

Intellectual Property Teaching Kit

IP Advanced Part II

Trade marks, copyright,
trade secrets and know-how

Trade marks



IP Advanced Part II

Trade marks

Part of the IP Teaching Kit

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Introduction

Intellectual property reaches into everyone's daily lives. A basic awareness and understanding of IP is therefore essential for today's university students, who are the engineers, researchers, lawyers, politicians and managers of tomorrow.

It is vital that students become acquainted with elementary aspects of IP, so that they can benefit from it fully in whatever career they eventually pursue. Students and universities should be aware too of how they can utilise the incomparable wealth of technical and commercial information to be found in IP documentation, and understand the need for universities to convert their research into IP rights, manage their IP portfolios and engage in technology transfer to industrial partners for value creation and the benefit of society as a whole.

Last but not least, students and universities should be aware of the consequences of failing to protect IP assets correctly, including the risk of reverse engineering, blatant copying and even industrial espionage.

This is where the IP Teaching Kit comes in. Produced by the European Patent Academy in association with the Academy of the EU's Office for the European Union Intellectual Property Office (EUIPO), the IPTK is a collection of materials — including PowerPoint slides, speaking notes and background information — which can be used to put together lectures and presentations on all kinds of IP, including patents, utility models, designs, trade marks, copyright, trade secrets and know-how. The materials can be tailored to the background of the students (science or engineering, business or law), their knowledge of the topic, the time available and their learning objectives.

IP Advanced Part II is the third part of the kit to be produced, following on from the introductory IP Basics and IP Advanced Part I. It contains the tools and information you need to deliver more in-depth lectures on the main aspects of trade marks, copyright, trade secrets and know-how.

With the IP Teaching Kit you have at your disposal an extensive set of freely accessible, professional teaching materials which represents one of the most comprehensive IP teaching resources in the world.

About IP Advanced Part II

IP Advanced II is part of the IPTK. It has been designed for teachers of students with little prior knowledge of intellectual property (IP), in order to provide them with advanced teaching material about trade marks, copyright, trade secrets and know-how.

In addition to the main presentations, IP Advanced Part II contains case studies and exercises on trade marks, copyright, trade secrets and know-how that demonstrate their use in the real world.

IP Advanced Part II consists of ready-made PowerPoint slides with speaking notes and additional background information. The speaking notes can be read out as they stand. The background information provides additional details which will help you prepare for the more advanced questions that students might have. It is not intended for this information to be included in the lecture.

For online access to the extensive IPTK collection, plus updates and further learning opportunities, go to www.epo.org/learning-events/materials/kit.html where you will also find a tutorial for teachers and lecturers.

Slide 1
IP Advanced Part II

Title slide



IP Advanced Part II

Intellectual Property Teaching Kit

1 Trade marks

Trade marks

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Slide 2

Trade marks

This presentation is all about trade marks.

TRADE MARKS

Slide 3

Introduction

The aim of this presentation is not to turn the students into trade mark experts, but to give them a general overview of the core concepts.

The presentation focuses on the European approach to trade marks, and the European Union trade mark system and registration process.

Students should be aware that in some parts of the world the approach may be different. This is particularly true in the United States, where trade mark protection can be obtained through mere use of the mark, and registration is not required. Most European countries expect trade marks to be registered.

Introduction

- **Definition**

- What is a trade mark?
- What are the grounds on which registration can be refused?
- Why is distinctiveness so important?

- **Registration**

- How can a trade mark be registered?
- What happens after registration?

- **Infringement**

- What are the rights conferred?
- What is the scope of protection?
- What are the allowed uses?

This module will introduce you to the core concepts of trade marks and trade mark registration. It is divided into three main parts: definition, registration and infringement.

We will look at the definition of a trade mark, the grounds on which registration can be refused, and the importance of distinctive character. We will find out how to register a trade mark, and what happens after registration. Finally, we will examine the rights and scope of protection afforded by trade marks, and look at aspects of trade mark infringement.

Slide 4

Example of a trade mark

The image on the slide is the logo of H&M Hennes & Mauritz AB, a Swedish multinational retail clothing company with stores all over Europe and the rest of the world. The logo is used in the stores, on the clothes and products and in advertising.

The students are likely to be familiar with this logo. They might also be able to describe what goods are sold by H&M, i.e. the type of products, their quality and price, etc.

Using this example will give the students an idea about trade marks and their functions, especially the origin function.

This logo is registered as a “figurative” European Union trade mark (No. 4320371) for various goods, including soaps, perfumery, cosmetics, jewellery, leather, travelling bags, umbrellas, clothing, footwear and headgear. The image on the slide is the image as it is registered in the European Union Trade Mark Register, i.e. in black and white. In practice, the logo is often used in red.

Example of a trade mark



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The slide shows the logo of H&M, a multinational retail company.

Are you familiar with this logo? If so, where have you seen it? Do you know anything about the type of product which is sold under it?

Slide 5

Definition

This first part will focus on what a trade mark is and what it does, the signs and images that can serve as trade marks, examples of conventional and unconventional marks, absolute grounds for refusal, including lack of distinctive character, and relative grounds for refusal, including assessment of the likelihood of confusion.



In the first part of this presentation we will focus on what constitutes a trade mark. We will start with the legal definition and then go on to summarise the different types of trade mark, with plenty of examples. We will also find out which signs cannot be trade marks because they are excluded from registration due to absolute or relative grounds for refusal.

Slide 6

What is a trade mark?

Definition

A trade mark is a sign, or combination of signs, which distinguishes the goods and services of one undertaking — or company or person — from those of another. The term “undertaking” is used in the EU trade mark legislation. It refers to all types of trader, such as companies, charities and individuals. In this presentation the terms “company”, “business” and “person” are used interchangeably instead.

Trade marks are distinctive signs or indicators used by individuals or businesses to show that products or services originate from a unique source. Trade marks help the consumer to make a choice between similar goods and services from different companies or providers.

The definition of a trade mark is also set out in Article 4 European Union trade mark Regulation (EUTMR) and Article 2 Trade Mark Directive (TMD). This definition states that a trade mark may consist of any signs capable of being represented in the Register of the European Union Trade Marks, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to their proprietors. Representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

The elimination of the requirement of graphical representation will enter into force on 1 October of 2017, once the European Commission issues secondary legislation to complement and develop some of the provisions of the EUTMR.

A sign should therefore be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect.

Said signs include words, including personal names, designs, letters, numerals, and the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one company from those of another.

Trade marks are intangible assets and can represent substantial economic value. Take the company name “Daimler” and its three-pointed star logo, for example. Consumers are interested in purchasing premium-priced cars from this company.

Functions

- The main function of a trade mark is to indicate the commercial source or origin of the products and services concerned. Trade marks serve as a badge of origin. They must allow the consumer to distinguish the products or services of one company from those of another.
- Trade marks also function as a standard of quality. The consumer can be confident, when buying a product or service bearing a particular mark, that the product or service expected will be delivered. Trade marks enable consumers to repeat the choice of goods if the experience was positive, or to not repeat it if the experience was unsatisfactory (judgment of 18/06/2009, C-487/07, ‘L’Oréal v. Bellure’).
- Advertisement is a further function. The proprietor of a trade mark may use the mark for advertising purposes designed to inform and persuade consumers. The mark can be used as a factor in sales promotion or as an instrument of commercial strategy (judgment of 23/03/2010, joined cases C-236/08 to C-238/08, ‘Google AdWords’).

Representation requirement

Only signs that can be represented can be registered as trade marks. A trade mark may therefore consist of any sign capable of being represented in the Register of the European Union Trade Marks, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to their proprietors.

In order to allow for more flexibility while also ensuring greater legal certainty, a sign should be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is “clear, precise, self-contained, easily accessible, intelligible, durable and objective”. These words are taken from the Sieckmann case of the European Court of Justice



What is a trade mark?

- Trade marks are signs which distinguish the goods and services of one business or company from those of another
- They have the following functions:
 - origin
 - quality
 - advertising
- Only signs that can be represented can be trade marks in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to their proprietors

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The main function of trade marks is to indicate the commercial source of the products and services concerned. Trade marks function as a quality standard, so that consumers can be confident when they buy a product or service bearing a particular mark that they are getting the product or service they expect. Trade marks are also used in sales promotion and as an instrument of commercial strategy.

Furthermore, only signs that can be represented in the Register of the European Union Trade Marks, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to their proprietors, can be registered as trade marks.

Please note that the elimination of the requirement of graphical representation will enter into force on 1 October of 2017, once the European Commission issues secondary legislation to complement and develop some of the provisions of the EUTMR.

Trade mark application forms must contain a representation of the sign in question.

In the case of European Union trade marks, the Court of Justice decided that the representation of a sign must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. Signs that do not meet these requirements will not be registered.

This means that, from 1 October 2017, signs can be represented in any appropriate form using generally available technology, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. Ahead of the entry into force of this provision of the Amending Regulation, the Office will provide users with information on the alternative media and formats that are considered to comply with the new provision.

(judgment of 25/01/2003, C-273/00). The Office provides users with information on the media and formats that are considered to comply with the EUTMR. Signs that do not fulfil the requirements must be refused. EUTM

As mentioned before, kindly note that the elimination of the requirement of graphical representation will enter into force on 1 October of 2017, once the European Commission issues secondary legislation to complement and develop some of the provisions of the EUTMR.

This means that, from 1 October 2017, signs can be represented in any appropriate form using generally available technology, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. Ahead of the entry into force of this provision of the Amending Regulation, the Office will provide users with information on the alternative media and formats that are considered to comply with the new provision.

The European Union Intellectual Property Office (EUIPO) reviews this requirement at two stages during the examination procedure. The first stage is during the formalities examination, at which point only the formal aspects of the trade mark application are examined. The second stage is during the examination for the absolute grounds of rejection of the trade mark (Article 7(1)(a) EUTMR).

The representation requirement is mentioned in the definition of a trade mark given in Article 4 EUTMR and Article 3 EUTMD.

Situation in the EU

In the European Union, trade marks are protected at national level by the different national trade mark laws. These national laws have been substantially harmonised by the European Union Trade Mark Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015. This is the consolidated version of the First Directive of 21 December 1988 to “approximate” the laws of the member states relating to trade marks (Directive 89/104/EEC) in order to create as far as possible equal conditions for the registration and protection of trade marks throughout the Union. The directive concerns registered trade marks only.

National trade marks continue to be necessary for those undertakings which do not want protection of their trade marks at Union level, or which are unable to obtain Union-wide protection while national protection does not face any obstacles. It should be left to each person seeking trade mark protection to decide whether the protection is sought only as a national trade mark in one or more Member States, or only as an EU trade mark, or both.

In addition to this harmonisation of the national trade mark systems within the EU, there is also the European Union trade mark (EUTM). The EUTM is governed by the European Union trade mark Regulation (EUTMR). It establishes a uniform regime for trade mark protection at EU level. Unlike patents, European trade marks only cover member countries of the European Union. EUTMs are not valid in Norway or Switzerland, for example. Of course, Norwegian and Swiss companies can still apply for trade mark protection.

The interpretation of trade mark laws, in both the directive and the regulation, is left to the Court of Justice of the European Union, which consists of the Court of Justice and the General Court. The case law (decisions) of the Court of Justice is an especially important source of information about trade marks. It can be found on the court’s website at <http://curia.europa.eu/>

Another important source of information is the EUIPO’s online manual of trade mark practice, which is available at <https://oami.europa.eu/EUIPOportal/en/web/guest/manual-of-trade-mark-practice>



Slide 7

Conventional trade marks

This slide gives an overview of the different types of conventional trade mark. Ask the students to come up with examples of trade marks themselves.

Types of trade mark

Trade marks come in many different types. For conventional trade marks (words, figurative elements, shapes and colours) the representation requirement is easy to fulfil. However, for “unconventional” marks (sounds, movements, smells and tastes, etc.) this hurdle is harder to overcome, since it becomes more difficult to comply with the Sieckmann criteria, according to which the representation should be: clear, precise, self-contained, easily accessible, intelligible, durable and objective. Said criteria have been set out by the Courts and have to be fulfilled.

Talk the students through the different types of trade mark. Give examples of each kind and refer to the representation requirement. A link can also be made with the requirement of distinctiveness of the sign, if it is to be registered as a trade mark. Some signs might be easy to represent, but have little or no distinctive character.

Kindly note that the elimination of the requirement of graphical representation will enter into force on 1 October of 2017, once the European Commission issues secondary legislation to complement and develop some of the provisions of the EUTMR.

Word marks

A word mark is a typewritten mark with elements including letters, words, numerals, keyboard signs and/or punctuation marks.

Examples on the slide: PHILIPS (EUTM 205971) and JUST DO IT (EUTM 514984). Examples not on the slide: VOLVO (EUTM 2361087), 3M (EUTM 4380739).

Signs consisting of verbal elements in non-standard fonts or in colour are known as figurative marks. For example, “adidas” with special letters is protected as both a word mark (EUTM 2288355) and a figurative mark in a special, stylised font (EUTM 8753113).

Figurative marks

Figurative marks are marks consisting of a logo or figurative elements (exclusively or in combination with verbal elements) and verbal elements in a non-standard font or in colour. Verbal elements in a non-EU alphabet, e.g. Chinese characters, are treated as figurative marks. Logos, for example, make excellent trade marks.

Examples on the slide: LEGO (EUTM 2829463), Starbucks (EUTM 5671938), IKEA (EUTM 1019389), M from McDonald’s (EUTM 58461), Audi rings (EUTM 18762), Coca-Cola (EUTM 569731), BMW (EUTM 91884), and adidas three stripes (EUTM 8753238).

Three-dimensional marks

Three-dimensional marks are marks consisting of a three-dimensional shape. This includes containers, packaging and the product itself.

Examples on the slide: Perrier bottle (EUTM 1231737) and cap (EUTM 550723), Toblerone chocolate box (EUTM 31203), Fisherman’s Friend (EUTM 43117), and Duracell battery (shape) (EUTM 146704) which “consists of the combination of the colours black, copper and silver, as applied on the three-dimensional representation of the battery” shown on the slide.

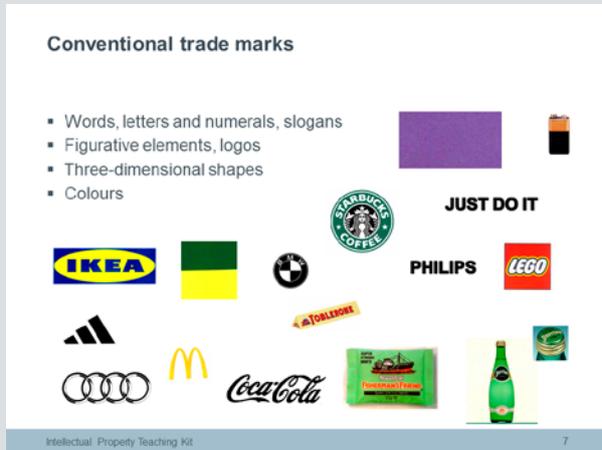
Colour marks

Colours are often used in other types of trade mark, e.g. figurative marks. In the case of colour per se marks, protection is sought for one or more colours, regardless of any specific shape or configuration. Protection is not sought for the colour as part of a figurative mark, e.g. a logo. It is the shade of colour that is protected and, in the case of more than one colour, the ratio in which the combination of colours are arranged. Both single colours and combinations of colours can be registered as trade marks. If the representation contains other matter, such as words or images, it is not a colour per se mark but a figurative mark.

Bear in mind the representation requirement. Referring to the requirement of the graphical representation, please note that the elimination of said requirement will enter into force on 1 October of 2017, once the European Commission issues secondary legislation to complement and develop some of the provisions of the EUTMR.

In some countries, applicants need to include an internationally recognised colour code – for example the Pantone number – in the application. The EUIPO does not insist on this. However, the application must contain an image showing the colour and an indication in words of the actual colour or colours claimed. Where a combination of colours is claimed, the representation must include the position and proportion of the various colours. An abstract claim, for example two colours “in any possible combination”, is not allowable and leads to an objection for lack of a representation which is sufficiently clear and precise (judgment of 24/06/2004, C-49/02, ‘Heidelberger’). For more information and with the aim of being aware of the current practice of the Office, EUIPO provide the users with information on the alternative media and formats that are considered to comply with the provision.

Examples on the slide: Lilac/violet for Milka chocolates (EUTM 31336) and green and yellow for agricultural vehicles (EUTM 3286614) with the following description: “the visible parts of the vehicle and machine bodies, superstructures and/or frames are wholly or mainly green; the wheels/wheel rims are yellow”. Example not on the slide: Duracell battery (colours) (EUTM 8148934) with “colours copper and black in relationship of 1/3 copper to 2/3 black”.



This slide shows some of the different types of trade mark. Can you think of any other examples?

Word marks are typewritten marks with elements including letters, words, numerals, keyboard signs and/or punctuation marks. Signs consisting of verbal elements in non-standard font, in colour or in a non-EU alphabet are known as figurative marks.

Figurative marks are marks consisting of figurative elements (logos or graphic designs) and/or verbal elements in a non-standard font or in colour.

Three-dimensional marks are marks consisting of a three-dimensional shape. This includes containers, packaging and the product itself.

Colour *per se* marks offer protection to one or more colours, regardless of any specific shape or configuration. What is protected is the shade of the colour or colours and, if there is more than one colour, the ratio in which the colours are arranged. If the representation contains other matter, such as words or images, it is a figurative mark rather than a colour *per se* mark.

Slide 8

Unconventional trade marks (audio file included)

Before the entering into force of the Regulation (EU) 2015/2024 of 16 December 2015, unconventional trade marks had trouble fulfilling the graphical representation requirement, and some did not succeed. On 1 October 2017, the requirement of graphical representation will be abolished from the definition of a EUTM, however, unconventional trade marks will still have problems fulfilling the representation requirements due to the strict criteria mentioned in the Sieckmann case. In our slide, all the types of sign mentioned are capable of serving as trade marks, although some of them cannot be registered because they do not fulfil the representation requirements, namely: clarity, precision, self-contained nature, easy accessibility, intelligibility, durability and objectivity

Sound marks

A sound mark can consist of any sound, music or jingle. Just like any other mark, sound marks must be represented graphically. The Court of Justice has given some indications about what is accepted and what will not be registered. Where the representation is limited to a description in words, a simple onomatopoeia or a sequence of musical notes by itself, the requirement is not satisfied. The requirement could be met if the sign is represented using the standard methods for reproducing sound, in particular musical notation, i.e. a clef, musical notes and rests whose form indicates the relative value (judgment of 12/12/2002, C-273/00, 'Shield mark').

In the case of EUTMs, musical notation alone – for example the lyrics of a song combined with musical notations and the tempo – is acceptable. An electronic sound file may be attached if wished, but it is neither necessary nor mandatory.

Some sounds cannot be represented in standard musical notation, for example a lion's roar or Tarzan's yell. In this case other means of representation are needed. The EUIPO will accept sonographs, but only if they are also accompanied by an electronic file containing the sound. In these cases the electronic sound file is mandatory, since the examiner cannot deduce the sound from the sonograph alone.

Example on the slide: Tarzan yell (EUTM 5090055). The slide contains the electronic sound file for the Tarzan yell. Example not on the slide: Haribo tune (EUTM 9460403).

Sound files are accessible in the eSearch Plus database on the EUIPO website.

Animated/movement marks

Movement marks consist of different sequences and contain animation. They can be represented by showing the different sequences of the movement. These images/representations of the mark must be accompanied by a detailed description explaining the animation. If the movement cannot be grasped from the images and description, the mark cannot be registered.

Examples on slide

- Microsoft movement mark (EUTM 5338629) with the following description: "The mark is an animated sequence with two flared segments that join in the upper right portion of the mark. During the animation sequence, a geometric object moves up adjacent the first segment and then down adjacent the second segment, while individual chords within each segment turn from dark to light. Stippling shown in the mark is for shading only. The entire animated sequence has a duration of between one and two seconds."
- Nokia movement mark (EUTM 3429909) with the following description: "The mark comprises an animation which consists of four images depicting hands coming together, shown in succession from left to right and from top to bottom."

Smell/olfactory marks

At the moment there is no way of representing a smell such that it fulfils all the Sieckmann criteria. A description of the smell, e.g. "the smell of vanilla" or "the smell of ripe strawberries", is not clear, precise or objective. Representation by means of a chemical formula is not easily accessible. Only an expert could make sense of the formula. A deposit of the substance or sample of the smell is not long-lasting or durable. The same is true for tastes, e.g. "the taste of artificial strawberry flavour".

While the eSearch Plus database contains a section of olfactory marks, the only accepted trade mark in the database is "the smell of fresh cut grass" for tennis balls (EUTM 428870). This registration has now expired.



Other marks

- **Holograms** are particularly difficult to represent, as a paper representation does not allow the image to change as it would naturally on holographic paper. However, in theory it remains possible given mark descriptions and enough views of the mark. Moreover, EUIPO provides the users with information on the alternative media and formats that are considered to comply with the new provision.
- **Position marks** are signs positioned on a particular part of a product in a constant size or particular proportion to the product. The aim is to protect the placement or position of the mark on the product, so a mark description detailing the positioning is essential.

Examples: light bulb with a “green ring positioned between the lamp base’s electric connectors” (EUTM 3799574) and footwear with a “red stripe placed longitudinally [...] partly covering the rear area of the sole and partly the rear area of the item of footwear” (EUTM 1027747).

- **Tracer marks.** These marks consist of coloured lines or threads applied to certain products and are popular in the textile industry. However, they can also be used outside the textile industry, e.g. as coloured lines on hoses and cables. Example: EUTM 3001203.



Slide 9

Other categories of protection

This slide gives an overview on several aspects of related rights that you will rarely encounter, but which it is important to know about if you are working in certain specialised fields. These are certification marks, collective marks and geographical indications, designations of origin and traditional specialities guaranteed.

These rights overlap with one another to a certain extent, and will be dealt with together.

Certification marks

A certification mark certifies the nature or origin of the goods or services to which it has been applied. This could include the region, location or origin of the goods or services, the materials of construction, method or mode of manufacture or provision, quality assurance, accuracy of the goods or services or any definable characteristic of the goods or services. Certification marks can also certify the manufacture or provision of services by members of an organisation which meet certain standards. For example, UK chartered accountants use the mark CA.

Examples of well-known certification marks include the CE mark, which indicates that products meet a certain safety standard, the woolmark showing that a product is made of wool, or the TÜV mark showing that a product has been tested by the TÜV organisation.

The registration of certification marks is currently possible in the European Union as a whole. The amending Regulation introduced a new EU trade mark type, certification marks, which also exist in most national systems.

However, kindly note that the above mentioned technical change will come into force on 1 October 2017. European Union (EU) certification marks are a new type of trade mark at EU level.

Certification marks differ from collective marks in that a collective mark requires a holder whose members use the mark as a sign for goods or services coming from the collective, whereas a certification mark allows a certifying institution or organisation to permit adherents to the certification system to use the mark as a sign for goods or services complying with the

certification requirements. Thus, certification marks are signs of supervised quality, whereas collective marks do not imply as such a quality claim.

Collective marks

A collective mark is a trade mark that is owned by an organisation and is used by its members to identify themselves with a level of quality or accuracy, geographical origin, or other characteristics set by the organisation. In other words, collective marks do not show the source of origin of the goods from a single trader, but rather from a group of traders.

New collective marks overlap to a certain extent with certification marks, but differ in that they may be used only by the members of the organisation which owns them. Certification marks may be used by anybody who complies with the standards defined by the owner of the particular certification mark.

The registration of collective marks in Europe is set out in Articles 64-72 EUTMR. There are some differences over the usual trade mark registration procedures. The most important difference is that the applicant has to provide a copy of the regulations governing the use of the collective mark.

Geographical indications and designations of origin

The protection of geographical indications and designations of origin is covered by the following EU regulations:

- Regulation No. 1151/2012 on the protection of geographical indications for agricultural products and foodstuffs;
- Regulation (EU) No 1308/2013 on the protection of geographical indications for wines;
- Regulation (EU) No 251/2014 on the protection of geographical indications for aromatised wines;
- Regulation (EC) No 110/2008 on the protection of geographical indications for spirit drinks.

Both geographical indications and designations of origin are used to indicate agricultural products, foodstuffs, wines, aromatised wines and spirits from a defined geographical area. In other words they do not indicate the origin of the products from a single trader, but from one or more producers in a particular area.



Other categories of protection

- Certification marks
 - CE mark, woolmark, TÜV
- Collective marks
- Protected geographical indications (PGI)
 - Turrón di Alicante, Ardennes ham
- Protected designation of origin (PDO)
 - Parma ham, Mozzarella di Bufala Campana, feta cheese
- Traditional specialities guaranteed (TSG)
 - Kriek beer, Mozzarella cheese, Serrano ham

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We will now deal with several different categories of protection which are related to trade marks which overlap to a certain extent. They are much less common, so you do not need to know much about them unless you are working in specialised areas.

Certification marks certify the nature or origin of the goods or services to which they have been applied. This could include the region, location or origin of the goods or services, the materials of construction, the method or mode of manufacture or provision, and so on. They can also certify the manufacture or provision of services by members of an organisation that meet certain standards. Examples include the CE mark and the woolmark.

Collective marks are trade marks that are owned by an organisation and used by its members to identify themselves with a level of quality or accuracy, geographical origin, or other characteristics set by the organisation. In other

words, they show the source of origin of the goods from a group of traders. The CA mark, for example, is used in the UK by chartered accountants.

Geographical indications, designations of origin and traditional specialities guaranteed are used to protect the names of agricultural products, foodstuffs, wines, aromatized wines and spirits.

Geographical indications and designations of origin are used to indicate agricultural products and foodstuffs, wines, aromatized wines and spirits from a defined geographical area. In the foodstuffs sector, protected designations of origin (PDO) describe foodstuffs which are produced, processed and prepared in a given geographical area using recognised know-how. Protected geographical indications indicate a link with the area in at least one of the stages of production, processing or preparation. The link with the area is therefore stronger for PDOs.

Finally, traditional specialities guaranteed is for products produced using traditional raw materials and characterised by a traditional composition or by a method of production or processing that corresponds to a traditional method. There is no need for a link to a particular area.

The two types of geographical description are different. For example, in the foodstuffs sector, PDO ("protected designation of origin") is used to describe foodstuffs which are produced, processed and prepared in a given geographical area using recognised know-how. Examples include Mozzarella di Bufala Campana. PGI ("protected geographical indication") indicates a link with the area in at least one of the stages of production, processing or preparation (such as Turrón de Alicante). The link with the area is therefore stronger for PDOs.

Applications for PDOs and PGIs are made not with the EUIPO, but with the individual member states of the European Union. Each state has designated an office responsible for processing such applications. These are then published in the Official Journal of the European Union for objections to be raised before being entered into a separate register.

Some PDOs and PGIs are originally registered as trade marks, but trade mark registration is not possible once a PDO or PGI has been applied for (Article 14(1) of Regulation 1115/2012).

In the area of absolute grounds for refusal, the European Union Trademark Regulation clarifies the degree of protection vis-à-vis trade marks of designations and origin, geographical indications, traditional terms for wine, traditional specialities guaranteed and plant variety rights, ensuring full consistency with relevant Union and national legislation providing for the protection of these intellectual property titles.

Moreover, in the area of relative ground for refusal, the Regulation introduces a specific ground of opposition and cancellation on the basis of PDOs/PGIs, in both opposition and cancellation proceedings, which allows the opponent or invalidity applicant to rely on the protected designation of origin or geographical indication. In addition, the opponent or invalidity applicant who relies on these specific earlier rights is no longer required to prove that they have been subject to use in the course of trade of more than mere local significance.

Traditional specialities guaranteed (TSG)

Finally, there is a separate register for products produced using traditional raw materials and characterised by a traditional composition or by a method of production or processing that corresponds to a traditional production/processing method. Protection is granted under the same European Union Regulation No. 1151/2012 and based on the older Regulation No. 509/2006, and the registration procedures are similar to those for PGIs and PDOs. There is no need for a link to a particular area.



Slide 10

What cannot be a trade mark (I)

This slide looks at absolute grounds for refusal. These grounds for refusal are usually examined by the examiner *ex officio* during the application procedure carried out by the trade mark office. If absolute grounds for refusal exist, the application will be rejected. However, some grounds for refusal can be remedied.

Signs which do not conform to the requirement of Article 4

First, the registration of the sign will be rejected if it cannot fulfil the representation requirement as discussed in previous slides.

Signs devoid of any distinctive character

These signs lack inherent distinctiveness. They are not capable of distinguishing the goods and services. The average consumer does not perceive the mark as a distinctive sign. These marks cannot fulfil the essential function of guaranteeing the identity of the origin of the marked goods or services to the consumer (Article 7(1)(b) EUTMR and Article 3(1)(b) TMD).

When assessing the distinctive character of a trade mark no distinction can be made between different categories of trade marks. However, in practice, some trade marks might have difficulty being registered due to the perception of the average consumer. For instance:

- Colour *per se* marks. It can be difficult to register a sign as a colour *per se* mark, especially a single-colour mark. The Court of Justice has stated that a single colour is not distinctive for any goods and services except under very special circumstances (judgment of 06/05/2003, C-104/01, ‘Libertel’). The consumer will generally not perceive the colour as a distinctive sign or an indication of the commercial origin of certain goods and services. Such very special circumstances require the applicant to demonstrate that the mark is absolutely unusual, i.e. striking, in relation to these specific goods and services. These cases will be extremely rare, for example in the case of the colour pink applied to insulating material. Combinations of colours are accepted more easily. Colours could also lack distinctive character because they are descriptive or they indicate a particular characteristic of the good, e.g. red for fire extinguishers, yellow for lemon-flavoured products.
- Slogans can be used as trade marks, although it might be difficult to establish the distinctive character of the sign. In essence slogans must be treated in the

same way as all other marks, but the perception of the average consumer might be different when encountering a slogan. The distinctiveness of the slogan might be harder to establish, because a slogan sends a message that could apply to any supplier of goods and services and therefore is not capable of being used as a badge of origin to indicate a single company. Value statements (“Caring for the planet”), customer service statements (“Putting you first”) or purely promotional statements (“Say it with champagne”) are not distinctive. Slogans can be distinctive only if they contain an element of fancifulness, such as a play on words, using an element of irony or by alteration and rhyme. Examples of slogans which are distinctive: “Just do it” (EUTM 514984) for sports shoes and “Vorsprung durch Technik” (EUTM 621086) for cars.

- Marks that consist of the shape of the product itself generally lack distinctive character, because they do not differ substantially from other shapes which exist in the market. Although no stricter criteria apply when assessing distinctive character, it may be more difficult to establish distinctiveness, as the average consumer is not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. In other words, the average consumer is less likely to see the shape or packaging of the product as a trade mark. For example, the shape of a torch or flashlight (judgment of 07/10/2004, C-136/02 P, ‘Maglite’) is not distinctive. Only shapes that depart significantly from the norm are usually acceptable. Special perfume bottles have been registered, such as EUTM 5043021.

What cannot be a trade mark (I)

Registration of a trade mark can be rejected based on "absolute grounds for refusal". This applies to:

- Signs that cannot be represented
- Signs devoid of any distinctive character

Applications for registration of a trade mark can be rejected based on absolute grounds for refusal.

If absolute grounds for refusal are found to exist by the examiner at the relevant trade mark office, the application will be rejected. However, some grounds for refusal can be remedied or overcome.

What are absolute grounds for refusal?

Firstly, registration will be refused if the sign does not fulfil the **representation** requirement we talked about earlier.

Secondly, to be registered as a trade mark, a sign must always have a **distinctive character**. A mark is distinctive if it can fulfil the origin function. When assessing the distinctive character, no distinction can be made between different categories of trade marks. However,

some trade marks might lack distinctive character due to a different consumer perception.

In the case of colour per se marks, the consumer might not perceive the colour as an indication of the commercial origin of certain goods and services.

As far as slogans are concerned, the perception of the average consumer might be different, because slogans send a message that could apply to any trader.

Marks that consist of the shape of the goods themselves generally lack distinctive character, because they do not differ substantially from other shapes in the market. The average consumer is not in the habit of making assumptions about the origin of products on the basis of their shape in the absence of any graphic or word element.

Slide 11

What cannot be a trade mark (II)

Descriptive signs

Signs can also lack distinctive character because they are descriptive of the goods and services for which registration is applied. A trade mark is descriptive if it consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or of rendering of the service, or other characteristics of the goods or service. The public interest underlying this ground for refusal is that no exclusive rights should be created for purely descriptive terms which other traders might also wish to use, as well as in the interest of the public that terms which have a purely informational value should not be reserved for one single trader (Article 7(1)(c) EUTMR and Article 3(1)(c) TMD).

Generic signs

A trade mark is generic if it consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade. An example is the abbreviation “BSS” for “balanced salt solution”, which has become customary for ophthalmic pharmaceutical preparations, as used by a specialised public (judgment of 05/10/2004, C-192/03 P, ‘Alcon’). This term can also cover figurative elements which either are frequent or have become the standard designation for goods and services, for example a white P on a blue background for parking places or the Aesculapian staff for a dispensing chemist or pharmacy. This ground for refusal deals with marks that have become generic or customary before registration. If a registered trade mark becomes generic after registration, it can be revoked (Article 7(1)(d) EUTMEUTMR and Article 3(1)(d) TMD).

Acquired distinctiveness

However, signs that are devoid of any distinctive character, descriptive or generic at the beginning can still acquire distinctiveness through the substantive use made of them. The applicant can show that the mark has become distinctive, i.e. capable of being recognised by sufficiently large numbers of the relevant public as being the mark of one single trader. The applicant will have to prove this extensive use of the mark. Evidence can consist of opinion polls, surveys, statements from the trade and consumer organisations, articles, brochures, samples, evidence of turnover and advertising and other types of promotion, of successful prosecution of infringers, of trade mark registrations obtained in other countries, etc.

Marks that have no inherent distinctive character or are descriptive or generic can still be registered trade marks because of the extensive use made of the trade mark (Article 7(3) EUTMR and Article 3(3) TMD).

Point of view – Average consumer

The distinctive character of a sign must be assessed from the point of view of the average consumer of the products or services for which the mark is registered. The average consumer is reasonably well informed, reasonably observant and circumspect. The level of attention of the average consumer can vary according to the goods or services involved. The consumer will pay more attention when the goods are more expensive, e.g. when buying a car. The distinctive character of a sign must always be assessed in relation to the goods and services for which registration is applied for. Clearly there is a difference in the average consumer between purchasers of cars and purchasers of prescription medicines. The general public will purchase cars, whereas only doctors and pharmacists are purchasers of prescriptive medicines, and the assessment needs to take this into account.

What cannot be a trade mark (II)

- Signs which are descriptive
- Signs which are generic

However, acquiring distinctive character through use is possible

A sign is **descriptive** if it consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or the rendering of the service, or other characteristics of the goods or service.

A sign is **generic** if it consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade. It can also cover figurative elements which are either frequent or have become the standard designation for goods and services.

Marks that have no inherent distinctive character or are descriptive or generic can still **acquire distinctiveness** through extensive use. A trade mark is considered to have become distinctive if it is capable of being recognised by a sufficiently large part of the relevant

public as the mark of one single company or organisation.

The distinctive character of a sign must be assessed from the point of view of the average consumer, who is reasonably well informed, observant and circumspect. The level of attention of the average consumer can vary depending on the goods or services involved. The distinctive character of a sign must always be assessed in relation to the goods and services for which registration is sought.

Slide 12

Scale or degree of distinctiveness

The more distinctive the trade mark, the stronger the mark. Strong marks therefore give wider protection. However, more distinctive marks, i.e. non-descriptive or non-generic marks, typically require more investment in marketing to raise consumer awareness.

The distinctive character of trade marks can be represented on a sliding scale from non-registrable trade marks (generic and descriptive signs), to registrable signs (suggestive and fanciful or arbitrary signs). An example of a sign that is generic would be “Fruit” for apples.

For a mark to be descriptive the relationship between the mark and the descriptive meaning must be concrete, direct and understandable without further reflection. There must be a sufficiently close relationship between the goods and services and the mark, e.g. “Computerland” for a computer store. On the other hand, a mark is not descriptive if the term is only suggestive of or allusive to certain characteristics of the goods. Sometimes this is also called a vague or indirect reference to the goods.

The dividing line is difficult to draw. Suggestive terms are those which suggest certain characteristics of the goods, without really describing them. However, it must be borne in mind that it will suffice for the application to be refused if there is a sufficiently direct relationship between the mark and the goods. One example of a suggestive, registrable term is “Playboy” for a men’s magazine. Allusive terms can best be described as plays on words. For example, “It is only lunch” is allusive for match-making agencies, as this is exactly the opposite of what the client expects. Fanciful signs, e.g. “Yahoo!” or “Amazon” for internet sites, or arbitrary signs, e.g. “Apple” for computers, have an average distinctive character.

A lack of inherent distinctive character can be remedied. It is possible for a mark to acquire distinctiveness through use.

Slide 13

Absolute grounds for refusal

Other types of sign may also be refused on absolute grounds. Unlike a lack of distinctive character, these grounds cannot be remedied or overcome by proving that the sign has acquired distinctiveness through use.

Certain shape marks

Certain 3D marks cannot be registered (Article 7(1)(e) EUMR and Article 3(1)(e) TMD). These are signs that consist exclusively of:

- A shape, or another characteristic, which results from the nature of the goods themselves, e.g. the shape of a football for a football or the shape of an umbrella for an umbrella, etc. This ground for refusal serves to prevent individual traders from monopolising shapes which must be used and cannot be avoided (Article 7(1)(e)(i)).
- A shape, or another characteristic, of goods which is necessary to obtain a technical result (Article 7(1)(e)(ii)). A shape which is exclusively technical in form cannot be registered. A shape can still be necessary to obtain the technical result, even when there are other shapes that can achieve the same result, e.g. the Philips razor (judgment of 18/06/2002, C-299/99, ‘Philips v. Remington’) and the Lego building block (judgment of 14/09/2010, C-48/09 P, ‘Lego Juris’).
- A shape, or another characteristic, which gives substantial value to the goods (Article 7(1)(e)(iii)). This ground for refusal is limited to shapes which have an exclusively aesthetic or pleasing function, such as the shape of a work of art for works of art, as the shape has nothing to do with the commercial value of the goods. The value that the shape or sign possesses is purely aesthetic. Signs which contribute significantly to the cost of a product, e.g. children’s shampoo bottles, are excluded from being registered. Example: B&O speakers (see trade mark case study module).

Signs contrary to public policy or accepted principles of morality

Signs contrary to public policy or accepted principles of morality are excluded from trade mark protection (Article 7(1)(f) EUTMR and Article 3(1)(f) TMD).

The purpose of these exclusions is to preclude trade marks from registration where granting a monopoly would undermine the state of law or would be perceived by the relevant public as going directly against the basic

moral norms of society. Note that the intrinsic qualities of the mark applied for are relevant when assessing this ground for refusal. Circumstances relating to the conduct of the person applying for the trade mark are irrelevant. For example, the fact that the trade mark owner is prohibited, under national legislation in a member state, from offering services, for example because of lack of a gambling licence, does not make the trade mark in itself contrary to public policy or accepted principles of morality (see, for example, judgment of 13/09/2005, T-140/02, ‘Intertops’).

“**Public policy**” is the body of all legal rules that are necessary for the functioning of a democratic society and a state of law. For a sign to be excluded from protection under this objection it is necessary that the sign itself or the message it conveys be prohibited by law, within one member state or at EU level. For example, in certain member states of the EU the use of the symbols of Nazi organisations is forbidden and so these symbols cannot be registered as a EUTM. This assessment is thus based on objective criteria and not the perception of the public.

“**Accepted principles of morality**” are those principles that are absolutely necessary for the proper functioning of society. This objection therefore excludes the registration of blasphemous, racist or discriminatory words or phrases. There is no need for the sign to be illegal or prohibited by law. What matters is the offensive impact on people of normal sensitivity. The assessment of the nature of the sign must be conducted from the point of view of the reasonable consumer with an average sensitivity and tolerance threshold. The mark must have an effect that is against the basic norms of society. This ground for refusal, therefore, is not concerned with bad taste or the protection of the feelings of individuals.

In practice, it is sometimes difficult to draw the line between what is in poor taste (allowed) and what is contrary to public policy or morality (not allowed). With regard to the EUTM this is even more difficult. Like all the other grounds for refusal, this is a European criterion and needs to be considered Europe-wide. It might be difficult to establish what would be unacceptable in a certain member state. Furthermore, if a sign is against public policy or morality in one member state, the registration of the mark as a EUTM for the whole of Europe is not possible. This is the “all or nothing” effect of the EUTM, due to the unitary character of it.



Absolute grounds for refusal

- Certain three-dimensional shapes
- Signs contrary to public policy or morality
- Deceptive trade marks
- Signs which consist of flags and other protected symbols
- Protected geographical indications

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Other types of sign may also be refused on absolute grounds. Unlike a lack of distinctive character these grounds cannot be overcome by extensive use of the sign.

Certain shape marks cannot be registered. These include: signs that consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves; the shape, or another characteristic, of the goods which is necessary to obtain a technical result; or the shape, or another characteristic which gives substantial value to the goods.

Signs contrary to “public policy” or “accepted principles of morality” are also excluded from trade mark protection. “Public policy” is the body of all legal rules that are necessary for the functioning of a democratic society and a state of law. “Accepted principles of morality” are those principles that are absolutely necessary for the proper functioning of a society. Only the intrinsic qualities of the mark applied for are relevant,

not the conduct of the applicant. Examples of signs that are excluded are signs that are against the law; blasphemous, offensive, racist or discriminatory terms; all direct references or incitements to commit criminal acts; and names of terrorist organisations.

Trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services, will be refused registration.

Identical reproductions of flags and symbols, emblems of states and international intergovernmental organisations as well as “heraldic imitations” can be incorporated in trade marks only on condition that the authority concerned has authorised their use.

Protected geographical indications and protected designations of origin enjoy special protection under EU law. Trade marks which consist of or contain or evoke PGIs or PDOs and where the goods do not have the claimed geographical origin will be refused.

One example is the coat of arms of the Soviet Union. Registration as a trade mark or a part of a trade mark is not possible in the EU (decision of 05/03/2010, R 1509/2008-2, 'Couture Tech'; and judgment of 20/09/2011, T-232/10, 'Couture Tech'). The display of Soviet symbols in public is prohibited by criminal legislation in Hungary and Latvia, among other countries. Other examples include the term "Paki", which is used as an insult to British citizens of Pakistani origin (judgment of 05/10/2011, T-526/09).

Note that refusal to register the sign only means that protection under trade mark law is not possible. It does not stop the sign from being used, even in business. It may also be possible to obtain a national trade mark registration in some countries where the offensive nature of the sign might not be recognised.

Deceptive trade marks

Trade marks which can deceive the public, for instance as to the nature, quality or geographical origin of the goods or service, will be refused registration (Article 7(1)(g) EUTMR and Article 3(1)(g) TMD).

This ground for refusal requires the existence of actual deceit or of a sufficiently serious risk that the consumer will be deceived (judgment of 04/03/1999, C-87/97, 'Gorgonzola').

An objection will be raised when registration is sought for goods and services that make a non-deceptive use of the trade mark impossible, e.g. "Lactofree" for lactose. The nature of the sign would immediately lead the relevant consumer to believe that the product in question does not contain any lactose. If the product that is being marketed under the sign "Lactofree" is actually lactose itself, then the mark would be clearly misleading (decision of 19/11/2009, R 892/2009-1, LACTOFREE).

Flags and other state symbols

Flags and symbols or emblems of states and international intergovernmental organisations are protected under Article 6ter of the Paris Convention for the Protection of Industrial Property ("Paris Convention") (Article 7(1)(h)-(i) EUTMR; Article 3(1)(h) and (2)(c) TMD).

The objective of the article is to exclude the registration and use of trade marks which are identical or similar to state emblems or emblems of international intergovernmental organisations. The registration of such

signs would violate the right of the country concerned to control the use of its symbols. It might also mislead the public with respect to the origin of goods or services. Make it clear to the students that flags and symbols might still be incorporated in a trade mark, but only on the condition that a competent authority has authorised the use.

A distinction must be made between three different situations: a mark containing (1) a state flag, (2) a state symbol other than a state flag, and (3) a flag or a symbol of an international intergovernmental organisation.

The identical reproduction of state flags in trade marks is prohibited, for example the use of the Swedish flag in the figurative mark "Swedish Navy" (EUTM Application 1956937). "Heraldic imitations" are also excluded. There will be a heraldic imitation only when the degree of similarity between the flag and the mark is quite high. The reason for this is that state flags and other state symbols frequently contain elements which are in themselves common, e.g. a lion or a bear. When making the comparison the colours, structure, shape and relative proportions of the flag are relevant. A representation of the flag in black and white may still be considered a heraldic imitation when the flag consists of or contains unique heraldic figures or symbols. Flags consisting only of bands of three colours in black and white reproduction will not be a heraldic imitation, because flags of that kind are quite common. This is not the case for the maple leaf in the Canadian flag. Use of the Canadian flag in black and white by River Woods in EUTM Application 2793495 was therefore considered a heraldic imitation.

A change in the shape of the flag may not be considered a heraldic imitation.

Examples

- Use of the French flag in EUTM 4624987 was allowed by the General Court (judgment of 05/05/2011, T-41/10, 'Ecole du ski français').
- Use of the Finnish flag in EUTM 7087281, "Finntastic", was also allowed.

Flags of state are protected without any need to be incorporated in a specific list of state emblems. Other state symbols must be incorporated in the list of state



emblems as registered by the World Intellectual Property Organization (WIPO). Examples of protected emblems are the Holy Seal (6ter number VA9) and the Canadian maple leaf (6ter number CA2). See also judgment of 16/06/2009, C-202/08 P, “RW” (EUTM Application 2785368). The list of state emblems can be found with a search tool at www.wipo.int/ipdl/en/6ter/

The flags and symbols of international intergovernmental organisations which are included in the list of state emblems are also protected, where there is a risk that the public could believe that there is a connection with the organisation. Note that even flags of international intergovernmental organisations must be incorporated in the list of state emblems. In contrast, flags of states are protected without inclusion in the list. The mark must also suggest to the public that there exists a connection between the flag and the organisation. In this respect, the goods and services for which the mark is applied for are always of relevance. As a result, any refusal of registration will have to specify which goods and services are affected. The flag of the EU is incorporated in the list and has led to refusals, for example in the judgment of 21/04/2004, T-127/02, “ECA”. For more on Article 6ter Paris Convention go to www.wipo.int/article6ter/en/

Some emblems and badges not covered by the Paris Convention are still protected and excluded from trade mark registration (Article 7(1)(i) EUTMR and Article 3(2)(c) TMD). However, only those symbols are protected which are of particular public interest. For EUTMs such particular interest can be shown by an international treaty or convention to which all or some of the member states of the EU are party. For example, the symbols (and names) of the “Red Cross”, “Red Crescent” and “Red Crystal” are reserved and protected by the Geneva Convention, which is signed by all the member states of the EU.

PGIs and PDOs

Protected geographical indications and designations of origin are also excluded. PGIs and PDOs enjoy special protection under EU law. The absolute grounds for refusal refer to trade marks which are excluded from registration under Article 7(1)(j), pursuant to Union legislation or national law or to international agreements to which the Union or the Member State concerned is party, providing for protection of designation of origin (PDOs) and geographical indications (PGIs).

Traditional terms for wine

The UETMR provides the same protection to trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine (Article 7(1)(k)). It is a ground for refusal of EUTMs, introduced for reasons of coherence, in order to offer an equivalent degree of protection to traditional terms for wine as to designations of origin and geographical indications for wines. The scope of protection of protected TTWs seems narrower than that of PDO/PGIs.

Traditional specialties guaranteed

The same applies with regard to trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional specialties guaranteed (Article 7(1)(l)). Just as in the case of TTWs, it is a ground for refusal of EUTMs, introduced for reasons of coherence, in order to offer an equivalent degree of protection to traditional specialties guaranteed to designations of origin and geographical indications. Article 17 of Regulation (EU) No 1151/2012 indicates that ‘A scheme for traditional specialties guaranteed is established to safeguard traditional methods of production and recipes by helping producers of traditional product[s] in marketing and communicating the value-adding attributes of their traditional recipes and products to consumers’.

Plant variety rights

Finally, the EUTMR excludes from registration those trade marks which consists of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation or national law, or international agreements to which the Union or the Member State concerned is a party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species (Article 7(1)(m)). Protection is granted to plant variety denominations in order, inter alia, to protect the legitimate interest of consumers and producers in knowing the variety they are using or purchasing, as well as possibly the breeder and origin of that variety. The obligation to use the variety denominations contributes to the regulation of the market and to the safety of transactions in the agricultural and food sector, thus preventing counterfeiting and any potential misleading of the public.

Slide 14

Relative grounds for refusal

This slide deals with relative grounds for refusal and the likelihood of confusion. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied shall not be registered under specific circumstances.

Relative grounds for refusal are not examined *ex officio* by most of the trade mark offices in Europe or by the EUIPO. It is up to the proprietors of earlier trade marks to file an opposition against the registration of similar or identical trade marks.

As explained before, a trade mark is a sign which serves to distinguish the goods or services of one trader from those of other traders or companies. The sign must enable the consumer to distinguish, without any possibility of confusion, the goods or services concerned from goods and services which have a different commercial origin. As long as there can be no confusion about the origin of the goods and services, two trade marks can peacefully coexist on the market.

This might not be the case if the two marks are so similar that it is not possible to distinguish them from one another, or if it is possible that consumers might confuse the origin of the goods and services, i.e. if they might think that they come from the same company. This is called the likelihood of confusion.

In short, the peaceful coexistence of two trade marks on the market can be an issue if an identical/similar trade mark is already protected for identical/similar goods and services and there is a likelihood of confusion between the two.

Moreover, the Regulation provides a specific ground for refusal, in both opposition and cancellation proceedings, which allow the opponent or invalidity applicant to rely on a protected designation of origin or geographical indication, in case that:

- An application for a designation of origin or a geographical indication has already been submitted, in accordance with Union legislation or national law, before the date of application or the date of the priority claimed for the applicant –subject to its subsequent registration.
- That designation of origin or geographical indication confers the right to prohibit the use of a subsequent trade mark

Relative grounds for refusal

- The coexistence of two trade marks on the market can be an issue if:
 - an **identical** trade mark is already protected for identical or similar goods and services
 - a **similar** trade mark is already protected for identical or similar goods and services **and** there is a **likelihood of confusion** between the two signs
 - Risk of confusion about the origin of the goods and services

We know that some trade mark applicants file new marks which are similar to older trade marks. The coexistence of two such trade marks can be an issue (a) if an identical trade mark is already protected for identical or similar goods and services or (b) if there is a similar trade mark which is already protected for identical or similar goods and services and also there is a likelihood of confusion between the two trade marks, or between a trade mark and a designation of origin or geographical indication.

In other words, we want to ensure that members of the public are not confused about the origin of the goods and services.

Slide 15

Assessing the likelihood of confusion

The likelihood of confusion depends on a number of factors. The two most important factors are the degree of similarity between the goods and services and the degree of similarity between the signs.

Degree of similarity between the signs

In determining the existence of the likelihood of confusion, trade marks have to be compared by making an overall assessment of the visual, phonetic and conceptual similarities between them. All signs can be visually compared, but only those signs which incorporate words or numerals can be aurally compared. Signs that reproduce images cannot be aurally compared. Only words, numerals and images that have a semantic meaning can be conceptually compared (this was explained in a decision concerning jumping cats: judgment of 11/11/1997, C-251/95, 'Sabèl').

Degree of similarity between the goods and services

In assessing the similarity between the goods and services, all the relevant factors relating to those goods and services should be taken into account. These include the nature of the goods (what are they?), their end users, their method of use (how are they used?) and whether they are in competition with each other or complementary (is there an essential or significant link between the goods or services?). Other factors include the intended purpose (what need do they satisfy?) of the goods and services, the usual origin and the distribution channels (main European Court of Justice case: judgment of 29/09/1998, C-39/97, 'Canon').

Overall assessment

Other factors may be relevant to the case, such as the relevant public and the degree of attention of the relevant consumer. The distinctiveness of the earlier mark and the distinctive or dominant elements of the signs can also be taken into account. The final result is reached by evaluating and weighing up all these factors together. This means that a lesser degree of similarity between two signs can be offset by a greater degree of similarity between the goods and services, and vice versa.

Assessing the likelihood of confusion

- Similarity between signs
- Similarity between goods and services
- Overall assessment

The likelihood of confusion depends on a number of factors. The two most important factors are the degree of similarity between the goods and services and the degree of similarity between the signs.

The similarity between two signs is assessed from a visual, aural and conceptual perspective.

The factors taken into account include the nature of the goods and services, their intended use, and complementary or competing goods.

Other factors that may be relevant to the case include the relevant public and the degree of attention of the relevant consumer. The overall assessment is based on all of these factors put together.

Slide 16

Registration

The second part of the presentation will focus on how to obtain trade mark protection via registration. The different routes for registering a trade mark will be examined. Special attention will be paid to the European Union trade mark system (principles, advantages and procedure) and the Madrid International Registration System. This second part will end with an overview of what can happen after registration.

REGISTRATION

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The second part of this presentation deals with trade mark registration.

Slide 17

How to obtain registration

In Europe, trade mark protection is obtained through registration. Different routes are available to applicants, depending on their current and future plans for the product or service.

National route

National applications can be filed at the national trade mark offices in those countries where protection is needed.

European route

At European Union level, trade mark law in all member states has been harmonised by the European Union Trade Mark Directive (EUTMD). This means that the requirements for obtaining trade marks are substantially the same. There may, however, be some national differences in the registration procedure.

Registration can be sought in the European Union Intellectual Property Office (EUIPO) to obtain protection that extends over the whole territory of the EU. The Office provides a fast, high quality, streamlined trade mark registration system, which is also consistent, user friendly, publicly accessible and technologically up to date. Applicants should consider this option if they want protection in several countries within the EU.

International route

International application and registration is also possible. The International Bureau of WIPO supervises the international registration of trade marks, under the Madrid system. This is the most suitable option for applicants wanting international protection, although it does not cover every single country worldwide. The international application requires an existing national or European registration.

There is no hierarchy between the different levels. In other words, they coexist. A registration at EU level does not supersede a national registration. What is important is the first registration, whether it is at national, EU or international level. Whoever registers their mark first will have earlier rights.

How to obtain registration

- Registration is possible at three levels:
 - national
 - EU
 - international
- Coexistence
- Remember: Be the first!

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Registration is possible at three levels, national, EU and international. Different circumstances will lead applicants to prefer one route over the another.

National applications can be filed at the national trade mark offices in those countries where protection is needed.

At EU level, registration can be sought before the European Union Intellectual Property Office (EUIPO) to obtain protection that extends over the whole territory of the EU.

Beside the national and European route trade marks can be registered at the International Bureau of WIPO in multiple countries by filing one international application under the Madrid system. International applications must be based on a national or EU application.

What is important is the first registration, whether it is at national, EU or international level. Whoever registers their mark first will have earlier rights.

Slide 18

The European Union trade mark

The two main principles of the European Union trade mark (EUTM) system are its unitary character and the principle of coexistence with national trade marks. The European Union Trade Mark Regulation aims at reducing the areas of divergence within the trade mark system in Europe as a whole, while maintaining national trade mark protection as an attractive option for applicants.

Unitary character

The EUTM system is a centralised system that gives unitary protection in all the member states of the European Union. This unitary character means that the EUTM is valid in the EU as a whole. In other words, the protection afforded extends automatically to all member states indivisibly. A consequence of this “unitary character” is that it is not possible to limit the geographic scope of protection to particular member states.

Article 1 (1) EUTMR states that EUTMs shall have equal effect throughout the EU. EUTMs can be registered, transferred or surrendered only in respect of the territory as a whole, and not for just a part of it. The same principle applies to decisions revoking trade marks or declaring them invalid.

It is all or nothing. A sign cannot be registered as a EUTM if it lacks distinctive character in one of the member states, or if another absolute ground for refusal exists in one state. Applications for EUTMs will also be refused if there is a conflict with an earlier national right; even if this earlier national right is only valid in one member state. However, there is a safety net. It is possible to convert EUTM applications to national applications, thanks to what is known as the principle of coexistence with national trade marks.

Principle of coexistence

The EUTM system exists in parallel with the national trade mark systems. It has not replaced the pre-existing national systems. As a consequence, it is still possible to obtain protection in a single member state or in a number of countries by registering with the relevant national authorities. Companies are free to file national trade mark applications or a EUTM application, or both. The large number of national trade marks already in existence and registered in the member states continue to remain valid. Applicants and proprietors can decide as a matter of strategy whether they want to rely on the EUTM protection exclusively, or in addition to national

trade mark rights. However, earlier national trade marks constitute earlier rights against a EUTM, and vice versa, and are therefore relative grounds for the refusal of the trade mark, as explained earlier.

Advantages

In addition to its unitary character, the EUTM offers applicants a simplified procedure:

- One application, in any of the official EU languages,
- One set of fees, in one currency (EUR),
- One set of procedures, in one office,
- Online filing possible,
- One single file to be managed,
- Reduced costs due to the simple procedure.

Applicants have the option of claiming the seniority of a national trade mark. If an applicant already holds a prior identical national trade mark for identical goods and services, then they may claim the seniority of that prior national mark. This allows them to preserve their prior rights even if they surrender their national trade mark or do not renew it.

Another important advantage of the EUTM system is the broader legal protection it affords. Infringement proceedings may be brought in front of the so-called EU trade mark courts, which are national courts designated by the EU member states to have jurisdiction in respect of EUTMs. Decisions reached by the national courts have effect throughout the whole of the EU, and not just in the country concerned. This can avoid the need to prosecute infringers in each member state.

EUTMs constitute prior rights in relation to all subsequent trade marks and other conflicting rights in all EU member states. This allows proprietors of European Union trade marks not only to protect their exclusive rights at Union level, but also to prevail over later national rights.

Finally, when new member states join the EU, existing EUTMs are automatically extended to include them.

The European Union trade mark

- Protection at EU level
- Two main principles
 - unitary character
 - coexistence with national trade marks
- Advantages of the EUTM
 - one application procedure
 - broader legal protection

Intellectual Property Teaching Kit

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The European Union trade mark system provides protection at EU level.

It is a centralised system that gives unitary protection in all the EU member states. This means that a sign cannot be registered as a European Union trade mark if, for example, it lacks distinctive character in one member state. It could, however, be converted to a national application.

The European Union trade mark exists in parallel with the national trade mark systems.

The European Union trade mark system offers a number of advantages. Applicants only need to file one application in any of the official EU languages, and pay one set of fees in one currency, the euro. They follow one set of procedures in one office, and have only one file to manage, resulting in a broader legal protection.

Slide 19

The European Union trade mark registration procedure

The procedure starts with the filing of the application. All EUTM applications must be filed directly with the EUIPO. They can be filed in any one of the languages of the EU. This is the “first language”. A second language must be indicated which must be different from the first language and must be one of the EUIPO’s five working languages: English, French, German, Italian and Spanish. The second language serves as the language for opposition and cancellation proceedings, if the first language is not one of the five Office languages.

On receipt of the EUTM application, the EUIPO issues a receipt and starts the examination procedure, which includes the following steps:

- Granting the filing date if the application meets the minimum requirements (name and address of the applicant, a representation of the trade mark, list of goods and services, payment of the basic fee).
- Conducting a goods and/or services classification check.
- Conducting a formalities examination, which includes checking the signature, languages, owner and/or representative, priority and/or seniority claims.
- Accepting or refusing the trade mark as a sign. This is an examination on absolute grounds for refusal. In this step of the procedure the EUIPO checks whether the sign can or cannot be a trade mark.

After examination, a search report is drawn up from the EUIPO’s database, listing any identical or similar earlier EUTMs (including international registrations designating the EU). The Office will draw up an EU search report for each application; nevertheless, it will only send the report to the applicant when he/she has requested to receive it when filing the application.

When the new application has been published, proprietors of the earlier trade marks or trade mark applications cited in the report are informed by letter about the new application. This is called a surveillance letter. This report does not include references to any older national marks. EUIPO has the duty of sending surveillance letters to the proprietors of any earlier EU trade marks or EU trade mark applications cited in an EU search report, and this regardless of whether the applicant has requested to receive the EU search report or not. However, proprietors are given the possibility of opting out, in which case they will no longer receive these letters.

If no problems arise during the examination, the trade mark is published in the European Union Trade Marks Bulletin (Part A). If the application is refused, it will not be published. The publication of the application opens the three-month period for filing an opposition. In the case of international registrations, the starting date for the opposition period will begin one month after the date of the publication by then Office of the international registration.

If no oppositions are filed during this period, the application proceeds to registration. The EUIPO does not examine

of its own accord the relative grounds for refusal. These may be raised only by third parties in opposition proceedings or in cancellation proceedings after registration of the EUTM.

If a third party requests that the EUIPO reject a European Union trade mark application, an opposition procedure takes place. Generally speaking, an opponent must have rights in an earlier trade mark. The grounds on which an opposition can be made are the relative grounds for refusal. For an opposition to be successful, the trade mark application must be found to be incompatible with the earlier rights, generally in the form of an earlier EUTM, an earlier national trade mark, protected designation of origin or geographical indication. Opposition proceedings start with a so-called “cooling-off” period, during which parties can negotiate an agreement. If the parties have not come to an agreement during the cooling-off period, then the EUIPO Opposition Division can make a decision about the opposition. It can decide to reject the opposed application totally, in which case the opposed application will not proceed to registration as a EUTM, or it can reject the opposition in part, i.e. for the overlapping goods and services. In this latter case, the EUTM will be registered only for those goods and services for which there is no risk of confusion. In making this decision, the Opposition Division reviews the arguments of both the applicant and the opponent. If the opposition is not justified and the Opposition Division decides that there is no risk of confusion, the opposition will be rejected and the EUTM application will proceed to registration.

If examination of the trade mark has raised no objections and either no opposition has been filed, or any opposition filed has been rejected, the application is registered in the EUIPO Register. The registered trade mark is published in the European Union Trade Marks Bulletin (Part B), and the applicant receives a certificate (in PDF format).

After registration a EUTM can still be deemed invalid or be revoked. This happens in the cancellation proceedings (see slide 23, “What happens after registration”).

The decision of the Opposition Division is subject to appeal by any of the parties. The appeal is decided by the EUIPO’s boards of appeal.

After an appeal has been filed and the appeal fee paid, the parties can request mediation. The mediation procedure allows the parties to come together and reach an amicable settlement before a formal decision from the boards is necessary. The EUTMR gives the Office the option of establishing, as some stage in the future, a Mediation Centre for the friendly settlement, on a voluntary basis, of inter partes disputes based on the EU trade mark Regulation and the Regulation on Community Designs, both at first instance and appeal level.

For more information see <https://euiipo.europa.eu/ohimportal/en/web/guest/registration-process>



The procedure starts with the filing of the application with the EUIPO itself.

The EUIPO issues a receipt and starts the examination procedure, which includes the examination on absolute grounds for refusal. It is at this stage of the procedure that the EUIPO checks if the sign can or cannot be a trade mark.

If no problems arise during the examination, the trade mark is published in Part A of the European Union Trade Marks Bulletin. If the application is refused, it is not published.

Once a trade mark is published, the opposition period starts. If no oppositions are filed during this period, the application proceeds to registration. The EUIPO does not examine relative grounds for refusal of its own motion. The opposition procedure will only take place if a third party asks it to reject a EUTM application. Generally

speaking, an opponent must have rights in an earlier trade mark and the trade mark applied for must be found to be incompatible with the earlier rights.

An application will be registered if the examination of the trade mark has raised no objections and either no opposition has been filed, or any opposition filed has been rejected. The registered trade mark is published in Part B of the European Union Trade Marks Bulletin and a certificate is issued to the applicant.

After registration the EUTM can still be deemed invalid or be revoked.

Decisions of the Opposition Division are subject to appeal by any of the parties. Appeals are decided on by the EUIPO's boards of appeal. In parallel to the appeal proceedings the parties can request mediation to resolve the conflict.

Slide 20

How to apply for a European Union trade mark (optional)

Who can file a EUTM application?

Any natural person or legal entity from any country in the world may file an application. There is no nationality restriction.

How and where?

Applications can be filed directly with the EUIPO.

Direct filing with the EUIPO is possible through any of the following means:

- E-filing (online application): <https://oami.europa.eu/EUIPOportal/en/apply-now>,
- Sending by mail,
- Sending via private delivery services,
- Handing in the application personally at the reception of the office,
- Transmission by telefax.

It is not possible to file by e-mail.

Is there an official application form?

An official form is available on the EUIPO website, in PDF format. The use of this form is not obligatory but strongly recommended. Applicants may use forms of a similar structure or format, such as forms generated by computers on the basis of the information contained in the official form.

What language should the application be filed in?

EUTM applications may be filed in any of the official languages of the EU. This is referred to as the “first language”. A second language must be indicated which must be different from the first language and must be one of the five languages of the EUIPO, which are English, French, German, Italian and Spanish.

A different language version of the form from the language chosen as the first language may be used. However, the form must be completed in the first language chosen.

The second language serves as an alternative language for opposition and cancellation proceedings.

What is the filing date?

The filing date is the date on which the application was actually received at the EUIPO (or, in the case of filing via a national office, the date of receipt at that office),

provided that it contains the following information (see Article 27 EUTMEUTMR in conjunction with Article 26(1) (a)-(d) EUTMEUTMR):

- A request for the registration of a EUTM, that is to say an indication that protection for a trade mark in the European Union is sought (and not another intellectual property right, such as a design right),
- Information identifying the applicant,
- A list of the goods or services in respect of which the registration is requested,
- A representation of the trade mark,
- and the fee must have been paid.

Who can be a representative?

Representation is optional for the filing of the application but for all further steps of the procedure it is mandatory for all applicants, either natural or legal persons, that have neither their domicile or principal place of business nor a real and effective industrial or commercial establishment in the European Economic Area (EEA). All other applicants may represent themselves or choose to appoint a representative.

How to apply for an EU trade mark (optional)

- Who?
- How and where?
- Official form?
- Language?
- Filing date?
- Representative?

The screenshot shows the 'Apply for a trade mark online' form. It is divided into several sections: 'Reference' (with a 'Personal reference' field), 'Use existing EUTM details as a template' (with a 'Copy from' dropdown and a 'Copy' button), and 'I want to claim' (with expandable sections for Priority, Seniority, Exhibition, and Transformation, each with an 'Add' button). Below these are checkboxes for 'The sign has acquired distinctive character through use', 'Indications of class', 'Principal', and 'Subsidiary'. On the right side, there is a vertical menu with options like 'Trade mark information', 'Check to claim', 'Representations', 'Classification', 'Trade mark information', 'Language', 'Kind of mark', 'Type of mark', 'Goods and services', 'Design marks', 'Rights', and 'Other attachments'. At the bottom right, there is a 'Total fee' section showing 'Basic fee' (€500.00), 'Class fee' (€300.00), and 'Total fee' (€800.00), along with buttons for 'Save to draft', 'Send application form', and 'Print'.

This slide shows the official e-filing application form used by applicants to file applications for European Union trade marks online.

Slide 21

The Madrid system for the international registration of marks

The Madrid System for the international registration of marks is founded on two treaties: the Madrid Agreement (1891) and the Madrid Protocol (1989). As of 31/10/2015 one Single Treaty is applicable for all members.

The member states of these treaties form the Madrid Union. The Madrid system is administered by the International Bureau of WIPO, located in Geneva, Switzerland.

The Madrid Protocol revised the registration procedure set out in the older Madrid Agreement and was adopted to enable the accession of new members to the Madrid Union. For example, the Protocol is open to intergovernmental organisations, such as the EU. As a consequence, applicants can designate the EU as a whole in an international application, which results in a EUTM registration for the whole of the European Union.

For a complete list of member states please refer to: www.wipo.int/madrid/en/members/

The Madrid system of international registration of marks may be used only by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country which is party to the Madrid Agreement or the Madrid Protocol, or which has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol, or is a national of a member State of such an organization.

The “office of origin” will communicate the request for An application for international registration must be presented to the International Bureau through the Office of the contracting party, the Office of origin. based on a national or regional registration or an application for registration, known as the “basic mark”.

The “office of origin” will communicate the request for an international registration to WIPO. The applicant may designate one or more countries for which they want to seek protection – which can be some or all of the member states of the Madrid system, including all the member states of the EU individually and the EU as a whole. The Office of origin cannot be self-designated. WIPO will then inform the trade mark offices in the designated states. These offices will examine the trade mark application separately. In each member state of the Madrid system the international registration is subject to the same rules

as apply to direct national applications. If there are no grounds for refusal (absolute or relative) the trade mark will be registered in the national or regional register.

Note: An International registration does not result in a “supranational” mark covering lots of countries, but in fact is a bundle of different national trade marks and, if requested, a EUTM. The Madrid system involves only one single formality, which is the equivalent of a whole series of filings of national (or regional) applications.

The advantages of the Madrid system are simplicity and financial savings through one single filing: Applicants have to file only one international application in one language (French, English or Spanish) and the national fees are paid directly to the International Bureau instead of paying to the national offices.

Further changes to the registration or renewals are done through a single procedural step with the International Bureau of WIPO. Additionally, more countries can be designated subsequently.

The Madrid system for the international registration of marks

- International registration at International Bureau of WIPO
- Basic trade mark registration with office of origin
- Offices of designation examine application
- Registration of national marks or EUTM
 - no supranational mark!
- Simplification of subsequent management of trade mark

Slide 22

Unregistered trade marks

Even trade marks that are refused registration because they are not distinctive can be unregistered trade marks, and action can be taken against direct competitors. However, this can be very difficult unless the competition between the competitors is very unfair. Sometimes a trader can use the rights in its company name to stop another trader.

Outside of the EU, and in particular in the United States, unregistered trade marks can play an important role. They are often indicated by the letters TM rather than the ® sign.

Unregistered trade marks

- No Europe-wide regulation
- Protected under local laws, e.g. passing off in UK and unfair competition in Germany and France
- Protection is only given when there is competition and a risk of confusion in the marketplace

These days, most brand names are registered as trade marks. There are cases of unregistered brands being copied by competitors. In most countries, these unregistered marks have very limited protection. There is no EU-wide protection and the user of the unregistered trade mark needs to rely on national laws.

In the UK, for example, a trader can take action against another trader for “passing off”, in other words for trying to suggest to consumers that its products are similar or identical to those offered by the original trader. In Germany, when one trader takes unfair advantage of the good name of a competitor’s products, protection is granted under unfair competition law.

Protection is very limited and often depends on the facts of the case. It is usually better to register a trade mark than rely on an unregistered one.

Slide 23

What happens after registration

Duration of protection

Trade marks are protected for an initial period of ten years from the date of filing of the application. This protection can be renewed for further periods of ten years. There is no limit to the number of renewals. This is a big difference to other registered IP rights, which are limited in time (see Article 46 EUTMR). Indeed, some national trade marks in Europe are over 100 years old. The oldest marks in the UK and Germany, for example, are both trade marks for beer which have been in continuous use since their registration.

Genuine use

However, this indefinite protection comes with an obligation of genuine use. Owners of registered trade marks are obliged to use them in a genuine manner. The obligation of use is not applicable immediately. Instead, owners have a period of five years after the registration during which they do not have to demonstrate the use of their mark in order to enforce it. During this period the mere formal registration of the trade mark gives full protection. Afterwards, owners may be required to demonstrate use of the mark in relation to the goods and services.

The use of the trade mark has to be genuine. This means actual use on the market and not mere token use or internal use by the company concerned. Only when a trade mark is used on the market can it fulfil its essential function, which is to indicate the origin of the goods and services and distinguish them from the goods and services of other traders. Commercial exploitation of the mark must be real, and capable of maintaining or creating a share of the market. The obligation of use has the purpose of restricting the number of trade marks registered and removing conflicts that might rise between them. The purpose is not to judge the commercial success of the product or to restrict trade mark protection to large-scale commercial use only. The use does not always have to be substantial for it to be deemed genuine. Even minimal use could be sufficient to establish genuine use, depending on the goods and services and the market concerned.

Lack of use has consequences. When the owners of a trade mark fail to deliver adequate evidence of use they will not be able to use the (unused) mark as the basis for opposition or invalidity proceedings against

later similar marks. Trade marks can also be revoked or cancelled if they have not been put to genuine use within a continuous period of five years, provided that there are no genuine reasons for non-use. Examples of good reasons for the non-use of a mark include import restrictions or other government requirements, e.g. clinical trials and authorisation for new medicines. These good reasons are independent of the will of the trade mark owner and must make use of the mark impossible or unreasonable (Articles 15, 42(2)-(3), 51(1) and 57(2)-(3) EUTMEUTMR; Articles 10, 11 and 12(1) TMD). Relevant case law: judgment of 11/03/2003, C-40/01, 'Minimax'; order of 27/01/2004, C-259/02, 'La Mer'; and judgment of 08/07/2004, T-203/02, 'Vitafruit'.

Cancellation

In theory, trade marks can last indefinitely. In practice, this is rarely the case. Owners can decide to let their trade mark lapse and not renew it, because they no longer use the mark and do not want to pay the renewal fee. Trade marks can also be cancelled.

The mark can be declared invalid. Even after registration, it is still possible for third parties to invoke absolute and relative grounds for invalidity. These grounds are the same as the absolute and relative grounds for refusal as discussed earlier.

The mark can also be revoked where:

- It was not put to genuine use.
- It has acquired a generic character. However, it will only be revoked if the proprietor has actively contributed to, or has failed to act against, the mark becoming a common name in trade for a product or service in respect of which it is registered. Trade mark owners must therefore be careful when advertising their products and services. For example, Google is careful not to use terms such as "googling" or "google it" when advertising its search engine. Instead, it uses phrases such as "use the Google search engine". Inactivity of the trade mark proprietor may also be deemed to have occurred if the trade mark owner delays taking action or fails to apply to try and prevent third parties from using a similar sign. See, for example, judgment of 27/04/2006, C-145/05, 'Levi Strauss' (Article 20 TMD and Article 58(1)(b) EUTMR).



What happens after registration

- Duration of protection
 - initial period of ten years
 - unlimited renewal
- Requirement of genuine use after five years
- Cancellation
 - invalidity
 - revocation:
 - lack of genuine use
 - acquired generic character
 - misuse

Registration is valid for a period of ten years from the date of filing. This protection can be renewed indefinitely.

However, this indefinite protection comes with an obligation to use it or risk losing it! Owners of registered trade marks are obliged to use them in a genuine manner. The requirement is applicable from five years after registration.

The use of the trade mark has to be genuine. In other words, it has to be actual use on the market and not mere token use. The use does not always have to be quantitatively significant for it to be deemed genuine.

One of the possible consequences of non-use is that the trade mark might be revoked.

Trade mark protection can be cancelled. A mark can be declared invalid or it can be revoked

if it has acquired a generic character and the proprietor has contributed to this, or if it is misused or used in a misleading way.

- It is misused or used in a misleading way or has become deceptive. The trade mark will be revoked if use of the mark is liable to mislead the public, in particular as to the nature, quality or geographical origin of the goods and services. For instance, a distinctive figurative trade mark is one that contains the words “goat’s cheese” and is registered for goat’s cheese. When use of the mark is made for cheese made of cow’s milk, the mark could be revoked due to misleading use (Article 12(2)(b) TMD and Article 58(1)(c) EUTMR).

There is a big difference between revocation and invalidity. In the event of revocation the mark will be deemed not to have any effects as from the start of the revocation proceedings (*ex nunc*). When the mark has been declared invalid it will be deemed never to have had any effects from the very beginning or outset of its registration (*ex tunc*).

For more on cancellation proceedings see the EUIPO trade mark practice manual, Part D, Section 2, available at <https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines>



Slide 24

Infringement

First, this section on infringement will explain what the scope of protection of a trade mark is. The scope is broader if the mark has a reputation, i.e. if it is well-known. Next, the different kinds of infringing acts will be summarised, as well as the conditions that must be fulfilled. A final slide will provide an overview of the types of use that do not constitute infringement, even without prior permission from the trade mark holder.

INFRINGEMENT

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The last part of this section will focus on trade mark infringement. In order to understand what infringement is, we first have to look at the scope of protection of trade marks. In other words: what rights does a trade mark confer? We will also look at the uses which are exceptions to trade mark infringement.

Slide 25

Scope of protection

Exclusive right

Registered trade marks give proprietors the exclusive right to prevent all others who do not have consent from using the mark in the course of trade. They can prevent the unauthorised use of an identical sign used for identical goods and services. However, this “double identity” (identical sign and identical goods/services) alone is not enough. There is no need to prove actual confusion, but proof of damage to one of the functions of the trade mark is necessary.

The European Court of Justice stated that the exclusive trade mark right is conferred in order to enable trade mark holders to protect their specific interests as the owners or proprietors of the mark. This interest is to ensure that the trade mark can fulfil its functions. The exercise of the exclusive right must be reserved for cases in which a third party’s use of the sign affects (or is liable to affect) the functions of the trade mark, in particular the essential function of guaranteeing to consumers the origin of the goods. This was discussed in judgment of 25/01/2007, C-48/05, ‘Opel/Autec’. The trade mark of Opel cars, which was also registered for models of vehicles, had been applied to a miniature toy car by another company. This use cannot be prohibited, unless it is liable to affect the functions of the registered trade mark.

Proprietors can also prevent the use of an identical sign for identical or similar goods and services and the use of a similar sign for identical or similar goods and services, but only if there is a likelihood of confusion. The assessment of likelihood of confusion in the case of infringement is the same as in the case of opposition proceedings on relative grounds for refusal. (There is one difference. In opposition proceedings every possible use of the trade mark must be examined, whereas in infringement proceedings only the actual alleged infringement is examined.)

Geographical scope of protection

The trade mark offers protection within the territory where it is registered, i.e. the principle of territoriality is applicable.

Scope of protection

- Exclusive right to prevent use of:
 - identical signs for identical goods and services
 - identical/similar signs for identical/similar goods and services
 - principle of speciality
- Geographical scope
 - principle of territoriality

Registered trade marks give their owners an exclusive right to prevent all others who do not have their consent from using the mark in the course of trade. Owners can prevent the unauthorised use of an identical sign for identical goods and services, if that use damages one of the functions of their trade mark.

Owners can also prevent the use of an identical or similar sign for identical or similar goods and services, but only provided that there is a likelihood of confusion.

The trade mark system is characterised by two important principles that limit the scope of protection.

One is the principle of speciality, under which the exclusive right of the holder of the trade mark is linked only to the goods and services for which the mark is registered, or to similar

goods and services. This will be examined more thoroughly in the next slide.

The other is the principle of territoriality. A trade mark offers an exclusive right that is limited to one country or region. The mark offers protection within the territory where it is registered. For national trade marks, this is the national territory for which registration is obtained. European Union trade marks offer a wider scope of protection, for the whole of the EU.

Slide 26

Principle of speciality: classification

The principle of speciality, i.e. the idea that a trade mark can be applied for in relation to specific goods or services only, limits the scope of protection. The EUTMR follows the line established by the ECJ in its judgment in case 'IP Translator', by requiring the goods and services to be identified with sufficient clarity and precision to enable the competent authorities and economic operators, on the basis of the specification alone, to determine the extent of the protection of the trade mark. The terms that are used will always be interpreted according to their literal meaning. In fact, the exclusive right of the holder of the trade mark is limited to the identical goods and services for which the trade mark is registered, or to similar goods and services.

Different enterprises can therefore use similar or identical trade marks on the same market for different goods or services.

The principle of speciality is based on the idea that if the goods and services are different, then the consumer will not perceive the two trade marks as originating from the same entrepreneur. There is therefore no risk of confusion at stake.

One example of this principle can be found in the use of the Lotus trade marks. Different companies use this trade mark to distinguish pastries (EUTM 2 284 016), papers (EUTM 8 808 966) and motor vehicles (EUTM 0 053 926). Since the goods are not similar, the trade marks can coexist peacefully in the market. Another example is "Mont Blanc". Mont Blanc is a registered EUTM, used for luxury pens and accessories (EUTM 2 508 380), and also for pastries (EUTM 3 867 711).

The identification of goods or services is made easier by the use of classification systems. The EUIPO and most other countries use the Nice Classification, an international classification of goods and services applied to the registration of trade marks and service marks. The terms that are used, including the general indications of the class headings of the Nice Classification, will always be interpreted according to their literal meaning, i.e. not comprising a claim to goods and services which cannot be so understood.

The Nice Classification was established by an international, multilateral agreement concluded at a Diplomatic Conference held in Nice in 1957 and known as the Nice Agreement Concerning the International

Classification of Goods and Services for the Purposes of the Registration of Marks. The Nice Classification is reviewed periodically. Goods and services are organised in classes, with the current edition comprising 34 classes for goods and 11 classes for services.

Principle of speciality: classification

- The scope of protection of a trade mark is limited to those goods and services applied for
- Similar trade marks can coexist peacefully in the market if they refer to different products
- Classification systems are used in order to easily identify the goods and services which a trade mark has been applied for



Trade marks have to be applied for in relation to specific goods and services. This is known as the principle of speciality.

It has the effect of limiting the scope of protection, meaning that the exclusive right of the holder of the trade mark is limited to the goods and services for which it is registered, or to similar goods and services.

Different businesses can therefore use similar or identical trade marks on the same market for different goods or services.

A good example of this principle can be found in the use of the Lotus trade marks, which includes pastries, papers and motor vehicles. Since the goods are not similar, the trade marks can peacefully coexist in the market.

The identification of goods and services is made easier by the use of classification systems.

The EUIPO, like many national offices, uses the Nice Classification, which is an international classification system applied to the registration of trade marks and service marks.

Slide 27

Trade marks with a reputation

Trade marks with a reputation enjoy a wider scope of protection, beyond the limitations of the principle of speciality. Even if there is no likelihood of confusion between the signs concerned, the exclusive right of the holder of the mark can still be harmed. However, to obtain this broader protection the following requirements have to be fulfilled.

The signs have to be identical or similar, but the goods and services can be dissimilar. The similarity between the signs is examined in the same way as in the case of likelihood of confusion.

Reputation

Reputation is thus a knowledge-threshold requirement. It is a quantitative requirement rather than a qualitative one. This means that a trade mark can be of a terrible quality, but as long as it is known by a substantial portion of the public, it will have a reputation and will be able to enjoy the enhanced protection.

A distinction can be made between national marks and EUTMs. A national trade mark must have a reputation in a substantial part of that country. A EUTM must have a reputation in a substantial part of the EU, which in certain circumstances can be the territory of one member state, such as Austria (judgment of 06/10/2009, C-301/07, 'PAGO').

The contested use of the sign must be capable of taking unfair advantage of, or be detrimental to the distinctiveness or the reputation of, the earlier mark. It is important to note that it is the reputation of the trade mark that is protected as such. This provision is not intended to prevent the registration or use of all signs which are identical or similar to the mark with a reputation. There must be a risk that the new sign would take unfair advantage of, or would be detrimental to the distinctive character or repute of, the older mark.

Examples of scenarios:

- Detriment to distinctiveness, or “blurring”. The more others use the earlier mark (with a reputation), the less distinctive the earlier mark will become. The risk is that eventually the trade mark could lose its distinctiveness. As an example, if Rolls Royce were used on restaurants, pants, candy, plastic pens, yard brushes etc, its distinctiveness would eventually be dispersed and its special hold upon the public would be reduced – even in relation to cars for which it is reputed
- Detriment to reputation, or dilution by “tarnishing”. The use of the sign is likely to devalue the image or prestige that a mark with a reputation has acquired among the public, for example, an earlier trade mark that enjoys a reputation for chewing gum, with a healthy image and targeted at young people, and an identical sign used for tobacco products.
- Taking unfair advantage of distinctiveness or repute, or “free-riding”. This is an unacceptable situation of unfair competition or commercial “parasitism”.

Trade marks with a reputation

- Broader scope of protection
 - beyond the limitations of the principle of speciality
 - without likelihood of confusion
- Requirements
 - identical or similar signs, but dissimilar goods and services
 - reputation in the relevant territory
 - likelihood of harm to the trade mark

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Trade marks with a reputation enjoy a wider protection, beyond the limitations of the principle of speciality. Even if there is no likelihood of confusion between the signs concerned, the exclusive right of the holder of the reputed mark – the mark with a reputation – can still be harmed. However, to obtain this broader protection the following requirements have to be fulfilled:

The signs have to be identical or similar – although the goods and services can be dissimilar.

The earlier registered mark must have a reputation in the relevant territory. It must be known by a significant part of the public in a substantial part of the relevant territory. Reputation is thus a knowledge threshold requirement.

The contested use of the sign must be capable of taking unfair advantage of, or be detrimental to, the distinctiveness or repute of the earlier mark. This could include

- blurring, that is, detriment to the distinctiveness of the mark;
- dilution by tarnishing or detriment to the repute of the trade mark; and
- free-riding, that is, taking unfair advantage of distinctiveness or repute.

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Infringing acts

Infringing acts

Examples of infringing use of a trade mark (Article 9() and (4) EUTMR and Article 10(3), (4) TMD) include:

- Affixing the infringing sign to the goods or to the packaging thereof.
- Offering the goods, putting them on the market or stocking them for these purposes under the infringing sign, or offering or supplying services thereunder.
- Importing or exporting the goods under the infringing sign.
- Using the sign as a trade or company name or part of a trade or company name.
- Using the infringing sign on business papers and in advertising.
- Using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC of the European Parliament and of the Council.

This list is not meant to be exhaustive. Other forms of use of the infringing sign are possible. Some courts have decided that use as an “AdWord” in Google (infringing use by the advertiser, not by Google) or as a metatag is infringement, but others disagree. This shows that use does not always have to be visible for infringement to occur. For example, UK retailer Marks & Spencer was found by the English High Court of Justice to have infringed Interflora’s trade mark as a keyword to trigger search results for a flower delivery service.

Conditions

However, for there to be trade mark infringement a few conditions have to be fulfilled.

First of all, the signs have to be similar or identical and be used for similar or identical goods and services, unless the trade mark has a reputation. The previous slide explained that when a trade mark has a reputation, it enjoys a wider scope of protection. In this case, the goods and services can be dissimilar, as long as the signs are identical or similar.

The (allegedly infringing) sign has to be used as a trade mark. This means that the sign is used for the purpose of distinguishing the goods or services in question as originating from a particular company.

One example is the Deenik case (judgment of 23/02/1999, C-63/97). The owner of a garage that advertised the sale of second-hand BMW cars and their repair and maintenance used the BMW mark to identify the source of the goods (i.e. cars) and the car repair services. The mark was used to distinguish the goods and services from those offered by other garages. The sign was used as a trade mark. In this case the use could be allowed. A reseller is free not only to resell second-hand goods, but also to advertise the sale of these goods, using the original mark. The advertisement of repairs and maintenance can be allowed if the use of the trade mark is necessary to indicate the intended purpose of the services, on condition that this takes place in accordance with honest business practices. The different forms of permissible use will be explained later. In this regard, the amending Regulation introduced a redrafting of the provision regarding the limitations of the effects of an EU trade mark, clarifying certain aspects as regards what is considered to be fair and honest use.

The use has to take place in the course of trade. This means that the use must take place as a commercial activity with a view to economic advantage, and not as a private matter (judgment of 12/11/2002, C-206/01, ‘Arsenal/Reed’). Mere private use, outside the course of trade, is not considered to be an infringement and is therefore allowed.

The use of the sign has to take place without the consent of the trade mark owner if it is to be deemed an infringement.

Infringing acts

- Infringing use includes:
 - offering or supplying
 - attaching the sign to goods
 - importing or exporting
 - use in advertising
- Conditions:
 - use as a trade mark
 - use in the course of trade
 - without consent

This slide gives an overview of the different kinds of infringing use, including attaching the sign to the packaging of the goods, offering or putting the goods on the market, and use of the mark on business paper.

Even use that is not visible to the consumer can be considered infringing use.

However, for there to be trade mark infringement, a number of conditions have to be fulfilled.

First of all, the signs have to be identical or similar and used for identical or similar goods and services. In addition, the sign has to be used as a trade mark, in other words for the purpose of distinguishing the goods or services as originating from a particular business or company. The use has to take place in the course of trade, that is within the context of

a commercial activity with a view to economic advantage, and it has to be without the consent of the trade mark owner.

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Allowed uses

Some uses of a trade mark without the consent of the holder are allowed.

Mere private use, i.e. use not involving commercial activity, is not infringing use. However, in some cases even use of the trade mark in the course of trade can be allowed. Trade mark owners cannot prohibit third parties from using:

- The name or address of the third party, where that third party is a natural person.
- Indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of production or other characteristics of the goods and services.
- The trade mark if it is necessary to indicate the intended purpose of a product or service, e.g. accessories and spare parts, such as the BMW trade mark described in the previous slide.
- Use of the trade mark is necessary where such use is the only means of providing the public with understandable and complete information about the intended purpose of the product. In that respect, in order to determine whether or not other means of providing such information may be used, it is necessary to take into consideration, for example, the possible existence of technical standards or norms generally used for the type of product and known to the public for which that type of product is intended (judgment of 17/03/2005, C-228/03, 'Gillette').

Honest practices

Use of the trade mark will not be in accordance with honest practices if:

- 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.

- 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 (judgment of 17/03/2005, C-228/03, 'Gillette').

Trade mark proprietors can of course consent to a trade mark being used by a third party. The trade mark can be licensed.

Acquiescence by the trade mark holder

See Article 61 EUTMR and Article 9 TMD.

Where the proprietor of a mark has acquiesced, for a period of five successive years, in the use of a later mark while being aware of such use, they shall not longer be entitled on the basis of the earlier trade mark to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless registration of the later EU trade mark was applied for in bad faith.

Exhaustion of trade marks within the European Union

Exhaustion of rights means that trade mark owners cannot prohibit the use of a trade mark in relation to goods which have been put on the market in the European Economic Area (EEA) under that trade mark by the owner or with their consent. This exception is possible only for goods. The right to deliver services under a particular trade mark cannot be exhausted.

The resale of products bearing a registered trade mark is possible, and third parties also have the right to advertise the resale of these goods (see judgment of 04/11/1997, C-337/95, 'Dior v. Evora'; and judgment of 23/02/1999, C-63/97, 'BMW/Deenik').

However, the exclusive right is not exhausted if there is a legitimate reason to oppose further commercialisation of the goods, e.g. because the condition of the goods is changed or impaired after they have been put on the market.

Allowed uses

- Mere private use
- In the course of trade:
 - use of own name
 - indication of characteristic or intended purpose
 - on condition that it is in accordance with honest practices
- Licences
- Acquiescence
- Exhaustion in the EU internal market

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We have already seen that private use of a trade mark is allowed.

In some cases, even use of a trade mark in the course of trade can be allowed. Trade mark owners cannot prohibit third parties from using their own name or address, or indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of production or other characteristics of the goods and services; or from using the trade mark when it is necessary to indicate the intended purpose of a product or service, for example in the case of accessories and spare parts.

This use in the course of trade has to take place in accordance with honest practices in industrial or commercial matters. Third parties are obliged to act fairly in relation to the legitimate interests of the trade mark holder. This is not the case where the use affects the value of the trade mark, suggests a commercial connection with

the trade mark owner or discredits the mark, or where the product is presented as an imitation.

Trade mark proprietors can also consent to use of their trade mark by a third party and can license their trade marks to others.

Where the proprietors of a mark have acquiesced, for a period of five successive years, in the use of a later mark while being aware of such use, they lose the right to apply for a declaration of invalidity or to oppose the registration of the later mark.

Finally, by “exhaustion of rights” we mean that a trade mark owner cannot prohibit the use of a trade mark in relation to *goods* which have been put on the market in the European Economic Area (EEA) under that trade mark by the owner or with his or her consent. The resale and accompanying advertising of products bearing a registered trade mark is possible.

Slide 30

Quiz

1. What is the main function of a trade mark?

The main function is the origin function. Trade marks serve as a badge of origin. They indicate the commercial source of the goods and services concerned. According to the definition, a trade mark is a sign which distinguishes the goods and the services of one undertaking from those of another.

When assessing the likelihood of confusion, the degree of similarity between (1) the signs and (2) the goods and services should be taken into account. Similarity between signs is assessed from a visual, aural and conceptual perspective, taking all the relevant factors relating to those goods and services into account.

2. Why is it so complicated to get a registered European Union trade mark for a smell?

While a smell is capable of fulfilling the essential function of a trade mark, which is to distinguish the goods and services of a particular company or organisation, it can hardly meet the representation requirements. Only signs which are capable of being represented in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to their proprietors can be registered as trade marks. Following the judgment of the Court of Justice in the Sieckmann case, the graphical representation of a sign must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”. A sign should therefore be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means. However, at the moment there is no way of representing a smell so that all the above mentioned criteria are fulfilled.

3. Would it be possible to register the word mark “EUROPIG” as a European Union trade mark for meat, sausages, smoked meats, ham and bacon?

The word “EUROPIG” is descriptive for the goods in question and should therefore be refused under Article 7(1)(c) EUTM/UTMR. There is a sufficiently direct and specific relationship between the sign and the goods in respect of which registration is sought. The sign can be used to describe certain characteristics of the products at issue. The relevant public (in this case the average English-speaking consumer) could take the sign to be an indication that it concerns products made from pigs’ meat and originating in Europe. For more information about the case, see judgment of 14/06/2007, T-207/06, ‘Europig’.

4. How is the likelihood of confusion assessed?

The coexistence of trade marks can be an issue if there is a risk or likelihood of confusion about the origin of the goods and services concerned.

Quiz

1. What is the main function of a trade mark?
2. Why is it not possible to get a registered a EU trade mark for a smell?
3. Would it be possible to register the word mark "EUROPIG" as a EU trade mark for meat, sausages, smoked meats, ham and bacon?
4. How is the likelihood of confusion assessed?

After all we have discussed I have a few questions for you:

1. What is the main function of a trade mark?
(The main function is the origin function.)
2. Why is it so complicated to get a registered European Union trade mark for a smell?
(Only signs which are capable of being represented according to the EUTMR can be registered as trade marks.)
3. Would it be possible to register the word mark "EUROPIG" as a European Union trade mark for meat, sausages, smoked meats, ham and bacon?
(The word "EUROPIG" is descriptive for the goods in question and should therefore be refused under Article 7(1)(c) EUTMEUTMR.)
4. How is the likelihood of confusion assessed?
(The coexistence of trade marks can be an issue if there is a risk or likelihood of confusion about the origin of the goods and services concerned.)

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Quiz (continued)

5. What are the two main principles of the European Union trade mark?

The two main principles are:

- (i) Unitary character. The EUTM is a centralised system that gives equal protection in all member states of the EU. This means that the sign cannot be registered as a EUTM if, for example, it lacks distinctive character in one member state.
- (ii) Coexistence. The EUTM exists in parallel with the national trade mark systems. It has not replaced them.

6. Can I obtain an international registration of a trade mark from the International Bureau of WIPO itself?

No, this is not possible. You first have to obtain a basic trade mark registration with a national trade mark office or the EUIPO.

7. Use of a trade mark is obligatory. True or false?

False. Use of a trade mark is required only after an initial period of five years from the date of registration. After this date, a lack of genuine use of a trade mark may lead to revocation of the mark.

Possible follow-up question

What is meant by “genuine” use of a trade mark?

This means actual use on the market, and not mere token use or internal use by the company or organisation concerned.

8. What are the two main limits to the scope of protection of a trade mark?

The scope of protection of a trade mark is limited by:

- (i) The principle of speciality. The exclusive right of the trade mark owner is linked exclusively to the goods and services for which it is registered, or to similar goods and services.
- (ii) The principle of territoriality. A trade mark can only enjoy protection in the territory for which it has been registered. European Union trade marks, for example, offer EU-wide protection.

Possible follow-up question

Is this always the case?

No. Trade marks with a reputation enjoy a broader scope of protection which goes beyond the limits of the principle of speciality, and there is no need to prove a likelihood of confusion. Trade marks with a reputation enjoy protection against identical/similar signs, even when they are used for goods and services which are dissimilar.

Quiz (continued)

5. What are the two main principles of the EU trade mark?
6. Can I obtain an international registration of a trade mark from the International Bureau of WIPO itself?
7. Use of a trade mark is obligatory. True or false?
8. Identify the two main limits to the scope of protection of a trade mark

5. What are the two main principles of the European Union trade mark?
(Unitary character and coexistence.)
6. Can I obtain an international registration of a trade mark from the International Bureau of WIPO itself?
(No, this is not possible.)
7. Use of a trade mark is obligatory. True or false?
(False.)
8. What are the two main limits to the scope of protection of a trade mark?
(The principle of speciality and the principle of territoriality.)

2 Trade mark case study

Trade mark case study

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Slide 32

Trade mark case study: B&O loudspeaker

TRADE MARK CASE STUDY B&O LOUDSPEAKER

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This case study focuses on an application for a European Union trade mark for the shape of a loudspeaker made by the Danish firm Bang & Olufsen.

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Facts (I)

Bang & Olufsen filed an application for a European Union trade mark on 17 September 2003. The application is a three-dimensional sign in the shape of a loudspeaker. The shape is shown on the next slide.

The goods and services listed in the application are from Classes 9 and 20:

- Class 9: electric and electronic apparatus and appliances for analogue, digital or optical reception, processing, reproduction, regulation or distribution of sound signals, loudspeakers,
- Class 20: music furniture.

Facts (I)

- EU Trade Mark application for shape (No. 3 354 371)
- Filing date: 17 September 2003
- Registration is sought for goods from:
 - Class 9, *including loudspeakers*
 - Class 20, *music furniture*

The European Union trade mark application in our case study has the application number 3354371. It was filed by Bang & Olufsen on 17 September 2003, for goods such as electric and electronic apparatus and appliances for analogue, digital or optical reception, processing, reproduction, regulation or distribution of sound signals, loudspeakers and music furniture.

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Facts (II)

The slide shows the actual three-dimensional shape for which registration was sought.

About the company

Bang & Olufsen A/S has been a manufacturer of high-end audio-visual equipment since 1925. Distinctive design has been part of its innovative strategy from the outset. The company was established in Denmark by two young engineers, Peter Bang and Svend Olufsen.

Source: www.bang-olufsen.com

About the loudspeaker

Registration was sought for the shape of the product. This was based on the idea of an organ pipe, which is itself also a “provider” of sound. The loudspeaker was sold under the name ‘BeoLab® 8000’. It had been on the market since 1991 and had been sold continuously in the member states of the EU. Today, it is sold as ‘BeoLab 8002’ and is described as an ‘icon of Bang & Olufsen design’. For more information, go to www.bang-olufsen.com/en/sound/loudspeakers/beolab-8002

The shape of the loudspeaker was protected as a design at the Danish Patent and Trade Mark Office under the number MR 1992 00868, with a filing date of 5 September 1991 (and application number MA 1991 00903). In 2006, it was deleted from the design register, as under the old Danish design law, design protection was limited to a maximum of three terms of five years, or a total of 15 years.

You can find this design by searching in the online tools section of the Danish Patent and Trade Mark Office website at www.dkpto.org/online-tools.aspx

Facts (II)

- Sign consists of 3D shape and represents a loudspeaker
- Produced by Bang & Olufsen
- Protected as a design in Denmark



This slide shows the actual sign for which registration was sought. It consists of the shape of a loudspeaker.

The applicant, Bang & Olufsen, is a company renowned for its distinctive range of high-quality televisions, music systems and high-performance loudspeakers. It sells its products through an independent retail network of concept stores in over 100 different countries.

The loudspeaker was originally registered as a design right in Denmark. On the market since 1991, it was described by the company as “an icon of Bang & Olufsen design”.

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Decisions relating to the case (I)

This slide and the next one give an overview of the decisions relating to this case.

On 1 March 2005, the examiner at the EUIPO rejected the application for registration pursuant to Article 7(1)(b) EUTMEUTMR as being devoid of any distinctive character. On 27 April 2005, B&O filed a notice of appeal with the EUIPO against the decision.

In a decision of 22 September 2005, the First Board of Appeal dismissed B&O's appeal and confirmed the rejection based on Article 7(1)(b) EUTMEUTMR, but failed to take into account any acquired distinctive character pursuant to Article 7(3) EUTMEUTMR. The Board of Appeal corrected its decision by corrigendum on 24 February 2006, stating that the body of evidence provided by the applicant was not sufficient to demonstrate distinctiveness acquired through use of the mark.

B&O contested this decision by lodging a further appeal at the Court of First Instance (CFI) requesting annulment of the Board of Appeal decision. On 10 October 2007, the CFI annulled the decision of the First Board of Appeal.

Relevant decisions

- Rejection of application by examiner, 1 March 2005
- First Board of Appeal, R 497/2005-1, 22 September 2005 (first decision, annulled)
- Court of First Instance, T 460/05, 10 October 2007

Decisions relating to the case (I)

- 1 March 2005: rejection of application by examiner
 - based on Article 7(1)(b) EUTMR
- 22 September 2005: first decision EUIPO Board of Appeal
 - appeal dismissed based on Article 7(1)(b) EUTMR
- 10 October 2007: judgment Court of First Instance (T-460/05)
 - annuls decision of board of appeal
 - holds that the mark is distinctive because of its valuable shape

As we have just seen, Bang & Olufsen filed its application on 17 September 2003.

On 1 March 2005, the examiner at the EUIPO rejected the application pursuant to Article 7(1)(b) of the European Union trade mark Regulation, considering it to be devoid of any distinctive character.

B&O appealed against this decision, but the appeal was dismissed by the First Board of Appeal in a decision of 22 September 2005. The rejection was based on Article 7(1)(b) of the Regulation.

B&O contested this decision by lodging a further appeal, and on 10 October 2007 the Court of First Instance annulled the decision of the First Board of Appeal, stating that the sign for which registration was sought had a sufficient degree of distinctive character because of its valuable shape and that the Board had misconstrued the wording of Article 7(1)(b) of the Regulation.

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Decisions relating to the case (II)

Finally after several proceedings, B&O disagreed with the Board of Appeal and contested its competence to examine a new absolute ground for refusal. This further decision was reviewed once again by the General Court (the new name of the CFI from 2009), which dismissed B&O's arguments.

Relevant decisions

- First Board of Appeal, decision of 10/09/2008, R 497/2005-1 (second decision, appeal rejected)
- General Court, judgment of 6/10/2011, T-508/08

Decisions relating to the case (II)

- 26 February 2008: objection letter by Board of Appeal
- 10 September 2008: second decision of Board of Appeal
 - annuls decision of examiner based on Article 7(1)(b) EUTMR
 - rejects application based on Article 7(1)(e)(iii) EUTMR
- 6 October 2011: judgment of General Court (T-508/08)
 - dismisses appeal by B&O

The case was referred back to the EUIPO and reallocated to the First Board of Appeal. In communications of 26 February and 22 April 2008, the Board invited B&O to comment on the application of Article 7(1)(e)(iii) of the European Union trade mark Regulation.

By decision of 10 September 2008, the First Board of Appeal annulled the examiner's decision of 1 March 2005, which was based on Article 7(1)(b) of the EUTMR. But it nevertheless still rejected the application, as it considered that the sign consisted exclusively of the shape, which gives substantial value to the goods within the meaning of Article 7(1)(e)(iii).

B&O disagreed with this, but its arguments were dismissed in a judgment of the General Court dated 6 October 2011.

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Distinctive character: too much or too little?

The main questions in this case concern the distinctive character — or lack of it — of the shape of the loudspeaker.

Is the shape not distinctive enough (Article 7(1)(b) EUTMEUTMR)? Or is it too striking and must therefore be excluded from trade mark protection because of Article 7(1)(e)(iii) EUTMEUTMR?

To assess whether the shape is devoid of any distinctive character, it is necessary to consider the relevant public. But what criteria have to be taken into account when determining who exactly the relevant public is? There is also the question of the distinctiveness of shape marks as such. Do stricter conditions apply when assessing the distinctive character of shapes, especially if they consist of the shape of the goods themselves?

What about the ground for refusal in Article 7(1)(e)(iii) EUTMEUTMR? Does the sign in question consist exclusively of a shape which gives substantial value to the goods? What do 'substantial value' and 'exclusively' mean? If this ground for refusal is applicable, can the applicants argue that their sign has acquired distinctiveness through use within the meaning of Article 7(3) EUTMEUTMR?

Before considering the sign under Article 7(1)(e)(iii) EUTMEUTMR, there is a procedural issue that has to be resolved. Can or must the Boards of Appeal (re)assess the application based on another absolute ground after a referral from the CFI?

Distinctive character: too much or too little?

- Does the loudspeaker have a distinctive character?
- Does the sign consist exclusively of the shape which gives substantial value to the goods?
- Can/must the Board of Appeal assess the application based on another absolute ground for refusal?

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The focus in this case study is on the distinctive character of the shape of the loudspeaker. Does it lack all distinctive character, or is it perhaps too distinctive?

The relevant questions are as follows:

Is the sign devoid of any distinctive character according to Article 7(1)(b) of the European Union trade mark Regulation? What criteria have to be taken into account when determining the relevant public? When is a shape mark distinctive?

Moreover, does the sign consist exclusively of the shape, or another characteristic, which gives substantial value to the goods pursuant to

Article 7(1)(e)(iii) of the Regulation? What does “exclusively” mean? And what is the meaning of “substantial value”?

If Article 7(1)(e)(iii) is applicable, can Article 7(3) be applied? Can the sign acquire distinctive character through use?

Last but not least, can or must the Board of Appeal reassess the application based on another absolute ground for refusal?

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Not distinctive enough? Article 7(1)(b) EUTMR

Article 7(1)(b) EUTMEUTMR states that trade marks which are devoid of any distinctive character shall not be registered.

For a trade mark to possess distinctive character, it must serve to identify the product as originating from a particular business or trader, and thus to distinguish that product from those of other businesses or traders.

This distinctive character must be assessed, first by reference to the goods or services in respect of which registration has been applied for, and second by reference to the perception of the relevant public. This relevant public consists of average consumers of the goods or services in question who are reasonably well informed and reasonably observant and circumspect.

Who is the relevant public in this case study?

According to B&O, the relevant public is a limited group of people with a higher level of attention than that of average consumers. The goods in question are top-of-the-range, high-value products within the electronics market. They are marketed exclusively through a selective distribution system. The suggested retail price for one loudspeaker is EUR 1 750. The applicant therefore argues that the target group is restricted in number and consists of consumers who are not only well-informed and reasonably observant and circumspect but also quality-minded, and who invest in the product only after careful consideration (see judgment of 10/10/2007, T-460/05, paragraph 19).

Or could it be that the relevant public is made up of all average consumers in the EU?

They also know that such products are available on the market in a number of different forms and that each manufacturer has its own brand name (see judgment of 22/09/2005, R 497/2005-1, paragraphs 17 and 18).

Not distinctive enough? Article 7(1)(b) EUTMR

- Assess distinctive character by reference to:
 - goods in question
 - perception of relevant public
- Relevant public according to Board of Appeal:
 - buyers of hi-fi equipment

The first topic to be dealt with is the inherent distinctive character of the shape mark in question.

According to Article 7(1)(b) of the European Union trade mark Regulation, trade marks which are devoid of any distinctive character shall not be registered.

Distinctive character is assessed by reference to (a) the goods or services in question, in this case the loudspeaker, and (b) the perception of the relevant public, which consists of the average consumers of the goods or services in question.

Who is the relevant public in this case? Is it a restricted public, or does it consist of all average consumers in the EU?

B&O argued that the goods were “of high value” and “top-of-the-range”, and that the target group was therefore restricted. It rejected the view that the relevant public consisted of all average Union consumers.

The Board of Appeal considered that the buyers of hi-fi equipment should be taken into account. These consumers are aware that the shape of a loudspeaker can be dictated by functional and aesthetic considerations.

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Who is the relevant public?

The Court of First Instance rejected the point of view of B&O.

It stated that the type of distribution network used cannot be taken into account. Furthermore, 'other circumstances of no consequence to the right conferred by the EUTM' are immaterial. The marketing method is also irrelevant. Since it is purely a matter of choice for the business concerned, the distribution network may change after the EUTM has been registered. The same applies to the price of the product (see judgment of 10/10/2007, T-460/05, paragraph 31).

In this case study, the relevant goods include loudspeakers and music furniture. The relevant public was therefore made up of all average European consumers in the EU, given that any consumer may be interested in purchasing the goods in question.

See judgment of 10/10/2007, T-460/05, paragraph 32.

Who is the relevant public?

Court of Justice:

- The following cannot be taken into account:
 - the kind of distribution system
 - the particular marketing method
 - the price
- All average EU consumers!
- Level of attention may vary according to goods in question

The Court of First Instance was of the opinion that all average Union consumers should be considered. The fact that the loudspeakers were “top-of-the-range” and were sold in a selective distribution network at a high price was irrelevant. The particular marketing method used by the applicant should not be considered during the examination of the registration of the mark, because this could change once the mark was registered.

However, the level of attention of the average consumer may vary according to the goods and services in question. Consumers have a low level of attention when buying everyday consumer goods. Their level of attention is higher when purchasing durable or high-value goods, or products for exceptional use.

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What is the level of attention?

The distinctive character of the loudspeakers must be assessed in relation to the perception of the average consumer, who exhibits a particularly high level of attention when preparing and making a choice between different goods in the category concerned (see judgment of 10/10/2007, T-460/05, paragraph 35).

What is the level of attention?

- Durable, high-value product of a technological nature
- Purchase after careful examination
- The relevant public:
 - is the average consumer
 - exhibits a particularly high level of attention

It is obvious that B&O loudspeakers are not everyday consumer goods. They are not cheap. They have a technological nature. They are durable and can last for many years.

So the level of attention of the relevant consumer when buying these goods is high.

This leads to the conclusion that the relevant public consists of average consumers who purchase goods after careful examination. They therefore exhibit a high level of attention.

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Distinctiveness of the shape

The criteria for assessing the distinctive character of marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade marks. Article 7(1)(b) EUTMR makes no distinction between different categories of mark. There is no need to apply stricter criteria to establish the distinctive character of signs consisting of the shape of the goods themselves. This means that signs consisting of a shape do not have to be more distinctive than other marks, such as word and figurative marks. This is the basic principle.

However, it should be borne in mind that the distinctive character must be assessed by reference to the relevant public. The public's perception is not necessarily the same in the case of a three-dimensional mark, which consists of the appearance of the product itself, as it is in the case of a word or figurative mark, which consists of a sign unrelated to the appearance of the product. It is a matter of commercial experience that average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging and in the absence of any graphic or word element. In the perception of the consumer, the shape of a product primarily relates to functional and/or aesthetic requirements. The shape, by itself, is rarely seen as indicating the commercial origin of the goods. It could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (see judgment of 10/10/2007, T-460/05, paragraph 37).

In those circumstances, only a shape which departs significantly from the norm or customs of the business sector will have a distinctive character. This shape will be registered on the grounds that the mark is not devoid of any distinctive character. Therefore, it has to be assessed whether or not the shape of the loudspeaker differs from what is common in trade (see judgment of 10/10/2007, T-460/05, paragraph 38).

Distinctiveness of the shape

- No stricter criteria
 - minimum degree of distinctiveness is sufficient
- BUT perception of relevant public is different
- Shape must depart significantly from the norm

Now that we know who the relevant public is, we can examine whether or not the shape has an inherent distinctive character.

The sign consists of the shape of the product itself. Can this type of mark have any distinctive character? Should stricter criteria be applied?

According to the established case law of the Court of Justice, these types of mark may not be treated any differently from figurative marks or word marks. There is no need to apply stricter criteria when assessing the distinctive character of shape marks. A minimum degree of distinctiveness will be sufficient.

However, the perception of the relevant public will be different. Average consumers are not in the habit of making assumptions about the commercial origin of products on the basis of their shape. Establishing distinctive character can be more difficult.

In those circumstances, only a mark which departs significantly from the norm or customs of the sector will have a distinctive character.

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What are the features of the loudspeaker?

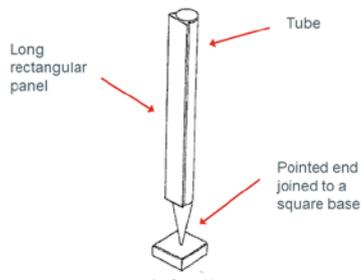
This three-dimensional mark consists of a loudspeaker which is in the form of a vertical, pencil-shaped column. According to B&O, the loudspeaker has an 'organ pipe'-like shape. It could also be described as consisting of a tube, i.e. the core of the loudspeaker, which is joined to an inverted cone.

The pointed end of the pencil or organ pipe joins a flat, square base.

In addition, a long rectangular panel is attached to one side of the column. This reinforces the impression that the weight of the whole loudspeaker rests on this point, which barely touches the square base. The decision to balance the organ pipe on such a small platform makes the loudspeaker appear very light and gives it a form which is similar to an exclamation mark.

The loudspeaker is also tall and narrow.

What are the features of the loudspeaker?



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The loudspeaker is in the form of a vertical, pencil-shaped column. According to B&O, it has an 'organ pipe'-like shape. It could also be described as consisting of a tube, which is the core of the speaker, joined to an inverted cone.

The pointed end of the pencil or organ pipe is joined to a flat, square base.

Conventional loudspeakers, on the other hand, generally follow regular, right-angled lines.

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Does the shape depart from the norm?

According to the Board of Appeal, there was no doubt that the shape of the loudspeaker was striking in some aspects:

- It is inordinately tall and narrow.
- The core of the loudspeaker is tube-like.
- The attachment of the inverted cone to the base is unusual.

Nevertheless, in the Board's opinion, it is not sufficient to argue that the shape is distinctive because its features are unusual. The fact that the relevant consumer perceives the shape as being unusual does not mean that he or she will also perceive the shape to be a trade mark. According to the Board, the relevant members of the public were the buyers of hi-fi equipment. These purchasers are aware of the different types of loudspeaker on the market and they will use the brand name to orientate themselves. They are used to seeing loudspeakers which have various designs and bear different brand names. They can make the distinction between the design of the product and the branding. The external appearance of the loudspeaker will be considered as its design and not as indicating the brand of the product (see judgment of 22/09/2005, R 497/2005-1, paragraphs 15 and 18).

The Court of First Instance, on appeal, took another view. It stated that all of the features distance the design shown in the trade mark application from the customary shapes of the goods falling within the same category which are commonly found in the trade. Examination of all the features leads to the conclusion that the shape of the mark is truly specific and cannot be considered to be altogether common. The whole creates a striking design which is easily remembered.

The Court concluded: "Thus this is not one of the customary shapes of the goods in the sector concerned or even a mere variant of those shapes, but a shape having a particular appearance which, having regard also to the aesthetic result of the whole, is such as to retain the attention of the public concerned and enable it to distinguish the goods covered by the trade mark application from those of another commercial origin" (see judgment of 10/10/2007, T-460/05, paragraph 42).

The fact that the shape was also dictated by aesthetic considerations is not sufficient to refuse trade mark protection. The sign can serve a purpose other than that of indicating commercial origin at the same time.

Overall conclusion of the Court of First Instance

- The shape of the loudspeaker has an inherent distinctive character.
- The decision taken by the First Board of Appeal is annulled.
- The case is sent back to the EUIPO.

Does the shape depart from the norm?

- According to the Board of Appeal:
 - striking in some aspects
 - but unusual features not sufficient
- According to the Court of First Instance:
 - truly specific and not common
 - a striking design which is remembered easily
- Conclusion
 - the shape of the loudspeaker has an inherent distinctive character

The Board of Appeal and the Court of First Instance came to different conclusions as to the distinctiveness of the shape mark.

According to the Board of Appeal there was no doubt that it was striking in some aspects. Nevertheless, in the Board's opinion, it is not sufficient for the features of a shape to be unusual. It referred to the relevant public and stated that the consumer in question can make the distinction between the design of the product and the branding. Consumers will use the brand name and not the outward appearance of the loudspeaker to orientate themselves.

The Court of First Instance however stated that all the features distance the trade mark applied for from the shapes which are commonly found in the sector concerned. The loudspeaker was very striking and truly specific.

The conclusion of the Court was that the sign possessed an inherent distinctive character.

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Back to the Board of Appeal: a new absolute ground for refusal?

When dealing with the case for the second time, the Board of Appeal saw an additional absolute ground for refusal in the form of Article 7(1)(e)(iii) EUTMR. The shape could be considered as a sign which consists exclusively of the shape, or another characteristic, which gives substantial value to the goods.

However, are the boards of appeal empowered to examine a case under a new ground for refusal?

Pursuant to Article 63(6) EUTMR, the EUIPO is required to take the necessary measures to comply with the judgments of the Courts of the Union. This includes the Court of First Instance (now called the General Court). This means that the boards do not have the power to review decisions made by the Courts of the Union. The boards of appeal at the EUIPO must comply with the judgment and implement or give effect to it. In this case, this means annulling the examiner's decision based on Article 7(1)(b) EUTMR and thereby closing the pending appeal. However, the Board of Appeal argued that the competence of the boards does not end there. The Board may opt to take on the role of an examiner and continue the examination. For instance, the Board can examine whether Article 7(1)(e)(iii) EUTMR is applicable in the present case. Of course, the applicant will then receive the right to be heard and to respond to the Board's arguments (see judgment of 22/09/2005, R 497/2005-1, paragraph 14 and 15).

This view was confirmed by the General Court. The boards could continue the procedure for the examination of the mark in question and reject the mark if they considered that the sign in question was covered by another absolute ground for refusal.

Note

It is established case law that the applicability of one of the absolute grounds for refusal suffices for a sign not to be registrable. Each of the absolute grounds is independent from any other absolute ground. There is no specific order in which to examine those grounds. There is no obligation to consider Article 7(1)(e) EUTMR before all the other grounds for refusal (see judgment of 6/10/2011, T-508/08, paragraph 41).

However, it might be more interesting to examine this ground first, because whenever a shape mark is refused under subsection (e) of the provision it can never acquire a distinctive character, in which case the examiner does not need to consider Article 7(3) EUTMR. This release explains the advantage, where several grounds for refusal may apply, of undertaking a prior examination of the sign under Article 7(1)(e), although it does not imply that there is an obligation to examine that sign first under Article 7(1)(e) EUTMR.

Back to the Board of Appeal: a new absolute ground for refusal?

- What about Article 7(1)(e)(iii) EUTMR?
- Is the Board of Appeal competent to examine any new ground?
- The Board is required to take the necessary measures to comply with the judgment
 - including re-examination
- Each absolute ground for refusal is independent

The Court of First Instance annulled the decision of the Board of Appeal and sent the case back to the EUIPO.

The EUIPO is required to comply with the judgments of the Court of the European Union. It therefore annulled the decision of the examiner, which was based on Article 7(1)(b) of the European Union trade mark Regulation. But the Board continued the examination by considering a new ground for refusal, that of Article 7(1)(e)(iii).

Are the boards of appeal competent to examine any new absolute ground for refusal? According to the General Court, they are. They are required to take the necessary measures to comply with any judgment of the courts of the EU which orders annulment. They can continue the procedure for the examination of the mark and reject it where they consider that the sign in question is covered by another absolute ground for refusal.

It is important to remember that each absolute ground is independent. There is no hierarchy among them, although examining a sign under Article 7(1)(e)(iii) first might have an advantage, because whenever a shape mark is refused under subsection (e) of the provision it can never acquire a distinctive character. Therefore, the examiner does not need to consider Article 7(3) in such a case.

As we will see on the next slide, this provision is not applicable to the shape mark in our case study.

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Article 7(1)(e)(iii) EUTMR

A product's shape is a sign which may constitute a trade mark. This follows from Article 4 EUTMEUTMR, which states that a EUTM may consist of any signs capable of being represented in the Register of the European Union Trade Marks, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to their proprietors, such as words, designs, the shape of goods and their packaging, provided that such signs are capable of distinguishing the goods or services of one business from those of other businesses.

However, under Article 7(1)(e) EUTMR, some signs cannot be registered. These are signs that consist exclusively of the shape or another characteristic:

- which results from the nature of the goods themselves;
- which is necessary to obtain a technical result; or
- which gives substantial value to the goods.

According to the case law, each of the grounds for refusal listed in Article 7(1) EUTMR must be interpreted in the light of the public policy interest underlying them. In the case of non-registrable shape marks, i.e. merely functional shapes or shapes which give substantial value to the goods, the immediate purpose in barring registration is to prevent the exclusive and long-term right (which the trade mark confers) from serving to extend the life of other intellectual property rights which the legislature has decided to make subject to limited periods of protection over time. The aim of Article 7(1)(e)(iii) EUTMR is to avoid the possibility of design and copyright protection, which are limited in time, being bypassed by trade mark law. By barring registration, the grant of an everlasting monopoly is prevented (see judgment of 6/10/2011, T-508/08, paragraphs 65 and 66).

In the present case, the loudspeaker was protected as a design in Denmark from 1991 onwards. At that time, design protection in Denmark was limited to a maximum of three terms of five years. The loudspeaker could also be considered as an article of "applied art" and, therefore, copyright protection under national law would also be possible. It should be noted that protection under design law and copyright law overlap to a certain extent.

It should also be noted that this does not mean that all copyrighted or design-protected three-dimensional signs should therefore be automatically barred from trade mark registration. On the contrary, only in certain specific cases will trade mark protection be refused.

This overall rationale also explains the choice of the legislator to make it impossible for these marks ever to acquire a distinctive character through the use made of them. Even if the shape has become distinctive as a result of use, registration is still not possible. For example, the Lego building brick was registered as a trade mark for games and playthings. The brick is famous all over the world, but still the registration was annulled on the basis of Article 7(1)(e)(ii) EUTMR. The shape was necessary to obtain a technical result (see judgment of 14/09/2010, C-48/09 P, 'Lego Juris').

The result is that, independently of recognition of the sign on the market as having distinctive character, trade mark protection is ruled out.

Article 7(1)(e)(iii) EUTMR

- A sign which consists exclusively of the shape which gives substantial value to the goods cannot be registered
- Protect public interest
 - avoid use of the trade mark to bypass limited rights, such as copyright and design right
 - prevent the granting of a monopoly
- The shape can never acquire a distinctive character, and thus be registered as a trade mark, through use!

A product's shape is a sign which can also constitute a trade mark.

However, we need to think carefully about the monopoly rights granted by a trade mark and how this can affect commerce. Is it in the public interest to grant such monopolies? The regulation clearly says that a sign which consists exclusively (and we emphasise the word exclusively) of the shape of the goods and which gives substantial value to the goods cannot be registered.

The public interest in using shapes in general is served by not allowing trade marks to be registered when design rights or copyrights with a limited life span can be filed. The aim is to prevent a permanent monopoly being granted.

It is important to note that a such shape can never acquire a distinctive character through use.

Without this exception, trade mark protection could be used to grant an everlasting monopoly on valuable shapes and in doing so would bypass the limitations of design law and copyright.

This also explains why even shapes which have acquired distinctiveness through use cannot obtain trade mark protection, even if the applicant can prove that his sign has become distinctive in the marketplace. Article 7(1)(e) of the European Union trade mark Regulation is applicable regardless of whether or not that particular shape might be distinctive in the marketplace.

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Does the shape give substantial value to the product? (I)

Under what circumstances does a shape give substantial value to a product? Does the sign applied for consist exclusively of such a shape?

The boards of appeal have dealt with the first issue quite extensively.

There are different approaches to determining the value that the shape gives to a product. A shape can have many values: aesthetic, economic or commercial. According to the boards, a shape gives substantial value to a product if it has the potential to influence or determine to a large extent the consumer's decision to buy the product. The ground for refusal therefore applies to products which the relevant public buys largely for the value of their shape. These are products where the shape is the only selling feature of the product, or one of the essential selling features. A mere convincing design is in itself not sufficient to be of substantial value (see judgment of 22/09/2005, R 497/2005-1, paragraph 24).

However, the shape is not necessarily the only factor which gives substantial value. For example, furniture can, of course, have a practical function, but designer furniture will be bought because of its special aesthetic design, rather than because of its function as furniture. Designer furniture will be rejected from registration (but may be protected under copyright law and possibly under design law).

On the other hand, the fact that the shape may be pleasing or attractive is not sufficient to exclude it from registration. If that were the case, it would be virtually impossible to imagine any shape mark being registered. In modern business, there is no product of commercial utility that has not been the subject of study, research and industrial design before its launch onto the market. Additionally, the Community Design Regulation explicitly recognises that a design can be protected by different types of intellectual property. In principle, and depending on the individual conditions, the same sign may be protected under trade mark law, design law, copyright law, patent law, and so on. Nevertheless, such multiple protection is not without limits, as set out in Article 7(1)(e) EUTMR.

The Board referred to three factors that may be taken into consideration in order to show whether or not the relevant products are bought mainly for their aesthetic value. The behaviour of the manufacturer and the consumer area both relevant (see judgment of 22/09/2005, R 497/2005-1, paragraphs 29 and following).

Firstly, it has to be assessed what relevance the manufacturers themselves give to the shape of their product as a marketing tool. In the present case, B&O stressed the significance of the particular design given to the loudspeaker by analysing the shape by itself. They emphasised the uniqueness of the design and referred to it as a classic design or design icon. They argued repeatedly that one of the essential selling features of their loudspeaker, if not the primary one, is the design; the attractiveness of the design sells loudspeakers.

Secondly, the aesthetic value also seems to be one of the most important reasons why consumers buy this B&O product. Retailers and resellers advertise B&O loudspeakers mainly by relying on their aesthetic appearance.

Thirdly, some experts referred to the uniqueness of the design. One expert stated that when the product was put on the market it attracted a lot of attention as being a truly unique design.

The Board concluded that the B&O loudspeaker is perceived not so much as an appealing loudspeaker but as a kind of pure, slender, timeless sculpture for music reproduction in the shape of an organ pipe balancing lightly on a small square base. The shape in itself is the decisive element for the appreciation by the relevant consumer, who will see in the shape a substantial value of the product.

Does the shape give substantial value to the product?(I)

- Potential to determine the consumer's behaviour with regard to buying the product
- Not necessarily the only feature which gives value
- Indications that show that a product is mainly bought for its aesthetic value:
 - behaviour of manufacturer
 - behaviour of consumers
 - behaviour of experts

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The boards of appeal have dealt with this issue quite extensively.

According to the boards, a shape gives substantial value to a product if it has the potential to influence to a large extent the consumer's decision to buy the product.

The mere fact that the shape is pleasing to the eye or attractive is not sufficient to exclude it from trade mark protection. If this were the case, hardly any shape marks could be registered.

However, the shape is not necessarily the only factor which gives substantial value to a product.

The Board referred to three indicators that may be taken into consideration in order to show whether or not a product is mainly bought for its aesthetic value.

One is the behaviour of the manufacturer. In its advertisements B&O relied heavily on the appearance and design of the loudspeaker. The visual appeal of the loudspeaker was used as a key selling point.

The second is the behaviour of consumers. We know retailers emphasised the aesthetic appearance of the product to sell the loudspeaker to consumers.

The third is the behaviour of experts. Experts wrote about the uniqueness of the design of the loudspeaker in our case study.

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Does the shape give substantial value to the product? (II)

The question that arose before the General Court was whether or not the Board of Appeal should have taken into account elements other than the shape in determining what gives substantial value to the product in question.

The Board of Appeal stated that the following are not relevant:

- the value of the material of the goods,
- the technology hidden inside the loudspeaker,
- the quality of the sound,
- the price.

The price relates to the marketing method of the business and therefore cannot have any impact on the assessment of the registrability of the sign. Furthermore, any distinctiveness of the trade mark potentially acquired due to B&O's marketing can also not be considered.

The General Court agreed with these points. It stated that, regarding Article 7(1)(e) EUTMR, there is no obligation to consider the perception of the target public, which is not a crucial element when applying this ground for refusal (see judgment of 6/10/2011, T-508/08, paragraph 72).

In the case of the B&O loudspeaker, the design is an element which is very important in the consumer's choice, even if other characteristics are taken into account.

In addition, the fact that the shape is considered to give substantial value to the goods does not preclude other characteristics of the goods, such as their technical qualities, from also conferring considerable value (see judgment of 6/10/2011, T-508/08, paragraph 77).

The Court concluded that in making its decision the Board of Appeal was correct and had not erred in law.

Does the shape give substantial value to the product?(II)

- Should the Board have considered other factors?
- General Court:
 - no obligation to consider the perception of the target public
 - other characteristics of the goods can also confer value

The Board of Appeal did not consider the value of the materials of the product, the technology used, the sound quality or the price of the loudspeaker on the market.

The General Court agreed with this decision. There is no obligation to take into account the perception of the target public with regard to this ground for refusal. Also, other characteristics of the goods, such as their technical qualities, can confer considerable value as well. The fact that the shape gives substantial value to the goods does not preclude this.

In the case of the B&O loudspeaker, it is clear that the design is an element which is very important in the consumer's choice, even if other elements are taken into account.

Therefore, in the Court's opinion, the Board of Appeal was correct in its decision and had not erred in law.

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The meaning of 'exclusively'

Further consideration must be given to the meaning of 'exclusively'. Only signs which consist exclusively of a shape that gives substantial value are excluded from trade mark protection.

The shape mark must be taken as a whole and analysed as a whole. There is no element in the shape which can be isolated from the design as a whole (see judgment of 22/09/2005, R 497/2005-1, paragraphs 35 and 36). In other words, it is not possible to isolate and consider only the essential or major features and then decide whether these features give a substantial value to the product.

B&O argued that the base of the loudspeaker was not part of the design. The Board disagreed and considered the base to be part of the shape. The solution of balancing the 'organ pipe' on such a small platform was very successful.

However, the Court seems to have taken a different approach in the Lego case, concerning signs which consist exclusively of the shape of goods and which are necessary to obtain a technical result. The Court stated that this condition is fulfilled when all the essential characteristics of a shape perform a technical function. The presence of non-essential characteristics with no technical function is irrelevant (see judgment of 14/09/2010, C-48/09 P, paragraph 51).

Furthermore, Article 7(1)(e)(ii) EUTMR cannot be applicable where the application for registration as a trade mark relates to a shape in which a non-functional element, such as a decorative or imaginative element, plays an important role. The Lego brick in the case was red, which is a non-functional element. The Court considered the red shape to be not essential and declared the trade mark invalid. However, this distinction between essential and non-essential elements in the Lego case was established within the context of the technical exclusion of Article 7(1)(e)(ii) EUTMR. The next question then would be whether 'exclusively' must be interpreted in the same way for exclusion under the different provisions of Article 7(1)(e)(iii) EUTMR.

The meaning of "exclusively"

- Not sufficient that only essential features of the shape give substantial value
 - trade mark must be analysed as a whole
- Base of loudspeaker also gives value

This slide deals with the meaning of “exclusively” in Article 7(1)(e)(iii) of the European Union trade mark Regulation. Remember: only signs that consist exclusively of a shape, or another characteristic, that gives substantial value are excluded from trade mark protection.

The Board of Appeal gave its own interpretation of the term. It is not possible to isolate and consider only the essential features of the shape. The trade mark has to be analysed as a whole. No element of the shape can be isolated from the design as a whole.

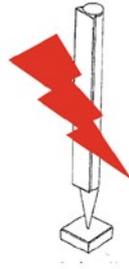
In this case, the base of the loudspeaker is also part of the shape and also gives value.

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Final decision

Bang & Olufsen's application for a European Union trade mark for the 3D shape of their loudspeaker was rejected.

Final decision



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In the end, Bang & Olufsen's application for a European Union trade mark for the 3D shape of their loudspeaker was rejected.

As a result, applicants wishing to register shape marks find themselves in an awkward position. If a shape is too common, it is not distinctive enough, and registration as a trade mark is excluded. If it is too striking, the trade mark could be considered as giving substantial value to the goods, and the shape barred from trade mark protection.

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Is Article 7(1)(e)(iii) EUTMR unfair to designers?

One might argue that the refusal under Article 7(1)(e)(iii) EUTMR is unfair to successful designers, as it bars their products from registration, even though the products are distinctive as a result of the distinctiveness of the design. The provision seems to penalise those designers whose designs are striking, perceptible and skilful. Under normal circumstances, these features would lead to recognition as a trade mark, or at least to a situation where protection under trade mark law could be acquired by prolonged use of the design.

Some commentators on trade mark law argue that the whole legislative balance is doubtful now that design protection may be granted to most figurative or three-dimensional trade marks and copyright-protected artistic works. Registered designs can be protected for up to 25 years. It could also be possible for a design to acquire distinctiveness through use as a trade mark. If a design is recognised as a trade mark as a result of its distinctive character, why deprive the owner of the easy tool of trade mark protection, at least during the term of design or copyright protection?

However, the legislator chose not to grant trade mark protection to shapes that give substantial value to the goods.

Is Article 7(1)(e)(iii) EUTMR unfair to designers?

- Does it penalise applicants whose design is particularly skilfully made?
- Should acquired distinctiveness through use be allowed?
- Choice of legislator:
 - protection by means of design and copyright law
 - limited in time
 - monopolising valuable shapes is misuse of trade mark law

One final question remains: is Article 7(1)(e)(iii) unfair to designers?

One might argue that refusal under Article 7(1)(e)(iii) of the European Union trade mark Regulation is unfair to successful designers, as it bars their products from registration even if they are distinctive. The decision seems to penalise designers who come up with striking and skilful designs. Should such shape marks be allowed trade mark protection once proof of acquired distinctiveness has been submitted?

The EU legislator chose to prioritise the protection of both valuable designs and copyright-protected works by means of design and copyright law, both of which provide limited protection in time. To try and monopolise such a valuable shape through trade mark protection would be a misuse of trade mark law.

3 Trade mark exercises

Trade mark exercises

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Trade mark exercises

This module contains a recap and two exercises on trade marks.

TRADE MARK EXERCISES

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In this first exercise we will be focussing on examining absolute grounds for refusal, in particular lack of distinctive character, in relation to an application for a European Union trade mark.

In the second exercise we will be going over the different steps in the opposition procedure.

Slide 52

Recap

The introductory part of the presentation will focus on absolute and relative grounds for refusal. The information in it will allow students to complete the exercise successfully.



We will start this module on trade mark exercises with a short recapitulation of absolute and relative grounds for refusal.

Slide 53

Grounds for refusal

This module starts with a short overview of the absolute grounds and relative grounds for refusal that will be used for the exercise.

Absolute grounds for refusal

Signs devoid of any distinctive character are not capable of distinguishing the goods and services of a business or trader. The average consumer would not perceive the mark as a distinctive sign (Article 7(1)(b) EUTMR).

Descriptive signs consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or of rendering of the service, or other characteristics of the goods or service (Article 7(1)(c) EUTMR).

A trade mark is generic when it consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade (Article 7(1)(d) EUTMR).

The distinctive character of a sign must be assessed from the standpoint of the average consumer. The average consumer is reasonably well informed, reasonably observant and circumspect. The level of attention of the average consumer can vary according to the goods or services involved.

Relative grounds for refusal

Article 8 EUTMR enables the proprietors of earlier rights to prevent the registration of subsequent EUTMs in a range of situations. It is possible that there is absolute identity both between goods and services and between marks (Article 8(1)(a) EUTMR). In that case, there is no need to prove any likelihood of confusion.

Grounds for refusal

- **Absolute** grounds for refusal
 - Distinctiveness
- **Relative** grounds for refusal
 - When peaceful co-existence on the market is an issue
 - Likelihood of confusion

We will now review the grounds for the refusal of a trade mark.

There are absolute grounds for refusal, such as the distinctiveness of the trade mark, and relative grounds for refusal.

A trade mark will be refused on relative grounds where the peaceful co-existence of the mark with another – older – trade mark is an issue and there is a likelihood of confusion between the marks.

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How do we assess the likelihood of confusion?

This slide contains a summary of how the likelihood of confusion is assessed.

The likelihood of confusion must be decided by referring to the commercial origin of the goods and services in question. There must be a risk that the relevant members of the public might assume that the goods and services in question are from the same supplier or from economically linked suppliers.

The degree of similarity between the goods and the services and the degree of similarity between the signs must be considered.

In assessing the similarity between the goods and services, all the relevant factors relating to those goods and services should be taken into account:

- Nature: What are they?
- Intended purpose: What needs do the goods and services satisfy? What problems do they solve?
- Method of use: How are they used?
- Complementarity: Is there a close connection between the goods and services in the sense that one is indispensable (essential) or important (significant) for the use of the other?
- In competition: Can one good or service be substituted for the other?
- Distribution channels: Where or how are the goods and services usually sold or provided?
- Relevant public: Who are the current and potential customers?
- Usual origin: Who is usually responsible for the manufacture or provision of the goods and services?

In addition, the signs must be compared by making an overall assessment of the visual, aural and conceptual similarities. All signs can be visually compared, but only those signs which incorporate words or numerals can be aurally compared. Signs that reproduce images cannot be aurally compared. Finally, only words, numerals and images that have a semantic meaning can be conceptually compared.

How do we assess the likelihood of confusion?

- Likelihood of confusion as to commercial origin
- Comparison of goods and services
- Comparison of signs

We assess the likelihood of confusion by comparing the signs as well as the registered goods and services of the older trade mark with the younger sign. It is important to think about the commercial origin of the goods. Will the relevant members of the public think that the goods have the same commercial origin?

Slide 55

Exercise 1: Examination

EXERCISE 1 EXAMINATION

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In this first exercise we will be focussing on examining absolute grounds for refusal, in particular lack of distinctive character, in relation to an application for a European Union trade mark.

Slide 56

Outline of the case

For this exercise, students should imagine that they are EUIPO examiners whose job it is to examine an application for a EUTM for the word mark 'Refuel' relating to certain goods and services in Classes 1, 4 and 40.

Outline of the case

- You are an examiner of Community trade mark applications at the EUIPO
- Your job is to examine an application for "REfuel"
- Registration is sought for:
 - Class 1: Combusting preparations
 - Class 4: Industrial oils
 - Class 40: Treatment and processing of crude oil

For exercise 1, I am going to ask you to imagine that you are an examiner at the EUIPO. Your job today is to examine an application for the word mark "REfuel".

The applicants are seeking registration for the following goods and services:

Class 1: Combusting preparations (chemical additives to motor fuel and lubricants)

Class 4: Industrial oils and greases, lubricants, fuels (including motor spirit) and illuminants

Class 40: Treatment and processing of crude oil and other forms of energy

Slide 57

Questions – Exercise 1

Questions – Exercise 1

- Would you accept the registration as a trade mark?
- Or would you reject the application
 - for all the goods and services requested?
 - for some of them?
- Is there an absolute ground for refusal which might be applicable?

Would you accept the application, or reject it?
For all the goods and services requested, or
some of them?

Is there an absolute ground for refusal which
might be applicable? Are there any reasons to
reject it?

Slide 58

Discussion and answers

Relevant absolute ground for refusal

The absolute ground that is of particular interest in this case is Article 7(1)(c) EUTMR, which states that the following may not be registered:

“trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service”.

This ground precludes from registration those signs that are purely descriptive of the goods or services for which they are registered. Descriptive marks are those that limit themselves to providing information about the goods and services in question. In order for a trade mark to be excluded from registration, the trade mark must consist only of descriptive matter. This decision is made by reference to the ordinary understanding of the word in question.

The public interest justification underlying this provision is that no exclusive rights should be created in purely descriptive terms which other traders might wish to use as well. It is also in the interest of the public that those terms which have a purely informational value should not be reserved for use by one single trader.

It is important to keep in mind that a EUTM application will be rejected even if the ground for refusal is present in only one member state (Article 7(2) EUTMR). The fact that in some territories of the EU the relevant public will perceive the term as being purely descriptive is sufficient for it to be rejected from trade mark registration for the whole of the EU.

The meaning of ‘REfuel’

The ordinary English term ‘refuel’ means simply to take on a fresh supply of fuel, to provide with additional fuel or to take on additional fuel. According to Oxford Dictionaries Online, ‘refuel’ is an English verb requiring an object and meaning ‘to supply [a vehicle] with more fuel’. See www.oxforddictionaries.com/definition/english/refuel?q=refuel

In the field of motor fuel and lubricants, whether it is their manufacture, supply or sale, the word ‘refuel’ is standard terminology and describes the basic nature and purpose of the business activity. In fact, the term is

generic and describes the mere commonplace action of putting more fuel into a fuel tank.

Moreover, the term ‘fuel’ exists also in French and Spanish and consumers speaking those languages will thus understand the obvious meaning of the word ‘refuel’. This means that, in total, some 230 million consumers living in the EU (the United Kingdom, Ireland, Malta, Cyprus, Denmark, Finland, Sweden, France, Belgium, Luxembourg and Spain) will directly and unambiguously understand the descriptive meaning of the word.

The word ‘refuel’ relates therefore directly and unambiguously to the kind, nature and purpose of the goods ‘fuels and lubricants’ (Class 4). The concept of ‘refuelling’ also relates directly and unambiguously to lubricants, since fuel contains lubricant to keep the fuel injectors running smoothly. It follows that the act of replenishing the fuel supply in a vehicle or other mechanical equipment inevitably includes the purchase and use of lubricants.

Distinctive element?

Considering the descriptive character of the term ‘refuel’, it follows logically that the only possible distinctive element in the earlier mark is the capitalisation of ‘RE’ at the beginning of the mark.

The trade mark could therefore possess some degree of distinctiveness, if this element will be taken into account.

If this element were not present, it is reasonable to think that the sign would be refused on the basis that no one business in the fuel and energy sector should be allowed to gain an exclusive right to the term ‘refuel’.

The sign ‘REfuel’ was in fact accepted by the EUIPO examiner as a EUTM. In other words, the examiner decided that the capitalisation was sufficiently distinctive.

Discussion and answers

- Relevant absolute ground for refusal
- Meaning of the term "refuel"
- Distinctive element



Accept as EUTM or not?

I asked you to think about whether there is an absolute ground for refusal of this trade mark application. If you think about the word "refuel" in English there is an obvious meaning, which is a standard or recognised meaning for a particular business activity. The word "fuel" also exists in French and Spanish.

But the trade mark has a distinctive element – the capitalised initial letters RE. This gives some degree of distinctiveness to the sign.

So what would you decide to do?

In real life, the examiner agreed to register the mark.

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Exercise 2: Opposition

The second exercise continues where the first one ended. It deals with the same mark, 'REfuel'. In this exercise, the students will go over the different steps in the opposition procedure.

EXERCISE 2 OPPOSITION

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Exercise 2 is a continuation of the first exercise. In this part I would like you to assess the likelihood of confusion between two trade marks.

Slide 60
Background to Exercise 2

Background to Exercise 2

- REfuel is registered as an EUTM
- An EUTM application is subsequently filed for:



- The owner of REfuel wants to block registration of the sign

As we saw, the EUIPO examiner accepted REfuel for all the goods and services for which registration was sought.

At some point following registration of the mark, the owner of the older trade mark, REfuel, became aware of a European Union trade mark application for a figurative sign, 4Refuel, which it thought was similar to its own mark.

The application had been published in the European Union Trade Marks Bulletin.

The owner of REfuel decided to take steps to block the registration of this sign for all the requested goods and services by filing an opposition to the registration.

Slide 61

Relevant goods and services

Go over the goods and services in each class.

Here is the list in full:

- **Class 4:** Fuels and lubricants;
- **Class 35:** Franchising services; business assistance services relating to the establishment and/or operation of businesses and outlets involved in the industrial on-site retailing, wholesaling, transportation and supply of fuels, oils, lubricants and greases; business advisory services relating to fuel and lubricant prices, consumption and usage; retailing of fuels and lubricants;
- **Class 37:** Refuelling and lubrication services for vehicles and equipment;
- **Class 39:** Transportation and delivery of fuels, oils, lubricants and greases;
- **Class 42:** Technical assistance services relating to the establishment and/or operation of businesses and outlets involved in the industrial on-site retailing, wholesaling, transportation and supply of fuels, oils, lubricants and greases.

Relevant goods and services



- Class 4: Fuels and lubricants
- Class 35: Franchising services and other; retailing of fuels and lubricants
- Class 37: Refuelling and lubrication services for vehicles and equipment
- Class 39: Transportation and delivery of fuels, oils, lubricants and greases
- Class 42: Technical assistance services

The applicant wanted to register 4Refuel for goods and services in various classes.

The slide shows the main categories concerned.

Slide 62

Questions – Exercise 2

Questions – Exercise 2

- **Group 1**

- What can the owner of REfuel do to stop the registration of the 4Refuel?
- Do you think he will be successful in blocking the registration?

- **Group 2**

- What arguments does the applicant have for dismissing the opposition to his application for 4Refuel?

Both the holder of the earlier European Union trade mark and the trade mark applicant needed to seek advice.

I would like you to divide yourselves into two groups. The first group should decide what advice they should give the owners of REfuel with regard to stopping the registration of 4Refuel, and whether they are likely to be successful.

The second group should provide arguments that the applicant can use to try and dismiss the opposition.

Slide 63

Factors to consider

The previous exercise established the low degree of distinctiveness of the earlier mark, REfuel.

It is now time to ask the students to compare the goods and services in each class. Encourage them to come up with arguments about why the goods and services are similar or dissimilar.

Then ask them to indicate the similarities and differences at the visual, aural and conceptual level. Remind them to consider the relevant territory (the EU). What kind of effect will this have on the conceptual and aural comparison?

They should also establish the distinctive and dominant elements of both signs, and identify the relevant public and the level of attention of the members of this public.

They should end by combining all these factors to make a global assessment of the two marks.

Factors to consider

1. Are the goods and services similar?
2. Are the signs similar?
3. What are the distinctive and dominant elements of the signs?
4. What is the relevant public?
5. What is your global assessment?

It might be useful to ask yourselves the following questions:

1. Are the goods and services similar?
2. Are the signs similar? Aspects to consider include the relevant territory, visual similarities, aural similarities and conceptual similarities.
3. What are the distinctive and dominant elements of the signs?
4. What is the relevant public and their level of attention?
5. What is your global assessment?

Slide 64

Solution

The following slides contain a step-by-step analysis of the solution to the exercise.

SOLUTION

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In the following slides we will carry out a step-by-step analysis of the solution to the exercise.

Slide 65

Degree of distinctiveness of REfuel

Before looking at the analysis in detail, it is important to examine the degree of distinctiveness of the prior mark.

The owner of the EUTM 'REfuel' can start an opposition procedure before the OHIM (provided that the opposition is filed within a three-month period starting from the date of publication of the EUTM application).

The relevant relative ground for refusal is Article 8(1)(b) EUTMR. This provision excludes the registration of a trade mark when peaceful coexistence on the market is an issue. This is the case where an identical or similar trade mark is already protected for identical or similar goods and services and there is a likelihood of confusion between the two marks on the part of the territory which the earlier trade mark is protected; the likelihood of confusion included the likelihood of association with the earlier trade mark. The risk of confusion must relate to the origin of the goods and services.

Under normal circumstances, examination of the likelihood of confusion would start with a comparison of the goods and services. However, this case is somewhat different.

During the first exercise, questions were asked about the degree of distinctiveness of the earlier mark, 'REfuel'. It could be argued that this mark lacks distinctive character because it might be descriptive of the goods and services.

Opposition proceedings do not deal with the registrability of the mark on absolute grounds. The fact remains that 'REfuel' was accepted and registered as a EUTM. Its registration cannot be challenged at this stage. However, this does not mean that its low degree of intrinsic distinctive character cannot be considered when assessing the likelihood of confusion. The public interest must also be kept in mind during the opposition procedure.

The scope of protection of the earlier EUTM will be narrow. This means that protection is limited to the particular representation of the word mark, i.e. with the capital letters 'RE'. Under normal circumstances, the protection of a word mark extends to the word as such, regardless of any upper- or lower-case letters used in the trade mark or the type of font. Bearing in mind the need to maintain a competitive market, it is not acceptable for one trader in the fuel and energy sector to possess the exclusive right to the term 'refuel'.

Therefore, the concerns previously raised regarding the descriptive nature of the earlier mark outweigh the usual presumption that a word mark confers protection for all versions of the word concerned.

Degree of distinctiveness of REfuel

- Descriptive nature of the mark remains relevant
- Public interest must be protected
- **Scope of protection will be narrow**

You will remember that we had to decide whether the trade mark was distinctive enough to allow registration. We agreed that the capitalised “RE” component gave some distinctiveness, but the fact remains that the descriptive nature or meaning of the mark is still relevant. We need to protect the interested public by making sure that the trade mark owner does not monopolise use of the word “refuel”. In other words, the scope of protection will be very narrow.

Slide 66

Step 1: Compare the goods and services (I)

This slide gives an overview of the different goods and services that are included in the scope of protection of both the registered EUTM and the EUTM application.

This overview is useful because, for each of the goods and services, it must be established whether they are identical, similar or dissimilar.

REfuel



Class 1: Combusting preparations (chemical additives to motor fuel and lubricants)	
Class 4: Industrial oils and greases, lubricants, fuels (including motor spirit) and illuminants	Class 4: Fuels and lubricants
	Class 35: Franchising services; business assistance services relating to the establishment and/or operation of businesses and outlets involved in the industrial on-site retailing, wholesaling, transportation and supply of fuels, oils, lubricants and greases; business advisory services relating to fuel and lubricant prices, consumption and usage; retailing of fuels and lubricants
	Class 37: Refuelling and lubrication services for vehicles and equipment
	Class 39: Transportation and delivery of fuels, oils, lubricants and greases
Class 40: Treatment and processing of crude oil and other forms of energy	
	Class 42: Technical assistance services relating to the establishment and/or operation of businesses and outlets involved in the industrial on-site retailing, wholesaling, transportation and supply of fuels, oils, lubricants and greases

Step 1: Compare the goods and services (I)

REfuel

- Class 1: Combusting preparations
- Class 4: Industrial oils and greases, lubricants, fuels and illuminants
- Class 40: Treatment and processing of crude oil and other forms of energy



- Class 4: Fuels and lubricants
- Class 35: Franchising services and other; Retailing of fuels and lubricants
- Class 37: Refuelling and lubrication services for vehicles and equipment
- Class 39: Transportation and delivery of fuels, oils, lubricants and greases
- Class 42: Technical assistance services

This slide shows the different goods and services covered by the registered European Union trade mark on the left, and the ones claimed in the European Union trade mark application on the right.

Slide 67

Compare the goods and services (II)

When comparing the goods and services with the opponent's goods and services, the following conclusions can be drawn.

Class 4

The trade mark of the opponent is registered for 'fuels and lubricants' in Class 4. These goods are **identical** to those for which protection is sought by the applicant.

Class 35

In Class 35, the applicant's services 'retailing of fuels and lubricants' are **similar** to the opponent's goods 'lubricants, fuels' in Class 4, since the goods of the opponent are the same as the goods sold by the applicant. The nature of the goods and services is not the same, but there is similarity because consumers may approach either the manufacturer of the goods, i.e. the opponent, or the company that provides retail services, i.e. the applicant, to acquire the products.

The applicant's other services in Class 35, i.e. franchising services, technical and business assistance services and business advisory services, are **dissimilar** to the goods of the opponent. Their nature is different, they are not complementary and they are not in competition with each other. These services fall into the category of business management, business administration and office functions. They are usually produced by different companies from those that produce or process fuels, lubricants or chemical additives. The goods and services in question also have a different nature. They are neither in competition with nor complementary to each other.

Compare the goods and services (II)

- Contested goods in Class 4: fuels and lubricants
 - **Identical** to opponent's goods in Class 4
- Contested services in Class 35: retailing of fuels and lubricants
 - **Similar** to lubricants and fuels in Class 4
- Contested services in Class 35: franchising services and other
 - **Dissimilar** to opponent's goods in Class 1, 4 and 40

Are the different goods and services for the two trade marks similar or dissimilar?

In Class 4 – fuels and lubricants – the goods are identical.

In Class 35 – the retailing of fuels and lubricants – the services are similar because this involves the retailing or sale of products of Class 4. Members of the public will think that the services and goods have the same commercial origin.

In Class 35, franchising services are clearly dissimilar to the goods in Classes 1, 4 and 10.

Slide 68

Compare the goods and services (III)

Class 37

The service of 'refuelling and lubrication for vehicles and equipment' in Class 37 is similar to the goods of the opponent in Class 4, i.e. fuels and lubricants, because they often originate from the same company. These companies can sell fuels and lubricants directly to customers or engage in services which aim to provide consumers with these goods. The relationship between the goods and services is complementary: the goods are an essential part of the provision of the services. For example, petrol stations also provide services for filling cars with petrol, or car-maintenance services such as putting lubricants into car engines.

Class 39

The applicant's service of 'transportation and delivery of fuels' (Class 39) is dissimilar to the goods of the opponent in Class 4. When one company seeks the services of another company for the transport of fuels, it is not likely to contact a (big) oil company. These companies transport their own goods to petrol stations or for home deliveries, but they do not normally provide a transport service to others. It is more likely that a transport company specialising in the transport of liquid goods will be contacted. The usual origin of the goods and services is thus different. They also have a different nature and are not in competition with each other.

The applicant's transportation services are also dissimilar to the opponent's 'combusting preparations' in Class 1. These preparations are raw materials which are used in the manufacturing process of fuels and lubricants. The producers of these materials are different from those that provide transport services. In addition, they have a different nature and they are not in competition.

Finally, the opponent's service of 'treatment and processing of crude oil' in Class 40 differs in nature from the transportation services of the applicant. The former deals with the processing of raw materials, and the latter with moving items from one place to another. The services also have different providers.

Class 42

The services of 'technical assistance relating to the retailing, wholesaling, and transportation, refuelling and supply of fuels, oils, lubricants and greases' are clearly linked to the Class 4 goods protected by the earlier mark. The nature and purpose of products are, by definition, distinct from the nature and purpose of services. There can be a connection between the two, most obviously, when the services involve technical assistance or maintenance of the specific products under comparison.

Compare the goods and services (III)

- Contested services in Class 37: refuelling and lubrication services for vehicles and equipment
 - **Similar** to lubricants and fuel in Class 4
- Contested services in Class 39: transportation and delivery of fuels, oils, lubricants and greases
 - **Dissimilar** to goods in Class 1, 4 and 40
- Contested services in Class 42: technical assistance services
 - **Linked** to Class 4 goods

In Class 37, refuelling and lubrication services for vehicles and equipment are similar to lubricants and fuel in Class 4. Members of the public will think that they have the same commercial origin.

The services in Class 39 relating to the transportation and delivery of fuels, oils, lubricants and greases are dissimilar. It is usual to contract different companies to provide the transportation services for goods, such as those in Classes 1 and 4. There is therefore no likelihood of confusion. Similar companies providing transportation services are not generally the same as those providing the services in Class 40, which is the treatment and processing of crude oil, so there is no confusion.

Finally, the services in Class 42 are certainly linked in some manner to the goods in Class 4,

but there is no direct connection. Goods and services are by their very nature different from each other.

Slide 69

Step 2: Compare the two signs (I)

Step 2: Compare the two signs (I)



- Relevant territory is the **EU**

We shall now look at the two signs in the whole of the EU, as the marks cover all the member states. We need to consider the cultural and linguistic perspectives in all these countries.

Slide 70

Compare the two signs (II)

The comparison of the signs usually starts by looking for similarities. However, as already seen, this is not a normal case. If the earlier sign is made up of a purely descriptive word, the comparison should focus on the differences rather than the similarities.

Visual comparison

What do you see? The earlier mark is a word mark. The contested sign is a figurative mark.

The signs are similar to the extent that they share the word element 'refuel'. Under normal circumstances, the reproduction in full of a word in a contested application would lead to the conclusion that the signs are visually highly similar. This is not the case where the verbal element is fully descriptive. The consumer will perceive the word 'refuel' not as a distinctive component, but as an element with a descriptive function, which is to provide information on the nature and purpose of the goods and services.

The relevant consumer will therefore be more attentive to the differences:

REfuel

4RefuelTM

The first two letters are written in block capitals	Only the first letter is a capital letter
Represented in black	Represented in red and blue
	Additional element '4' at the front of the mark
Written in standard font	Written in a stylised script in which the letters tilt slightly from left to right, as with italics



Compare the two signs (II)

- **Visually**
 - What do you see?
- **Aurally**
 - What do you hear?
- **Conceptually**
 - What does it mean?
- **Overall**  Similar only to a low degree

Think carefully about the two signs. What is similar and what is different?

Visually – what do you see? They are similar in that they have the same verbal element, “refuel”.

The differences are in the capital letters at the beginning, the colours, the addition of “4” at the beginning, and the plain versus stylised script.

Now we need to think about what you can hear.

The presence of the number “4” modifies the sound, which varies according to the language of reference.

As far as the conceptual meaning is concerned, what do you understand? English, Spanish

and French speakers, for example, would understand “re-supply with fuel”.

The overall conclusion is that the signs are similar only to a low degree, limited to “refuel”, a descriptive element.

Of these elements, it is mainly the number '4', in red at the beginning of the mark, which stands out.

Phonetic or aural comparison

What do you hear? What are the aural similarities and differences, the number of syllables, the coinciding syllables and their position within the signs, similar syllables and differing syllables?

Again, the relevant consumer will be more attentive to the differences between the signs.

The signs are similar in the sound of 'refuel'. However, the contested mark is modified by the presence of the element '4' at the beginning. The earlier mark is pronounced as 'refuel', while the contested application will also be pronounced as 'refuel', but preceded by the number 4.

Remember that the relevant territory is the entire EU. As a consequence, the pronunciation of '4' will vary depending on the language of reference. In French, four is 'quatre', which creates quite a different pronunciation, and in German it is 'vier'. In English, the contested sign would be pronounced 'four refuel'. It is not necessary to assess all the possible pronunciations in all parts of the European Union if there is a clear likelihood of confusion in one country. If this is the case, the comparison can focus on that country alone.

Conceptual comparison

What does it mean? What is the semantic content of the signs? In this case, the words have a clear semantic meaning. Conceptual comparison is possible.

Pay particular attention to the relevant territories. Conceptual comparison is possible only for those consumers in the EU who understand the word and for whom it has a meaning.

- English-speaking consumers: the marks coincide in the word 'refuel', which means to resupply, e.g. a vehicle, with fuel, such as petrol. The contested application, '4Refuel', would be seen as the combination of '4' and 'refuel'. The number '4' is identical in sound to

the preposition 'for', thereby giving the mark the overall meaning of 'for refuel'. It is now customary to use the number 4 to shorten the representation of this sound in brand names. The resulting concept of the contested sign thus differs somewhat from the meaning of 'refuel' on its own, which would be understood as a descriptive element.

- The term 'fuel' also exists in French and Spanish, and consumers speaking those languages will thus understand 'Refuel'.
- From the perspective of the members of the public of the European Union who are not familiar with English, French or Spanish, on the other hand, both signs would appear meaningless and no conceptual comparison is possible.

Overall

The two signs are similar to a low degree, limited to the common but descriptive element 'refuel'.



Slide 71

Step 3: Identify the distinctive and dominant elements

Any global assessment of conflicting marks must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

A dominant element is a visually prominent element. Distinctiveness, on the other hand, is the greater or lesser capacity of a sign to identify the goods and services for which it has been registered as coming from a particular business or trader. A sign or an element of a sign is not distinctive if it is exclusively descriptive of the goods and services themselves or of the characteristics of those goods and services.

The earlier mark consists of the term 'refuel', which, in relation to the goods and services concerned, is descriptive. The visually dominant feature of the mark is the capitalised letter combination 'RE' at the beginning of the mark. This capitalised syllable is the only feature of the mark which could conceivably have any degree of distinctiveness. (Later, during the global assessment, this low degree of distinctiveness will result in a limited scope of protection of the earlier mark, i.e. the scope will be limited to this nuance.)

The contested mark also contains the descriptive term 'refuel'. The dominant and distinctive features of the mark lie in the red '4' at the beginning of the mark and the contrasting blue word 'Refuel' which follows it.

Step 3: Identify the distinctive and dominant elements

- Refuel = **descriptive!**
- REfuel:
 - RE
- **4Refuel**
 - Red "4" at beginning
 - Contrasting blue word "Refuel"

We know that the word element “refuel” is descriptive for the registered mark.

We also know that the distinctive element is the capitalised RE at the beginning of the mark.

We can see, however, that the younger mark has a red number 4 at the beginning and the descriptive word ‘refuel’ in blue.

These are its distinctive elements.

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Step 4: Identify the relevant public

The relevant public plays an important role when it comes to assessing the likelihood of confusion between two marks. When comparing two signs, the impression that the signs make on the relevant members of the public has to be taken into account, as well as their meaning and the way they are pronounced in the language or languages spoken in the relevant territory.

The relevant public is ascertained in relation to the goods and services in question and the relevant territory.

Since the earlier mark is a European Union trade mark, the relevant public resides within the territory of the European Union.

In this case, the goods and services are directed at both the public at large and at a specialised public.

With respect to 'fuels and lubricants', 'retailing of fuels and lubricants' and 'refuelling and lubrication services for vehicles', the relevant public is mainly made up of average consumers. The average consumer in the European Union generally owns or uses a motor vehicle, which will require fuels and lubricants in order to function. The average consumer of the goods concerned is deemed to be reasonably well informed and reasonably observant and circumspect.

'Refuelling and lubrication services for equipment' concerns technical equipment and machines which would be serviced by specialised personnel. This latter service is therefore directed more at a specialised public composed of technical professionals, with a higher level of attention.

The relevant consumer therefore has a level of attention that ranges from reasonably attentive to highly attentive.

Step 4: Identify the relevant public

- Geographically: European Union
- Goods and services directed at public at large
- Goods and services directed at specialised public
- Level of attention

Now we need to know who the members of the relevant public are.

Both marks are valid in the European Union, so we need to consider all the member states.

Some of the goods and services are directed at the public at large. These are:

- fuels and lubricants
- the retailing of fuels and lubricants
- refuelling and lubrication services for vehicles.

Others are directed at specialised groups of professionals. These are refuelling and lubrication services for equipment.

The level of attention of the public therefore ranges from reasonably attentive to highly attentive.

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Step 5: Make a global assessment

The likelihood of confusion must be assessed globally, taking into account all the circumstances of the case. The likelihood of confusion implies some interdependence between the relevant factors. This is particularly the case with similarity between the trade marks and between the goods or services. Accordingly, a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.

Furthermore, the more distinctive the earlier mark, the greater the risk of confusion. Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.

In the global assessment phase, all these different factors are weighed up and evaluated, and their relative importance globally assessed.

In our case, the low degree of distinctiveness of the earlier mark has been already discussed. Since the mark is less distinctive, the risk of confusion will be lower. Consequently, the scope of protection will be narrow.

It has been already established that the conflicting signs are similar only to a low degree, limited to the common but descriptive element 'refuel'. On the other hand, some of the goods are either identical or similar. However, taking into account the narrow scope of protection of the earlier mark, it can be concluded that the differences between the signs are sufficient to exclude any likelihood of confusion.

Step 5: Make a global assessment

- "REfuel"
 - Low degree of similarity between signs
 - Some identical and similar goods and services
 - Low degree of distinctiveness
 - Narrow scope of protection

 **No likelihood of confusion**

Finally, we need to put everything together and make a global assessment.

We have a low degree of similarity between the signs.

Some goods are identical. Some services are similar. Other goods and services are not similar.

The older trade mark is not very distinctive and has a narrow scope of protection.

There is therefore no likelihood of confusion.

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Useful information

Useful information

- Decision of Opposition Division, 29 June 2011 (B 1 420 605)
- Decision of Fifth Board of Appeal, 23 May 2012 (R 1790/2011-5)
- EUIPO Manual of Trade Mark Practice
 - Part B: Examination
 - Part C: Opposition



<http://euipo.europa.eu>

Here are the two main decisions concerned.

You can read more about examination and opposition in the EUIPO manual of trade mark practice on their website at <https://euipo.europa.eu/ohimportal/en/trade-mark-guidelines>

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