



FACULTY OF LAW  
Lund University

Anton Thelander

# Descriptive indications as part of composite marks

The scope of protection awarded to non-distinctive elements  
of otherwise distinctive trademarks

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Supervisor: Ulf Maunsbach

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## *Summary*

The protection awarded to trademarks includes the right to prevent others from using signs confusingly similar to the trademark, for similar goods or services. The thesis aims to establish to what extent descriptive indications or non-distinctive elements could be registered as part of a trademark, as well as to discern the scope of protection awarded to such non-distinctive elements of otherwise distinctive trademarks.

There exists an incentive for businesses to choose descriptive marks for their goods. If they are successful in registering such descriptive marks, and if they are successful in prohibiting others from using the descriptive indications, it places the registrant's competitors at a disadvantage in marketing their similar goods as they cannot forward descriptive information in an as flexible manner. A trademark proprietor may also threaten unmeritorious proceedings against competitors wishing to use descriptive indications that are part of the proprietor's trademark.

The thesis focus on Community Trade Marks, and the rules regarding the registration and protection of such marks is found in the Community Trade Mark Regulation. The Regulation contains several grounds for refusal aimed at preventing the registration of descriptive or non-distinctive indications as trademarks. While such descriptive or non-distinctive indications are not allowed registration independently, they can be registered as part of a composite or compound mark. The sign to be registered must be looked at in its entirety. As long as other elements are added, so that the sign is not exclusively descriptive or devoid of distinctive character, it can be registered.

Once such a mark is registered the proprietor can prevent similar signs from being used or registered, either through opposition proceedings or infringement proceedings. Similar signs can be prevented from being used if there exists a likelihood of confusion between a third party's sign and an earlier Community Trade Mark. A likelihood of confusion can be established if there is a risk that the relevant public might believe that the goods or services in question come from the same undertaking or from economically linked undertakings due to the signs and products being similar or identical. The main rule is that descriptive or non-distinctive elements of a trademark should be given low or no importance when determining the existence of a likelihood of confusion. However, there are cases in which signs have been successfully opposed even though the only coinciding element of the opposed sign and the earlier trademark was a descriptive indication.

Thus, there are circumstances under which the proprietor of a trademark containing descriptive indications could prevent the use of the descriptive indication. It is proposed that the legislator should clarify in which way descriptive indications should be protected, possibly by stating that such indications should be ignored when establishing the existence of a likelihood of confusion.

## *Sammanfattning*

Skyddet som tilldelas varumärken inkluderar rätten att hindra andra från att använda märken som är förväxlingsbara med detta tidigare varumärke för liknande varor eller tjänster. Syftet med denna uppsats är att fastställa i vilken utsträckning beskrivande termer eller icke särskiljande element skulle kunna registreras som en del av ett varumärke, samt att urskilja omfattningen av skyddet som tilldelas sådana icke särskiljande element i annars distinkta varumärken.

Det finns flera incitament för företag att välja beskrivande varumärken för sina produkter. Om de lyckas registrera sådana beskrivande varumärken, och om de lyckas förbjuda andra från att använda samma beskrivande termer, missgynnas konkurrenter då dessa inte kan vidarebefordra den beskrivande informationen på samma smidiga sätt. En varumärkesinnehavare kan också hota konkurrenter, som vill använda beskrivande termer som ingår i innehavarens varumärke, genom ogrundade förfaranden.

Denna uppsats fokuserar på gemenskapsvarumärken, och reglerna kring registrering och skydd av sådana märken finns att finna i Rådets förordning om gemenskapsvarumärken. Förordningen innehåller flera grunder för avslag med syfte att hindra registreringen av termer som är beskrivande eller saknar särskiljningsförmåga. Även om sådana termer inte kan registreras självständigt så kan de registreras som en del av sammansatta varumärken. Märket som ska registreras måste bedömas i sin helhet, och så länge andra element läggs till så att märket inte är uteslutande beskrivande eller saknar särskiljningsförmåga så kan det registreras.

När ett sådant sammansatt varumärke är registrerat kan innehavaren förhindra att liknande kännetecken används eller registreras, antingen genom ett invändningsförfarande eller intrångsförfarande. Användningen av liknande märken kan stoppas om det finns en risk för förväxling mellan de två märkena. En förväxlingsrisk kan fastställas om det finns en risk att allmänheten kan tro att varorna eller tjänsterna i fråga kommer från samma företag eller från företag med ekonomiska band på grund av att märkena och produkterna är likartade eller identiska. Huvudregeln är att beskrivande element i ett varumärke bör ges liten eller ingen betydelse när domstolen fastställer förekomsten av en risk för förväxling. Trots detta finns det fall där varumärkesinnehavare har framgångsrikt motsatt sig användningen av ett annat märke trots att det enda sammanfallande elementet i de båda märken är ett beskrivande element.

Således finns det tillfällen då innehavaren av ett varumärke som innehåller beskrivande termer kan förhindra användningen av samma beskrivande termer. Det föreslås i uppsatsen att lagstiftaren bör klargöra på vilket sätt beskrivande beteckningar bör skyddas, möjligen genom att fastställa att sådana beteckningar ska ignoreras vid ett fastställande av förväxlingsrisk.

## *Preface*

I would like to thank my supervisor Ulf Maunsbach for all the help and guidance he has provided me with.

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*Anton Thelander*

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## *Abbreviations*

AG	Advocate General
CTM	Community Trade Mark
CTMIR	Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (Community Trade Mark Implementing Regulation)
CTMR	Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L78/1 (Community Trade Mark Regulation)
ECR	European Court Reports
ETMR	European Trade Mark Reports
EU	European Union
OHIM	Office for Harmonisation in the Internal Market (Trade Marks and Designs)
OJ	Official Journal of the European Union
RPC	Reports of Patent, Design and Trademark Cases
TMD	Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L299/25 (Trade Mark Directive)
USA	United States of America
WIPO	World Intellectual Property Organization

# 1. Introduction

## 1.1. Background

There are over 900 000 Community Trade Marks registered as of 2013 and there exists an interest among owners of such trademarks, as well as those interested in procuring new ones, to understand the scope of protection awarded to the marks.<sup>1</sup>

Trademarks have become a fundamental pillar when it comes to competition between businesses. Trademarks are guarantees of origin, confirmed to be their most essential function by the Court of Justice of the European Union.<sup>2</sup> By extension trademarks are a way for companies to effectively build goodwill and reputation, and an increasing amount of money and effort is spent on trademarks. With this increasing importance and value of trademarks there exists a need to know to what extent they are protected.

It is problematic when a company registers a descriptive indication, such as a word describing the product or its quality, as part of their trademark. There is a need from the public that such descriptive indications, or otherwise non-distinctive elements, should be able to be used by all. The courts that administer the Community Trade Marks have been incoherent in their assessments, and lately descriptive indications have been given undue importance. The question has been raised as to what extent such marks and elements should be protected. It is undisputed that an identical sign for identical products compared to that of an earlier trademark should be prohibited from being used or registered as a trademark, but should such protection also extend to cases in which the earlier trademark and the infringing sign only coincide in a descriptive indication? Concerns have surfaced that single companies would be able to monopolise descriptive indications by including them in a perpetual trademark.

## 1.2. Purpose

There have been cases where the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) has refused the registration of a word mark due to it only comprising a descriptive or non-distinctive word while later granting the registration of a complex mark containing the same descriptive or non-distinctive word, and then granted an opposition against another Community Trade Mark application containing that same word element.<sup>3</sup> To provide an example: in 2010 the sign ‘olive oil’ was denied registration due to it being exclusively descriptive of the goods or services applied for.<sup>4</sup> In comparison, a couple of years earlier the mark

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<sup>1</sup> Office for Harmonization in the Internal Market (Trade Marks and Designs), *Statistics of Community Trade Marks* (SSC009, 2013) 31.

<sup>2</sup> cf Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273 (Arsenal v Reed); Case C-487/07 *L'Oréal SA, Lancôme parfums et beauté & Cie SNC and Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd and Starion International Ltd* [2009] ECR I-05185 (L'Oréal/Bellure).

<sup>3</sup> Charles Gielen and Verena von Bomhard (eds), *Concise European Trade Mark and Design Law* (Kluwer Law International 2011) 129.

<sup>4</sup> Rejected Community Trade Mark application ‘OLIVE OIL’, Application N° 008900201, date of refusal 21/09/10.



‘Olive line’ was permitted registration.<sup>5</sup> The ‘Olive line’ mark was later able to prevent the registration of another mark that was using the word ‘olive’, although they did only coincide in that descriptive word.<sup>6</sup>

The protection awarded to trademarks includes the right to prevent others from using signs confusingly similar to the trademark, for similar goods or services. While descriptive or non-distinctive words are not allowed registration independently, they can be registered as part of a device mark, and once registered award protection to that word by allowing the proprietor to prevent similar signs from being used or registered.<sup>7</sup> Such behaviour would erode the trademark system, and steps have been taken to prevent such occurrences. Still, the problem is real, and such abuse can be observed.<sup>8</sup>

This thesis will establish to what extent descriptive indications or non-distinctive elements could be registered as part of a trademark, as well as to discern the scope of protection awarded to such non-distinctive elements of otherwise distinctive trademarks. The thesis will not discuss acquired distinctiveness through use. Focus will be on the registration of descriptive or non-distinctive indication that has not acquired distinctiveness and would not be allowed registration independently, and the scope of protection awarded to such elements when they are part of a bigger complex mark, with the elements still being considered descriptive and non-distinctive.

It will also contemplate whether there exists a need to keep some signs free for all to use, and to what extent this corresponds with the possibility to monopolise non-distinctive elements, such as descriptive words, using a trademark registration.

### *1.3. Methodology and material*

This thesis will focus on the possibility to register descriptive or non-distinctive indications as part of complex trademarks in the Community Trade Mark system, and the protection awarded to such elements. The thesis could thus be seen as twofold.

Traditional legal dogmatic method will be used, and the primary source of information will be legislation and case law at Community level. Focus will be on the Community Trade Mark Regulation<sup>9</sup>, but identical provisions as those to be analysed

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<sup>5</sup> Registered Community Trade Mark ‘Olive line’ (fig), Trade mark No 005086657, registration date 14/05/2007.

<sup>6</sup> Case T-485/07 *Olive Line International, SL v OHIM* [2011] Not yet published (Olive Line).

<sup>7</sup> Amanda Michaels and Andrew Norris, *A Practical Approach to Trade Mark Law* (4th edn, Oxford University Press 2010) 153.

<sup>8</sup> Tobias Cohen Jehoram and Constantinus van Nispen, *European Trademark Law: Community Trademark Law and Harmonized National Trademark Law* (Wolters Kluwer 2010) 295.

<sup>9</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L78/1 (Community Trade Mark Regulation).

can be found in the Trade Mark Directive<sup>10</sup>, thus sources concerning both will be considered.<sup>11</sup>

Complementary material such as legal doctrine, legal articles, examination guidelines and case law from OHIM, the Board of Appeal and the General Court will be used. As the case law from these courts are not binding, they will be used to illustrate current practice. The same applies to OHIM's examination guidelines. Some material originates from the USA and will only be used to further illustrate some of the complications relating to the topic, as well as to provide further guidance on what could be done to solve any eventual problems.

The discussion will be made from the point of view of the legislator, with the aim of finding any problems connected to the registration and protection of descriptive indications. The discussion could also be seen as made from the point of view of trademark proprietors, as their needs reflect the conflicting interests in allowing new trademarks to be registered and to protect those that already are.

The legal requirements and their application are described and analysed individually in the thesis' main chapters, with the final chapter considering what has already been stated to enable an analysis of the subject of the thesis.

#### *1.4. Delimitations*

This thesis will only deal with substantive law, procedural matters will not be discussed and will only be mentioned to enable the reader to understand the material problems. Focus will be on registration and protection concerning trademark law, and other intellectual property rights will not be part of the thesis. Economics and competition law will be left outside the thesis. EU law, and especially the Community Trade Mark system, is at the centre of this thesis. Other jurisdictions will not be dealt with.

The thesis assumes that the reader has at least basic knowledge of intellectual property law, and especially trademark law, as well as of the European Union and EU law.

Composite marks, consisting of words and pictorial elements, are at the centre of the investigation, and other marks such as shape marks, colours *per se*, etcetera will only be used to illustrate underlying interests of European trademark law. When discussing registrability, some grounds for refusal are left out, such as deceptive marks and marks contrary to public policy. The comparison of goods and services, as well as acquired distinctiveness through use, will only be mentioned briefly. The thesis will focus on the registration of descriptive or non-distinctive indication that has not acquired distinctiveness and would not be allowed registration independently, and the

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<sup>10</sup> Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L299/25 (Trade Mark Directive).

<sup>11</sup> cf Case T-156/01 *Laboratorios RTB, SL v OHIM* [2003] ECR II-02789 para 61; Case T-288/03 *TeleTech Holdings, Inc v OHIM* [2005] ECR II-01767 para 75.

scope of protection awarded to such elements when they are part of a composite or compound mark, the elements still being considered descriptive and non-distinctive.

### *1.5. Terminology*

In this thesis Italics are used for Latin expressions and for emphasis. Words that form part of trademarks will be written in capital letters.

There are several words used to denote trademarks that are encompassing more than one element. When using terms such as complex marks, compound marks and composite marks, they all refer to marks consisting of more than one element. These different expressions are used interchangeably, and what is said about any of them apply to all.

The word ‘sign’ and ‘mark’ is used to designate symbols that have or have not been registered as trademarks, while the word ‘trademark’ indicates that such symbols have been registered. When the word ‘product’ is used, it is meant to include both goods and services.

The Court of Justice of the European Union is used to designate the institution within the European Union that contains the whole judiciary, most notably the Court of Justice (or ‘the Court’, formerly the European Court of Justice, or ECJ) and the General Court (formerly the Court of First Instance). The new terminologies are used even when referring to judgments predating the Treaty of Lisbon and the change of names associated with the new treaty.

### *1.6. Outline*

Chapter 2 is about trademark law in general, going into its *ratio juris*, the functions of trademarks and the need to keep signs free. This chapter is important, as it provides a way to compare actual practise with the more general thoughts surrounding trademarks and trademark protection.

Chapter 3 deals with the registration of Community Trade Marks and the general rules on what signs are considered to be registrable. It also goes through the absolute and relative grounds for refusal. The rules prohibiting the registration of purely descriptive or non-distinctive indications are an important part of trademark registration and trademark protection and will be given space in this chapter. The end of chapter 3 deals with the registration of word marks and cases in which words cannot be registered due to them being descriptive or non-distinctive.

Chapter 4 deals with those cases where such descriptive or non-distinctive words could be permitted registration as part of a device/figurative mark, complex trademark or composite trademark.

Chapter 5 delves into the scope of protection awarded to trademarks, and especially the protection awarded to non-distinctive elements of otherwise distinctive composite marks.

Chapter 6 will briefly go into the new proposal for amendments of the Community Trade Mark Regulation and if any of these changes would affect the way in which descriptive indications, or otherwise non-distinctive signs, are treated.

Chapter 7 presents an analysis on the possibilities to register descriptive indications as part of a trademark, what protection is granted to such elements, and whether the approach towards such indications is appropriate.

## 2. Trademark law in the European Union

Trademarks have been used for centuries and have changed from being simple indications of ownership into valuable assets of companies. EU trademark law holds that there are several functions of trademarks, one being their ability to indicate origin, and has built much of the trademark system around these functions. If a mark can fulfil these functions, then it can be registered as a trademark and merits protection.

This chapter goes through the history and evolution of EU trademark law, the functions of trademarks, as well as the need to keep signs free. The latter is a concept that has been established in the case law of the Court of Justice,<sup>12</sup> and ascertains a need for descriptive indications to be kept free for all to use and not be monopolised by a small number of companies through the use of trademarks. This will act as the basis for further discussions on the possibility to register, and successfully protect, descriptive indications or non-distinctive elements.

### 2.1. History and evolution of European Union trademark law

Trademarks have been used for centuries. The underlying reasons for using them have changed as our views on trademarks have changed.<sup>13</sup> Originally trademarks were used as an indication of ownership – for example as branding on cattle.<sup>14</sup> During a time in which guilds produced crafts for sale, trademarks developed into signs of origin.<sup>15</sup> This allowed customers to identify whom to hold responsible in case of a malfunctioning product, or allow them to repeat a satisfactory purchase by buying a product bearing the same mark of origin.<sup>16</sup>

Trademarks were here to stay. As markets expanded, as did the worth of trademarks, resulting in a desire to protect trademark rights legally. This was further stressed during the age of industrialisation, where trademarks became more and more used in advertisement. It was now well established that trademarks could be used as indications of origin as well as of quality.<sup>17</sup> Trademarks became symbols, and could single-handedly aid sales by making products desirable to consumers.<sup>18</sup>

Today, trademarks could be the difference between success and failure when launching a new product. Some products are bought because of their trademark and the message they convey to the consumer as well as to others. Some products, due to their trademarks, could, in a sense, bring status or identity to a consumer.

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<sup>12</sup> Joined cases C-108/97 & C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber and Franz Attenberger* [1999] ECR I-02779 (Windsurfing Chiemsee) para 25.

<sup>13</sup> Thomas D. Drescher, 'The Transformation and Evolution of Trademarks: Signals to Symbols to Myth' (1992) 82 *Trademark Reporter* 301, 338.

<sup>14</sup> Sidney A. Diamond, 'The Historical Development of Trademarks' (1975) 65 *Trademark Reporter* 265, 267.

<sup>15</sup> Drescher (n 13) 309-10.

<sup>16</sup> Catherine Seville, *EU intellectual property law and policy* (Edward Elgar 2009) 210.

<sup>17</sup> Drescher (n 13) 321.

<sup>18</sup> Seville (n 16) 210.

Functionality has become less important.<sup>19</sup> Providing a picture on the huge value of trademarks: in 1986 The Coca-Cola Company was appraised at \$14 billion, of which \$7 billion was the value of the COCA-COLA trademark.<sup>20</sup> In 2011 Google was considered to be the most valuable trademark in the world, with a trademark value of \$44.3 billion.<sup>21</sup>

Legal protection of trademarks was demanded due to their value and significance. Products were no longer sold solely on the local market, and international harmonisation was called for. In 1883 the Paris Convention for the Protection of Industrial Property was signed. The convention, administered by the World Intellectual Property Organization ('WIPO'), focus on the harmonisation of substantive law. All European countries have acceded the convention, and even though the European Union is not part of the convention itself, traces of the convention could be found in EU trademark law. For example, similarities can be found between Article 6*quinquies* B of the Paris Convention and Articles 7 and 8 CTMR relating to the absolute and relative grounds for refusal.<sup>22</sup> Reference to the convention is made in the recitals of the TMD, and it is pointed out that the Directive would have to be consistent with the provisions in the convention as these bind all Member States.<sup>23</sup>

The European Union, acknowledging the importance of a unified approach towards trademarks within the Union, began their pursuit with the Trade Mark Directive in which they harmonised trademark law, and later on with the Community Trade Mark Regulation in which they provided for a possibility to register trademarks at a Community level.<sup>24</sup>

The Trade Mark Directive, not being a full-scale harmonisation of the laws of the Member States, harmonised substantive law relating to the acquisition and protection of trademarks. The TMD only focuses on those provisions necessary for the functioning of the free market, omitting provisions relating to procedural matters.<sup>25</sup>

The Community Trade Mark system, which came into being in 1993, permits the registration of trademarks at Community level. The system coexists with the Member States' national trademark systems, as these still fulfil a function within the global trademark system. Community Trade Marks are enforced in national courts that have been designated as special Community trade mark courts.<sup>26</sup> Due to the CTMR and TMD being developed side-by-side, there are several provisions in the two that are identical or similar.<sup>27</sup>

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<sup>19</sup> *ibid* 210-11.

<sup>20</sup> Drescher (n 13) 301.

<sup>21</sup> Sean Stonefield, 'The 10 Most Valuable Trademarks' (*Forbes*, 15 June 2011) <<http://www.forbes.com/sites/seanstonefield/2011/06/15/the-10-most-valuable-trademarks/>> accessed 4 May 2013.

<sup>22</sup> Seville (n 16) 212-14.

<sup>23</sup> Trade Mark Directive (n 10) 13<sup>th</sup> recital.

<sup>24</sup> Seville (n 16) 220.

<sup>25</sup> Trade Mark Directive (n 10) 2<sup>nd</sup>, 4<sup>th</sup> and 6<sup>th</sup> recitals.

<sup>26</sup> Michaels and Norris (n 7) 7; Seville (n 16) 221.

<sup>27</sup> To illustrate, Articles 4, 7, 8 and 9 CTMR are partly identical to Articles 2, 3, 4, 5 TMD respectively.

The Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('OHIM') was formed in Alicante to oversee all the procedural matters associated with the Community Trade Mark Regulation. The OHIM has been very successful, always striving to become better, cheaper and more efficient, and the number of registrations are booming.<sup>28</sup> The OHIM decides on registrations, and its decisions can be appealed to the Board of Appeal, then to the General Court and in the end to the Court of Justice.<sup>29</sup>

The Community Trade Mark system is governed by several principles: the unitary character of Community Trade Marks, the principle of autonomy, and the principle of coexistence.<sup>30</sup> The unitary character is expressed in Article 1(2) CTMR where it is stated that the Community Trade Mark shall have effect throughout the Community without any limitations created by the Member States.<sup>31</sup> The principle of autonomy asserts that Community Trade Marks are ruled only by the CTMR and any legislation associated with it,<sup>32</sup> as well as by Community law principles. The principle of coexistence asserts that the Community Trade Mark system and the Member States' national trademark systems could coexist. It is possible to register a Community Trade Mark, one or several national ones, or both.<sup>33</sup>

## 2.2. *Rationale behind trademark protection*

The protection and promotion of intellectual properties, to which trademarks belong, is of great importance within the EU, as they collectively promote innovation, employment, competition and, in the end, economic growth.<sup>34</sup> This reasoning cannot be fully extended to trademarks, as trademarks do not promote innovation in the same manner as other intellectual property rights.

There exists a public interest in that lowly distinctive trademarks are not registered and later exploited against third parties, with the result that competition is distorted.<sup>35</sup> In *Hag*<sup>36</sup> the Court of Justice held that trademarks are an essential element in the system of undistorted competition, thus justifying its protection under EU law. An undertaking must be in a position to keep its customers by virtue of the quality of its products, which is enabled by the use of trademarks.<sup>37</sup>

The *ratio juris* of trademark protection is closely related to the functions of trademarks. It is not the trademarks themselves that merit protection, but what can be achieved by using them, i.e. their functions.

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<sup>28</sup> Seville (n 16) 221-22.

<sup>29</sup> Community Trade Mark Regulation (n 9) 12<sup>th</sup>-14<sup>th</sup> recitals.

<sup>30</sup> Gielen and von Bomhard (n 3) 5.

<sup>31</sup> Community Trade Mark Regulation (n 9) art 1(2).

<sup>32</sup> cf Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (CTMIR).

<sup>33</sup> Gielen and von Bomhard (n 3) 5.

<sup>34</sup> Seville (n 16) 220.

<sup>35</sup> Justine Antill, 'Registrability and the scope of the monopoly: current trends' (2004) 26 European Intellectual Property Review 157, 161.

<sup>36</sup> Case C-10/89 *SA CNL-SUCAL NV v HAG GF AG* [1990] ECR I-03711 (Hag).

<sup>37</sup> *ibid* para 13.

### 2.3. Functions of trademarks

Trademarks become more and more important in today's society as well as for the companies, and it allows the latter to build an image in relation to its products or the company itself. This image could be based on quality, style or any other positive attribute, and in the end result in better goodwill for the company. More and more money is invested into trademarks, and in some companies the trademark is the single most valuable asset. A trademark could, for example, convey quality, origin or any other positive or negative information, that in turn could enhance or reduce the value of a company's business.<sup>38</sup> Thus there are several important features of trademarks, and the question is whether they all merit protection.

There is one feature that has been labelled the essential function of trademarks. The legislators of the CTMR, following the case law of the Court of Justice,<sup>39</sup> have held the origin function of trademarks as the essential function of trademarks. The origin function is a trademarks possibility to act as an indication of origin.<sup>40</sup>

This view was developed in *Hoffman-La Roche*<sup>41</sup> where the Court of Justice stated that protection through trademark rights should protect a trademark proprietor from competitors taking advantage of the proprietor's repute by selling products illegally bearing the proprietor's trademark. The trademark should be a guarantee of the identity of the origin of the product, and help consumers to distinguish between products both before and after purchase. This, in turn, helps the consumers to keep track of which products they like and dislike.<sup>42</sup>

The Court of Justice refers to 'functions' of a trademark, indicating that several exist besides the origin function.<sup>43</sup> In *L'Oréal/Bellure*<sup>44</sup> these other functions were stated. They are, *inter alia*, guarantee of quality function, advertising function and goodwill or investment function.<sup>45</sup> These functions apply to all trademarks, and not only those with an enhanced reputation.<sup>46</sup>

The other functions could be seen as subcategories to the origin function. To some consumers the quality of a product is the most important aspect when it comes to indicating origin.<sup>47</sup> The question remains as to what length the Court of Justice would go to protect these other functions. The scope of protection, when purely looking at a

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<sup>38</sup> Michaels and Norris (n 7) 6; Case T-215/03 *SIGLA SA v OHIM* [2007] ECR II-00711 para 35.

<sup>39</sup> *Arsenal v Reed* (n 2) paras 42, 48 and 51.

<sup>40</sup> Community Trade Mark Regulation (n 9) 8<sup>th</sup> recital.

<sup>41</sup> Case C-102/77 *Hoffmann-La Roche & Co. AG contre Centrafarm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse mbH* [1978] ECR I-01139 (Hoffman-La Roche).

<sup>42</sup> *ibid* para 7; Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2002] ECR I-05475 (Philips) para 30.

<sup>43</sup> Cohen Jehoram and van Nispen (n 8) 9.

<sup>44</sup> *L'Oréal/Bellure* (n 2).

<sup>45</sup> *ibid* paras 58 and 63.

<sup>46</sup> *ibid* paras 63-64.

<sup>47</sup> Alison Firth, Gary Lea and Peter Cornford, *Trade Marks: Law and Practice* (3rd edn, Jordans 2012) 8-9.



trademark's functions, is not entirely set in stone yet, but the Court of Justice seems keen to at least protect some of the huge investments put into trademarks.<sup>48</sup>

The function of a trademark is not solely to prevent consumers from being misled, but exist to promote innovation and commercial investment. A trademark protects the investment that the trademark proprietor has made and, in so doing, creates economic incentives for further innovation and investment. The other functions of the trademark relate to that promotion of innovation and investment.<sup>49</sup>

## 2.4. *The need to keep signs free*

Trademarks can be seen as economic rights, granting perpetual monopolies over symbols and words that are part of the trademark. The monopoly awarded through trademark protection is not absolute, and can change over time as it depends on the perception of the relevant public and what they consider to be a distinctive or descriptive mark or not.<sup>50</sup>

Concerns have risen, especially in relation to the absolute ground for refusal relating to descriptive marks,<sup>51</sup> concerning the possibility for traders to monopolise terms that may serve to designate a product's characteristics. That trader would be granted an unfair advantage over competitors who have an interest in using such descriptive terms.<sup>52</sup> In *Libertel*<sup>53</sup> the discourse concerned colours *per se* and their registrability. It was held that the registration of single colours could confer a real monopoly of use of the colour on a few traders, a monopoly that in turn could distort competition. Competitors could be disadvantaged, and in some cases even be prevented from entering the market at all.<sup>54</sup>

Another concern is that consumers could be disadvantaged if a company was granted a monopoly over a descriptive word. Only the proprietor could provide that descriptive information in an easy and accessible manner. Consumers should be provided an easy access to information so that they could become well informed, something that is hindered when descriptive words are controlled by a single company.<sup>55</sup>

From this it can be concluded that in some cases there is a need to keep signs free, such as in the case of descriptive indications. Competitors should be able to use words that they may need in the course of trade, or else they would be at a disadvantage compared with those being able to use such words.<sup>56</sup> A trademark should be denied

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<sup>48</sup> Michaels and Norris (n 7) 9.

<sup>49</sup> Case C-236/08 *Google France SARL and Google Inc v Louis Vuitton Malletier SA* [2010] ECR I-02417 (Google France and Google) Opinion of AG Maduro para 96.

<sup>50</sup> Cohen Jehoram and van Nispen (n 8) 7.

<sup>51</sup> Community Trade Mark Regulation (n 9) Art 7(1)(c).

<sup>52</sup> Case C-329/02 *SAT.1 SatellitenFernsehen GmbH v OHIM* [2004] ECR I-08317 (SAT2) Opinion of AG Jacobs para 22.

<sup>53</sup> Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2003] ECR I-03793 (Libertel).

<sup>54</sup> *ibid* Opinion of AG Léger paras 101-103; Jeremy Phillips, 'Trade Mark Law and the Need to Keep Free' (2005) 36 *International Review of Intellectual Property and Competition Law* 389, 393.

<sup>55</sup> Phillips (n 54) 392.

<sup>56</sup> *ibid* 392, 399.

registration as a CTM if it consists exclusively of descriptive indications.<sup>57</sup> The problem is that this does not prevent companies from registering descriptive indications as part of bigger composite or compound trademarks.

In relation to the registration procedure, and especially the absolute ground for refusal concerning descriptive indications, the Court of Justice has stated that there exists a public interest objective to protect the need to keep certain signs free for general use.<sup>58</sup>

The possibility of registering a trademark may be limited for reasons relating to public interest.<sup>59</sup> Article 7(1)(c) CTMR pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 7(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.<sup>60</sup> To allow one trader to monopolise a term which may serve to designate a product's characteristics would be to accord him an unfair advantage over competitors who have a legitimate interest in being able to use the term descriptively.<sup>61</sup>

The public interest to keep signs free is only as good as it is achievable. Article 7(1)(c) CTMR, with the underlying public interest that descriptive signs should be kept free, only prevents such signs to be registered if they are the sole element of that trademark. In certain circumstances such indications can be registered as part of complex trademarks. If these descriptive signs can be used in proceedings against other trademarks, then the public interest of keeping signs free would be ineffective, as companies still could get protection over descriptive indications.

The justification for the need to keep signs free, that is to prevent traders from monopolising terms that may serve to designate a product's characteristics, should influence other parts of the Community Trade Mark Regulation to be able to yield some result. Article 12 CTMR, that is dealt with later in this thesis, is another Article in the Regulation which prevents descriptive words from being monopolised, holding that such descriptive signs are allowed to be used honestly in the course of trade by anyone who desires to do so.<sup>62</sup> Another possible solution would be the use of disclaimers, also dealt with later in this thesis.

The risk with using the approach endorsed by Article 12, by granting the registration of descriptive indications under certain circumstances and later assert that the descriptive indications should be available to all, is that financially strong proprietors could threaten legal actions against those desirous of using the descriptive indications that are part of the proprietors' trademarks.<sup>63</sup> It is thus better to bar descriptive

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<sup>57</sup> Community Trade Mark Regulation (n 9) art 7(1)(c).

<sup>58</sup> Phillips (n 54) 393; *Windsurfing Chiemsee* (n 12) para 25.

<sup>59</sup> *Libertel* (n 53) para 50.

<sup>60</sup> *Windsurfing Chiemsee* (n 12) para 25; Case C-53/01 *Linde and Others* [2003] I-03161 (Linde) para 74.

<sup>61</sup> *SAT.2* (n 52) Opinion of AG Jacobs para 22.

<sup>62</sup> Phillips (n 54) 397, 399.

<sup>63</sup> Case C-104/00 P *DKV Deutsche Krankenversicherung AG v OHIM* [2002] ECR I-7561 (Companyline) Opinion of AG Colomer para 86; Case C-191/01 P *OHIM v WM Wrigley JR Co*

trademarks from registration at an early stage. This would reduce the risk that such trademarks are used against defendants that do not have the will and necessary means to defend such an unmeritorious trademark infringement action.<sup>64</sup>

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[2003] ECR I-12447 (Doublemint) Opinion of AG Jacobs paras 94-95; Rasmus Dalsgaard Laustsen, 'The Principle of Keeping Free Within EU Trade Mark Law' [2010] Retsvidenskabeligt Tidsskrift, 10.

<sup>64</sup> Phillips (n 54) 399-400.

### *3. Registration of a Community Trade Mark*

This chapter deals with the substantive rules regarding the registration of a Community Trade Mark. It will provide a basis for determining which descriptive or non-distinctive indications cannot be registered in isolation, and under which circumstances such indications can be registered as part of complex, composite or compound marks.

Any natural or legal person may register and be the proprietor of a CTM.<sup>65</sup> The trademark application is to be filed at the OHIM or at a national trademark office in a Member State.<sup>66</sup> The trademark application has to include: information about the applicant; a list specifying the goods and services the registration is for, and; a graphic representation of the trademark up for registration.<sup>67</sup> The classifications used are the Nice Classification system for the goods and services, and the Vienna Classification system to classify figurative elements of the sign.<sup>68</sup> Through the use of priority and seniority, one can turn a national trademark into a CTM.<sup>69</sup>

When examining the application, OHIM can only deny registration if it falls within the absolute grounds for refusal in Article 7 CTMR.<sup>70</sup> The registration is then published, and other parties get three months time to initiate opposition proceedings against the mark on the grounds established in Article 8 CTMR.<sup>71</sup>

For a sign to be registered by the OHIM it needs to: fall within the definition of a registrable mark; it must not fall within the scope of the absolute grounds for refusal; and it must not fall within the scope of the relative grounds for refusal.<sup>72</sup> All these steps will be dealt with in this chapter, ending in an analysis of word marks and under what circumstances such a mark is unable to be registered due to its elements being descriptive or non-distinctive.

#### *3.1. Registrable marks*

A sign must qualify under Article 4 CTMR to be able to be registered as a Community Trade Mark. Article 4 regulates whether a sign, in the abstract, could be registered as a trademark, and specifies a minimum standard when it comes to the sign as such.<sup>73</sup> Article 4 CTMR is mirrored in Article 2 TMD. Article 4 CTMR states that:

A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of

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<sup>65</sup> Community Trade Mark Regulation (n 9) art 5.

<sup>66</sup> *ibid* art 25(1).

<sup>67</sup> Seville (n 16) 222.

<sup>68</sup> *ibid* 222-23.

<sup>69</sup> Community Trade Mark Regulation (n 9) arts 29 and 34.

<sup>70</sup> *ibid* art 38.

<sup>71</sup> *cf ibid* arts 39-42, 51-53.

<sup>72</sup> Seville (n 16) 225.

<sup>73</sup> Gielen and von Bomhard (n 3) 9.

distinguishing the goods or services of one undertaking from those of other undertakings.<sup>74</sup>

What constitutes a *sign*, and what is meant by *capable of being represented graphically* and *capable of distinguishing* is not developed further in the Regulation, and has been the subject of some of the case law coming from the Court of Justice.<sup>75</sup>

A sign under examination is to be assessed under Article 4 CTMR several times,<sup>76</sup> but for this thesis it is only important to note that Article 4 should be considered as part of the absolute grounds for refusal in Article 7 CTMR.

### 3.1.1. *Sign*

What should be considered a *sign* is interpreted broadly by OHIM, and could include sounds and three-dimensional shapes.<sup>77</sup> The non-exhaustive list in Article 4 CTMR mentions words, personal names, designs, letters, numerals and the shape of goods or of their packaging. The limits were set in *Dyson*<sup>78</sup> where the Court of Justice held that some shapes should not, and could not, be considered as a sign.<sup>79</sup>

It is clear that words and figurative elements are capable of being signs, as these are included in the non-exhaustive list of examples in Article 4 CTMR. These are also the most common trademarks, with over 99% of all CTMs being word marks or figurative marks.<sup>80</sup> The viewpoint on smells, sounds and single colours is much less developed by the Court of Justice.<sup>81</sup>

### 3.1.2. *Capable of being represented graphically*

The need for the sign to be capable of being *represented graphically* leads to legal certainty, as it ensures that the rights associated with the trademark are delineated precisely. It also helps others that are looking through the trademark registry to determine which trademarks are registered and to what extent they are protected.<sup>82</sup>

The criterion is easily satisfied when merely considering the registration of words or pictures – the words are easily written and the pictures are easily depicted graphically. Problems arise when trying to register non-traditional trademarks such as sounds and

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<sup>74</sup> Community Trade Mark Regulation (n 9) art 4.

<sup>75</sup> cf Case C-273/00 *Ralf Sieckmann v Deutsches Patent- und Markenamt* [2002] ECR I-11737 (Sieckmann); Case C-321/03 *Dyson Ltd v Registrar of Trade Marks* [2007] ECR I-00687 (Dyson); *Libertel* (n 53).

<sup>76</sup> Such as when examined under Articles 26(1)(d), 27 and 36 CTMR, under the formalities check under Article 9 CTMR, and when examined under the absolute grounds for refusal in Article 7(1)(a) CTMR.

<sup>77</sup> Seville (n 16) 225.

<sup>78</sup> *Dyson* (n 75).

<sup>79</sup> *ibid* paras 31-40.

<sup>80</sup> Statistics of Community Trade Marks (n 1) 31.

<sup>81</sup> Seville (n 16) 225-26.

<sup>82</sup> *Sieckmann* (n 75) paras 48-52.

smells, as these are harder to depict graphically.<sup>83</sup> The criterion was developed further in *Sieckmann*<sup>84</sup> in which the Court of Justice held that the graphic representation must be visual, particularly by means of images, lines or characters, so that it can be precisely identified.<sup>85</sup>

### 3.1.3. *Capable of distinguishing*

The last criterion, that the sign must be *capable of distinguishing* the product from that of others, is a result of the essential function of trademarks – i.e. that trademarks should be able to indicate origin.<sup>86</sup> This criterion has only been given some attention from the Court of Justice, and is seen as a less specific criterion than that in the absolute ground for refusal concerning distinctiveness.<sup>87</sup> It should be seen as an interrelated provision, underlining the need for a trademark to act as a guarantee of origin.<sup>88</sup>

## 3.2. *Absolute grounds for refusal*

Article 7 CTMR stipulates several absolute grounds for refusal that should be considered during the registration of a trademark. These grounds cover those cases where a sign lacks distinctiveness in any kind of way, as well as to protect some public interests.<sup>89</sup> The grounds for refusal are considered to be absolute as they protect public interests and not those of individuals.<sup>90</sup>

Any breach of the absolute grounds for refusal would result in the sign not being registered. This holds true only when the underlying public interests are breached, and is also why the grounds for refusal should be interpreted in the light of these public interests.<sup>91</sup>

The first absolute ground for refusal refers to Article 4 CTMR, described above, stating that a mark would have to conform to the requirements set out by Article 4.<sup>92</sup> The next ground for refusal, Article 7(1)(b) CTMR, refers to a mark's ability to act as an indication of origin, i.e. its distinctiveness.<sup>93</sup> This ground for refusal is a more general one, and the following two grounds for refusal, Articles 7(1)(c)-(d) CTMR, could be seen as variations of the case in which a mark is devoid of distinctive character.<sup>94</sup> These two grounds for refusal are when the mark is exclusively descriptive of the goods or services or when the mark consists exclusively of

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<sup>83</sup> Seville (n 16) 226.

<sup>84</sup> *Sieckmann* (n 75).

<sup>85</sup> *ibid* (n 75) para 46.

<sup>86</sup> Seville (n 16) 231.

<sup>87</sup> cf Community Trade Mark Regulation (n 9) art 7(1)(b).

<sup>88</sup> Seville (n 16) 231.

<sup>89</sup> *ibid* 233.

<sup>90</sup> Gielen and von Bomhard (n 3) 22.

<sup>91</sup> *Libertel* (n 53) para 48-51.

<sup>92</sup> Community Trade Mark Regulation (n 9) art 7(1)(a).

<sup>93</sup> *ibid* art 7(1)(b).

<sup>94</sup> Seville (n 16) 233.

customary indications.<sup>95</sup> There are several other absolute grounds for refusal, but this thesis will focus on the ones already mentioned here as these are the most relevant when registering non-distinctive or descriptive words or pictures as part of composite or compound marks. The other absolute grounds for refusal are, *inter alia*, the registration of shapes, signs contrary to public policy or signs that deceive the public.

The grounds for refusal in Article 7(1)(b)-(d) CTMR could be remedied through Article 7(3) CTMR, making the sign registrable. Article 7(3) CTMR stipulates that 7(1)(b)-(d) shall not apply if the trademark has become distinctive in consequence of the use that has been made of it. This is an important aspect when it comes to registration or when someone, after registration, raises doubt that the mark is distinctive and that it should be declared invalid.<sup>96</sup> There is no requirement that the use of the mark should be done independently, but could form part of another mark.<sup>97</sup> A sign that, unused, is seen as descriptive or otherwise non-distinctive, and due to this cannot be registered, can be registered if evidence is brought forward to prove that the mark is distinctive due to the use that has been made of it.<sup>98</sup> Not all use will remedy a sign devoid of distinctiveness, and the key to understanding this is to understand the essential function of trademarks – the mark, after acquired distinctiveness through use, should be able to act as an indication of origin. Article 7(3) CTMR is interesting as it can trump the underlying public interest in Article 7(1)(c) to keep signs free. This provision will, however, not be dealt with as such in this thesis. The thesis will focus on the registration of descriptive or non-distinctive indication that has not acquired distinctiveness and would not be allowed registration independently, and the scope of protection awarded to such elements when they are part of a complex mark, still being considered descriptive and non-distinctive.

### *3.2.1. Marks devoid of distinctive character*

Marks are considered to be devoid of distinctive character if they cannot act as the carrier of the information concerning its origin. The reason why marks devoid of any distinctive character are denied registration is because then the mark cannot fulfil the essential function of trademark – the mark cannot indicate from which undertaking the product originates.<sup>99</sup>

Article 7(1)(b) CTMR, stating that signs devoid of any distinctive character shall not be registered, can be seen as having a wider scope of application than the two following grounds for refusal, 7(1)(c)-(d) CTMR. A sign can qualify under these two, but still be considered to be devoid of any distinctive character, but if a sign fails under Articles 7(1)(c)-(d) then the sign is ultimately devoid of distinctive character.<sup>100</sup>

The public policy justifying this ground for refusal is that a ‘mark must be capable of identifying the product as originating from a particular undertaking, and thus

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<sup>95</sup> Community Trade Mark Regulation (n 9) arts 7(1)(c) and 7(1)(d) respectively.

<sup>96</sup> Seville (n 16) 243.

<sup>97</sup> Case C-353/03 *Société des produits Nestlé SA v Mars UK Ltd* [2005] ECR I-06135 (KitKat) para 27.

<sup>98</sup> Michaels and Norris (n 7) 21.

<sup>99</sup> *SAT.2* (n 52) para 23.

<sup>100</sup> Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* [2004] ECR I-01619 (Postkantoor) paras 70 and 86.

distinguishing it from those of other undertakings.’<sup>101</sup> This corresponds with the essential function of trademarks, i.e. as an indication of origin.<sup>102</sup> Trademarks should aid consumers to repeat the experience of purchase if positive, or avoid it if it proved negative.<sup>103</sup>

### 3.2.1.1. *Relevant public*

Most legal examinations dealt with in this thesis should be done in relation to the relevant public. The relevant public is the persons making the choice that the specific goods or services should be bought or not. Examination is often done by referring to the average public or consumer if it involves consumer goods. This reflects the realities of the relevant market, where the attention of the relevant public depends on the goods or services as well as on the mark itself. The relevant public could be professionals or consumers, and these are more or less likely to pay attention to a mark.<sup>104</sup>

When it comes to distinctiveness, it depends on the relevant public whether the sign is seen as an indication of origin or not.

### 3.2.1.2. *Distinctiveness*

A sign is devoid of distinctiveness if the average consumer cannot rely on the sign as an indication of commercial origin for the goods or services it is to be registered for. The average consumer, who is unaccustomed to the sign, should be able to, without any analytical or thorough examination, determine that the goods or services bearing the sign has a commercial origin. In other words, the sign should be seen as a trademark by the average consumer.<sup>105</sup>

Distinctiveness should be assessed in relation to the particular goods or services applied for in the registration.<sup>106</sup> It should also be assessed in relation to the perception of the relevant public, i.e. the average consumer of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect.<sup>107</sup> The overall impression of the sign must be considered, even though each component may be examined individually in the process.<sup>108</sup>

The level of distinctiveness is not hard to achieve, as it would have to be ‘devoid’ of distinctiveness to fall under the scope of Article 7(1)(b) CTMR.<sup>109</sup> There is no requirement on the sign that it should exhibit any particular level of artistic or linguistic creativity.<sup>110</sup>

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<sup>101</sup> *Linde* (n 60) para 47.

<sup>102</sup> Community Trade Mark Regulation (n 9) 8<sup>th</sup> recital.

<sup>103</sup> Case T-79/00 *Rewe Zentral AG v OHIM* [2002] ECR II-00705 (Lite) para 26.

<sup>104</sup> *Gielen and von Bomhard* (n 3) 28.

<sup>105</sup> *ibid* 27-28.

<sup>106</sup> *Postkantoor* (n 100) paras 34, 72-74.

<sup>107</sup> *ibid* para 34.

<sup>108</sup> Case C-383/99 *Procter & Gamble Co v OHIM* [2001] ECR I-6251 (Baby-Dry) paras 44-45.

<sup>109</sup> *Seville* (n 16) 234.

<sup>110</sup> *ibid* 234.



Signs that are considered to be most distinctive are invented words or elaborate devices. Less distinctive are partly descriptive word marks or device marks, as well as the shapes of containers. Least distinctive are the shape of goods, exclusively descriptive words or devices and non-traditional trademarks such as smells or colours *per se*, being the least probable to communicate the origin of the goods or services bearing the sign.<sup>111</sup>

The signs should be analysed as a whole, and the court should consider all its components and whether they, when used together as a sign, could function as an indication of origin.<sup>112</sup> Cases concerning distinctiveness are often about semi-descriptive signs that have passed the other absolute grounds for refusal. The court would then have to look at whether the signs still should be considered as descriptive, or if they could convey a message of origin.

This means that non-distinctive elements could be included in a complex mark as long as there is another element, distinctive or non-distinctive. This element together with the non-distinctive element that one would like to register could be considered to have distinctiveness when looked at as a whole, making them registrable as a sign.

### 3.2.2. *Marks that consist exclusively of descriptive indications*

Article 7(1)(c) CTMR asserts that trademarks ‘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’ shall be denied registration.<sup>113</sup> This precludes exclusively descriptive signs from being registered.

In *Windsurfing Chiemsee*<sup>114</sup> the company Windsurfing Chiemsee had registered CHIEMSEE as part of several composite marks, both with pictorial and word elements. Chiemsee is the name of the largest lake in Bavaria, and the question rose whether the geographical indication should be granted registration. It was argued that some signs, such as geographical indications, should be available to all traders that would want to use them.<sup>115</sup> The Court of Justice held that the public interest behind Article 7(1)(c) CTMR was that some signs would have to remain available.<sup>116</sup> Descriptive signs should be freely available to all, and no undertaking should be able to prevent such descriptive signs from being used through its registration as a trademark.<sup>117</sup>

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<sup>111</sup> Michaels and Norris (n 7) 20.

<sup>112</sup> *SAT.2* (n 52) para 28.

<sup>113</sup> Community Trade Mark Regulation (n 9) art 7(1)(c).

<sup>114</sup> *Windsurfing Chiemsee* (n 12).

<sup>115</sup> Spyros Maniatis and Botis Dimitris, *Trade Marks in Europe: A Practical Jurisprudence* (2 edn, Sweet & Maxwell 2010) 207-08.

<sup>116</sup> *Windsurfing Chiemsee* (n 12) paras 25-26.

<sup>117</sup> *Doublemint* para 31.

Signs to be refused registration are only those that may serve, from the point of view of the relevant public, to designate, either directly or by reference to one of their essential characteristics, the goods or services the mark is to be registered for.<sup>118</sup>

The mark would have to consist *exclusively* of descriptive indications to fall foul of Article 7(1)(c). Only if the trademark, seen as a whole, acts as a descriptive indication should it be refused registration.<sup>119</sup> A mark composed of descriptive indications should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.<sup>120</sup> The addition of a distinctive element, such as a picture, could render the mark registrable, as it is no longer consisting exclusively of descriptive indications.<sup>121</sup> The added elements would have to be at least a little distinctive, either by themselves or when looking at the mark as a whole. In *BioID*<sup>122</sup>, the addition of a full stop and the use of a certain font was not enough to render the mark registrable.<sup>123</sup>

In *Baby-Dry*<sup>124</sup>, the Court of Justice considered whether the registration of the words BABY and DRY, configured as BABY-DRY, should be admissible in relation to disposable diapers.<sup>125</sup> The Court held that descriptiveness would have to be determined by looking at the components as such, but also the sign as a whole. Registration should not be refused when a new element, in this case the unusual juxtaposition, adds distinctiveness to the sign.<sup>126</sup> Both words BABY and DRY were considered to be descriptive, or at least indicative, of the product and its end users. In the end the sign could not be considered to be exclusively descriptive, prompting an analysis under Article 7(1)(b) CTMR.

Article 7(1)(c) CTMR is mostly brought up when it comes to word marks, as these marks easily could describe the goods or services registered for.<sup>127</sup> But this does not rule out the Article's scope of application when it comes to non-verbal trademarks. Figurative marks may indeed describe the goods or services for which the mark is registered.<sup>128</sup>

Descriptiveness should be examined in relation to the goods or services that the mark is to be registered for, and a relationship between the sign and the goods or services would have to be established.<sup>129</sup>

Even though descriptive indications cannot be registered as marks individually, there is nothing besides Article 7(1)(b) CTMR that prevents such indications from being

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<sup>118</sup> *Baby-Dry* (n 108) para 39.

<sup>119</sup> Gielen and von Bomhard (n 3) 34.

<sup>120</sup> *Baby-Dry* (n 108) para 39.

<sup>121</sup> Cohen Jehoram and van Nispen (n 8) 140.

<sup>122</sup> Case C-37/03 *BioID v OHIM* [2005] ECR I-07975 (*BioID*).

<sup>123</sup> *ibid* paras 71-72.

<sup>124</sup> *Baby-Dry* (n 108).

<sup>125</sup> *ibid* para 4.

<sup>126</sup> *ibid* para 40.

<sup>127</sup> Michaels and Norris (n 7) 22.

<sup>128</sup> Gielen and von Bomhard (n 3) 37; cf *Linde* (n 60) para 75.

<sup>129</sup> Case C-150/02 P *Streamserve Inc v OHIM* [2004] ECR I-01461 (*Streamserve*) paras 13, 28.

registered as part of a complex mark. Only if the mark also is devoid of distinctive character is it to be denied registration. With the result that descriptive indications actually can be registered, without consideration of the need to keep signs free, the question remains what amount of protection should be awarded to such elements of a complex mark.

### *3.3. Marks that consist exclusively of customary indications*

Article 7(1)(d) CTMR states that trademarks ‘which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade’ shall not be registered. This provision is about signs that have become generic and is closely connected with Article 7(1)(c) CTMR about descriptiveness.<sup>130</sup> Customary indications are often descriptive, even though they do not have to be, and there is often an overlap between these two Articles.<sup>131</sup> It comprises common trade descriptions, as well as commonly used shapes or pictures.<sup>132</sup> Such customary indications should be barred from registration, as they are not perceived as trademarks by the relevant public, and thus do not fulfil a trademark’s essential function.<sup>133</sup> Due to this, there is also an overlap between this provision and Article 7(1)(b) CTMR.<sup>134</sup>

This provision is very similar to Article 7(1)(c) CTMR, with the same underlying public interest, and will not be further addressed in this thesis, as most of what is said about descriptive signs also applies to customary indications.

### *3.4. Disclaimers*

Article 37(2) CTMR holds that the Office may request that the applicant disclaims any exclusive rights to an element which is not distinctive, in cases where the inclusion of that element could give rise to doubts as to the scope of protection of the trademark. This is referred to as a disclaimer. They are intended to make certain that there is no uncertainty as to the scope of protection awarded to the trademark in case of a conflict with another mark.<sup>135</sup>

A disclaimer results in that the disclaimed element is considered to be non-distinctive. No protection will be granted to the trademark containing the disclaimed element in case of an infringement proceeding where the only link between the two marks is the disclaimed element.<sup>136</sup>

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<sup>130</sup> Gielen and von Bomhard (n 3) 37.

<sup>131</sup> Seville (n 16) 243.

<sup>132</sup> Michaels and Norris (n 7) 24.

<sup>133</sup> Cohen Jehoram and van Nispen (n 8) 146.

<sup>134</sup> cf Case C-517/99 *Merz & Krell GmbH & Co* [2001] ECR I-06959 (*Merz & Krell*) para 24.

<sup>135</sup> Max Planck Institute for Intellectual Property and Competition Law, *Study on the Overall Functioning of the European Trade Mark System (Allensbach Study)* (2011) 75.

<sup>136</sup> OHIM, *The Manual Concerning Opposition, Part 2: Identity and Likelihood of Confusion, Chapter 4: Distinctiveness* (2012) 13.

Members of the Boards of Appeal of OHIM have voiced the opinion that disclaimers should be used to a larger extent, ensuring that composite marks are not given to broad protection regarding elements that should be able to acquire protection as such.<sup>137</sup>

The problem is that in practice, OHIM does not seem to use its option to request disclaimers.<sup>138</sup> Another is that some Member States still have trademark systems in which disclaimers are used more or less frequently.<sup>139</sup> This discrepancy could pose a problem, as those marks that have been granted registration without the need to disclaim any element would potentially be granted broader protection than those marks that are burdened with a disclaimer. The use of disclaimers also fails to take into consideration distinctiveness acquired through use, and only those trademarks without a disclaimed element could then benefit from this.

One solution would be to make disclaimers mandatory. Another would be to abandon the concept entirely. Following the first path would most likely create more problems, as the examiners would have to examine each and every element of a trademark, something that would possibly become tedious, especially when examining complex trademarks. Each element would then have to be examined from the point of view of distinctiveness, descriptiveness or functionality.<sup>140</sup> Another problem is that a lot of trademarks already have been granted registration without the need for a disclaimer, resulting in that newly registered trademarks subject to a disclaimer would be at a disadvantage compared to the earlier marks.

The alternative solution, to abandon the concept in its entirety, would be preferable. In the Allensbach Study<sup>141</sup> it is proposed that it should be set out in the Preamble of the CTMR that a finding of a likelihood of confusion cannot be based on elements which are descriptive or devoid of distinctive character, rendering the use of disclaimers pointless.<sup>142</sup>

### *3.5. Relative grounds for refusal*

The relative grounds for refusal, in Article 8 CTMR, relate to earlier trademarks and the prior rights of third parties by which they can prevent a trademark applicant from registering a similar or identical trademark to that of the earlier trademark. These rules exist to protect the owner of an earlier mark, but also to protect the function of origin, as the latter would be harmed if similar or identical signs existed on the market.<sup>143</sup>

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<sup>137</sup> Allensbach Study (n 135) 75.

<sup>138</sup> Gielen and von Bomhard (n 3) 129; Allensbach Study (n 135) 74.

<sup>139</sup> Allensbach Study (n 135) 74.

<sup>140</sup> *ibid* 76.

<sup>141</sup> See note 135, a study made by the Max Planck Institute for Intellectual Property and Competition Law to provide the Commission with an assessment of the overall functioning of the trademark system in Europe.

<sup>142</sup> Allensbach Study (n 135) 76.

<sup>143</sup> Seville (n 16) 253.

The opposition should be filed within three months of the publication of the CTM application,<sup>144</sup> and the relative grounds for refusal are not looked at *ex officio* by OHIM.<sup>145</sup> Approximately 15% of all CTM applications are opposed, and about 50% of the oppositions are successful.<sup>146</sup>

The relative grounds for refusal will be dealt with below in chapter 5 dealing with the scope of protection awarded to trademarks. This because the relative grounds for refusal can be seen as a right granted to the proprietor of an earlier trademark to prevent the registration of a new trademark in an opposition proceeding.

### 3.6. *The registration of a word*

This section intends to illustrate why single, descriptive or non-distinctive, elements cannot be registered as trademarks by themselves. As an example, single words that are descriptive will be used. Word marks are probably the most important category of marks, as these could be allusive or indicative of the goods without being obviously descriptive. Word marks could be names, signatures, real or invented words, combinations of words and slogans.<sup>147</sup> The desire to use descriptive words as part of ones trademark is due to that it offers an easy and accessible source of information directed at the consumers.<sup>148</sup>

Descriptive words include, *inter alia*, the name of the product as well as indications of quality, origin, purpose and value. For example, the word SOAP is not allowed as a trademark on the product soap.<sup>149</sup> Laudatory epithets, such as BEST, are considered to be descriptive of the quality of the product, and are thus also considered to be a descriptive indication barred from registration by Article 7(1)(c) CTMR.<sup>150</sup>

Such descriptive words do not fall foul of Articles 4 and 7(1)(a) CTMR. Words are given as an example of signs that can be registered in Article 4. The criterion that it should be possible to be represented graphically poses no problem as well.

Hindrance for the registration of single descriptive, or non-distinctive, words are Article 7(1)(b) and 7(1)(c) CTMR, and such words fall foul of both. The latter of the two Articles prevents the registration of exclusively descriptive marks, and there is no question that this provision includes single words that are descriptive of the goods. Such words are also considered to be devoid of distinctive character, as they cannot indicate origin. This reasoning applies not only to words, but also to descriptive or non-distinctive pictures.

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<sup>144</sup> Community Trade Mark Regulation (n 9) art 41.

<sup>145</sup> cf *ibid* art 8(1).

<sup>146</sup> Gielen and von Bomhard (n 3) 53.

<sup>147</sup> Michaels and Norris (n 7) 26-29.

<sup>148</sup> Jason K. Levine, 'Contesting the Incontestable: Reforming Trademark's Descriptive Mark Protection Scheme' (2005/06) 41 *Gonzaga Law Review* 29, 50-51.

<sup>149</sup> cf *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, [1997] ETMR 118 [305] (Jacob J); Michaels and Norris (n 7) 30.

<sup>150</sup> Michaels and Norris (n 7) 30.

Consequently, words that are only consisting of a descriptive indication are prevented from being registered, with the motivation that such trademarks would grant undue monopolies over descriptive words that should be free for all to use. The question remains under what circumstances such descriptive indications can be registered as part of composite or compound marks.

## *4. Registration of composite and compound marks*

The absolute grounds for refusal, as described above, only prevent the registration of a descriptive indication if a mark consists exclusively of such descriptive indications. Similarly, the absolute grounds for refusal only prevent the registration of marks devoid of distinctive character. This results in that only exclusively descriptive trademarks, devoid of distinctive character, are barred from registration. It allows for such descriptive or non-distinctive indications to be registered, as part of complex trademarks together with other elements, as long as the trademark seen as a whole does not fall foul under the absolute grounds for refusal described in the previous chapter.

Such a combination mark could either be in the form of a compound mark or a composite mark. Compound marks consist of a combination of words, where, for example, one part of the mark is distinctive and another part is descriptive or non-distinctive. A composite mark is a combination of a word element with a picture, as in the case of logos. The word could be distinctive whereas the pictorial element is descriptive or non-distinctive, or vice versa. Many other combinations of trademarks are possible, such as device marks in a certain colour.<sup>151</sup>

It is of interest for this thesis whether descriptive indications could form part of a trademark, and if the grounds for refusal described in chapter 3 apply to such marks.

### *4.1. Signs of which a trademark may consist*

Just as the word marks described in chapter 3.6 above, Articles 4 and 7(1)(a) CTMR pose no problem when it comes to the registration of compound or composite marks encompassing a descriptive or non-distinctive element. Compound marks are considered to be word marks and composite marks could be seen as a design, both being described as possible signs in Article 4. There is nothing preventing such marks from being represented graphically. The hurdles to overcome for such marks are the other absolute grounds for refusal, and especially Article 7(1)(b) and 7(1)(c) CTMR.

### *4.2. Absolute grounds for refusal*

#### *4.2.1. Descriptiveness*

As stated above, Article 7(1)(c) CTMR prohibits the registration of trademarks consisting exclusively of descriptive indications. Descriptiveness should be examined by looking at the sign as a whole. In the case of a mark in which all elements are descriptive, it must be established that the trademark seen as a whole is more than the sum of its parts.<sup>152</sup> If a mark, which consists of a combination of elements, is to be

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<sup>151</sup> cf Cohen Jehoram and van Nispen (n 8) 77.

<sup>152</sup> Gielen and von Bomhard (n 3) 35.

regarded as descriptive, it is not sufficient that each of its components may be found to be descriptive. The word itself must be found to be so.<sup>153</sup>

Composite and compound marks as those studied in this chapter could be separated into two categories. In the first the marks consists of several descriptive indications, and in the second the mark consists of a descriptive indication combined with one or several distinctive element.

As a general rule, when several descriptive elements are made into a trademark, the trademark itself remains descriptive for the purpose of Article 7(1)(c) CTMR. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned. Such a mark would have to create an impression that is sufficiently far removed from that produced by the simple combination of those elements. There should be a perceptible difference between the word and the mere sum of its parts.<sup>154</sup>

The addition of distinctive elements, or non-descriptive ones, will in most cases take the mark out of the scope of application of Article 7(1)(c) CTMR. It would have to result in the mark not being exclusively descriptive, resulting in the mark becoming subject of Article 7(1)(b) and not 7(1)(c) CTMR.<sup>155</sup> The additional elements would have to be more than negligible. The absence of an accent mark was not considered to make a mark any less descriptive of the goods or services.<sup>156</sup>

A mark moves out of the ambit of Article 7(1)(c) CTMR by the addition of another element, making it not exclusively consisting of descriptive indications. If one wants to register a descriptive indication as part of ones trademark, it can be done as long as another element is added. When this is done, the mark would have to be examined under Article 7(1)(b) CTMR to see whether the additional element renders the mark distinctive.

#### *4.2.2. Distinctiveness*

After a trademark containing descriptive indications pass the test under Article 7(1)(c) CTMR it would have to be examined under Article 7(1)(b) CTMR to see whether the mark, seen as a whole, is distinctive or not. A trademark should be examined as a whole, even though this does not prevent that all the elements are analysed separately with reference to distinctiveness ending in an analysis of whether the combination is more than the mere sum of its individual elements.<sup>157</sup>

The descriptive element that is part of the mark is considered to be devoid of distinctive character, as descriptive elements cannot be used to indicate origin unless they have become distinctive through use. For such marks to be registrable, an

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<sup>153</sup> *Postkantoor* (n 100) para 96.

<sup>154</sup> *ibid* paras 98-100.

<sup>155</sup> *Michaels and Norris* (n 7) 22.

<sup>156</sup> *Case T-32/00 Messe München GmbH v OHIM* [2000] ECR II-03829 para 38.

<sup>157</sup> *Gielen and von Bomhard* (n 3) 29.



additional distinctive element would have to be added, or, if several non-distinctive elements are added, the mark would have to be found distinctive when considered as a whole. Not all ornamentations, such as colours, fonts and devices, render a mark registrable.<sup>158</sup>

Usually marks are registered as a combination of a descriptive word and a distinctive design or pictorial element, or vice versa. This often renders the mark registrable due to the fact that there exists a distinctive element within the mark, which probably could have been registered by itself.<sup>159</sup> There is also the possibility to combine several descriptive or non-distinctive elements, as long as the new mark is distinctive when seen as a whole. This was the case in *Baby-Dry*<sup>160</sup> and *SAT.2*<sup>161</sup> in which these marks were considered to only comprise non-distinctive or descriptive elements. The marks were deemed registrable under Article 7(1)(b) CTMR as their juxtaposition made them distinctive enough.

### 4.3. Conclusion

The absolute grounds for refusal only preclude the registration of exclusively descriptive signs devoid of distinctive character. It is not possible to register descriptive or non-distinctive signs independently unless they have acquired distinctiveness through use, but it is possible to register such signs either by including a distinctive element, or to add non-distinctive or descriptive elements in such a way to make the mark, when seen as a whole, distinctive.

The remainder of the thesis will deal with the protection awarded to trademarks, and especially the amount of protection awarded to descriptive or non-distinctive elements, that has been shown to be registrable as part of otherwise distinctive signs.

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<sup>158</sup> *ibid* 29.

<sup>159</sup> Michaels and Norris (n 7) 31.

<sup>160</sup> *Baby-Dry* (n 108).

<sup>161</sup> *SAT.2* (n 52).

## 5. *Scope of protection*

The registration of descriptive indications is possible by including such indications in a composite or compound trademark. The question that remains is whether such a registration in any way grants the proprietor a right to prevent others from using or registering the same descriptive indication, even though there is an express need to keep descriptive signs free for all to use.

The scope of protection is wider than the strict ambit of the registration. Trademarks could merit protection even when not identical to an infringing sign. Protection could be awarded to a trademark in case of similarity between the CTM and another sign.<sup>162</sup> The question is whether the protection includes instances in which the similarity exists only in coinciding descriptive or non-distinctive elements.

It is important to remember the functions of trademarks and why trademarks in some cases should be granted protection.<sup>163</sup> The functions of a trademark, and especially the origin function, could only be fulfilled if the proprietor of a trademark was granted, at least partially, exclusivity over a registered mark. The same applies to economic functions, such as building goodwill and repute.<sup>164</sup>

To provide exclusivity over trademarks, the registration of identical signs for identical goods or services, as well as the registration of a confusingly similar sign for similar goods, should be prevented. Confusingly similar signs should only be allowed to exist in those cases where the goods or services registered for are dissimilar enough to prevent anyone from concluding that the goods or services bearing similar trademarks have the same commercial origin.<sup>165</sup> There should be no restrictions on what signs one can use if that exercise is not liable to affect the functions of the trademark.<sup>166</sup>

There are several cases in which a trademark merits protection, such as when an earlier mark is infringed by another confusingly similar sign, when someone takes unfair advantage of one's reputed trademark or detriment is done to one's trademark. This thesis will focus on the first of these, protection from the use of confusingly similar signs.<sup>167</sup>

In *Redrock*<sup>168</sup>, the General Court granted no protection to the earlier trademark ROCK in an opposition proceedings against the mark REDROCK. The coinciding word 'rock' could be seen as descriptive of the products for which the marks were registered. Due to this the signs were not considered to be similar to one another, even

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<sup>162</sup> cf Michaels and Norris (n 7) 153.

<sup>163</sup> OHIM, *The Manual Concerning Opposition, Part 2: Identity and Likelihood of Confusion, Chapter I: General Principles and Methodology* (2012) 3.

<sup>164</sup> Michaels and Norris (n 7) 140.

<sup>165</sup> Case C-252/07 *Intel Corporation Inc v CPM United Kingdom Ltd* [2008] ECR I-08823 (Intel) Opinion of AG Sharpston paras 5-7.

<sup>166</sup> Case C-207/01 *Altair Chimica SpA v ENEL Distribuzione SpA* [2003] ECR I-08875 (Altair Chimica) para 51.

<sup>167</sup> Cohen Jehoram and van Nispen (n 8) 241-42.

<sup>168</sup> Case T-146/08 *Deutsche Rockwool Mineralwoll GmbH & Co OHG v OHIM* [2009] ECR II-00199 (Summary publication) (Redrock).

though the goods or services were identical. Similarly, in *Echinaid*<sup>169</sup>, the two marks ECHINAID and ECHINACIN shared the prefix ‘echina’ referring to the plant ‘echinacea’ and thus being descriptive of the goods or services applied for. The prefix was the only descriptive element, and these two marks have been permitted registration as they are compound marks and, when seen as a whole, not exclusively descriptive. The General Court concluded that the marks were not confusingly similar.

In *Star Snacks/Star Foods*<sup>170</sup>, the marks STAR SNACKS and STAR FOODS were considered to be similar by the General Court, as the marks were comparable conceptually, even though the only coinciding element was the laudatory word ‘star’. The General Court came to a similar conclusion in *Tofuking*<sup>171</sup> where the only coinciding element was the laudatory word ‘king’. In *Avex*<sup>172</sup>, the General Court considered whether two marks, both consisting of the letter ‘a’ on a black background, should be considered similar. Even though a single letter is potentially devoid of distinctive character, as the dominant element in both marks was the letter ‘a’ they were considered to be similar.

It seems as if the presence of a descriptive element sometimes precludes similarity between two marks, and sometimes the descriptive element, being the only element in which two signs coincide, is the one causing the similarity.

This chapter will analyse the scope of protection awarded to trademarks as well as determine whether the protection extends to non-distinctive elements such as descriptive indications. The chapter will also try to establish why some descriptive indications, such as ‘king’ and ‘star’, merit protection, while other descriptive indications, such as ‘echina’, does not merit protection. It is important to determine the scope of protection awarded to such elements, as it is only then that such descriptive indications and their implications can be fully evaluated.

Every step of the process in establishing identity and similarity will be reviewed, as all of these steps could, in one way or another, affect the amount of protection awarded to descriptive elements of trademarks.

### *5.1. Opposition proceedings and infringement proceedings*

The proprietor of a CTM would be granted protection in two instances. Using Article 8 CTMR, the owner of an earlier trademark could oppose the registration of a newer trademark that either is identical or similar to the earlier trademark. This will be referred to as opposition proceedings. The proprietor is also granted exclusive rights through Article 9 CTMR that enables him to prevent third parties from using an identical or similar sign, compared to the proprietors trademark, in the course of trade. This will be referred to as infringement proceedings.

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<sup>169</sup> Case T-202/04 *Madaus AG v OHIM* [2006] ECR II-01115 (*Echinaid*).

<sup>170</sup> Case T-492/08 *Nicolas Wessang v OHIM* [2010] ECR II-00082 (Summary publication) (*Star Snacks/Star Foods*)

<sup>171</sup> Case T-99/10 *Meica Ammerländische Fleischwarenfabrik Fritz Meinen GmbH & Co KG v OHIM* (Not yet published) (*Tofuking*)

<sup>172</sup> Case T-115/02 *AVEX Inc v OHIM* [2004] ECR II-02907 (*Avex*)

Article 9 CTMR, partially reproduced below, is the provision asserting the scope of protection awarded to Community Trade Marks in the case of an infringement, and will be used to illustrate the criteria for double identity as well as for likelihood of confusion. There are several similarities between Article 8 and 9 CTMR. As Article 9 CTMR mirrors the relative grounds for refusal in Article 8 CTMR, any case law adhering to the two Articles is relevant when determining the scope of protection awarded to trademarks.<sup>173</sup>

#### Article 9 Community Trade Mark Regulation

1. A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered;

(b) any sign where, because of its identity with, or similarity to, the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark

Thus the cases in which an earlier trademark is infringed could be separated into two categories: 1) that which is referred to as double identity, and 2) when there is a likelihood of confusion due to a similarity between the signs as well as the goods or services for which the signs are used. These are regulated in Article 9(1)(a) and 9(1)(b) CTMR respectively. Once double identity or a likelihood of confusion has been established the outcome depends on whether it is an opposition proceeding or an infringement proceeding.

The wordings in Article 8 and 9 CTMR are identical when it comes to double identity and likelihood of confusion. However, there are other similarities. Both Articles provide protection to the earlier mark in case it has a reputation in the Community.<sup>174</sup>

Differences between the two Articles are, for example, that Article 8 CTMR gives further directions on what constitutes earlier trademarks, and trademarks registered in any Member State as well as CTMs are included.<sup>175</sup> Whereas Article 9 gives examples through a non-exhaustive list of what should be considered as in the course of trade, as use could only be prevented in these instances.<sup>176</sup>

One would also have to keep in mind Article 12 CTMR, which limits the scope of protection awarded to a trademark proprietor through Article 9. Article 12 provides some instances in which use of a sign in the course of trade should be permitted, even

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<sup>173</sup> Seville (n 16) 253.

<sup>174</sup> Community Trade Mark Regulation (n 9) arts 8(5) and 9(1)(c).

<sup>175</sup> *ibid* art 8(2).

<sup>176</sup> *ibid* art 9(2).

though the sign that is being used and the earlier trademark are considered identical or similar with respect to Article 9(1) CTMR.

This thesis focuses mainly on the concept of likelihood of confusion, under which descriptive indications can be seen as given too much protection. A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings.<sup>177</sup> In some of the cases mentioned above the proprietors of earlier trademarks were able to oppose the registration of what the General Court considered to be similar marks, even though the signs only coincided in descriptive elements. The remainder of this chapter will investigate under what circumstances descriptive elements should be given an importance in infringement and opposition proceedings, as well as to determine the results of such proceedings.

## 5.2. *Double identity*

Article 9(1)(a) CTMR (c.f. Article 8(1)(a) CTMR) deals with the cases in which an earlier trademark is infringed by an identical sign for identical goods or services for which the earlier mark is protected. The literal definition of identity suggests that the two elements compared should be the same in all aspects.<sup>178</sup>

This provision expressly requires there to be identity between the sign and the earlier mark as well as between the goods and services in question. This provision alone provides for a fairly limited scope of protection, as double identity is rarely the case.

Double identity is invoked in many opposition and infringement proceedings, but seldom leads to anything, either because it was wrongly invoked or because identity could not be proven in the case. Instead most refusals are due to a likelihood of confusion in Article 8(1)(b) and 9(1)(b) CTMR.<sup>179</sup>

However, if identity actually exists, then it would be easier to prove. Compared with Article 9(1)(b) CTMR, no likelihood of confusion on the part of the relevant public would have to be proven – this follows from the absolute protection awarded in case of double identity.<sup>180</sup> Another reason is that confusion is presumed in cases of double identity.<sup>181</sup>

If identity is asserted, then absolute protection is granted by Article 9(1)(a) CTMR.<sup>182</sup> The reason for this absolute protection is quite obvious, as the essential function would be seriously harmed otherwise. The origin could not be guaranteed if others were allowed to use identical signs for identical goods or services.<sup>183</sup> The same

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<sup>177</sup> OHIM, *The Manual Concerning Opposition, Part 2: Identity and Likelihood of Confusion, Chapter 3: Comparison of Signs* (2012) 4.

<sup>178</sup> Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ECR I-02799 (LTJ Diffusion) para 50.

<sup>179</sup> Gielen and von Bomhard (n 3) 54-55.

<sup>180</sup> Cohen Jehoram and van Nispen (n 8) 254.

<sup>181</sup> Seville (n 16) 254.

<sup>182</sup> OHIM Manual Concerning Opposition Part 2:1 (n 163) 4; Community Trade Mark Regulation (n 9) 8<sup>th</sup> recital.

<sup>183</sup> *Arsenal v Reed* (n 2) para 51.

applies to trademarks containing descriptive or non-distinctive elements. In cases of double identity the descriptive indication is not the only coinciding element, but the signs, seen as a whole, are identical. Even though a right is awarded to an earlier trademark containing descriptive elements to prevent others from using an identical sign, it could not be held that unreasonable protection is awarded to such trademarks and the descriptive indications. The trademark system and the essential function of trademarks would be undermined if the proprietor of a trademark, even if weakly distinctive, could not prevent competitors from using an identical sign.

### 5.2.1. *Identical sign*

When are two signs considered identical? Does two word marks have to be exactly the same to be considered identical, resulting in an interpretation of ‘identical’ to be objective and absolute? The concept of identity was originally construed narrowly by the Court of Justice. ‘The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects.’<sup>184</sup>

There is ‘identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.’<sup>185</sup> Thus all elements would have to be practically the same in all aspects.<sup>186</sup> ‘The exercise of that right must therefore be reserved to 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 its essential function of guaranteeing to consumers the origin of the goods.’<sup>187</sup> It was further stressed in *Céline*<sup>188</sup> that the use of an identical sign should not be prevented in those circumstances in which it does not affect any function of the earlier mark.<sup>189</sup> The absolute protection should not be awarded to trademarks in all circumstances, and some situations are instead covered by Article 9(1)(b) CTMR.<sup>190</sup>

### 5.2.2. *Border to similarity and likelihood of confusion*

Identity is ‘assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind.’<sup>191</sup> One objection is that this would require surveys to prove who the average consumers are and how observant they are, and these cost a lot of money to do and are in some cases unreliable.<sup>192</sup>

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<sup>184</sup> *LTJ Diffusion* (n 178) para 50.

<sup>185</sup> *ibid* para 51

<sup>186</sup> Michaels and Norris (n 7) 53.

<sup>187</sup> *Arsenal v Reed* (n 2) para 51.

<sup>188</sup> Case C-17/06 *Céline SARL v Céline SA* [2007] ECR I-07041 (*Céline*).

<sup>189</sup> *ibid* para 27.

<sup>190</sup> *LTJ Diffusion* (n 178) para 50.

<sup>191</sup> Seville (n 16) 254; *LTJ Diffusion* (n 178) paras 52.

<sup>192</sup> Belinda Isaac and Rajiv Joshi, ‘What Does Identical Mean?’ (2005) 27 EIPR 184 187.

This means that absolute identity is not required, and slight differences may go unnoticed by the average consumer and it would still be considered to be identity between the signs. It becomes a sliding scale in which the criteria for double identity are replaced with those for likelihood of confusion.<sup>193</sup> This stance on double identity has been criticised as it blurs the border to cases concerning similar signs. A blur would be self-defeating, and such an approach should only be advised when the differences are minimal, such as hyphens or other similar symbols – otherwise the boundary to Article 9(1)(b) CTMR would be imprecise.<sup>194</sup>

Double identity is not as interesting as the situations in which a trademark is granted protection only on the grounds that another sign is similar to the trademark. It is quite clear why trademarks should be granted protection in the case of double identity, as the function of trademarks would be seriously harmed otherwise. It is more interesting, from the point of view of this thesis, to analyse the concept of likelihood of confusion, where a trademark can be granted protection even when the element in which the two marks coincide is a descriptive indication.

### *5.3. Likelihood of confusion*

When it comes to oppositions of trademark registrations based on Article 8 CTMR, 95 % of the cases invoke similarity and a likelihood of confusion.<sup>195</sup> These statistics hold true when it comes to infringements, as Article 9(1)(b) CTMR is one of the most frequently invoked articles in the CTMR.<sup>196</sup>

The criteria in Article 9 CTMR are the same as those in Article 8 CTMR. Cases concerning any of the two can be used to determine the scope of protection when another company uses a confusingly similar sign. The concept is more abstract in opposition procedures, as no real confusion has yet occurred, and this could lead to a wider scope of protection than if the goods or services bearing that sign would have entered the market.<sup>197</sup> There are identical provisions in the TMD,<sup>198</sup> providing even more case law concerning the concept of likelihood of confusion.

For the proprietor of a CTM to be able to prevent a third party from using a sign in the course of trade there would have to exist a likelihood of confusion on the part of the public due to a similarity between the CTM and another sign, as well as a similarity between the goods or services covered by the CTM and the sign.<sup>199</sup> Only some guidance was given in the CTMR as to how to interpret Article 9(1)(b) CTMR:

The protection should apply also in cases of similarity between the mark and the sign and the goods or services. An interpretation should be given of the concept of similarity in relation to the likelihood of confusion. The likelihood of confusion,

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<sup>193</sup> Michaels and Norris (n 7) 54-55.

<sup>194</sup> Isaac and Joshi (n 192) 187.

<sup>195</sup> Gielen and von Bomhard (n 3) 54-55.

<sup>196</sup> Cohen Jehoram and van Nispen (n 8) 270.

<sup>197</sup> Gielen and von Bomhard (n 3) 55-56.

<sup>198</sup> Trade Mark Directive (n 10) arts 4(1)(b) and 5(1)(b).

<sup>199</sup> Community Trade Mark Regulation (n ) art 9(1)(b).

the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, should constitute the specific condition for such protection.<sup>200</sup>

The Court of Justice has interpreted the notion of likelihood of confusion several times,<sup>201</sup> and rough guidelines on how to interpret similarity and likelihood of confusion have emerged. The case law has been building up since *Sabel*<sup>202</sup> and is now applied both by national courts in relation to national trademark law based on the TMD, national Community trade mark courts dealing with CTMs, as well as by OHIM.<sup>203</sup>

Absolute protection is awarded to trademarks when a confusingly similar sign is used for similar goods or services and there is a likelihood of confusion. The protection exists, foremost, to guarantee that the earlier trademark can continue to function as an indication of origin.<sup>204</sup> It follows from the origin function of trademarks that likelihood of confusion would have to exist in cases of similarity. There must be a risk that the public might believe that the goods or services in question come from the same undertaking or from economically linked undertakings.<sup>205</sup> The reputation of a mark is protected as a result of this, as the mark is protected from losing distinctiveness and exclusivity.<sup>206</sup>

Protection could be granted to a trademark in those situations in which the signs are similar and the goods or services are identical; when the signs are identical and the goods or services are similar, and; when the signs are similar and the goods and services are similar.<sup>207</sup> The two variables (similarity of the signs and similarity of the goods or services) are interdependent, and a high similarity between the signs would require less similarity between the goods or services, and vice versa.<sup>208</sup>

These are not the only criteria to be satisfied for there to be a likelihood of confusion, and as stated in *Sabel* the court would have to perform a global assessment, taking into consideration all relevant aspects.<sup>209</sup> Several of these have been identified in the case law of the Court of Justice, and are as follow:

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<sup>200</sup> *ibid* (n 9) 8<sup>th</sup> recital.

<sup>201</sup> Case C-251/95 *SABEL v Puma, Rudolf Dassler Sport* [1997] ECR I-06191 (*Sabel*); Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-03819 (*Lloyd*); Case C-334/05 P *OHIM v Shaker* [2007] ECR I-4529 (*Limoncello*); Case C-3/03 P *Matratzen Concord GmbH, formerly Matratzen Concord AG v OHIM* [2004] ECR I-03657 (*Matratzen I*); Case C-120/04 *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* [2005] ECR I-08551 (*Medion*); Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer* [1998] ECR I-5507 (*Canon*); Case C-425/98 *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ECR I-04861 (*Marca Mode*).

<sup>202</sup> *Sabel* (n 201).

<sup>203</sup> *Michaels and Norris* (n 7) 56.

<sup>204</sup> Community Trade Mark Regulation (n 9) 8<sup>th</sup> recital.

<sup>205</sup> *Canon* (n 201) paras 29-30; *Lloyd* (n 201) para 17.

<sup>206</sup> *Cohen Jehoram and van Nispen* (n 8) 270-71.

<sup>207</sup> *Michaels and Norris* (n 7) 153.

<sup>208</sup> Case C-235/05 P *L'Oréal SA v OHIM* [2006] ECR I-00057 (Summary publication) (*Flexi Air*) order para 35.

<sup>209</sup> *Sabel* (n 201) paras 22-23.



1. The likelihood of confusion must be appreciated globally, taking account of all the relevant factors.<sup>210</sup>
2. The matter must be judged through the eyes of the average consumer of the goods in issue, who is deemed reasonably observant and circumspect.<sup>211</sup>
3. In order to assess the degree of similarity between the marks the court must determine the degree of visual, aural and conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements taking into account the nature of the goods in question and the circumstances in which they are marketed.<sup>212</sup>
4. The above similarities have to be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. The perception of the marks in the mind of the average consumer plays a decisive role in the overall appreciation of the likelihood of confusion.<sup>213</sup>
5. The average consumer perceives the mark as a whole and does not proceed to analyse its various details.<sup>214</sup> The assessment of similarity does not amount to taking into consideration only one component of a complex trademark and comparing it with another mark, but each is considered as a whole.<sup>215</sup>
6. There is a greater likelihood of confusion where the earlier mark is more distinctive (*per se* or due to use).<sup>216</sup> Such marks enjoy broader protection than marks with a less distinctive character, so there may be a likelihood of confusion even where there is a lower level of similarity between the marks.<sup>217</sup>
7. The average consumer has rarely any chance to make direct comparisons between the marks and must instead rely upon the imperfect picture of them he has kept in his mind, further the average consumer's level of attention is likely to vary according to the category of goods in question.<sup>218</sup>
8. Appreciation of the likelihood of confusion depends upon the degree of similarity between the goods. A lesser degree of similarity between the goods could require a greater similarity between the signs as such.<sup>219</sup>
9. Mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of the assessment.<sup>220</sup>

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<sup>210</sup> *ibid* paras 22-24; *Lloyd* (n 201) para 18; *Matratzen I* (n 201) para 28; *Limoncello* (n 201) para 34.

<sup>211</sup> *Sabel* (n 201) paras 22-24; *Lloyd* paras (n 201) 26-27.

<sup>212</sup> *Lloyd* (n 201) paras 27-28; *Limoncello* (n 201) para 36.

<sup>213</sup> *Sabel* (n 201) paras 22-24; *Lloyd* (n 201) para 25; *Matratzen I* (n 201) para 29; *Limoncello* (n 201) para 35.

<sup>214</sup> *Sabel* (n 201) paras 22-24.

<sup>215</sup> *Matratzen I* (n 201) para 32; *Limoncello* (n 201) paras 39-41; *Medion* (n 201) paras 28-32.

<sup>216</sup> *Sabel* (n 201) paras 22-24;

<sup>217</sup> *Canon* (n 201) paras 18-19; *Lloyd* (n 201) paras 20-21.

<sup>218</sup> *Lloyd* (n 201) paras 26-27.

<sup>219</sup> *Canon* (n 201) para 17.

<sup>220</sup> *Sabel* (n 201) para 26.

10. The risk that the public might believe that the goods come from the same or economically linked undertakings does constitute a likelihood of confusion within the meaning of the section.<sup>221</sup>

The courts would have to evaluate all these aspects when determining whether there exists a likelihood of confusion or not. First, the factors would have to be examined. Then, their relevance would have to be decided and the different factors would have to be weighed against one another to enable the court to come to the conclusion that there exists a likelihood of confusion or not.<sup>222</sup>

There have been cases in which a likelihood of confusion has been established due to coinciding descriptive indications within the conflicting signs.<sup>223</sup> This part of the thesis aims at determining under what circumstances such importance could be awarded to descriptive indications.

Some of the factors to be taken into consideration when establishing a likelihood of confusion are to be dealt with more in-depth below, as these in one way or another could alter the way in which descriptive indications are given protection through Article 8(1)(b) and 9(1)(b) CTMR.

### *5.3.1. The need to keep signs free and infringement procedures*

The Court of Justice has expressed its views on the need to keep signs free, the underlying public interest of Article 7(1)(c) CTMR, and its relation to infringement procedures and whether this need to keep free should be considered when determining the existence of a likelihood of confusion. The Court held that it should not be one of the factors to be considered. Signs that must, generally, remain available for all economic operators are likely to be used abusively with a view to creating confusion in the mind of the consumer. If, in such a context, the third party could rely on the requirement of availability to use a sign which is nevertheless similar to the trade mark freely without the proprietor of the latter being able to oppose that use by pleading likelihood of confusion, the effective application of Articles 8 and 9 CTMR would be undermined.<sup>224</sup>

### *5.3.2. Relevant territory and relevant public*

The relevant territory could matter when comparing signs and deciding whether they are similar or not. The perception of similarity is likely to differ between Member States due to differences in language and in pronunciation (affecting aural and

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<sup>221</sup> *Canon* (n 201) paras 29-30.

<sup>222</sup> OHIM Manual Concerning Opposition Part 2:1 (n 163) 11.

<sup>223</sup> cf *Tofuking* (n 171); *Star Snacks/Star Foods* (n 170); Joined cases T-5/08 to T-7/08 *Société des produits Nestlé SA v OHIM* [2010] ECR II-01177 (Golden Eagle); Case T-158/05 *Trek Bicycle Corp v OHIM* [2007] ECR II-00049 (Summary publication) (Trek Bicycle); *Olive Line* (n 6); Case T-313/10 *Three-N-Products Private Ltd v OHIM* [2011] Not yet published (Ayuuri Natural); Case T-7/04 *Shaker di L Laudato & C Sas v OHIM* [2008] ECR II-03085 (Limoncello Shaker).

<sup>224</sup> Case C-102/07 *adidas AG andt adidas Benelux BV v Marca Mode CV and Others* [2008] ECR I-02439 (Adidas and adidas Benelux) paras 30-31.

conceptual similarities) or meaning (affecting conceptual similarities). The examination of CTMs must extend to the whole EU, but could be narrowed down to fewer countries where the likelihood of confusion is deemed to be more plausible (which in turn saves both time and money in the proceedings).<sup>225</sup>

The relevant public is also important to consider, as some groups of consumers may be more attentive than others, and may be less likely to be confused.<sup>226</sup> Some consumers have a high degree of attention that is directed at the signs when purchasing the relevant goods or services.<sup>227</sup> If the ‘relevant public is specialised in the sector of the products in question [this] implies that it is likely to take great care in the selection of those products.’<sup>228</sup> This could also be the case where the goods or services are more expensive or of a highly technological character, and the average consumer is more likely to think through before buying such expensive products.<sup>229</sup> It could also be the opposite, in the context of fast pace consumer goods and the brief moments in which the average consumer decides to buy these, where the average consumer is less likely to pay attention to signs and trademarks.<sup>230</sup>

The ‘average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect. [...] However, [...] the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind.’<sup>231</sup>

In *Redrock*<sup>232</sup> the marks ROCK and REDROCK were registered for building materials, and the relevant public was held to be consumers visiting DIY stores as well as professionals of the construction sector. Due to the high price of the products, the relevant public would be showing a particularly high degree of attention at the time of purchase.<sup>233</sup> This was one of the factors that led the General Court to conclude that there was no likelihood of confusion between the two marks, even though the goods and services covered by the marks were identical, and although the slightly descriptive word ROCK existed in both marks.<sup>234</sup>

In *Ayuuri Natural*<sup>235</sup> the two conflicting marks AYUR and AYUURI NATURAL both referred to the word ‘ayurveda’, the name of a form of alternative medicine originating in India.<sup>236</sup> The General Court concurred with the claims that there exist consumers familiar with the word ‘ayurveda’, but held that those consumers do not make up a large enough part of the relevant public.<sup>237</sup> As the greater part of the

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<sup>225</sup> OHIM Manual Concerning Opposition Part 2:3 (n 177) 7.

<sup>226</sup> *Lloyd* (n 201) para 26.

<sup>227</sup> Michaels and Norris (n 7) 60.

<sup>228</sup> Case T-389/03 *Dainichiseika Colour & Chemicals Mfg Co Ltd v OHIM* [2008] ECR II-00058 (Summary publication) para 60.

<sup>229</sup> Case C-361/04 P *Claude Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643 (Picasso/Picaro) para 39.

<sup>230</sup> Cohen Jehoram and van Nispen (n 8) 288-89.

<sup>231</sup> *Lloyd* (n 201) para 26.

<sup>232</sup> *Redrock* (n 168).

<sup>233</sup> *ibid* para 41.

<sup>234</sup> *ibid* para 86.

<sup>235</sup> *Ayuuri Natural* (n 223).

<sup>236</sup> *ibid* para 56.

<sup>237</sup> *ibid* para 49.

relevant public would not see AYUR nor AYUURI NATURAL as referring to 'ayurveda' the two marks were seen as similar enough to create a likelihood of confusion.<sup>238</sup>

As seen in the two cases mentioned above, the relevant public could affect in which way descriptive indications are treated.

### 5.3.3. Comparison of goods and services

The comparison of goods and services is important, as at least a minimum degree of similarity is needed for there to be a likelihood of confusion.<sup>239</sup> However, the comparison of goods and services can be made quite complicated (a possible subject for another Master thesis) and for the rest of this thesis it will be assumed that the goods or services adhering to the trademark registrations being studied are at least similar. Still, it could be meaningful to explain the comparison of goods and services to some extent.

In assessing the similarity of the goods or services concerned [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.<sup>240</sup>

To prove that there is a likelihood of confusion it is not enough to prove similarity or identity between the earlier mark and the sign. Article 9(1)(b) CTMR demands that there is at least similarity between the goods and services, even though this similarity could be minimal.<sup>241</sup>

The similarity between the goods and services has to be done without taking into account the similarity of the signs or the distinctiveness of the earlier mark – there would have to be an objective approach, taking into consideration the realities of the marketplace, such as customs and trade practices in the relevant field.<sup>242</sup> As developed through *Canon*, there would have to be an examination of all the relevant aspects, and the aspects mentioned in *Canon* are only examples. There may be other factors that could affect the examination whether goods and services are similar that may be specific to the case at hand.<sup>243</sup>

The Nice Classification system governed by WIPO could act as a starting point when comparing goods or services. The system encompasses several categories for which trademarks could be registered, and is the system used by the CTMR to classify the goods or services applied for.<sup>244</sup> But the fact that the respective goods or services are registered in the same class in the Nice Classification system is not an absolute

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<sup>238</sup> *ibid* paras 63-66.

<sup>239</sup> OHIM, *The Manual Concerning Opposition, Part 2: Identity and Likelihood of Confusion, Chapter 2: Comparison of Goods and Services* (2012) 4.

<sup>240</sup> *Canon* (n 201) para 23.

<sup>241</sup> *ibid* para 22; Case T-400/06 *Zero Industry Srl v OHIM* [2009] ECR II-00150 (Summary publication) (*Zero*) para 32.

<sup>242</sup> OHIM Manual Concerning Opposition Part 2:2 (n 239) 12-13.

<sup>243</sup> *ibid* 19.

<sup>244</sup> *Seville* (n 16) 222-23.

indication that they are similar in the sense of Article 9(1)(b) CTMR. This statement holds true even when two registrations (specific goods/services) fall under the same general indication of a class heading. This holds true, although not in the same amount, if the specific goods or services are registered for different classes – they should not be deemed automatically as dissimilar. The Nice Classification system is best used as a rough guideline (as the Nice Classification serves administrative purposes originally), giving indications and hints to whether several goods or services are similar.<sup>245</sup>

OHIM has their own database for the comparison of goods and services, which act as an internal search tool to speed up proceedings. The use of such a database does in turn result in a consistent practice, as the one handling trademark cases can see the reasoning in previous cases. This database is of great importance when the OHIM is deciding upon trademark infringement, must be consulted, and is binding over other sources of its practice. Even so, the database is still at an early stage.<sup>246</sup>

Factors, as established in *Canon*, to be taken into consideration are: nature; intended purpose; method of use; complementarity; in competition. Additional factors are: distribution channels; relevant public; the usual origin of the goods or services.<sup>247</sup>

The criteria listed in *Canon* were not given a specific order, and no hierarchy should be inferred from this case. They should be considered one by one, but could be given different weigh depending on the case at hand, as some of them are interrelated and some criteria are more important than others.<sup>248</sup> Still, OHIM consider some factors as generally strong (such as usual origin; purpose; nature; complementarity; in competition) and some as less important (such as method of use; distribution channels; relevant public).<sup>249</sup>

As the similarity between the signs is dependent on the similarity between the goods and services, the latter could affect the weight given to descriptive indications in infringement and opposition proceedings. In *Tofuking*<sup>250</sup> the identity of the products in question was one of the factors that helped the General Court to conclude that there existed a likelihood of confusion between the marks CURRY KING and TOFUKING, even though they only coincided in the laudatory word ‘king’.<sup>251</sup>

#### 5.3.4. *Comparison of signs*

Determining whether the two signs are similar is the next, very important step. All elements of the signs should be taken into consideration. The purpose is to decide

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<sup>245</sup> OHIM Manual Concerning Opposition Part 2:2 (n 239) 5-7.

<sup>246</sup> *ibid* 7.

<sup>247</sup> *ibid* 20.

<sup>248</sup> *ibid* 33.

<sup>249</sup> *ibid* 34.

<sup>250</sup> *Tofuking* (n 171).

<sup>251</sup> *ibid* paras 46-47.

whether the two signs as such are identical, similar or dissimilar.<sup>252</sup> This is one of the necessary conditions for finding that there is a likelihood of confusion.<sup>253</sup>

In *Sabel*<sup>254</sup> the Court of Justice held that the assessment of the similarity of the signs must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.<sup>255</sup>

In practice, the similarity of signs is compared on three levels: visually, aurally and conceptually. Signs can usually be analysed on these different levels – word marks can be looked at visually and read out loud to be analysed aurally, as well as being conceptually similar to another word mark or another form of trademark. Signs are often analysed on all three levels, but the analysis of one level can be neglected in cases in which it is impossible (e.g. aural comparison of abstract figurative marks).<sup>256</sup> Figurative marks have mostly a visual impact on the observer, while a word mark may predominantly have an aural impact. There is also the case of composite marks, containing both a pictorial element as well as a word element. These marks will mostly be referred to using the word element, and thus aural similarity can be given greater importance in the final assessment of the similarity of the signs.<sup>257</sup>

The similarity found on these three levels have to be examined and compared with one another. Similarity between the signs could be established if there is similarity on only one of the three levels, but the question is then whether this slight similarity is enough for there to be a likelihood of confusion.<sup>258</sup> In most cases there would have to be similarity on all three levels for there to be a likelihood of confusion, and likelihood of confusion still depends on several factors (such as similarity between the goods or services) which have to be assessed separately then weighed against one another.<sup>259</sup>

There should be a global appreciation of the visual, aural and conceptual similarities of the marks in question, and such an appreciation must be based on the overall impression given by the marks. The perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion, as the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.<sup>260</sup>

Determining whether two signs are similar or not is often where descriptive indications can compensate for lacking distinctiveness. They are often similar (at least conceptually) to the same, similar or other descriptive indications. However, the comparison depends on the other elements of the marks as well, and the intrinsic qualities of these other elements often determine the protection awarded to the descriptive indications.

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<sup>252</sup> OHIM Manual Concerning Opposition Part 2:3 (n 177) 4.

<sup>253</sup> Case T-112/06 *Inter-Ikea Systems BV v OHIM* [2008] ECR II-00006 (Summary publication) (IDEA) para 81.

<sup>254</sup> *Sabel* (n 201).

<sup>255</sup> *ibid* para 23.

<sup>256</sup> OHIM Manual Concerning Opposition Part 2:3 (n 177) 4-5.

<sup>257</sup> *Michaels and Norris* (n 7) 61-62.

<sup>258</sup> Case T-434/07 *Volvo Trademark Holding AB v OHIM* [2009] ECR II-04415 para 50-53.

<sup>259</sup> OHIM Manual Concerning Opposition Part 2:3 (n 177) 5.

<sup>260</sup> *Sabel* (n 201) para 23.

#### 5.3.4.1. Signs to be compared

The signs should, if possible, be compared in the form in which they are protected. Parts of a sign that are considered to be non-distinctive, or smaller than other elements, should not be ignored when comparing the signs. The fact that some elements are dominant or distinctive should only be taken into consideration when performing the overall assessment if there exists a likelihood of confusion.<sup>261</sup> Only in special situations could negligible elements be omitted in the analysis of the signs.<sup>262</sup> The concept of negligible elements should be interpreted strictly, and it should only be in special cases that elements are considered too negligible and thus omitted from the comparison. This is for example when the element is not noticeable at first sight or is part of a complex sign and the relevant public is likely to disregard it.<sup>263</sup>

[I]t must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.<sup>264</sup>

In *IDEA*<sup>265</sup> the mark under consideration consisted of the word ‘idea’ positioned on a figurative element in the form of a grid. The distinctiveness of the expression ‘idea’, being part of the basic vocabulary of the English language, was considered to be low, while the distinctiveness of the figurative element was considered to be relatively high. Due to this the verbal element ‘idea’ was not considered to be dominant and in the subsequent comparison importance was given to both the verbal and figurative elements.<sup>266</sup>

#### 5.3.4.2. Visual comparison

A visual comparison could be called for when comparing a sign with a device mark, where the earlier mark contains pictorial elements. Visual similarity could also matter when comparing two word marks, as the word may be pronounced differently but are visually similar anyhow. When comparing word marks one would have to consider the fashion in which the marks are shown, and whether the relevant public are likely to retain a mental picture of the mark as such. Word marks could also have a specific design or font that could lead to visual similarities. The same could be hold true for the use of specific colours.<sup>267</sup>

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<sup>261</sup> OHIM Manual Concerning Opposition Part 2:3 (n 177) 5.

<sup>262</sup> *Limoncello* (n 201) paras 41-42.

<sup>263</sup> OHIM Manual Concerning Opposition Part 2:3 (n 177) 5-6.

<sup>264</sup> Case T-6/01 *Matratzen Concord v OHIM - Hukla Germany* [2002] ECR II-4335 para 33.

<sup>265</sup> *IDEA* (n 253).

<sup>266</sup> *ibid* paras 49-53.

<sup>267</sup> *Cohen Jehoram and van Nispen* (n 8) 276-77.

When it comes to consumer goods, product recognition is mostly visual, and by that reason the pictorial (visual) elements carry extra weight in these instances. Minor details and different words and headings may then be of minor importance, and the imperfect picture in the mind of the average consumer is the one that should be used in the comparison. The similarities are often more important than the differences, and it is the overall picture that matters and could be the one causing confusion.<sup>268</sup>

In *Olive Line*<sup>269</sup>, the figurative marks O-LIVE and OLIVE LINE were considered visually similar. Both marks had figurative elements alluding to olives, the product for which the marks were registered. The dissimilarities could not detract from the similarities, as the relevant public would focus on the word 'olive' discernable in both marks. The General Court thus held the two marks to be similar visually, although there being differences between the two marks.<sup>270</sup> This illustrates the fact that two trademarks can be considered similar, at least on a visual level, by reference only to the descriptive word they are consisting of.

#### 5.3.4.3. Aural comparison

Aural similarity between two marks could in some situations be enough for the signs to be considered similar, and it has been shown that this correspond well with practice where it has been shown that aural similarities play an important role. These cases could for example be when the trademark is mostly heard and forwarded orally.<sup>271</sup>

Figurative marks, without any word elements, does not usually provide for a good aural comparison. The aural comparison is mandatory when it comes to word marks or sound marks.<sup>272</sup>

The relevant public does play an important role here as well, as they may pronounce words differently.<sup>273</sup> There have been some cases giving a greater importance to the beginning of words, as well as to the first word where there are several, with the reasoning that the average consumer pay more attention to these.<sup>274</sup>

In *Olive Line*<sup>275</sup>, the marks were not only considered to be visually similar, but also similar aurally. This is often the case when word marks, or composite marks where the word element is prominent, are compared with one another. The fact that one mark was OLIVE LINE and the other O-LIVE did not make the marks any less similar phonetically, as the new mark O-LIVE comprised the dominant parts of the earlier mark in its entirety.<sup>276</sup>

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<sup>268</sup> *ibid* 276-77.

<sup>269</sup> *Olive Line* (n 6).

<sup>270</sup> *ibid* paras 79, 86, 89 and 92.

<sup>271</sup> Cohen Jehoram and van Nispen (n 8) 276.

<sup>272</sup> *ibid* 276.

<sup>273</sup> Michaels and Norris (n 7) 62.

<sup>274</sup> *cf* *ibid* 62.

<sup>275</sup> *Olive Line* (n 6).

<sup>276</sup> *ibid* para 95.



#### 5.3.4.4. Conceptual comparison

Conceptual similarities exist if the signs communicate the same or similar content. When it comes to word marks they can refer to exactly the same or similar thing. There could also be conceptual similarities between different kinds of marks, such as word marks and figurative marks, where the latter could depict the word used in the former.<sup>277</sup>

[I]t should be noted that the conceptual differences which distinguish the opposing marks may be such as to counteract to a large extent the visual and aural similarities between those marks. For there to be such a counteraction, however, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately and the other mark must have no such meaning or an entirely different meaning.<sup>278</sup>

An example of this can be seen in *Picasso/Picaro*<sup>279</sup>, where the two would not likely be confused, as Picasso is the name of a famous painter, and Picaro is only slightly similar conceptually and aurally.<sup>280</sup>

Signs containing descriptive elements are often similar conceptually to other signs containing the same or even similar descriptive elements. Companies tend to use similar laudatory terms, leading to conceptually similar signs. This was the case in *Tofuking*<sup>281</sup> and *Star Snacks/Star Foods*<sup>282</sup>. In *Tofuking* the marks TOFUKING and CURRY KING were considered to be similar, and especially similar conceptually, as both marks comprised words descriptive of the goods and services registered for (also being similar to one another), followed by the laudatory word 'king'.<sup>283</sup> In *Star Snacks/Star Foods* both marks, STAR SNACKS and STAR FOODS, referred to goods one could eat, as well as used the laudatory word 'star' as a prefix to imply the products' quality.<sup>284</sup>

#### 5.3.5. Distinctiveness

Distinctiveness of the earlier mark, as well as that of the components of the signs that are studied, is another factor to be considered when determining whether there is a likelihood of confusion.<sup>285</sup>

Distinctiveness has been described above, as it is a requisite to pass the absolute grounds for refusal.<sup>286</sup> Distinctiveness is a mark's possibility to act as an indication of origin and thus fulfilling its essential function as a trademark. In determining the

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<sup>277</sup> Cohen Jehoram and van Nispen (n 8) 277.

<sup>278</sup> Joined cases T-183/02 & T-184/02 *El Corte Inglés v OHIM* [2005] ECR II-965 para 93.

<sup>279</sup> *Picasso/Picaro* (n 229).

<sup>280</sup> *ibid* para 27.

<sup>281</sup> *Tofuking* (n 171).

<sup>282</sup> *Star Snacks/Star Foods* (n 170).

<sup>283</sup> *Tofuking* (n 171) paras 25, 39-40.

<sup>284</sup> *Star Snacks/Star Foods* (n 170) paras 25, 28-29.

<sup>285</sup> cf *Zero* (n 241) para 74; *Golden Eagle* (n 223) para 65.

<sup>286</sup> cf Community Trade Mark Regulation (n 9) Art 7(1)(b).

distinctive character of a mark the court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings.<sup>287</sup>

It is important to distinguish between the distinctiveness of the earlier mark as a whole and the distinctiveness that an element of a composite mark possesses. The distinctiveness of the earlier mark determines the protection afforded to that mark. The distinctiveness of an element of a composite mark determines its ability to dominate the overall impression created by the mark.<sup>288</sup>

The distinctiveness of the earlier mark is to be considered in the overall assessment of whether there exists a likelihood of confusion or not. The distinctiveness of the earlier mark should not be considered when determining whether two signs are similar. A low degree of distinctiveness of the earlier mark should not be taken into account at the stage of assessing the similarity of the signs.<sup>289</sup> If the low degree of distinctiveness was taken into account at this stage of the assessment, the overall distinctiveness would be given too much importance, and only cases of double identity would protect the mark from infringement.<sup>290</sup> A low degree of distinctiveness is only one factor to consider when determining whether there exists a likelihood of confusion, and may be offset by the similarity either between the signs or between the goods or services covered by sign.<sup>291</sup>

The more distinctive a mark is, the more protection should it be granted, and this should be considered in the overall assessment of a likelihood of confusion. The more distinctive the earlier mark, the greater will be the likelihood of confusion.<sup>292</sup>

For a mark to have more than average distinctiveness, it would be required to have enhanced distinctiveness due to the use made by the sign for the relevant goods or services.<sup>293</sup>

This thesis does not consider enhanced distinctiveness. It is only interesting to study the consequences that the distinctiveness of a mark's components has on the overall assessment of whether there is a likelihood of confusion. Descriptive indications are generally seen as devoid of distinctiveness.

#### *5.3.5.1. Distinctiveness of a mark's components*

When assessing the distinctiveness of an element of a composite mark, the same assessment of distinctiveness is done as of the mark as a whole. It is necessary to assess the greater or lesser capacity of that element of the mark to identify the goods or services for which the mark has been registered as coming from a particular

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<sup>287</sup> *Lloyd* (n 201) para 22.

<sup>288</sup> *Golden Eagle* (n 223) para 65; *Flexi Air* (n 208) order para 43.

<sup>289</sup> *Golden Eagle* (n 223) para 65.

<sup>290</sup> *Zero* (n 241) para 75.

<sup>291</sup> *ibid* para 74.

<sup>292</sup> *Sabel* (n 201) para 24.

<sup>293</sup> OHIM Manual Concerning Opposition Part 2:4 (n 136) 9.

undertaking.<sup>294</sup> The distinctiveness of a component matters as it determines the component's ability to dominate the overall impression created by the mark.<sup>295</sup>

A component of a mark may turn out to be descriptive, laudatory or otherwise devoid of distinctive character. Components that have little or no distinctiveness will sometimes be totally disregarded when assessing similarity between the signs. In the case of a total absence of distinctiveness the component will likely be disregarded, regardless of how much the component dominates the sign visually.

What constitutes the components of a mark is not clearly defined by the Court of Justice. The perception of the relevant public is the one that matters, and if they are considered to distinguish a component from the rest of the sign, then this should be considered as being a separate component.<sup>296</sup> All aspects of the mark should be analysed, including, *inter alia*, words, figurative elements and colours.<sup>297</sup>

In *Echinaid*<sup>298</sup>, the two marks ECHINAID and ECHINACIN shared the prefix 'echina-', referring to the plant 'echinacea' and thus describing the product for which the marks were registered. The shared prefix, due to its descriptive nature, was seen as devoid of distinctive character and was given no attention when determining the existence of a likelihood of confusion. Instead, only the endings, '-id' and '-cin' were compared, resulting in that no likelihood of confusion was found by the General Court.<sup>299</sup>

The court came to the opposite conclusion in *Olive Line*<sup>300</sup>, in which the two marks were considered to be similar, even though the coinciding word 'olive' was descriptive of the goods and services for which the marks were registered. The descriptiveness was not enough to render the word devoid of distinctiveness. The General Court held that the reason for why they treated this case differently from *Echinaid* was that the word 'olive' in *Olive Line* was highlighted in both marks by the use of pictorial elements suggestive as to olives.<sup>301</sup>

The main rule seems to be that descriptive elements should be disregarded when comparing signs. This rule can be put aside under certain circumstances, as for example when the descriptive element is accentuated by the rest of the elements of the mark.

### 5.3.5.2. Disclaimers

The concept of disclaimers has been dealt with above. The existence of disclaimers matters when determining whether two marks are similar. If a component of a sign is disclaimed, then that element is considered void of distinctiveness. There will be no

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<sup>294</sup> *Golden Eagle* (n 223) para 38.

<sup>295</sup> *Flexi Air* (n 208) order para 43.

<sup>296</sup> OHIM Manual Concerning Opposition Part 2:4 (n 136) 4.

<sup>297</sup> *ibid* 5.

<sup>298</sup> *Echinaid* (n 169).

<sup>299</sup> *ibid* para 55.

<sup>300</sup> *Olive Line* (n 6).

<sup>301</sup> *ibid* paras 85-86.

protection awarded to a sign in the specific case if the two signs only coincide with the disclaimed element.<sup>302</sup>

### 5.3.6. Dominant character

A complex trademark cannot be regarded as being similar to another trademark that is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.<sup>303</sup>

When determining whether a likelihood of confusion exists, the similarity between the two signs should be assessed by looking at the signs as a whole, but consideration could be taken to their distinctive and dominant components.<sup>304</sup> Only in some cases can two marks be regarded as similar when they only correspond in some of their elements, and only then if these elements can be considered as having a dominant character. Such an element must be likely to dominate, by itself, the image of that mark with the result that all other components of the mark are negligible within the overall impression created by the mark. It is only if all components of the mark are negligible that the dominant component alone can be assessed as to similarity.<sup>305</sup>

Consideration should be taken of the imperfect picture of the average consumer, as they often only remember the dominant and distinctive characteristics of a sign, justifying the fact that such characteristics are given more weight in some cases.<sup>306</sup>

What should be considered as a component is as stated above, any elements that would be singled out by the average consumer as a possible separate component.<sup>307</sup>

In *Limoncello Shaker*<sup>308</sup>, the General Court had to assess whether the two marks LIMONCHELO and LIMONCELLO, the latter being a figurative mark, were similar enough to cause a likelihood of confusion. The word ‘Limoncello’ was considered to be dominant in the opposed mark, even though it was argued that the word ‘Limoncello’ was descriptive, and even though there was a pictorial element taking up equally much space. The General Court held that the relevant public was, through their imperfect recollection of the mark, likely to confuse the two marks.<sup>309</sup> It is not clear cut what should be considered as the dominant element of a mark, but the finding that a descriptive indication is the dominant element could award the

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<sup>302</sup> OHIM Manual Concerning Opposition Part 2:4 13.

<sup>303</sup> *Matratzen Concord v OHIM - Hukla Germany* (n 264) para 33.

<sup>304</sup> *Sabel* (n 201) para 23.

<sup>305</sup> *Limoncello* (n 201) opinion of AG Kokott para 21.

<sup>306</sup> Case T-16/08 *Perfetti Van Melle SpA v OHIM* [2009] ECR II-00097 (Summary publication) 40.

<sup>307</sup> cf OHIM, *The Manual Concerning Opposition, Part 2: Identity and Likelihood of Confusion, Chapter 5: Dominant Character* (2012) 3.

<sup>308</sup> *Limoncello Shaker* (n 223).

<sup>309</sup> *ibid* paras 56-58.

descriptive indication more protection than if it should not have been considered as dominant within the mark.

### 5.3.6.1. *Assessing dominance*

When assessing dominant character of a component of a compound mark, account must be taken of the intrinsic qualities of the component compared with the others of that compound mark. Account should also be taken of the relative position of the various components within the arrangement of the compound mark.<sup>310</sup>

### 5.3.6.2. *Dominant character and distinctiveness*

As a general rule, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark, but there is nothing that stops such a non-distinctive element from being regarded as a dominant element. The weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them.<sup>311</sup>

In *Echinaid*<sup>312</sup>, the trademark registration of the word ECHINAID was opposed by the owner of the international word mark ECHINACIN. The shared prefix, ‘echina-’, refers to the plant ‘echinacea’, thus being descriptive for the goods or services applied for. Due to it being descriptive, the average consumer was deemed likely to pay attention to the endings of the mark rather than the prefix. The General Court, due to this line of reasoning, concluded that there was no likelihood of confusion in this case.<sup>313</sup>

In *Golden Eagle*<sup>314</sup>, the earlier mark, registered for different kinds of coffee, consisted of a device depicting a red coffee mug on a bed of coffee beans. The proprietor of the earlier mark opposed the registration of a figurative mark with the words GOLDEN EAGLE also depicting a red coffee mug on a bed of coffee beans. The General Court assessed there to be a slight similarity between the marks, thus creating a likelihood of confusion between the marks. The red coffee mug was not devoid of distinctiveness, it was only considered to be not highly distinctive and suggestive of the goods.<sup>315</sup>

In *Star Snacks/Star Foods*<sup>316</sup>, the words SNACKS and FOODS were considered to be descriptive of the goods and services the marks were registered for, and the word STAR was deemed laudatory, referring to products of high quality. Even though the

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<sup>310</sup> *Matratzen Concord v OHIM - Hukla Germany* (n 264) para 35.

<sup>311</sup> Case T-153/03 *Inex SA v OHIM* [2006] ECR II-01677 para 32.

<sup>312</sup> *Echinaid* (n 169).

<sup>313</sup> *ibid* para 55.

<sup>314</sup> *Golden Eagle* (n 223).

<sup>315</sup> *ibid* paras 44-45, 74.

<sup>316</sup> *Star Snacks/Star Foods* (n 170).

elements where descriptive and laudatory, the marks were considered to be similar by the General Court, leading to a likelihood of confusion.<sup>317</sup>

In *Tofuking*<sup>318</sup>, the General Court held two marks, TOFUKING and CURRY KING, to be similar, resulting in a likelihood of confusion, due to them both containing the same descriptive word KING. The Board of Appeal had earlier rejected the opposition with the same reasoning: that the only coinciding element between the two marks was the descriptive word KING, and thus no likelihood of confusion could exist between the marks.

Concerns have risen that this trend will continue, allowing proprietors to successfully oppose registrations on grounds of their descriptive elements. This would effectively grant monopolies over certain descriptive or laudatory indications, and chances to register new trademarks would grow slimmer.<sup>319</sup>

### 5.3.7. *Assessment of factors – a global assessment*

The courts would have to evaluate all aspects when determining whether there exists a likelihood of confusion or not. First, the factors would have to be examined. Then, their relevance would have to be decided and the different factors would have to be weighed against one another to enable the court to come to the conclusion that there exists a likelihood of confusion or not.<sup>320</sup> As seen above, several of the factors to be considered can have an effect on how descriptive indications are treated when establishing a likelihood of confusion.

## 5.4. *The scope of protection*

It has been established that in certain instances there could be a likelihood of confusion where the signs only coincide in a descriptive element,<sup>321</sup> and it is now important to determine what such a finding will result in. Once a likelihood of confusion has been established the outcome depends on whether it is an opposition proceeding or infringement proceeding.

### 5.4.1. *Opposition proceedings*

A successful opposition would prevent the registration of the new trademark.<sup>322</sup> Trademarks are granted protection not only against the use of identical signs, but also the use by third parties of similar signs under the circumstances described above. This

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<sup>317</sup> *ibid* paras 48-49, 52, 56.

<sup>318</sup> *Tofuking* (n 171).

<sup>319</sup> Hogan Lovells, Verena von Bomhard and Riccardo Raponi, 'Weak but lethal – olives, kings, and ayurveda: broad protection afforded to marks containing descriptive terms' Lexology <<http://www.lexology.com/library/detail.aspx?g=ee1ac4eb-b043-45a4-bbf6-b26302ba0b78>> accessed 7 May 2013.

<sup>320</sup> OHIM Manual Concerning Opposition Part 2:1 (n 163) 11.

<sup>321</sup> *cf Tofuking* (n 171); *Golden Eagle* (n 223); *Star Snacks/Star Foods* (n 170).

<sup>322</sup> Community Trade Mark Regulation (n 9) art 8.

could result in unmeritorious opposition proceedings where the proprietor of a trademark encompassing a descriptive indication could scare third parties not able to defend themselves because of financial means from registering a similar mark.<sup>323</sup>

#### 5.4.2. *Infringement proceedings*

Infringement proceedings prevent the use of a sign in the course of trade.<sup>324</sup> Infringement proceedings are used when an identical or similar sign is used without it being applied for registration.

The scope of application of Article 9 CTMR is thus wider than that of Article 8, as it acts to prevent the mere use of a similar sign. Limitations have been added to prevent an extensive use of infringement proceeding. Article 9 CTMR only prevents use in the course of trade, and Article 12 CTMR provides for several defences, such as the ability to use descriptive indications honestly in the course of trade.

##### 5.4.2.1. *Use in the course of trade*

A non-exhaustive list as to activities that are to be considered as *use in the course of trade* is presented in Article 9(2) CTMR:

The following, inter alia, may be prohibited under paragraph 1:

- (a) affixing the sign to the goods or to the packaging thereof;
- (b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under that sign;
- (d) using the sign on business papers and in advertising.

Use in the course of trade should be understood as use ‘in the context of commercial activity with a view to economic advantage and not as a private matter’.<sup>325</sup> If the use does not affect the essential function of trademarks, i.e. its function as an indication of origin, then it cannot be prevented.<sup>326</sup>

##### 5.4.2.2. *Defences*

There are limitations to the rights conferred by Article 9 CTMR listed in Article 12 CTMR, provided below.

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<sup>323</sup> cf Phillips (n 54) 399-400.

<sup>324</sup> Community Trade Mark Regulation (n 9) art 9.

<sup>325</sup> *Arsenal v Reed* (n 2) para 40.

<sup>326</sup> *Seville* (n 16) 276; *Gielen and von Bomhard* (n 3) 63.

A Community trade mark shall not entitle the proprietor to prohibit a third party from using in the course of trade:

- (a) his own name or address;
  - (b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;
  - (c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts,
- provided he uses them in accordance with honest practices in industrial or commercial matters.

Due to this provision, descriptive indications are allowed to be used honestly in the course of trade by anyone who desires to do so. It could be argued that this would solve many of the problems where descriptive indications are monopolised through trademarks, and that the risk that operators might appropriate certain signs which ought to remain available is neutralised by the limits imposed by Article 12.<sup>327</sup> One problem, observed by the Allensbach Study, is that non-distinctive indications are not included in Article 12.<sup>328</sup>

Article 12 seeks to reconcile the fundamental interests of trademark protection with those of free movement of goods in the common market in such a way that trademark rights are able to fulfil their essential role in the system of undistorted competition.<sup>329</sup> On the one hand the trademark system seeks to protect the essential function of trademarks, and on the other hand to promote need to keep certain signs free for all to use.<sup>330</sup>

It was initially thought that Article 12 CTMR did not confer the right to use descriptive indications as trademark, but merely to use them descriptively in accordance with honest practices in industrial and commercial matters.<sup>331</sup> This changed with *Kerry Spring*<sup>332</sup> in which the Court of Justice held the actual use of the descriptive indication did not matter.<sup>333</sup> In this case the proprietor of the earlier GERRI mark opposed the registration of the KERRY SPRING mark, where the latter was descriptive as of origin.

Instead, it is important to determine what constitutes ‘honest practices in industrial and commercial matters’. It is not in line with honest practices if the use of the sign creates the impression that a link exists between the parties.<sup>334</sup> This can be compared

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<sup>327</sup> cf *Libertel* (n 53) para 58.

<sup>328</sup> Allensbach Study (n 135) 121.

<sup>329</sup> Case C-100/02 *Gerolsteiner Brunnen GmbH & Co v Putsch GmbH* [2004] ECR I-00691 (*Kerry Spring*) para 16.

<sup>330</sup> Uche U. Ewelukwa, ‘Comparative Trademark Law: Fair Use Defense in the United States and Europe—The Changing Landscape of Trademark Law’ (2006) 13 *Widener Law Review* 97, 145.

<sup>331</sup> *Windsurfing Chiemsee* (n 12) para 28.

<sup>332</sup> *Kerry Spring* (n 329).

<sup>333</sup> *ibid* para 19.

<sup>334</sup> Allensbach Study (n 135) 123.



with the definition of a likelihood of confusion, which is the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings.<sup>335</sup> The Court of Justice has held that the existence of a likelihood of confusion does not necessarily mean that the use is in breach of honest practices,<sup>336</sup> but it is not difficult to understand that it can be difficult in practice to draw a line between the two. Instead, it is necessary to see whether the use of the sign is against honest practices, and the amount of allowed use becomes a question of degree. The courts must carry out an overall assessment of all the relevant circumstances to determine whether the defendant has engaged in unfair competition or acts in accordance with honest practices.<sup>337</sup>

It is also feared that this approach is liable to shift the balance of power in favour of a trademark owner with monopolistic ambitions who may assert, or threaten to assert, his rights against an alleged ‘infringer’ who merely seeks to use descriptive terms descriptively and honestly.<sup>338</sup> A fully functioning fair use defence could enhance the trademark system, by which it becomes impossible to monopolise descriptive indications that others have an interest in using. However, if the fair use defence is defined too narrowly it could have implications on consumers and competitors, as it does not award an appropriate level of protection to the free use of descriptive indications.<sup>339</sup>

A trademark owner wishing to monopolise not only his trademark, but the area around it, may threaten unmeritorious proceedings against a competitor, who may capitulate rather than incur the costs of litigation as well as risk an adverse outcome.<sup>340</sup>

It must be a stringent and full examination, in order to prevent trademarks from being improperly registered. For reasons of legal certainty and good administration, it is necessary to ensure that trade marks whose use could successfully be challenged before the courts are not registered to begin with.<sup>341</sup>

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<sup>335</sup> *Canon* (n 201) para 29.

<sup>336</sup> *Kerry Spring* (n 329) para 25.

<sup>337</sup> *ibid* paras 24-26; Ewelukwa (n 330) 137-38, 145, 147-48.

<sup>338</sup> *Doublemint* (n 117) Opinion of AG Jacobs para 94.

<sup>339</sup> Ewelukwa (n 330) 167.

<sup>340</sup> *Doublemint* (n 117) Opinion of AG Jacobs para 95.

<sup>341</sup> *Libertel* (n 53) para 59.

## *6. Proposal for amending the Community Trade Mark Regulation*

On the 27<sup>th</sup> of March 2013 came a proposal from the European Commission on amending the Community Trade Mark Regulation.<sup>342</sup> It was partly based on the Allensbach Study already mentioned in the thesis, in which it was concluded that the Community Trade Mark system, seen as a whole, is solid. Nevertheless, some further convergence of trademark laws and practices in the EU was required.<sup>343</sup>

Changes are proposed, of which some would affect the way in which descriptive indications are treated, thus justifying this chapter in the thesis in which these changes will be examined. These changes include a clarification of the origin function's role when determining double identity or the existence of a likelihood of confusion, as well as clarifications regarding Article 12 CTMR.

In the proposal it is clarified that in cases of both double identity under Article 9(1)(a) and similarity under Article 9(1)(b) it is only the origin function that matters.<sup>344</sup> That is, protection should be granted to a mark when the essential function of trademarks, i.e. its function as an indication of origin, is adversely affected.<sup>345</sup>

The reason for including such a clarification is probably to clarify that the essential function also applies to cases of double identity. The courts ruling on trademark infringements and oppositions should not assume that the origin function is adversely affected just because double identity is established.

When it comes to Article 12 CTMR, the Commission's proposal suggests that the Article should include non-distinctive indications alongside the descriptive indications already covered by the Article.<sup>346</sup> They also propose that a clarification of what constitutes honest practices is added in a new Article 12(2) CTMR, stating that the use by a third party shall be considered not to be in accordance with honest practices if it gives the impression that there is a commercial connection between the third party and the proprietor of the trade mark.<sup>347</sup>

This would lead to a codification of case law from the Court of Justice, but would not bring us any closer to understand the relationship between the existence of a likelihood of confusion and the existence of an impression that there is a commercial connection between two separate businesses.

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<sup>342</sup> Proposal for a Regulation of the European Parliament and of the Council Amending Council Regulation (EC) No 207/2009 on the Community Trade Mark [2013] COM(2013) 161 (Commission Proposal).

<sup>343</sup> *ibid* 3.

<sup>344</sup> *ibid* 8.

<sup>345</sup> *ibid* 15<sup>th</sup> recital.

<sup>346</sup> *ibid* 21<sup>st</sup> recital.

<sup>347</sup> *ibid* art 12(2)(a).

## 7. Analysis

[I]n the practical world powerful traders will naturally assert their rights even in marginal cases. By granting registration of a semi-descriptive or indeed a nearly-but-not-quite-completely descriptive mark one is placing a powerful weapon in powerful hands. [...] With such words or phrases the line between trade mark and descriptive use is not always sharp. Moreover, it must not be forgotten that the monopoly extends to confusingly similar marks. In any marginal case defendants, [small and medium-sized enterprises] particularly, are likely to back off when they receive a letter before action. It is cheaper and more certain to do that than stand and fight, even if in principle they have a defence.<sup>348</sup>

This thesis has posed the questions whether descriptive or non-distinctive indications can be registered as part of trademarks, and, if so, could the proprietor of such a trademark prevent others from using the indication. To sum up: yes, it is possible to register a descriptive indication as part of a trademark, and yes, it is possible to use such a trademark to exclude others from registering that same descriptive indication.

The possibility to register descriptive or non-distinctive indications is determined by Article 7 CTMR, and a mark would have to pass the absolute grounds for refusal to be registrable. The most important grounds for refusal when it comes to descriptive or non-distinctive signs are Articles 7(1)(b) - (c) CTMR in which the registration of signs devoid of distinctive character and signs consisting exclusively of descriptive indications are prevented. There are two underlying public interests of these provisions. Non-distinctive marks are precluded from registration, as the essential function of trademarks would otherwise be harmed; the registration of a sign that is not seen as a trademark by the relevant public could not act as an indication of origin. Descriptive indications, on the other hand, are precluded from registration due to a need to keep certain signs free for all to use. It is feared that the registration of such descriptive indications would result in the monopolisation of the public domain.

However, the absolute grounds for refusal only prohibit the registration of descriptive and non-distinctive signs as long as they are *exclusively* descriptive and *devoid* of distinctive character. Descriptive words are prevented from being registered when isolated, but the addition of other elements could make the word registrable as part of a composite or compound mark. As long as elements are added so that the sign, when seen as a whole, is not considered as exclusively descriptive or devoid of distinctiveness, then the sign can be registered. The need to keep free can thus be trumped by acquired distinctiveness by adding additional distinctive or non-distinctive elements. Thus, to register a descriptive word, one would only have to add other elements. These elements could in turn be descriptive, distinctive or non-distinctive, as long as the mark seen as a whole is distinctive and non-descriptive.

Descriptive indications can thus be registered as an element of a mark. The question that follows is whether such descriptive indications are awarded any protection?

The scope of protection awarded to trademarks can be divided into the right to oppose registrations through opposition proceedings and the right to oppose use of a similar

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<sup>348</sup> *Nichols Plc's Trade Mark Application* [2003] ETRM 15, [2003] RPC 16 [14] (Jacob J).

sign through infringement proceedings. These proceedings can be initiated in cases of double identity or when there is a likelihood of confusion. It is the latter that has been interesting to study, from the point of view of this thesis, as it allows the proprietor of a mark to prohibit others from using similar signs.

When determining the existence of a likelihood of confusion, several factors should be considered, all of which could affect how descriptive indications are treated. There have been several rulings from the General Court in which descriptive elements have been given different degrees of protection. In *Echinaid*, the common descriptive element 'echina' was left out of the analysis made by the court, and no likelihood of confusion was found, as this descriptive element was the only visual similarity between the marks. In *Golden Eagle*, the registration of a picture of a cup of coffee was awarded protection, and the registration of a mark containing a similar picture was successfully opposed. In *Star Snacks/Star Foods* the coinciding element 'star' was seen as laudatory and describing the quality of the product, but was still given importance and a likelihood of confusion between the two marks was found. The same happened in *Tofuking* in which the proprietor of the word mark CURRY KING successfully opposed the registration of the word mark TOFUKING due to the similarity of the two signs as they both used the word 'king'. The word 'king' was, similar to the assessment in *Star Snack/Star Foods*, considered to be laudatory as it describes the good quality of the products. In some of these cases the Board of Appeal had come to a different conclusion.

The results of the proceedings depends on whether it was an opposition or infringement proceeding. The former results in a trademark being prevented from registration. In the latter the trademark proprietor could prevent the use of a sign, but in these cases the defendant could invoke several defences. The defendant is allowed to use descriptive indications as long as the use is in accordance with honest practices. The new Commission Proposal has dealt with what should be considered as honest practices, and stated that use of a sign shall not be considered to be in accordance with honest practices if it gives the impression that there is a commercial connection between the defendant and the proprietor.

Not all infringements in which there is a likelihood of confusion are also in breach of honest practices. However, the similar concepts would likely result in that many cases, in which confusion is established, the descriptive use defence cannot be utilized.

It is thus possible to register descriptive indications and later prevent others from using the same descriptive indications, either through infringement or opposition proceedings.

There exists an incentive for businesses to choose descriptive marks for their goods. If they are successful in registering such descriptive marks, and if they are successful in prohibiting others from using the descriptive indications, it places the registrant's competitors at a disadvantage in marketing their similar goods as they cannot forward descriptive information as easily. Furthermore, consumers experience greater difficulty in obtaining the information necessary to make optimal purchasing decisions.

A trademark proprietor may also threaten unmeritorious proceedings against competitors wishing to use descriptive indications that are part of the proprietor's trademark. The competitors may yield rather than paying the costs related to such an infringement proceeding as well as risk an adverse outcome.

One could argue that any negative effects are lessened by Article 12 CTMR, as this provision permits the use of descriptive marks in the course of trade. This is only true to a certain extent, as the applicability of Article 12 in cases concerning a likelihood of confusion is still somewhat unclear. This would also transfer the review from OHIM during registration to the courts judging infringements.

It is thus better to bar descriptive trademarks from registration at an early stage. This would reduce the risk that such trademarks are used against defendants that do not have the will and necessary means to defend such an unmeritorious trademark infringement action. Such extortion would also have the effect of broadening the scope of trademark protection. In a dispute where Article 12 CTMR is relied on, the proprietor of the earlier trademark will always enjoy an advantage.

Another negative effect with allowing a too broad protection to descriptive indications is that it would effectively reduce chances to register new trademarks. The possibility for traders to monopolise terms that may serve to designate a product's characteristics would grant him an unfair advantage over competitors who have an interest in using such descriptive terms. Competitors could be disadvantaged, and in some cases even prevented, from entering the market at all.

Establishing a likelihood of confusion can be seen as somewhat arbitrary; sometimes granting protection to descriptive indications, sometimes disregarding them entirely. The scope of protection awarded to trademarks and descriptive indications is still unclear, making it difficult to predict the outcome in litigation. This uncertainty negatively affects those businesses already having a trademark, as well as those desirous of registering one.

The likelihood of confusion test can be seen as complicated and is possibly in a need for restructuring and revising to better fit the underlying interests of trademark law and trademark protection. The legislator would have to balance several public interests, such as the need to ensure the origin function and distinctiveness of trademarks, safeguarding the investments made by proprietors into their trademarks, as well as preventing non-distinctive signs from being registered and used to distort competition.

Today the courts seem to focus on the protection of consumers from confusion as of origin, by prohibiting the use of similar signs, even in instances in which similar signs only coincide in descriptive indications. Other interests, such as keeping descriptive signs free, are disregarded. It can be questioned whether such actions are justified by public interests. Clearly descriptive indications such as the name of the product will not be regarded as an element possible of causing a likelihood of confusion. However, the monopolisation of descriptive indications such as laudatory terms is to some extent possible. A company desirous of monopolising a descriptive indication could, for example, add elements that enhance the descriptive indication, as was the case in *Olive Line*.

So, what could be done? One proposed solution is a more extensive use of disclaimers, in which it would be stated that no protection is granted to a disclaimed element in case of infringement or opposition proceedings.

As stated earlier in the thesis, the problem with disclaimers is that OHIM has requested very few of them in its practice. Furthermore, not all Member States use them in their national trademark systems, creating a discrepancy between those marks burdened with a disclaimer and those that are not. The use of disclaimers also fails to take into consideration distinctiveness acquired through use, and only those trademarks without a disclaimed element could then benefit from this.

Another solution was put forward in the Allensbach Study in which it was proposed that it should be set out in the Preamble of the CTMR that a finding of a likelihood of confusion cannot be based on elements which are descriptive or devoid of distinctive character, rendering the use of disclaimers pointless. This is a more preferable solution as case law would become coherent in the matter, as well as the fact that an undertaking could not monopolise descriptive indications.

A third solution would be to wait for clearer guidance from the Court of Justice on how to treat distinctive indications that are part of trademarks. This would also solve the problem with incoherent case law from the lower courts. Today, it seems as the lower courts are not completely sure as to what extent they should grant protection to descriptive indications, nor how the indications should be treated when analysing the similarities of marks. This is also the case when establishing a likelihood of confusion. Consequently, descriptive indications are sometimes given too broad protection; protection that should be more or less limited to facilitate other interests.

Limiting the protection of partly descriptive marks would possibly have another consequence, namely the emergence of more creative and imaginative marks by which undertakings can indicate business origin. The protection of non-distinctive descriptive elements is unnecessary, and it is proven that descriptive marks are not needed for success on today's market. Some of the most successful trademarks of our time are inventive and original, and not at all descriptive. Everyone should be allowed to use descriptive indications, but for their actual and inherent purpose – to describe.

Extensive trademark monopolies should only be granted protection if they can be justified on the basis of public policy. It should not be possible to monopolise descriptive indications, nor should businesses be able to use them unreasonably to confuse consumers as to business origin. Currently, the protection of consumers from confusion is given precedence. This protection, as it is executed now, does not provide such a public policy justification. Trademarks should get the protection they deserve, not more, nor less.

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