

# BRANDS UPDATE

A PERIODICAL UPDATE ON DEVELOPMENTS IN EUROPEAN TRADE MARK LAW AND PRACTICE

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## INTRODUCTION

There are two ways to obtain registered trade mark protection in the EU. An applicant can apply either to the national trade mark registries for separate national trade mark registrations enforceable in each EU Member State ("the national system") or to the Community Trade Mark Office (OHIM) for a single Community trade mark registration enforceable throughout the EU ("the Community system").

Although there are two systems, the legislative framework governing both systems has to a large extent been harmonised by virtue of the EU Trade Marks Directive ("the Directive") and the EU Trade Marks Regulation ("the Regulation"). The EU Trade Marks Directive has harmonised the differences between the national trade mark laws of the EU Member States and the threshold harmonisation provisions of the Directive are reflected in the provisions of the Regulation which governs the Community system.

At the centre of both systems is the ECJ. This is the Community court which hears references from the national courts on the interpretation of the Directive and the Regulation and also appeals from OHIM on the interpretation of the Regulation. The fact that the basic law governing both the national system and the Community system is the same means that regardless of the origin of a case before the ECJ (i.e., whether it is a reference from a national court or an appeal from OHIM), ECJ decisions are applicable to both regimes.

In this Brands Update, we concentrate on some of the recent decisions which have been handed down by the ECJ and the impact which those decisions are having on the way in which the national trade mark laws are being interpreted by the national courts of the EU Member States.

## Recent ECJ/CFI Decisions

### Registrability

#### *Descriptive Marks – BABY-DRY*

**Background:** The issue on this appeal from OHIM was whether the word BABY-DRY was registrable as a Community trade mark as being distinctive for nappies.

**Decision:** The ECJ held that:

- The provisions of the Directive only prevented the registration as trade marks of signs or indications which because they were no different from the usual way of designating the relevant goods and services or their characteristics could not fulfil the function of identifying the undertaking that markets them and were thus devoid of the distinctive character needed for that function. Thus, the provisions of the Directive were intended only to prevent registration of those signs which served in normal usage from a consumer's point of view to designate, either directly or by reference to one of the essential characteristics, goods or services such as those in respect of which registration was sought.
- A mark should be refused registration unless it comprised no other signs and, in addition, the purely descriptive signs of which it was composed were presented or configured in a manner that distinguished the resultant whole from the usual way of designating the goods or services or their essential characteristics.
- Marks composed of two words had to be considered as a whole. A perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics was apt to confer distinctive character on the word combination.
- In this instance, an English-speaking consumer when considering the words BABY-DRY in relation to nappies would consider that the combination of words did not refer to the function of the goods; the unusual juxtaposition of the two words not being familiar in the English language.
- Therefore the application as a whole should not have been refused registration.

**Commentary:** BABY-DRY is notable in its own right because it is the first appeal to reach the ECJ from OHIM. It is also an extremely important decision because it appears to have set a very low threshold for the registrability of marks in Europe. Indeed, the threshold is so low that it has already started to be called into question not only by the national courts but also by the ECJ (in the guise of the Advocate-General) itself.

Thus, in the pending ECJ appeal in the *Koninklijke v Benelux Merkenbureau* case (or "Postkantoor" (post office) case), the Advocate-General has pointed out the inconsistency between the reasoning in BABY-DRY and the previous ECJ decision in the *Windsurfing Chiemsee* case. In particular, he raised the issue of the relevance of the protection of the public interest in the determination of the registrability of a mark.

More recently, in the UK in the *Nichols* case, Mr Justice Jacob, in the course of referring the case to the ECJ, commented that he was surprised by the approach taken by the ECJ in BABY-DRY and in particular, the need to have regard to potential defences when determining the registrability of a mark.

It is clear from the judicial pronouncements made in both the *Postkantoor* and *Nicholls* cases that this is an issue which still has a long way to run.

### *3-Dimensional Marks – Philips v Remington*

**Background:** The case itself involved Philips' trade mark registration which depicted the face of a 3-headed rotary shaver with circular blade heads arranged in an equilateral triangle registered in class 8 for shavers. Philips had sued Remington for trade mark infringement and Remington had in turn counterclaimed for revocation of Philips' trade mark. The English Court of Appeal had provisionally concluded that the mark was invalid but referred a number of questions on the meaning of certain provisions of the Directive to the ECJ.

**Decision:** The ECJ held that:

- There was no class of marks which even though they had acquired distinctive character were not capable of distinguishing goods or services and therefore were not registrable.
- The assessment of registrability of shape marks was made on the same basis as for any other type of mark. The argument that capricious addition, such as an embellishment which had no functional purpose, was necessary in order for a shape mark to be registrable was rejected.
- If a shape mark fell foul of one of the absolute grounds of refusal specific to shape marks (e.g., signs which consist exclusively of the shape of goods which is necessary to obtain a technical result), its registrability could not be saved on the ground that it had nevertheless acquired distinctive character through use.
- Subject to a shape mark being refused registration on one of the absolute grounds of refusal specific to shape marks, if a trader had been the only supplier of particular goods to the market, extensive use of a sign which consists of the shape of those goods might give the sign a distinctive character sufficient for registration in circumstances where, as a result of that use, a substantial proportion of the relevant class of persons associated that shape with that trader and no other. However, it was for the national courts to decide whether the identification by the relevant class of persons of the product as originating from the particular undertaking resulted from use of the mark as a trade mark.
- In relation to the absolute ground of refusal specific to shape marks that signs which consisted of shapes "necessary to obtain a technical result" were unregistrable, there was a risk that the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function, or at least limit their freedom of choice in regard to the technical solution they wished to adopt in order to incorporate such a function in their product. Accordingly, where the essential functional characteristics of the shape of a product were attributable solely to the technical result, registration of a sign consisting of that shape was precluded, even if that technical result could be achieved by other shapes.

**Commentary:** The crux of the ECJ decision was the finding that if the essential functional characteristics of the shape of a product were attributable solely to the technical result to be obtained then the shape was not registrable i.e., it was irrelevant that other shapes could achieve the same technical result. Given the findings of fact made by the first instance court, the effect of the ECJ decision was to uphold the provisional Judgment of the Court of Appeal declaring Philips trade mark invalid.

In many cases, a shape mark will not be caught by the "necessary to obtain a technical result" exclusion or the other absolute grounds of refusal specific to shape marks. In those cases, the effect of the ECJ decision is to place the onus on the brand owner to demonstrate that the public do in fact perceive the shape as a trade mark in order to obtain the registration of the shape mark. This issue is in fact the subject of the pending appeal to the ECJ in the *Mag Instruments v OHIM* case which concerns the registrability as a mark of the shape of the Maglite torch.

## Infringement

### *Use as a Trade Mark – Arsenal v Reed*

**Background:** The case itself involved various Arsenal Football Club trade marks including ARSENAL, GUNNERS, a crest device and a cannon device, registered in many different classes (the “Marks”). Arsenal had alleged infringement of these marks by the sale of merchandise bearing their marks by Mr Reed, a street trader. The English Court held that there was no infringement (or passing off) because trade mark use was a pre-condition to a finding of infringement and Mr Reed’s use of the marks on the merchandise was not use of the mark as a trade mark because the use was not indicative of trade origin, being rather as a badge of support, loyalty or affiliation.

**Decision:** The ECJ decision itself has not yet been handed down. However, the Advocate-General has rendered his opinion.

In essence, the Advocate-General’s view was that (a) use of a sign as a trade mark is a pre-condition to a finding of infringement but (b) where there is use for commercial purposes of an identical sign to a registered trade mark on identical goods/services, there is a presumption that such use is “as a trade mark.”

He particularly emphasised that where unauthorised third parties commercially exploit a trade mark that has been registered by football clubs say for the purpose of merchandising i.e., marketing articles of clothing connected to the team, the proprietor of the registration is entitled to prevent such use. He went on to state that the reasons for the consumer purchasing such merchandise was an irrelevant consideration. The decisive factor was that the persons for whom they were intended acquired or used them because they incorporated the distinctive sign not merely because they believed they were the club’s official merchandise.

**Commentary:** The outcome of this decision obviously has important implications for merchandising in the sports, music and fashion industries whose ability to police counterfeit merchandising has been brought into question since the English Court’s decision.

### *Use of an Identical Sign – LTJ Diffusion v Sadas*

**Background:** This case involved a figurative mark for the word ARTHUR written in a distinctive, handwritten form with a dot below the initial “A”. LTJ Diffusion brought an infringement action against SADAS for use of ARTHUR ET FÉLICIE which did not reproduce the handwritten form of LTJ Diffusion’s mark.

**Decision:** The ECJ decision has not yet been handed down. The Advocate-General has however rendered his opinion.

In essence, the Advocate-General said that the national court should first identify what it is that is perceived by the average reasonably well informed observant and circumspect consumer as the relevant marks then perform a global assessment of the visual aural and conceptual features of the marks in question in order to determine whether the two are likely to be perceived as the same or merely similar. He goes on to say that two marks will be identical where in the light of such an assessment any differences are minute and wholly insignificant.

By way of example, the Advocate-General suggested that reproduction of LTF Diffusion’s mark in the same distinctive script but without the dot under the initial “A” might be perceived by the average consumer as identical to the original (the change being minute and wholly insignificant). However, the use of a noticeably different script and/or the addition of another name might be seen as only similar (such changes, at least taken together, being substantial).

**Commentary:** This is an important issue in many trade mark conflict and infringement actions as it determines whether it is necessary to show confusion in order to establish a conflict or infringement: if the mark and sign are identical there is no necessity; if they are not identical, there is. Guidance on the issue is to be welcomed not least because of the effect of the apparently different approaches to this issue taken by the registries and the national courts in the various EU Member States.

*Exhaustion (Consent) – Davidoff v A & G Imports and Levi Strauss v Tesco*

**Background:** The Directive provides that a registered trade mark proprietor is entitled to prevent third parties from using the mark in the course of trade without the proprietor's consent. This includes the importation of goods bearing the registered mark. It also states, on the other hand, that this right may not be exercised in relation to goods bearing the mark which have already been put on the market within the EEA by the proprietor, or with the proprietor's consent. In such circumstances the proprietor's rights are said to be exhausted.

The cases of Davidoff and Levi Strauss concerned the question of whether exhaustion of trade mark rights within the EEA can result from the placing of goods on the market by the proprietor, or with the proprietor's consent, outside the EEA. In other words, the cases examined the circumstances in which the placing of goods on the market outside the EEA can be said to amount to implied consent for the subsequent marketing of those goods within the EEA.

Davidoff and Levi Strauss had both placed trade marked goods on the market outside the EEA. It was their intention that these goods should remain outside the EEA. To this end, Davidoff imposed contractual obligations on its distributors not to sell the goods within the EEA and that they should impose the same obligation on all sub-distributors. Levi Strauss, in contrast, did not seek to impose any contractual restriction relating to resale. Instead, it notified its authorised retailers both orally and in writing that goods should only be sold to end-purchasers whilst its authorised wholesalers were instructed that goods should not be sold for export.

**Decision:** The ECJ held that before consent to marketing within the EEA could be inferred from the proprietor's behaviour it was necessary that the proprietor had unequivocally demonstrated an intention to renounce his trade mark rights. As such, although intention to renounce the rights might be either express or implied, it cannot be inferred from mere silence on behalf of the proprietor. The fact that a trade mark proprietor has not communicated his opposition to subsequent marketing within the EEA to first purchasers, or imposed contractual restrictions, is therefore not relevant and does not amount to implied consent. Similarly, it is irrelevant whether or not such objections have been conveyed to subsequent purchasers or that they have knowledge of the same.

**Commentary:** The clear thrust of these decisions is that in reality only the express consent of the trade mark proprietor will suffice to permit the parallel importation of trade marked goods into the EU.

Following the ECJ ruling, the English High Court has recently entered summary Judgment for Levi Strauss despite Tesco's raising various arguments based on the incompatibility of the effects of the ECJ ruling both with existing Community trade mark law and also on Tesco's human rights under the European Convention on Human Rights.

## **Opposition Procedure**

*Failure to File a Translation of Evidence - Chef Revival v Marin*

**Background:** The application by Chef Revival USA Inc to register a figurative mark consisting of the words CHEF REVIVAL had been opposed by Joachin Massague Marin on

the basis of an earlier Spanish registration for a figurative mark consisting of the word CHEFF. The language of the opposition proceedings became English.

OHIM asked Marin (pursuant to Rules 16(3), 17(2) and 20(2) of the Implementing Regulations) to present the evidence and arguments to be relied upon in support of the opposition including in particular a copy of the registration certificate of the mark on which the opposition was based. OHIM also asked for translations of the evidence and arguments to be presented in the language of the proceedings within 2 months. Marin filed a copy of the Spanish registration certificate but failed within the 2 month period to file an English translation.

The Opposition Division rejected the opposition on the ground that the opponent had failed to prove the existence of the earlier trade mark on which the opposition was based. Marin appealed to the Board of Appeal. The Board of Appeal allowed the appeal primarily on the ground that (pursuant to Rule 18(2)) the failure to file the translation of the Spanish registration certificate was a deficiency the existence of which OHIM was obliged to notify to the opponent and call upon him to remedy within 2 months. Chef Revival appealed to the CFI. Before the CFI, Marin did not intervene and OHIM contended that the decision of the Opposition Division was correct and the appeal should be allowed.

**Decision:** The CFI held that:

- If the opponent fails to file the evidence in support of the opposition and a translation of it into the language of the opposition within such period as originally specified by OHIM or any extension thereto then OHIM may decide the opposition on the basis of the evidence (or lack of it) before it.
- The translation of the Spanish registration certificate was a matter of evidence and there was therefore no requirement on OHIM under Rule 18(2) to allow a party a further period in which to rectify the deficiency.
- Accordingly, Marin's failure within the specified 2 month period to submit a translation of the Spanish registration certificate nor request an extension of time justified the Opposition Division in rejecting the Opposition.

**Commentary:** As Marin did not appear in the appeal and both of the other parties argued against the decision of the Board of Appeal, this decision is effectively a final one.

The decision is of particular interest because OHIM itself argued for its own Board of Appeal's decision to be overturned.

It is also important to note that the CFI expressly left open the issue as to whether and if so, in what circumstances, OHIM should take into account evidence and arguments submitted after any specified time limit i.e., grant retrospective time limits – the likely situation in most cases.

## **Pending ECJ and CFI Appeals**

### **Pending ECJ Appeals**

As an aide memoire, we have set out in the annex a brief description of each of the pending references to the ECJ from the national courts and appeals from the CFI to the ECJ.

## Pending CFI Appeals

In our last update we included a table describing the pending appeals from OHIM to the CFI. OHIM itself has now made this information available on-line. It can be accessed at <http://oami.eu.int>

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## NATIONAL TRADE MARK LAW AND PRACTICE

### Benelux

*Non-Origin Association – Benelux amends its Trade Mark Act so as to conform with recent ECJ Judgments*

Trade mark law in Belgium, The Netherlands and Luxembourg (“Benelux”) is governed by the Uniform Benelux Trademark Act (“BTA”). Recently, the Committee of Secretaries of the Benelux Economic Union adopted the Draft Protocol Amending the BTA. Although national ratification procedures will have to be carried out before the Protocol takes effect, it is expected that the proposed amendments to the BTA will have entered into force by the end of 2003. The Protocol will result in at least three major changes to the BTA.

Firstly, the BTA will be aligned with the Directive with regard to the concept of requiring confusion as to origin as opposed to mere non-origin association as a ground for trade mark infringement. Article 13A BTA currently provides that a trade mark can be infringed by the mere association in the minds of the public between a registered mark and a sign. This is in accordance with long established case law of the Benelux Court of Justice that a risk of actual direct or indirect confusion as to origin is not necessary. When the Directive was first incorporated into the BTA in 1992, the Benelux governments were of the opinion that this provision would not have to be amended because it would be a feature of the law under the Directive. A number of courts in the Benelux followed that position, but the issue remained unclear until the European Court of Justice ruled in *Sabel BV v Puma AG*, 11 November 1997, that the standard under the Directive was likelihood of confusion only. The Benelux Court of Justice decided in *Brouwerij Haacht NV v Grandes Sources Belges NV*, 2 October 2000, that the BTA should be interpreted to have likelihood of confusion only as the test for infringements committed after 31 December 1992, the date on which the Directive should have been implemented into national law. The proposed amendment therefore serves to bring the text of the BTA into conformity with the Directive.

Secondly, the BTA will be amended to alter the date upon which the right to commence proceedings for infringement is conferred on the rights holder. Currently Benelux law provides that the right vests in the applicant at the time of filing the application. This will now be changed so that the right vests on the date of registration of the mark, as in most of the EU. The result will be that it will no longer be possible to bring pre-grant proceedings for infringement, a practice that is currently common in Benelux. It will however be possible to apply for an “accelerated registration procedure”. This will be useful if the mark needs to be enforced quickly although such an accelerated registration would be revoked following the later outcome of any successful opposition proceedings. In any event, it will be possible to claim reasonable damages for infringements that took place between the date of publication of the application and the registration of the mark.

Thirdly, an opposition procedure will be introduced into the BTA to allow third parties to oppose applications on relative grounds in the same way as much of the rest of the EU. Currently the Benelux Trademark Office is only permitted to refuse applications on absolute grounds, e.g. when a sign is not at all distinctive. The new opposition procedure will therefore enable proceedings to be brought in the Benelux Trademark Office by proprietors of prior registered or filed marks against published applications for identical or confusingly similar marks. In the event that the Benelux Trademark Office refuses to register a mark as the result of such an opposition the applicant will be entitled to appeal to the Court of Appeals in The Hague, Brussels or Luxembourg.

## France

### *Revocation of Generic Marks – Pina Colada*

A trade mark that has become the generic designation of a product or service prevents the public from distinguishing it from other products or services offered by competitors.

In compliance with the Directive, Article L. 714-6 of the French Intellectual Property Code states that: "The owner of a trade mark shall be liable for revocation of his rights if, in consequence of his own acts, the trade mark has become (a) the common name in the trade for a product or service (...)" in respect of which the trade mark is registered.

To date, this ground for revocation has rarely proved successful: in cases concerning the trade marks LYCRA, BIC, CADDIE, FRIGIDAIRE and CELLOPHANE, revocation was refused by the French Courts.

However, on 19 October 2001, the Paris Court of Appeals rendered a decision revoking the trade mark PINA COLADA on the basis that the sign had become the generic appellation of a cocktail and had consequently lost its distinctiveness.

This exceptional decision was heavily influenced by two aspects of the trade mark owner's behaviour. First, he had been considered to be completely passive with respect to the generic use of his trade mark to designate a cocktail made of alcohol and fruit juice. For instance, he had never reacted against the use of his trade mark for in soundtracks, recipe books, on web sites dedicated to cocktails, in bar menus, etc. Second, he had made no effort to educate the public about his ownership of the mark in order to thereby minimise any possible confusion.

The outcome of this case provides trade mark owners with a useful lesson in the consequences of failing to police the proper use of their marks.

## Germany

### *Bundespatentgericht questions pure colour trade mark – The ECJ reference in the Heidelberger Bauchemie case*

Pure colour trade marks have been a very hot issue within the trade mark world in the last few years. The communicative impact of a colour is an important part of the public appearance of a business. Everybody knows that BP is green and Shell yellow/red. The approach of the trade mark examiners in the countries of the European Union has been very different. Whereas France and The Netherlands have been quite positive, Germany has been reluctant at least initially. However, in December 1998 the German Supreme Court decided that pure colours could become trade marks but did not decide about the requirements. In later decisions, the Supreme Court made it clear that the measure for pure colour trade marks should not be different than for word or design marks.

This liberal German approach is now at stake. The 33rd Senate of the German Bundespatentgericht has asked the European Court of Justice to decide whether a pure colour trade mark is registrable in accordance with the European Community Trademark Directive. The Court that has made the reference to the ECJ disagrees with the decisions of the Supreme Court and also other Senates of the Bundespatentgericht. It is of the opinion that pure colour trade marks are too abstract to be graphically representable as trade marks.

## **Sweden**

### *Proposal For A New Swedish Trademark Act*

The Swedish Committee on Trademarks has recently proposed that the Swedish Trademark Act of 1960 should be replaced by a new Act. Naturally, the point of departure has been the EU Trade Mark Directive. We set out below a brief description of some of the most notable amendments to the Swedish trade mark legislation proposed by the Committee.

### *Trade marks established by usage*

Notwithstanding the fact that the Trademark Directive only refers to registered trade marks, the Committee maintains that, as under current Swedish trade mark legislation, trade marks established by usage should enjoy the same protection as registered trade marks. Thus, according to the draft act, trade marks established by usage have, in principle, the same status as registered trade marks.

### *Reduced scope of statutory examinations*

The Swedish Trademark Register is maintained by the Swedish Patent and Registration Office (PRV). Today, the PRV controls whether there are any absolute or relative grounds for refusal of trade mark applications. According to the draft act the PRV shall no longer refuse registration of a trade mark on relative grounds which means that the examination of relative grounds which the PRV performs ex officio shall be abolished. According to the draft act an opponent who would like to invoke relative grounds for refusal must therefore himself present the interest at stake in order for the PRV to base a revocation decision on such grounds.

### *Opposition procedure*

The Committee proposes that the time limit for filing an opposition shall be harmonised with the Directive and thus extended from two to three months.

### *Transfer of an application*

The Committee further suggests the introduction of a new rule which would enable transfer of an application for registration of a trade mark to another party if such party can demonstrate stronger rights in the trade mark.

### *Simplified revocation procedure*

Under current trade mark legislation a party who wishes to have another party's trade mark registration revoked must, if the other party does not approve of or contests the application for revocation submitted to the PRV, bring an action before a court of law. According to the proposal a simplified procedure for the revocation of trade mark registrations shall be introduced whereby the PRV should be authorised to revoke trade mark registrations independently of an opposition procedure.

### *Compensation for infringements*

In the Committee's view there is a need to clarify the provisions on compensation for trade mark infringements. The Committee does not propose any changes to the existing obligation to pay compensation for an infringing use of another's trade mark equivalent to a justified licence fee. However, the Committee proposes amendments to the provision concerning compensation for other damage caused by an infringement. The Committee considers it necessary to define more clearly the criteria relevant to an assessment of such damage. In the Committee's view such an assessment should especially consider the following: (i) the

loss of sales suffered by the holder of the right; (ii) the profit made by the infringer as a result of the infringement; and (iii) the holder's of right interest in ensuring that his trade mark is not infringed.

### **United Kingdom**

*Revocation: Descriptive Marks and Broad Specifications - David West t/a Eastenders v. Fuller Smith & Turner plc*

**Background:** Mr West applied to revoke the trade mark E.S.B. registered in class 32 for beer on the basis that (a) it had not been validly registered at the date of application in 1988 and (b) it had not been used in relation to lagers and was therefore vulnerable to revocation in relation to non-bitter beers.

**Decision:** On the basis of his review of the ECJ decision in BABY-DRY and also the CFI decision in DOUBLEMINT, the Judge noted that:

- registrability might be assisted by the need for some mental activity in order to discern a reference to the quality or a characteristic of the goods;
- likewise, uncertainty as to the precise nature of the reference to the quality or character of the goods will assist;
- marks which only refer directly to the quality or character of the goods must be refused registration.

The Judge held that E.S.B. was prima facie distinctive and therefore registrable. The consumer would have to work out what the letters stood for as it was not immediately apparent that they may stand for Extra Special Bitter or Beer.

However, the attack based on non-use in relation to non-bitter beers was successful. The Judge held that commercially bitter and lager are different and that the class of articles represented by beer has a number of sub-sets of which bitter is only one. Since Fullers had only used the mark in relation to bitter the Judge held that non-use of the mark in relation to lager was established and the mark was therefore partially revoked in relation to lager.

**Commentary:** The appeal on this case which is due to be heard in the Autumn will be the first opportunity for the English Court of Appeal to comment on the rationale and implications of the ECJ decision in BABY-DRY (referred to above).

The appeal will also be the first time that the Court of Appeal has had an opportunity to comment on the extent to which non-use can be used to attack a registration with a broad description of goods/services.

Bird & Bird's Intellectual Property Group was involved in 2 of the cases reported in this Brands Update: the *West v Fuller* case before the English High Court and the *Chef Revival* case before the CFI. The Group provides both national and pan-European trade mark advice and litigation services to brand owners.

### Annex - Pending Appeals to the ECJ

ECJ Case No.	Parties	Subject Matter	Status
C-363/99	Koninklijke v Benelux Merkenbureau	Whether "POSTKANTOOR" (post office) is registrable	AG
C-104/00	DKV v OHIM	Whether "COMPANYLINE" is registrable	AG
C-244/00	Van Doren v Lifestyle	Whether Arts 28 and 30 of the EC Treaty permit the application of national legislation requiring an infringer who claims exhaustion of a mark to prove it	AG
C-265/00	Campina v Benelux Markenbureau	Whether "BIOMILD" is registrable	AG
C-273/00	Sieckmann v Deutsches Patent und Markenamt	Whether sounds and smells are registrable	AG
C-291/00	LTJ Diffusion v Sadas	What constitutes an identical sign to a registered mark	AG
C-292/00	Davidoff v GOFKID	Whether the protection afforded to marks with a reputation extends to the use of such marks in relation to similar as well as dissimilar goods	AG
C-23/01	Robelco v Robeco Group	What constitutes an identical sign to a registered mark	AG
C-40/01	Ansul v Ajax	Whether "genuine use" includes use merely to maintain the registration of the mark	AG
C-53/01 C-55/01	Linde, Winward & Rado Uhren v Deutsches Patent und Markenamt	Whether certain 3-D marks are registrable	
C-104/01	Libertel Roep v Benelux MerkenBureau	Whether a single specific colour is registrable	
C-191/01	OHIM v Wrigley	Whether "DOUBLEMINT" is registrable	
C-205/01	Arsenal v Reed	Whether the use of a sign as a trade mark is a pre-requisite to a claim of trade mark infringement	AG
C-218/01	Henkel v Deutsches Patent and Markenamt	Whether certain 3-D marks and packaging are registrable	
C-283.01	Shield Mark v Joost Kist	Whether sound or noise marks are registrable and if so, the form that such registration should take	
C-326/01	Telefon & Buch v OHIM	Whether "UNIVERSAL TELFONBUCH" and "UNIVERSALKOMMUNIKATIONSVERZEICHNIS" are registrable	
C-361/01	Christina Kik v OHIM	Whether OHIM's language regime is lawful	
C-408/01	Adidas v Fitness World	Whether the protection afforded to marks with a reputation extends to the use of such marks in relation to similar as well as dissimilar goods	
C-456/01 C-457/01	Henkel v OHIM	Whether certain 3-D marks are registrable	
C-468/01 C-474/01	Procter & Gamble v OHIM	Whether certain 3-D marks are registrable	
C-498/01	Zapf Creation v OHIM	Whether "NEW BORN BABY" is registrable	
T-292/01	Phillips-Van Heusen v OHIM	Whether "BASS" is registrable over German mark "PASH"	

## Annex - Pending Appeals to the ECJ Continued

ECJ Case No.	Parties	Subject matter	Status
C-49/02	Heidelberger Bauchemie v Deutsches Patent und Markenamt	Whether certain colour marks are registrable	
C-064/02	OHIM v Erpo Möbelwerk	Whether "DAS PRINZIP DER BEQUEMLICHKEIT" is registrable	
C-100/02	Gerolsteiner Brunnen v Putsch	Whether the "descriptive use" defence to a claim of trade mark infringement is available when the infringing sign is being used as a trade mark	

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*This update is not intended to be exhaustive and appropriate advice should be sought in relation to any specific circumstances.*

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