surgical and medical instruments was found to be descriptive;<sup>37</sup>
- The slogan ‘Innovation For The Real World’ for automotive and medical products in classes 7, 9, 10 and 12 was refused registration due to lack of distinctiveness.<sup>38</sup>
- The slogan ‘Built To Resist’, applied for paper goods, leather, clothing and footwear was found to be descriptive.<sup>39</sup>
- The slogans ‘So What Do I Do With My Money’ and ‘Investing For a New World’, applied for financial and investment services, were found to be laudatory and promotional and devoid of any distinctiveness.<sup>40</sup>
- The marks ‘MMF – Multi Market Fund’ and ‘NAI – Der Natur-Aktien-Index’ were refused registration as being descriptive and non-distinctive. The addition of an abbreviation before a descriptive phrase does not render the whole mark distinctive.<sup>41</sup>
- The mark ‘Caffè Nero’ for coffee products and cafeteria services was refused registration on the ground that in Italian, ‘caffè nero’ means ‘black coffee’, i.e., ‘coffee without sugar or milk’. So long as an EUTM is destined to apply to all Member States, lack of distinctiveness or descriptiveness in only one Member State may be fatal.<sup>42</sup>
- The mark ‘Deluxe’ for several goods and services in classes 9, 35, 37, 39, 40, 41, 42, 45 was refused registration as merely laudatory, descriptive and non-distinctive; the CJEU affirmed this decision.<sup>43</sup>

### ***The filing and registration process***

An application for an EUTM can be filed either electronically (online) or in writing, sent by fax or mail. The application contains details of the applicant, its professional representative acting on its behalf before EUIPO, as well as the mark applied for, and the respective goods or services. The application is accompanied by a power of attorney appointing the professional representative. The power of attorney and the application need no legalisation, neither certification, nor the Hague Convention Apostille. If the mark includes colours, the applicant is required to identify the colours by reference to a generally accepted colour index, such as the Pantone Index. If the mark includes figurative elements, the applicant is required to identify these figurative elements by reference to EUIPO’s Figurative Classification Manual (version 3.0, 15 March 2013), which is based on the codes provided in the Vienna Convention (1973) on the classification of figurative elements of marks (seventh edition, 2012).

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33 GCEU, T-328/11, 24 February 2012.

34 GCEU, T-470/09, 12 July 2012.

35 GCEU, T-435/11, 2 May 2012.

36 GCEU, T-654/14, 2 June 2016.

37 CJEU, C-21/12, 17 January 2013.

38 GCEU, T-515/11, 6 June 2013.

39 GCEU, T-80/07, 16 September 2009.

40 GCEU, T-609/13, 29 January 2015 and T-59/14, 29 January 2015.

41 CJEU, C-90, 91/11, 15 March 2012.

42 GCEU, T-29/16, 27 October 2016.

43 CJEU, C-437/15, 17 May 2017.

The goods or services applied for are identified by reference to the Nice Classification Agreement (1957), currently consisting of 45 classes. Following the ruling of the CJEU in the *IP Translator* case,<sup>44</sup> EUIPO requires that the specification of the goods or services should be sufficiently precise and clear; using the whole class heading will usually not satisfy EUIPO, which is likely to insist of a more concrete and precise specification.

Applications are assessed by a single examiner. If the examiner finds the application acceptable, it is published through the EUIPO website. Upon publication, the application is open to opposition for a period of three months. If no opposition is filed, the mark is registered. The whole process from the filing of the application until registration usually requires a period of four months, if no obstacles arise. An examiner's decision rejecting an application can be appealed to the EUIPO Boards of Appeal within a period of two months from its notification to the applicant.

## ii Relative grounds – Prior rights

Prior rights include:

- earlier applications or registrations of EUTMs;
- earlier applications or registrations of national trademarks in the EU Member States;
- earlier applications or registrations of international trademarks filed with WIPO designating the EU or a Member State;
- earlier well-known marks in the sense of Article 6 *bis* of the Paris Convention;
- earlier non-registered national signs used in the course of trade in one or more Member States of the EU; and
- earlier designations of origin, geographical indications and applications thereof.

EUIPO does not carry an *ex officio* search for prior rights on its own initiative. As a result, prior rights must be invoked by way of formal opposition proceedings, otherwise, an EUTM application will succeed in being registered, even if it is confusingly similar to an earlier mark.

There follow some notable recent cases on likelihood of confusion.

### *Cases where likelihood of confusion was established*

- The marks 'Kompressor' and 'Compressor Technology & device', both for household appliances in classes 7 and 11, were found to be confusingly similar, although their common element 'compressor' was a descriptive term. The argument of the court was that, even when the common elements are descriptive, likelihood of confusion may still exist, if the two marks are highly similar to one another. The court suggested that the fact that the earlier trademark greatly consists of descriptive or non-distinctive elements must be the subject-matter of separate cancellation proceedings, but cannot be taken into account in the context of opposition proceedings.<sup>45</sup> Similarly, the CJEU<sup>46</sup> reaffirmed a judgment of the GCEU<sup>47</sup> that the marks 'Solidfloor, the professional's choice' and 'Solid floor and device', both for building and flooring materials in class 19, were confusingly similar.

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44 CJEU, C-307/10, 19 June 2012.

45 CJEU, C-43/15, 8 November 2016. However, note the difference with the cases relating to the marks 'Airtours', 'Magnext', etc., which are discussed below.

46 CJEU, C-190/15, 19 November 2015.

47 GCEU, T-395/12, 11 February 2015.

In another case, the marks ‘Micro & device’ and ‘Micro in coloured letters’, both in class 9 for photographic equipment, were confusingly similar;<sup>48</sup> in this case, the court also reasoned that in opposition proceedings, an earlier national mark must be considered to have at least a minimum of distinctiveness. The same argument, that is, that in opposition proceedings an earlier national mark must be deemed to be distinctive, even to a low degree, was followed by the GCEU in case T-10/09 (11 December 2014) where the marks ‘F1’ (word mark) and ‘F1’ (figurative), owned by Formula One Licensing BV, were found to be confusingly similar to the mark ‘F1-Live & device’ for print and online media products in classes 16, 38 and 41. In case T-178/16 (6 April 2017), the GCEU found that the mark ‘Policolor & device’ for paints, varnishes, lacquers and similar goods in class 2 is confusingly similar to the mark ‘Proficolor & device’ for the same goods. The fact that the common element ‘color’ is a merely descriptive term, and that each mark was accompanied by a different figurative device, was not sufficient to prevent likelihood of confusion.

- A figurative and position mark consisting of ‘two parallel stripes’ appearing on athletic shoes was found to be confusingly similar to the Adidas earlier ‘three parallel stripes’ mark, although the stripes had a different orientation in each case.<sup>49</sup>
- The marks ‘Smith’ and ‘Anna Smith’, both for clothing and leather products in classes 18 and 25, were found to be confusingly similar, although the common element ‘Smith’ was a common surname.<sup>50</sup>
- In case T-450/13 (12 November 2015), the GCEU found that two marks consisting of the labels of vodka bottles, which shared a representation of a bison animal and a vertical diagonal line (although with a different orientation in each mark) were confusingly similar, because the other word elements appearing on the respective labels were rather descriptive.
- The marks ‘Aquaperfect’ and ‘Waterperfect’, both in class 7, were found to be confusingly similar due to their conceptual similarity, as ‘aqua’ means ‘water’ in Latin and is considered to be a Latin vocabulary term that European consumers clearly understand.<sup>51</sup> In another similar case, likelihood of confusion was established between the marks ‘Vitaminwater’ and ‘Vitaminaqua’ in classes 30 and 32.<sup>52</sup>
- The mark ‘Colombiano House & device’ for restaurant and food services in class 43 was refused registration, because of an earlier protected geographical indication ‘Café de Colombia’.<sup>53</sup>
- The mark ‘Beyond Retro’ for clothing in class 25 was found to be confusingly similar to the mark ‘Beyond Vintage’ for clothing and accessories in classes 18 and 25; however, there was no likelihood of confusion as to watches and jewellery in class 14, for which an application for ‘Beyond Vintage’ was also made, as these goods were considered to be sufficiently dissimilar to clothing in class 25.<sup>54</sup>

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48 GCEU, T-149/12, 16 January 2014.

49 CJEU, C-396/15, 17 February 2016. Note, however, that the Adidas ‘three parallel stripes’ mark was found to be non-distinctive and was cancelled by the EUIPO Boards of Appeal, as discussed above.

50 GCEU, T-295/15, 18 April 2016.

51 GCEU, T-123/14, 28 January 2015.

52 GCEU, T-410/12, 28 November 2013.

53 GCEU, T-387/13, 18 September 2015.

54 GCEU, T-170/12, 30 April 2014.

- The marks ‘Pentasa’ and ‘Octasa’, both for pharmaceuticals in class 5, were found to be sufficiently similar, although they differ as to their respective first part.<sup>55</sup>
- The marks ‘Ginraw’ and ‘Raw’, both for household and kitchen utensils and containers, glassware and other goods in class 21, were found to be confusingly similar, as the term ‘gin’ was likely to be associated with the alcoholic beverage and was hence rather descriptive of the respective goods.<sup>56</sup>

### ***Cases where likelihood of confusion was not established***

- The marks ‘Easy Air-tours’ and ‘Airtours’, both for transport services in class 39, were not found to be confusingly similar, because their common components were descriptive terms.<sup>57</sup> Similarly, the following pairs of marks were not found to be confusingly similar, because the common elements they shared were merely descriptive: ‘Magnext’ and ‘Magnet 4’, both for toys in class 28;<sup>58</sup> ‘Capital Markets & device’ and ‘Carbon Capital Markets’, both for financial and similar services in class 36;<sup>59</sup> ‘Premium & device’ and ‘Premium & device’ both for foodstuffs in class 30.<sup>60</sup>
- The figurative mark ‘Stick Mini MINI Fratelli Beretta & device’, for foodstuffs in class 29 was found to be dissimilar to the word mark ‘Mini Wini’ for similar goods in the same class, as the element ‘Mini MINI’ was considered not to have an independent distinctive role within the combined mark ‘Stick Mini MINI Fratelli Beretta & device’.<sup>61</sup>
- ‘Real estate services’ was found to be dissimilar to ‘financial and banking services’, although ‘real estate appraisal services’ was found to be similar to ‘financial services’.<sup>62</sup> In another case, ‘retail services’ was found to be dissimilar to ‘distribution services’;<sup>63</sup> ‘Watches and jewellery’ in class 14 was found to be dissimilar to ‘Clothing’ in class 25, although both are usually traded through the same channels.<sup>64</sup> ‘Compotes’ were found to be dissimilar to ‘dairy products’.<sup>65</sup> ‘Restaurant and bar services’ were found to be similar to ‘foods and beverages’.<sup>66</sup>

### ***Dilution cases***

- The well-known mark of Calvin Klein ‘CK’ was found not to be diluted by the mark ‘CK Creaciones Kennya’ (both for clothing and leather goods in classes 18 and 25), because the two marks were so dissimilar (although CK was incorporated as such in the later mark), that a ‘link’ between them could not possibly be established.<sup>67</sup> In a similar case, the marks ‘Kinder’ (for food products in class 30) and ‘Ti Mi Kinder Joghurt’ (for yogurt-based products in class 29) were so dissimilar that consumers could not possibly

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55 GCEU, T-501, 502/12, 9 April 2014.

56 GCEU, T-258/16, 7 June 2017.

57 GCEU, T-608/13, 13 May 2015.

58 GCEU, T-604/11 and 292/12, 4 February 2014.

59 GCEU, T-563/08, 22 June 2010.

60 GCEU, T-60/11, 22 May 2012.

61 CJEU, C-182/16, 26 July 2017 confirming GCEU, T-247/14 4 February 2016.

62 GCEU, T-323/14, 17 September 2015.

63 CJEU, C-400/14, 16 July 2015 and T-372/11, 26 June 2014.

64 GCEU, T-170/12, 30 April 2014.

65 GCEU, T-21/15, 26 April 2016.

66 GCEU, T-711, 716/13, 18 February 2016.

67 CJEU, C-254/09, 2 September 2010.

establish a link between the two, although 'Kinder' was incorporated as such in the later mark.<sup>68</sup> In these cases, the CJEU reasoned that, in assessing the level of similarity of the respective marks, the reputation of the earlier mark shall not be taken into account and that such reputation will be considered only at a later stage, in order to assess the likelihood that consumers might make a link between the two marks; but this later stage will not follow at all, unless sufficient similarity is not established in the first place.

- Dilution was not established between the mark 'Grazia' for consulting services in class 35 and financial services in class 36 on the one hand, and an identical mark 'Grazia' for cosmetics, audio visual matter, printed publications, leather goods, clothing and broadcasting in classes 3, 9, 16, 18, 25 and 38. The respective goods and services were so dissimilar that consumers could not possibly establish any link between the two marks.<sup>69</sup>
- The well-known word mark 'Zytel' of Du Pont, which was registered for plastics in classes 1 and 7 was found not to be diluted by a later mark 'Zytel & device' for various goods and services in classes 9, 12 and 37. The reasoning of the court was that the Du Pont mark was addressed to professionals only and, on this ground, it was highly improbable that the later mark could possibly gain unfair advantage, or that professionals could possibly make a link between the two marks.<sup>70</sup>
- The well-known 'Volvo' mark was found not to be diluted by the mark 'Lovol' in classes 7 and 12 because the two marks were sufficiently dissimilar, although they shared the letters 'v', 'o' and 'l', as well as the syllable 'vol'.<sup>71</sup>
- The mark 'MacCoffee' for food and beverages in classes 29, 30, 32 was found to dilute the marks 'McDonald's', 'McNuggets', 'McFlurry', 'McChicken', etc.<sup>72</sup>
- The mark 'Pret A Diner', for food and restaurant services, was found to dilute the reputation of the earlier mark 'Pret A Manger' and 'Pret' for similar goods and services.<sup>73</sup>
- The mark 'Spa Wisdom' applied for by the Body Shop company in respect of cosmetics in class 3, was found to dilute the reputation of the earlier mark 'Spa' registered for mineral water and non-alcoholic beverages in class 32. The court reasoned that, although the term 'spa' was broadly used in respect of health and wellness services based on hydrotherapy, such use was not common in respect of cosmetics. As a result, the term 'spa' was not descriptive in respect of cosmetics.<sup>74</sup>

### iii Inter partes proceedings

*Inter partes* proceedings before EUIPO include (1) oppositions to EUTM applications; (2) applications for invalidity of registered EUTMs; and (3) applications for revocation of registered EUTMs.

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68 CJEU, C-552/09, 24 March 2011.

69 CJEU, C-548/14, 17 September 2015.

70 GCEU, T-288/12, 9 April 2014.

71 GCEU, T-524/11, 12 November 2014.

72 GCEU, T-518/13, 5 July 2016.

73 GCEU, T-2/16, 30 November 2016.

74 GCEU, T-201/14, 16 March 2016.

### ***Oppositions to EUTM applications***

Since EUIPO does not take into account earlier rights on its own initiative, opposition proceedings is the only means of invoking such earlier rights to prevent the registration of an EUTM application. The time limit to file an opposition against an EUTM application is three months from its publication.

### ***Applications for invalidity of registered EUTMs***

If an application for an EUTM has been registered, although there were absolute or relative grounds that should have resulted in its rejection, then this registration is open to cancellation (invalidity). There is no time limit restricting the filing of an application for invalidity. Such an application can be filed either with EUIPO or with a national court of an EU Member State by way of a counterclaim during infringement proceedings initiated by the owner of the EUTM registration which is the subject matter of attack. The effects of invalidity are retrospective and date back to the filing of the contested EUTM registration.

### ***Applications for revocation***

A registered EUTM can be revoked, if:

- the mark has not been used for a period of five consecutive years and there are no proper reasons justifying non-use;
- due to acts or inactivity of the proprietor, the mark has become a common name in trade for a product or service for which it is registered; or
- as a result of the use made of it by its proprietor, the mark has become misleading to the public.

There is no time limit for filing an application for revocation.

The effects of revocation are retrospective, but date back to the date of filing of the application for revocation, or to another date fixed by the decision that revokes the registration.

An application for revocation can be filed either with EUIPO or with a national court of an EU Member State by way of a counterclaim during infringement proceedings initiated by the owner of the EUTM registration which is contested.

In respect of the form of the proceedings for oppositions, applications for invalidity and revocations, see Section II.ii.

### ***Proof of use defence***

EU trademark law adopts the ‘proof of use’ defence. The party who invokes earlier trademark rights may be requested to prove that such rights have been used in the course of trade during the past five years, or that there are reasonable reasons justifying non-use. This is so in opposition, invalidity and revocation proceedings, as well as in infringement proceedings before a civil court. The EUIPO Boards of Appeal has held that unauthorised use of the earlier mark by an infringer and pending litigation with respect to it are reasonable grounds justifying non-use.<sup>75</sup> In addition, CJEU has held that the reasons justifying non-use are only those that have a direct relationship with the respective trademark, make its use impossible or unreasonable, and are independent of the will of its owner.<sup>76</sup>

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75 EUIPO Boards of Appeal case R-2425/2013-4, 28 January 2015, *Chronopost v. DHL*.

76 CJEU, C-246/05, 14 June 2007, *Armin Haepfl v. Lidl Stiftung & Co. KG*.

#### iv Appeals

Decisions of the EUIPO Operations Department on oppositions, applications for invalidity or revocations, as well as decisions of the examiners on absolute grounds preventing trademark registration can be appealed before the EUIPO Boards of Appeal, which can review cases on matters of both fact and law. The decisions of the EUIPO Boards of Appeal can be appealed before the GCEU on matters on law only. The judgments of the GCEU can be appealed before the CJEU on matters of law only (see Section II.ii).

### IV CIVIL LITIGATION

#### *The European Union Trademark*

Infringement cases relating to EUTMs are dealt with by national courts of the Member States according to local rules of civil procedure. Article 95 of Regulation 207/2009/EC provides that Member States shall designate in their territories as limited a number of possible national courts and tribunals of First and Second Instance, which shall have competence to deal with infringement of EUTMs.

A major aspect of such litigation before national courts is that the defendant in infringement proceedings is entitled to file a counterclaim to request the national court to cancel an EUTM, if there are legal grounds that render it invalid (i.e., if it was registered although there were absolute or relative grounds that should have prevented its registration, if it has been filed in bad faith, etc.) or make its revocation possible (i.e., in the case of non-use for a period of five years). This means that national courts are entitled, on the application of a defendant in infringement proceedings, to examine grounds of invalidity or revocation of EUTMs and can cancel such EUTMs. If such a counterclaim has been filed seeking the invalidity or revocation of an EUTM, the EUTM owner can invoke two defences: (1) that the party seeking invalidity or revocation has acquiesced for a period of five consecutive years in the use of the EUTM (see Article 54 of Regulation 207/2009/EC); or (2) a 'proof of use' defence under Article 57 of Regulation 207/2009/EC. In this case, the EUTM owner may request the party filing a counterclaim with the purpose of cancelling the EUTM, to prove that such party has used its own earlier EUTM during a period of five years preceding the counterclaim.

Another important aspect of infringement proceedings relating to EUTMs is that the defendant can invoke the 'proof of use' defence (see Section III.iii (Proof of use defence)). Unless the claimant is able to prove that he or she has used the earlier EUTMs that are being invoked, the legal action will be rejected.

#### *Directive 2004/48/EC on enforcement of intellectual property rights*

Directive 2004/48/EC establishes a legal regime that is favourable to trademark owners regarding the collection of evidence relevant to trademark infringement and remedies. In particular, trademark owners may request a court order, enabling them to inspect third premises where infringing goods are likely to be found, or to make a list of allegedly infringing goods and obtain samples of same, or even provisionally arresting allegedly infringing goods, as well as any other measure that could make it possible to preserve evidence relating to trademark infringement. Such measures can be ordered by a national court under either ordinary or summary proceedings, and may be ordered by a national court without notifying the defendant in advance, or hearing its arguments. Furthermore, the Directive provides

practical criteria for the quantification of damages on the basis of (1) the amount of royalties that would have been due if the infringer had requested a licence; (2) loss of profits suffered by the trademark owner; or (3) the profits made by the infringer.

## **V OTHER ENFORCEMENT PROCEEDINGS**

The EU has developed a particularly efficient system to trace and seize counterfeit goods within customs authorities. The system functions at a European level. The system is established by Regulation 608/2013/EC, and its main characteristics are the following:

- It covers goods infringing any intellectual property right based on EU law, such as trademarks, patents, utility models, supplementary protection certificates, plant varieties, semi-conductor topographies, copyright, industrial designs, as well as protected geographical indications.
- There is an accelerated procedure to secure destruction of infringing goods without a court order.
- There are provisions dealing with counterfeit products imported by post or courier in small consignments.

The Regulation has reduced administrative costs and has ensured that more substantial information is made available so that the customs authorities can be better prepared to take proper action.

The terminology of the Regulation distinguishes three categories of goods: counterfeit goods infringing trademarks; pirated goods infringing copyright; and goods suspected of infringing any other intellectual property right. The Regulation applies only to ‘counterfeit’ and ‘pirated’ goods; it does not apply to parallel imports of genuine goods and overruns, i.e., goods produced by an authorised manufacturer in excess of the quantities ordered by the trademark owner, since these are also genuine products and not counterfeit. Obviously, the Regulation does not apply to goods that are only confusingly similar or diluting.

Seizure of goods means either suspension of the release of the goods or detention of the same. In cases of suspected infringement, seizure can be initiated in two ways. The right-holder may file an application for action (AFA) to any EU customs authority, or goods may be suspected of infringing an IP right and seized without a prior AFA. In the latter scenario, the customs authorities will ask for further information from the right-holder or may ask for an AFA to be filed. An AFA may be filed on a national or European level; a national application refers to a single Member State, whereas a European application will be filed in a Member State, notifying other Member States whose customs authorities have to take action.

The AFA has to identify the intellectual property rights for which protection is requested. It also needs to provide certain information about the original goods and certain clues that will be of assistance to the customs authorities to trace counterfeits. Whether the AFA will be accepted depends on the customs departments. In cases of missing information, the right-holder has 10 days in which to provide all relevant details, but no further extension can be given. If no information is missing, the customs department has 30 days in which to notify the applicant of the acceptance or rejection of their request. If the AFA is accepted, it will remain in force no more than a year and it may be extended, if so requested, for one more year.

When customs authorities trace goods that are suspected of being counterfeit, they notify the owner of the goods within one working day of suspension of release or detention of goods. The right-holder has also to be informed of the decision of the customs authorities and both parties have to be informed about the nature and quantity of the goods. The right-holder is informed of the name and address of the owner of the goods. Both parties have a right to inspect the goods, and the customs authorities may take samples and send them to the right-holder, upon the latter's request. If the right-holder cannot be identified or if no AFA is filed, the customs authorities will stop detention of the goods.

As mentioned before, there is a compulsory accelerated procedure for the destruction of any goods detained. This means that there is no need for judicial proceedings to determine that there is an infringement, provided, though, that two prerequisites are satisfied: (1) the right-holder must confirm in writing within 10 days (or three working days for perishable goods) of notification of the suspension of the release or the detention of goods, that 'in his conviction' an intellectual property right has been infringed and his agreement to the destruction of goods; (2) the holder of the goods must confirm in writing within the same period, i.e., 10 days (or three working days for perishable goods) of notification of the suspension of the release or the detention of goods, that they also agree to the destruction of the goods. Where the holder of the goods has not confirmed agreement to the destruction of the goods nor notified his or her opposition, the customs authorities may deem the holder of the goods to have confirmed agreement to the destruction of those goods. If these conditions are not met, the goods will be released, unless legal proceedings have been initiated. In cases where the holder of the goods has neither agreed to the destruction of goods nor is deemed to have confirmed agreement to the destruction, the customs authorities shall immediately notify the holder of the decision. The latter shall within 10 working days (or three working days for perishable goods) of notification of the suspension of the release or the detention of goods, initiate proceedings to determine whether an IP right has been infringed.

Many complexities were raised by counterfeit goods that were in transit through the EU territory. The CJEU had issued a series of judgments that goods in transit cannot establish trademark infringement, as transit does not qualify as use of a trademark in the course of trade. Hence, since an infringement could not be established, goods in transit could not be detained under the Regulation, even in cases where it was clear that such goods were infringing imitations.<sup>77</sup> In order to overcome this difficulty, Regulation 2015/2424/EU, which amended Regulation 207/2009/EC, expressly provided that

*the proprietor of that EU trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into the Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorisation a trade mark which is identical with the EU trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark. (Article 9.4)*

Hence, this provision, under the current regime, seems to be a solution of the 'in transit' issue in favour of trademark owners. However, this entitlement of the proprietor shall lapse if evidence is provided by the holder of the goods that the proprietor of the EU trademark is not

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<sup>77</sup> CJEU, C-383/98, 6 April 2000, C-60/02, 7 January 2004, C-281/05, 9 November 2006, C-446, 495/09, 1 December 2011. See also CJEU, C-405/03, 18 October 2005 holding that goods supplied to a vessel in the port area have not yet entered the EU territory.

entitled to prohibit the placing of the goods on the market in the country of final destination. Hence, this provision, under the current regime, seems to be a resolution of the ‘in transit’ issue in favour of trademark owners (Article 9.4).

According to EU statistics, in 2016, more than 63,000 detention cases were registered by customs authorities; more than 41 million articles were detained and the value of the equivalent genuine goods is estimated to be just over €672 million. Cigarettes remain at the top of the list of detained articles (24 per cent), followed by toys (17 per cent), foodstuffs (13 per cent) and packaging materials (12 per cent).

## **VI RECENT AND PENDING CASES**

### ***The Kerrygold and Kerrymaid case***

The CJEU has clarified that the peaceful coexistence in two Member States of marks that are confusingly similar (such as ‘Kerrygold’ and ‘Kerrymaid’) does not prevent likelihood of confusion in other Member States. On the evidence, ‘Kerrygold’ and ‘Kerrymaid’ (both for dairy products) coexisted peacefully for many years in Ireland and the United Kingdom. It was argued that, because of the unitary nature of the EUTM, peaceful coexistence in two Member States prevented likelihood of confusion in other Member States as well. The CJEU turned down this argument, confirming that likelihood of confusion depends greatly on the relevant public and that, hence, may be assessed differently in each Member State; this is not in conflict with the unitary nature of the EUTM. It was further argued that peaceful coexistence in two Member States establishes sufficient grounds to argue in favour of limitation of trademark rights in other Member States, but the CJEU turned down this argument as well. Finally, it was argued that in the context of dilution, peaceful coexistence in two Member States establishes ‘due cause’ to use the same mark in other Member States as well and that, hence, it prevented a dilution claim raised in other Member States where the marks do not coexist; the CJEU also rejected this argument.<sup>78</sup>

### ***The case of the cotton flower mark***<sup>79</sup>

Verein Bremer Baumwollbörse (the Bremen Cotton Exchange) (VBB) had registered an EUTM consisting of the figurative representation of a ‘cotton flower’. The mark was filed and registered as an individual mark, but it was actually used as a collective one. VBB was not producing its own products, but was only licensing the mark to other manufacturers of textiles, who promised to comply with good quality standards. There were certain concerns as to whether VBB was exercising efficient quality control on the goods produced by its licensees. VBB brought infringement proceedings against a manufacturer who was using the mark without having obtained a licence. The CJEU, responding to a request for a preliminary ruling submitted by the national court, clarified that ‘genuine use’ of an individual mark exists only if this mark is used as an indication of origin, since this is the essential function of trademarks. In the present case, the use was not one as an indication of origin, but one as an indication of quality. Therefore, the mark was open to revocation for non-use. The CJEU was also requested to consider whether the ‘cotton flower’ mark was deceptive and hence open to invalidation, because, on the evidence, it seemed that VBB was not exercising

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78 CJEU, C-93/16, 20 July 2017.

79 CJEU, C-689/15, 8 June 2017.

sufficient quality control over its licensees. The CJEU responded that a mark is deemed to be deceptive, if it is deceptive *per se* as from its filing; in this respect, the subsequent management and behaviour of the trademark owner or its licensees is irrelevant. It is to be noted, however, that a mark is open to revocation if it is likely to mislead the public, because of the use made of it by its owner after its filing and registration. This issue, though, was not brought to the attention of the CJEU. Finally, this case was decided under the provisions of Regulation 207/2009/EC, as those provisions were phrased before the amending Regulation 2015/2424/EU. By that time, Regulation 207/2009/EC provided for individual marks and collective marks. Regulation 2015/2424/EU supplemented provisions in respect of certification marks as well, which became effective from 1 October 2017. The ‘cotton flower’ mark was actually used as a certification mark and it could be accommodated as such under the new provisions.

### ***The AdWords and On Line Marketplaces cases***

Use of trademarks on the internet raises many complicated and controversial issues. The CJEU has delivered several preliminary rulings, which shed some light on how such complexities can be overcome.

#### *The Google France case*<sup>80</sup>

In the *Google France* case, three French companies alleged that Google had infringed their trademarks by making it possible for other companies to use their trademarks as keywords for internet advertising and promotion. In its preliminary ruling, the CJEU reasoned that a ‘keyword use’ of a sign identical to a trademark cannot establish infringement for an internet referencing provider such as Google, on the ground that such use does not qualify as use of the trademark as such; however, such a ‘keyword use’ could possibly establish infringement on the part of the company that uses a third party’s trademark as a keyword to promote its own goods or services. According to the CJEU, infringement is established when the trademark functions, particularly the origin function, are frustrated. This mainly depends on how the internet advertisement appears. If it appears in a way that an average internet user can understand that it does not originate from the trademark owner, then there is no adverse effect on trademark functions, and no infringement is established. On those grounds, the CJEU concluded that, when the internet advertisement does not enable an average internet user to ascertain whether the goods or services referred to in a website originate from the trademark owner or from a third party, then trademark infringement is established.

#### *The BergSpechte case*<sup>81</sup>

BergSpechte and Trekking at Reisen were both selling trekking and nature tours and, hence, were direct competitors. Trekking at Reisen used two keywords for internet advertisement purposes. The first was identical to one of BergSpechte’s trademarks, while the second was only similar to an earlier trademark of its competitor. In its preliminary ruling, the CJEU followed the reasoning of the *Google France* judgment and concluded that in cases of a keyword that is identical to an earlier trademark, infringement is established if trademark functions are frustrated, i.e., if the internet advertisement does not enable an average internet

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80 CJEU, C-236, 237, 238/08, 23 March 2010.

81 CJEU, C-278/08, 25 March 2010.

user to ascertain where the goods or services originate. On the other hand, when the keyword use is only similar (but not identical) to an earlier trademark, then trademark infringement depends on whether likelihood of confusion or likelihood of association can be established.

*The L'Oréal v. eBay case*<sup>82</sup>

This case related to the sale through the eBay online marketplace of counterfeit goods as well as of goods constituting parallel imports to the EU from non-EEA countries. L'Oréal alleged that eBay was liable for trademark infringement in making such sales possible through its online marketplace. In its preliminary ruling, the CJEU reasoned the following.

- Trademark rights are enforced only against traders, not against consumers; so, sales of goods in online marketplaces can possibly infringe trademark rights, if committed by entities acting on a commercial scale, but not if committed by consumers as a private activity.
- Sales through online marketplaces are subject to the same rules on parallel imports as traditional sales; so, sales originating from non-EEA countries destined for EU countries are illegitimate parallel imports and can be prevented by trademark owners.
- Trademark owners can prohibit an online marketplace from advertising products through Google AdWords by using a keyword that is identical to an earlier trademark, when such advertising does not enable an average internet user to ascertain where such goods originate.
- The mere fact of displaying goods for sale in an online marketplace does not by itself amount to 'use' of the trademarks affixed on such goods. So, an online marketplace does not commit an infringement only because it makes available to potential purchasers goods bearing trademarks of third parties. This type of use is by the sellers of the goods, but not by the marketplace itself.
- An online marketplace may not be able to avail itself of certain defences, which are available to other information society service providers under EU law (Directive 2000/31/EC, Article 14), if it plays an active role in the promotion of the products concerned and thus has knowledge and control over the goods and their status.
- Trademark owners must have available efficient injunctions, sufficient to prevent both current and future infringements.

*The Interflora case*<sup>83</sup>

Interflora was a US-based worldwide flower delivery service. Marks & Spencer, the well-known English retailer, operated its own flower delivery service and used the Interflora trademark as a keyword for internet promotion. In its preliminary ruling on possible trademark infringement, the CJEU repeated the principles laid down in the *Google France* judgment. However, this time the court went further, and examined the potential dilution of the Interflora trademark through its use as an AdWord. The court observed that trademarks with reputation have an additional function, which is called the 'investment function'. It is possible that this function may be adversely affected by the use of the trademark as a keyword by a third party. If this is the case, trademark infringement in the form of dilution is established. However, this requires something more than a mere necessity for the trademark owner to adapt its efforts to

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82 CJEU, C-324/09, 9 December 2010.

83 CJEU, C-323/09, 22 September 2011.

increased competition and to additional strain to preserve its reputation and retain the loyalty of its clients. Dilution, in the form of free riding and detriment to the distinctive character of the trademark concerned, is likely, when the goods displayed on the internet are imitations of the goods of the trademark owner, but this is not necessarily the case, because the goods displayed may not be imitating goods.

## VII OUTLOOK

On 23 March 2016, Regulation 207/2009/EC (regarding the EUTM) was amended by Regulation 2015/2424/EU. The major amendments can be summarised as follows.

- The prerequisite of graphical representation has been abolished. It is now possible to register marks, even though they cannot be represented graphically. This is expected to facilitate the registration of non-traditional types of marks, such as sound marks, etc. However, the mark must still be identified in a clear, precise, self-contained, easily accessible, intelligible, durable and objective way.
- The new Regulation implements the judgment of the CJEU in the *IP Translator* case;<sup>84</sup> as a result all goods or services for which the mark is used, or will be used in the future, must be clearly and precisely reflected in the trademark application. Although the use of the whole class heading is not prohibited, still, in most cases, it will not meet this standard.
- The new Regulation contains specific provisions for ‘certification marks’, which are effective from 1 October 2017, while the old Regulation provided only for individual and collective marks.
- Functionality, both technical and aesthetic, is expressly mentioned and strongly emphasised as an absolute ground preventing registration.
- Designations of origin, geographical indications, traditional terms for wines, traditional specialities guaranteed and plant varieties are expressly mentioned and emphasised as absolute grounds preventing registration. Designations of origin and geographical indications are also mentioned as express relative grounds preventing registration.
- Trademark infringement may be established even in cases of goods in transit through the EU territory, although such goods are not intended to be put into circulation in the Single Market. However, trademark infringement cannot be established if the owner of such goods in transit can prove that the trademark owner is not entitled to prevent the circulation of such goods on the market of their final destination.
- Trademark infringement can be established even in cases of acts that are only of a preparatory nature, such as affixing a registered trademark on packaging, labels or other materials.
- The ‘own name use’ defence is expressly limited to natural persons only. Hence, legal entities are not allowed to invoke the ‘own name’ defence.

Similar amendments were introduced in connection to Directive 2008/95/EC (replaced by Directive 2015/2434/EU) regarding the approximation of national laws of the Member States on trademarks.

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84 CJEU, C-307/10, 19 June 2012.

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