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List of abbreviations

Art	Article
BGH	Bundesgerichtshof (German Federal Supreme Court)
BPatG	Bundespatentgericht (German Federal Patent Court)
CJEU	Court of Justice of the European Union
ECJ	Court of Justice of the European Union
EEC	European Economic Community
etc	et cetera
EU	European Union
EUIPO	European Intellectual Property Office
EUTM	European Trade Mark
EUTMR	European Trade Mark Regulation; Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark
GC	General Court of the European Union
lit	litera
MSchG	“Markenschutzgesetz” (Austria)
Nice Agreement	Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks
OGH	Oberster Gerichtshof (Austrian Supreme Court)
OHIM	Office for Harmonisation in the Internal Market (Trade Marks and Designs)
para	paragraph
Paris Convention	Paris Convention for the Protection of Industrial Property of 20 March 1883
TFEU	The Treaty on the Functioning of the European Union
TM	trade mark
TMD	Trade Mark Directive; Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks

1. Introduction

1.1. General Topic

1.1.1. Evolution of trade mark law in the European Union

Trademark law constitutes a part of intellectual property law. First and foremost, it serves to protect signs in the commercial traffic. Intellectual property rights were basically governed by the territoriality principle.¹ Thus, protection was restricted to the territory of the state in which protection was granted. This territoriality resulted in a discrepancy with the fundamental freedoms of the TFEU, in especially the free movement of goods.² Owners of national intellectual property rights were not to be able to invoke national norms to prevent the importation or marketing of a product which had been lawfully launched on the market of another Member State (exhaustion of trade mark rights).³ Therefore, a need arose for rules allowing intellectual property rights such as trade mark rights to be obtained consistently for the entire internal market and not individually in each Member State in which the product is marketed.⁴

The First Trade Mark Directive (Council Directive 89/104/EEC to approximate the laws of the Member States relating to trade marks) brought harmonisation of the trade mark laws of the Member States of the European Union. By the end of 2015, the new Trade Mark Directive sought further harmonisation and adaptation to the era of the internet (Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks), now known as Trade Mark Directive, TMD. The Community Trade Mark Regulation (Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark) created the means to obtain a Community trade mark with unitary effect for the European Union.⁵ At the same time, the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), the

¹ Hildebrandt, Trade Mark Law - The Case Law of the European Court of Justice (2016) page 86.

² Schuhmacher/Rauch, Europäisches Marken-, Muster- und Urheberrecht (2017) page 1.

³ Gamharter/Handig in Kuscko/Schuhmacher, markenschutz "Einleitung" point 21.

⁴ Schuhmacher/Rauch, Europäisches Marken-, Muster- und Urheberrecht (2017) page 4.

⁵ Schuhmacher/Rauch, Europäisches Marken-, Muster- und Urheberrecht (2017) page 4.

European trade mark agency was created on 1 April 1996. There were already 20,000 applications for a Community trade mark filed with OHIM on 1 April 1996. Since then, the amount of applications has increased substantially each year.⁶

The Community Trade Mark Regulation was amended in the course of a reform to the European Union Trade Mark Regulation, EUTMR (Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark), and the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) was renamed EUIPO, European Intellectual Property Office.⁷

1.1.2. Relationship between national trade marks and European trade marks (EUTM)

The EUTMR establishes a uniform trade mark system on a Europe-wide basis. The system shall provide the possibility to acquire a uniform trade mark with validity for the whole internal market. However, national trade mark law will nevertheless persist and remain applicable. Union trade marks will therefore coexist with trade marks protected under national law without displacing or eliminating them (principle of coexistence).⁸ This regime offers companies a choice as to the extent of their market presence: small-scale protection is less expensive and promises fewer disputes with competitors, while cross-border protection enhances the legal security and value of the trade mark and simplifies its enforcement in other EU countries.⁹

It also follows from this that rights deriving from a European Union trade mark (EUTM) can be enforced in parallel with any existing rights under national law (double protection). On the other hand, however, there is also room for conflicts between national trade marks and European Union trade marks. The EUTMR recognises national trade marks as a ground for refusal if the proprietor of an earlier identical or comparable trade mark has filed an objection.

⁶ Boggild/Staunstrup, Community Trade Mark Law (2015), § 1.01 page 2.

⁷ Schuhmacher/Rauch, Europäisches Marken-, Muster- und Urheberrecht (2017) page 4; Ekey/Bender/Fuchs-Wisseemann, Markenrecht page 14.

⁸ Schuhmacher/Rauch, Europäisches Marken-, Muster- und Urheberrecht (2017) page 5; Boggild/Staunstrup, Community Trade Mark Law (2015), § 1.02 page 4.

⁹ Jaeger/Weller, Das neue europäische Markenrecht, ecolex 2015, 1066.

It is also a possibility to prohibit the usage of an EUTM for the area of a Member State due to infringement of earlier rights, according to the law of the particular Member State.¹⁰

1.1.3. Functions of a trade mark

Trade marks and trade mark rights are inevitably linked to specific products of a specific company. For an individual company, trade mark rights can be of considerable significance and value. Trade mark rights are therefore intended to be a connection between companies or products of the owner of the trade mark rights and his consumers.¹¹

The main function of a trade mark is undoubtedly that of distinguishing or identifying. This derives from the legal provision according to which trade marks may consist of any signs capable of being represented in a register, particularly letters, words, numbers, designs and the shape of goods, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings (Art 4 EUTMR, Art 3 TMD). However, such signs may only be granted registration if they have distinctive character. The function of a trade mark is to attribute the identity of origin of a product or service to one company and to differentiate it from other products of the same type of other companies.¹²

Nonetheless, a trade mark may also have "secondary functions" beyond that. One of these is the function of quality. A trade mark allows consumers to have confidence in a certain constant quality of the goods or services offered under the trade mark. Furthermore, trade marks may serve purposes such as advertisement or investment, as they constitute an autonomous asset. The general public creates a link between the trade mark and specific characteristics of the goods or services, which is why it is referred to as the advertising and communication function of trade marks.¹³

The relevance of trade marks goes hand in hand with the various functions mentioned above. This meaningful role of trade marks must, however, also be protected by certain grounds for refusal in order to ensure genuine use of the trade mark. To obtain an European Union trade

¹⁰ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 5.

¹¹ *Boggild/Staunstrup*, Community Trade Mark Law (2015), § 2 page 17.

¹² *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) pages 6,7.

¹³ *Kucsko*, Wozu Marken? *ecolex* 2012, 563; *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 7.

mark right, it has to be registered according to Art 6 EUTMR. The registration is carried out by the EUIPO in the Register of Union Trade marks and presupposes a prior application to the EUIPO or to the national central industrial property office of a member state, which then forwards the application to the EUIPO.¹⁴ In the examination of the application, the absolute grounds for refusal under Art 7 EUTMR are primarily examined. These are the main focus of this master thesis.

1.2. Aim of the master thesis

The aim of the master thesis is therefore to examine the potential grounds for refusal of registration of trade marks. The analysis of the respective limits to trade mark registrations is mainly based on decisions of the European Court of Justice, but also decisions of the highest courts of individual member states, mainly Austria and Germany, are discussed. Some judgments are reproduced very precisely in order to understand the decision-making system of the CJEU and its line of argumentation. Although the main focus of this master thesis lies on “absolute” grounds for refusal, the topic of relative grounds for refusal is also dealt with and the differences between these two types of barriers to trade mark protection are set out.

1.3. Legal framework

European trade mark law is based on the European Trade Mark Regulation (EUTMR) on the one hand, which is enforced by the European Intellectual Property Office¹⁵ in Alicante. On the other hand, the Trade Mark Directive (TMD) approximates national trademark laws.¹⁶ Therefore, the legal framework of the Master's thesis is mainly,

¹⁴ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) pages 5, 6.

¹⁵ until March 23, 2016 the EUIPO was called OHIM, see section 1.1.1.

¹⁶ *Grünberger/Podszun*, Die Entwicklung des Immaterialgüterrechts im Recht der Europäischen Union in Jahr 2015 (Teil II), GPR 2016, 87.

1. TMD: Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks as well as

2. EUTMR: Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

Since Article 4 of TMD and Article 7 of EUTMR are of particular importance in this context, these two provisions are listed below.

Article 4 of Directive (EU) 2015/2436

Absolute grounds for refusal or invalidity

1. The following shall not be registered or, if registered, shall be liable to be declared invalid:

(a) signs which cannot constitute a trade mark;

(b) trade marks which are devoid of any distinctive character;

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

(d) trade marks 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;

(e) signs which consist exclusively of:

(i) the shape, or another characteristic, which results from the nature of the goods themselves;

(ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;

(iii) the shape, or another characteristic, which gives substantial value to the goods;

(f) trade marks which are contrary to public policy or to accepted principles of morality;

(g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;

(h) trade marks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property ('Paris Convention');

(i) trade marks which are excluded from registration, pursuant to Union legislation or national law or to international agreements to which the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications;

(j) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine;

(k) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional specialities guaranteed;

(l) trade marks which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation or national law, or international agreements to which the Union or the Member State concerned is a party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species.

2. A trade mark shall be liable to be declared invalid where the application for registration of the trade mark was made in bad faith by the applicant. Any Member State may also provide that such a trade mark is not to be registered.

3. Any Member State may provide that a trade mark is not to be registered or, if registered, is liable to be declared invalid where and to the extent that:

(a) the use of that trade mark may be prohibited pursuant to provisions of law other than trade mark law of the Member State concerned or of the Union;

(b) the trade mark includes a sign of high symbolic value, in particular a religious symbol;

(c) the trade mark includes badges, emblems and escutcheons other than those covered by Article 6ter of the Paris Convention and which are of public interest, unless the consent of the competent authority to their registration has been given in conformity with the law of the Member State.

4. A trade mark shall not be refused registration in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration, following the use which has been made of it, it has acquired a distinctive character. A trade mark shall not be declared invalid for the same reasons if, before the date of application for a declaration of invalidity, following the use which has been made of it, it has acquired a distinctive character.

5. Any Member State may provide that paragraph 4 is also to apply where the distinctive character was acquired after the date of application for registration but before the date of registration.

Article 7 of Regulation (EU) 2017/1001

Absolute grounds for refusal

1. The following shall not be registered:

(a) signs which do not conform to the requirements of Article 4;

(b) – (h) same as in Art 4 of the Directive.

(i) trade marks which include badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest, unless the consent of the competent authority to their registration has been given;

(j) – (m) same as (i) – (l) of Art 4 of the Directive.

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Union.

3. Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it.

1.4. Methodological approach of the master thesis

The starting point of my research work when writing my master's thesis was the identification of relevant case law of the European Court of Justice. In the course of this, however, it was also the aim to find the scientific publications that fit to my topic and the decisions, in order to be able to comprehend and process the topic as a whole.

The following databases were used to find the relevant materials:

- Beck Online,
- Rechtsdatenbank (RDB),
- Lexis-Nexis.

Law journals with a focus on European law were also borrowed manually from the respective institute of the Juridicum Wien.

To view the decisions of the European Court of Justice, please visit the homepage curia.europa.eu.

After a detailed examination of the material found, a selection of the documents was made. In this respect, it was particularly important to use articles that were specific enough to present the topic in detail.

The use of search engines, the manual retrieval of material and the writing of the seminar paper took place between the end of November 2018 and January 2020.

2. Individual bars to trade mark protection

2.1. What are limits to trade mark protection?

The first step in order to be able to discuss the obstacles precluding the registration of a trade mark is to examine the characteristics and ability which a trade mark must display so as to qualify for registration. For a sign to be capable of functioning as a trade mark, it must be suitable for differentiating goods or services from those of other companies. This means the ability to distinguish in the abstract, i.e. whether the sign is qualified for identification only theoretically. It is only when the sign is capable of identification in the abstract that it must be evaluated in the context of the examination of the grounds for refusal to registration whether the sign also has concrete distinctive character. Another mandatory capability of a trademark is its representability in a register in a manner which allows the respective national authority and also the public to clearly define the subject of the trade mark protection. Before the amendment, "graphic" representability was a prerequisite. However, a substantive change to the requirement of representability is not recognisable at this point in time.¹⁷

Now at a second step, the exhaustive list contained in Art 7 EUTMR and Art 4 TMD mentioning the absolute barriers to registration can be examined. The relevant point in time for the fulfilment of the requirements for registration is the date of application.¹⁸ If EUIPO decides in its assessment that one of the grounds mentioned in the list is given, the trade mark applied for will not be registered unless the applicant can provide proof, that EUIPO's assessment is not correct.¹⁹ The absolute grounds for refusal should be interpreted independently. It is only necessary that one of the grounds for refusal is fulfilled. However, it is also a possibility that multiple grounds for refusal overlap. This is especially the case for the main ground of lack of distinctiveness and grounds for refusal which contain solely descriptive indications and generic names. In this case, there is an overlapping of distinctiveness, the need to maintain availability (The Principle of Keeping Free, "Freihaltebedürfnis") and the recognition by the public. In addition, the non-distinctive character of a sign also plays a role in the evaluation of the likelihood of confusion.²⁰ Also the

¹⁷ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) pages 9 and 10.

¹⁸ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 10.

¹⁹ *Boggild/Staunstrup*, Community Trade Mark Law (2015), § 5 page 55.

²⁰ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 10.

categorization of marks is important since the applicant decides on the scope of the protection awarded, according to the type of trade mark for which an application was filed. The distinctive character must therefore be examined in the light of the category chosen.²¹ Possible categories are word marks, figurative marks, word-figurative marks, shape marks (3D), and possibly colour or colour combinations or sound marks.²² Article 7 para 1 EUTMR shall be interpreted as a common European standard, meaning that registration shall not take place even if the ground for refusal is present only in a part of the European Union (Article 7 para 2 EUTMR). Thus, in principle, a trade mark will not be registered if it is considered to be descriptive or devoid of distinctive character even in one specific Member State.²³

2.2. Status quo

The following section represents the main part of the Master's thesis and provides an overview of important and groundbreaking decisions of the European Court of Justice in recent years in the context of absolute grounds of refusal for registration of trade marks. These decisions highlight the current barriers to trade mark registration and represent the status quo.

2.2.1. Impossibility to constitute a trade mark

The relevant provisions of this limit are to be found in Art 4 para 1 lit a EU Trademark Directive (TMD) or Art 7 para 1 lit a EUTMR. What is meant by this, is the impossibility of registering signs which do not fall under the concept of a trade mark or which cannot constitute a trade mark at all.²⁴ The following CJEU decision shall provide more detailed explanations.

²¹ *Folliard-Monguiral/Rogers*, European Union trade mark round-up 2017, *Journal of Intellectual Property Law&Practice*, 2018 Vol.13, No 5 page 357.

²² *Schuhmacher/Rauch*, *Europäisches Marken-, Muster- und Urheberrecht* (2017) page 9; *Hildebrandt*, *Trade Mark Law, The Case Law of the European Court of Justice* (2016) page 15.

²³ *Boggild/Staunstrup*, *Community Trade Mark Law* (2015), § 5 page 55.

²⁴ *Schuhmacher/Rauch*, *Europäisches Marken-, Muster- und Urheberrecht* (2017) page 10.

This preliminary reference was made following a dispute between Dyson Ltd ('Dyson') and the Registrar of Trade Marks ('Registrar'), which refused to register two trade mark applications from Dyson. The applications were each a transparent container or collection container integrated into the external surface of a vacuum cleaner.

With regard to the legal framework, it can be said that it concerns the interpretation of Article 3 para 1 and 3 of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (predecessor of TMD, now to be found in Art 4 TMD as mentioned above).

Article 3 of the former Directive also dealt with grounds for refusal of registration of signs, in particular para 1 lit a is relevant in the present case, namely signs which cannot constitute trade marks or lit b which are devoid of any distinctive character and lit c. Para 3 provides that a mark is not to be refused registration under para 1 lit b and c if, prior to the application for registration, it has acquired distinctive character as a result of the use which has been made of it.

Dyson made a vacuum cleaner product that did not have a dust bag, but collected the dirt into a transparent container that was part of the vacuum cleaner. Over the years, it filed various trade mark applications. Two trade mark applications were maintained, which were described like this: '[t]he mark consists of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation'.

The registrar refused the application and Dyson appealed to the High Court of Justice. The High Court considered that there was a lack of distinctiveness (Article 3 para 1 lit b) and that the descriptions were descriptions within the meaning of Article 3 para 1 lit c. However, the High Court wondered whether those marks had acquired distinctive character in terms of use in the sense of Article 3 para 3 at the time of the application for registration, since only Dyson had a transparent collection container for vacuum cleaners and no competitor. Dyson had an actual monopoly, but without advertising it.

²⁵ The information in the whole following section derives exclusively from this judgment (CJEU 25 January 2007, C-321/03 Dyson Ltd vs Registrar of Trade marks),
<http://curia.europa.eu/juris/liste.jsf?language=en&jur=C,T,F&num=C-321/03&td=ALL>.

The High Court therefore turned to the ECJ to ascertain the circumstances in which a sign may obtain distinctiveness within the sense of Article 3 para 3 of the Directive if, prior to filing the application, the user of the sign had a factual monopoly over a product in which the sign is integrated.

Both the national court and Dyson confirmed that the application for registration was not intended to register a trade mark in respect of certain shapes of a transparent collecting bin, but simply in respect of the containers themselves. Accordingly, the trade mark application which Dyson intended to lodge was directed at all possible shapes of a transparent containers for the outer face of vacuum cleaners.

According to Article 2 of the Directive, conditions must be fulfilled in order to be able for signs to function as a trade mark. The first condition is that it has to be a sign as such, the second is that it must be capable of being represented graphically and the third is that it must be capable of differentiating goods from one establishment to those of another. The Commission takes the view that Dyson's application is not a sign within the meaning of Article 2 because it is rather a conception which is not perceptible by the five senses.

The Court held that the purpose of the directive was to prevent infringements of trade mark rights and unfair competitive advantages. It repeated that Dyson's application was not for a specific type of collection cups but a general, transparent collecting bin possible in all forms. The topic of the registration is therefore possible in several potential manifestations and is consequently unspecific.

The owner of such a non-specific mark would therefore have an unfair competitive advantage, opposite to the meaning of Article 2, as it would make it impossible for other vacuum cleaner manufacturers to use transparent containers.

The Court therefore rules that Article 2 must be interpreted as meaning that the topic of a trade mark application, as in this case relating to all imaginable forms of a good, cannot constitute a sign in the sense of that provision and therefore cannot be a trade mark. On the basis of that conclusion, an interpretation of Article 3 para 3 of the Directive is obsolete.

2.2.2. Colours as such

In principle, colours and combinations of colours are capable of differentiating goods and services. However, the requirement of representability in a register can be a problem in this context.²⁶ The following decision shall set out the needed requirements.

CJEU 6 May 2003, C-104/01, Libertel Groep BV v Benelux-Merkenbureau²⁷

The judgment was based on a preliminary ruling in a dispute between Libertel Groep BV and the Benelux Markenbureau. Libertel wanted to register orange, the colour as a trade mark for goods and services in the field of telecommunications. The Benelux Markenbureau denied the request.

The legally relevant provisions of that order for reference are, first, Article 6 lit b nr 2 of the Paris Convention²⁸ refusing registration of trade marks on the ground that they are devoid of any distinctive character and lit c nr 2, which requires an assessment of all the circumstances surrounding the protectability of the trade mark.

With regard to Community law, this judgment applies Article 3 of Directive 89/104/EEC²⁹ (predecessor of TMD), which regulates the grounds for refusal and Article 6³⁰, namely limitation of the effects of a trade mark, is also relevant.

In the main proceedings, Libertel intended to register the colour orange as a trade mark for certain goods and services in the area of telecommunications at the Trade Mark Office. In the application form, Libertel described the colour with the term 'orange' and printed an orange square without mentioning any colour code. The Benelux Trade Mark Office declined the filing and the dispute went to the Hoge Raad of the Netherlands. During the check of the

²⁶ *Schuhmacher/Rauch*, *Europäisches Marken-, Muster- und Urheberrecht* (2017) page 9.

²⁷ The information in the whole following section derives exclusively from this judgment (CJEU 6 May 2003, C-104/01, *Libertel Groep BV v Benelux-Merkenbureau*), available at : <http://curia.europa.eu/juris/liste.jsf?num=C-104/01>.

²⁸ Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883.

²⁹ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks; predecessor of the current Directive (EU) 2015/2436 (TMD).

³⁰ now to be found in Art 14 of the amended Directive (EU) 2015/2436 (TMD).

dispute, questions of interpretation regarding Article 3 of the directive arose for the Hoge Raad.

In order to explain whether a colour per se without a spatial shape may have distinctive character, it must first be clarified whether a colour per se may be a trade mark within the meaning of Article 2. Three prerequisites must be fulfilled for this to be the case: first, the colour must itself constitute a sign. Second, it must be capable of being displayed visually and, ultimately, of distinguishing the goods and services of one undertaking from those of others.

Basically, a colour as such is a mere property of an object. With regard to goods or services, it can be a sign as such if it is used in the right context. The graphical representability must be clear, unambiguous and comprehensible.³¹

In the given case, the colour was represented in a colour pattern with a literal specification. However, a mere colour pattern does not meet the demands, as it may change over time and lack permanence. Therefore, the background of a colour pattern alone does not constitute a graphic representation within the meaning of Article 2. The word 'colour', in the case of orange, is a graphic representation but does not have to fulfil the other requirements.

The combination of the colour pattern and the word may amount to a graphic representation insofar as it is clear and unequivocal. The designation of a colour after an identification code may be regarded as a graphic representation because it is specific and durable. If the combination of colour sample and literal description does not meet the requirements, an identification code may be used to rectify the defect.

As regards the ability of a colour to separate the goods and services of one enterprise from those of others, it must be clarified whether colours as such are suitable for transmitting clear messages. There is no doubt that colours are suited for mental connections, but by their very nature they are of little use in transferring unambiguous information. However, it should not be automatically inferred from this actual determination that colours as such are not capable of differentiating goods or services of different companies from each other. It should therefore be noted that colours may be capable of satisfying the latter condition.

In conclusion, a colour per se may therefore confer the status of a trade mark within the meaning of Article 2 of the Directive.

³¹ for more details see judgment CJEU 12 December 2002, C-273/00, Sieckmann vs Deutsches Patent- u. Markenamt, in the section "smells" 2.2.4.

As to the question whether, when it is necessary to evaluate the distinctive character of a particular colour as a trade mark, it is relevant to examine whether there is a public significance in the reachability of that colour, such as may exist in the case of signs indicating a geographical source, the Court states the following. The registrability of a colour as a trade mark depends on the view of the pertinent public. In the present case, the goods and services are targeted at average users who are normally knowledgeable and attentive. The distinctive character of the quantity of colours of the target audience is to be considered as low. Account must also be taken of the objective of trade mark protection law, namely to ensure genuine competition, and it must be borne in mind that the owner of a trade mark has extensive rights which enable him to have a monopoly over the registration of the sign as a trade mark. However, the registration options may be subject to restrictions in favour of the common benefit.

Since the range of accessible colours is narrow, it could follow that with only a few registrations as trade marks for particular goods, the whole spectrum of colours will be used up. Such unilateral dominance would not be conducive to undistorted competition and would hinder business growth. It is therefore necessary to recognise the general significance in this area that the disposability of colours to other economic actors is not unlawfully constrained.

In order to answer the question whether the public interest must be taken into account when evaluating the distinctive character of a particular colour as a trade mark, it can be said that the possibility of having a colour available to other economic operators who also supply goods or services of the kind covered by the application must not be subject to an unlawful restriction.

The national court also asks whether and to what extent a colour may be recognised as such as having distinctive character under Article 3 para 1 lit b (the ground for refusal to register marks which are devoid of any distinctive character) and Article 3 para 3 (registrability notwithstanding an obstacle arising from use) of the Directive.

Trademarks are mainly used to convey the original indication of the product to the end-user. This is done by allowing the consumer to differentiate the object from goods of other origin without any risk of confusion, i.e. a certain company is to be identified as the origin. It follows that the perceived image of the target public (defined above, average consumer) and the usual use of the mark must be taken into account.

The average consumer usually lacks the opportunity to directly compare different marks. Usually he has to rely on an imprecise impression in his memory. The average consumer is in

principle not in the habit of deducing the origin from a colour of objects without graphic word elements, since colours as such are not currently regarded as a method of identifying. It follows that colours as such do not normally have the capacity to identify goods by a particular undertaking and to separate them from others.

A colour as such, irrespective of its use, rarely has distinctiveness (within the meaning of Article 3 para 1 lit b). Nevertheless, on the basis of their utilization, as a result of a process of habit, this defect can be remedied (para. 3). In its evaluation, the authority shall take into account all aspects.

In summary, it is possible that a certain colour as such may have unmistakable character for specific goods without spatial limitation (iSv Article 3 para 1 lit b and para 3 of the Directive). This, however, is subject to the condition that the graphic depiction of the colour is unequivocal, impartial, comprehensible and permanent. These requirements are met by an international colour code, but not by the representation on hard copy.

A colour per se may have unmistakable character for the purposes of the above mentioned provisions if, in the mind of the average consumer, the mark is likely to identify the goods or services applied for as belonging to certain companies.

It is also important to note that the fact that registration of a particular colour is applied for as such for a great variety of goods or services or only for certain goods or services, together with any other factors specific to the case, is important in assessing the distinctiveness of the intended registration. This also applies to the assessment of whether registration would be contrary to the public good.

Finally, it should be noted that, when evaluating the distinctiveness of the colour as a trade mark, the department appointed to grant the trade mark must consider all possible factors of the individual case, including past usage, in the specific examination.

Just recently, another decision was made dealing with a colour mark. In this case, a colour mark comprising two colours was not considered to be eligible to constitute a trade mark within the meaning of Article 7 para 1 lit a EUTMR, as the two colour compounds were not at all structured in a systematic way.³²

³² *Bartos/Majchrzak*, Rechtsprechung des EuGH und EuG in EUIPO-Verfahren, ÖBl 2019/72.

CJEU 29 July 2019, C-124/18 P, Red Bull v European Union Intellectual Property Office (EUIPO)³³

On 15 January 2002, Red Bull filed an application for registration of the combination of a pair of colours as a colour mark for energy drinks, represented by two neighbouring squares (left blue, right silver). On 25 July 2005, the mark was granted registration with an emphasis on its distinctive character acquired in consequence of its usage. Another mark was also registered. In 2011 and 2013, Optimum Mark submitted an action to EUIPO for a declaration of invalidity of the marks. The cancellation was carried out by the Cancellation Division of EUIPO. This decision was upheld by the Board of Appeal and the General Court, which is why the proceedings were brought before the ECJ.

The ECJ pointed out that its graphical depiction of two or more abstract and non-contour colours must be positioned in such a way that the colours in question are linked in a previously defined and constant manner. This is essential in order to satisfy the principles of precision and ambiguity which a trade mark must comply with. However, the existing appearance allows for varying combinations which are sufficiently frequent to make it impracticable for a customer to identify and recall a specific combination of colours which he could be certain to refer to for later purchasing. Nor is it possible for the relevant authorities to be aware of the scope of the trade mark owner's protected rights.³⁴

CJEU 27 March 2019, C-578/17, Oy Hartwall Ab v Patentti-ja rekisterihallitus

In a further decision, the ECJ dealt with the constellation in which the applicant submitted a figurative sign (consisting of blue and grey) but wanted it to be registered as a colour mark.³⁵ The relevant authority refused the application on the grounds of lacking distinctiveness. The Finnish Economic Court upheld the decision and pointed out the lack of systematic arranging of colours (see “RedBull” judgment above). The complainant referred the matter to the

³³ available at:

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=216554&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=402077>.

³⁴ all information of this judgement derive solely from itself.

³⁵ *WegrosteK*, Ein „Bild von einer Farbmarke“, ÖBl 2017/65.

Finnish Supreme Court of Administration, which referred the following questions to the ECJ.³⁶

First, the national court asked whether the applicant's qualification of a sign as a 'colour mark' or a 'figurative mark' was a decisive criterion for ascertaining whether that sign was capable of functioning as a trade mark and, where applicable, whether it had distinctiveness. The ECJ replied to that question that the qualification of a sign by the applicant as a 'colour mark' or 'figurative mark' is one of a number of decisive criteria for assessing the likelihood of that sign being a trade mark and the distinctiveness of that mark, but does not dispense the relevant trade mark authority from its duty to undertake an overall examination of distinctiveness in relation to the facts, which implies that the competent trade mark authority is not entitled to reject registration of a sign as a trade mark solely because it has not become distinctive in consequence of the use which has been made of it in connection with the products or services applied for.

The national court also asked whether it precluded registration of a mark, such as that at issue in the main proceedings, which is a figurative mark, as a colour mark. The ECJ replied pregnantly by stating that, given the facts of the case at issue, it precludes a sign from being registered as a trade mark in the case of an incompatibility of the application. However, it is for the national court to examine this.³⁷

The decision illustrates the importance of carefully considering, at the time of filing the application, which category of trade mark is best suited to grant the best protection to a sign. Even though the scope of protection of a colour mark may be wider, it should be borne in mind that it is only in exceptional circumstances that it has an intrinsic distinctive character.³⁸

³⁶ CJEU 27 March 2019, C-578/17, *Oy Hartwall Ab v Patentti-ja rekisterihallitus*, available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=212285&pageIndex=0&doclang=DE&mode=req&dir=&occ=first&part=1>.

³⁷ the whole information come from the judgement, CJEU C-578/17.

³⁸ *WegrosteK*, Ein „Bild von einer Farbmarke“, ÖBl 2017/65.

2.2.3. Sounds

CJEU 27 November 2003, C-283/01, Shield Mark BV v Joost Kist h.o.d.n. Memex³⁹

This preliminary ruling was based on a dispute between Shield Mark BV and Mr Kist, who was operating under the company Memex. Shield Mark complained that Mr Kist would use melodies which Shield Mark had earlier filed with the Benelux Trade Mark Office as sound marks.

Regarding the legal framework, the First Council Directive 89/104/EEC⁴⁰ is applied. The first recital in the preamble to the Directive states that the aim is to harmonise laws on trade marks in order to ensure the free movement of goods and services and to guarantee undistorted competition. Article 2⁴¹ of the Directive comes into force, which contains an indicative list of possible signs which may constitute a trade mark.

As mentioned before Article 2 states the following: 'A trade mark may consist of any sign 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 distinguishing the goods or services of one undertaking from those of other undertakings.'

Article 3⁴² also affects that judgment, in particular the grounds for refusal. First, para 1 lit a, inability to register a sign as a trade mark, and para 1 lit b, trade marks devoid of any distinctive character.

Shield Mark is the owner of a total of 14 trade marks for various goods and services in the computer, magazine, advertising, legal and other sectors registered in the Benelux Trade

³⁹ The information in the whole following section derive exclusively from this judgment (CJEU 27 November 2003, C-283/01, Shield Mark BV v Joost Kist h.o.d.n. Memex), available at: <https://eur-lex.europa.eu/legal-content/GA/TXT/?uri=CELEX:62001CJ0283>.

⁴⁰ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, now amended by the current Directive (EU) 2015/2436 (TMD).

⁴¹ now to be found in Article 3 of the Directive (EU) 2015/2436 (TMD).

⁴² now to be found in Article 4 paragraph 1 lit a and b of the Directive (EU) 2015/2436 (TMD).

Mark Office. The marks in question are each sound marks, namely the initial frequency of “Für Elise” and the crows of a rooster, which are described or represented in a variety of ways.

The two signature tunes were used by Shield Mark in promotional campaigns for its services and their use. Mr Kist used the same melodies in similar or overlapping sectors in promotional campaigns and Shield Mark brought an action against him for infringement.

The court of first instance rejected the trade mark part of the action on the ground that, according to the Benelux States, sounds could not be registered as a trade mark. The Hoge Raad of the Netherlands subsequently applied to the European Court of Justice.

First of all, the national court seeks to ascertain whether Article 2 of the Directive must be understood as opposing the recognition of sound signs as trade marks. If that question is in the negation, another question arises, namely whether sound signs have to be recognised as trade marks under that article.

The Court states that the objective of Article 2 is to determine which signs may act as trade marks. In particular, it mentions words and letters as well as shapes, i.e. signs which are visually noticeable (by means of scripts or illustrations)⁴³. However, the list in Article 2 is to be seen as a mere illustrative list and is not final. Therefore, despite not being mentioned, the provision does not exclude signs which are not visually discernible, such as sounds.

Sound signs are also not unsuitable for assigning goods and services to a certain company. Article 2 must therefore be understood as saying that sounds are capable of being registered as trade marks provided that they can be visually represented.

On the basis of the findings so far, Member States are prohibited from refusing to register sounds as trade marks per se, as an approximation of legal situations is desirable.

The answer must therefore be that Article 2 must be read as implying that sound signs have to be registered as trade marks in so far as they have the potential to be represented visually and are competent of discerning the goods and services of a specific enterprise from those of others.

The Hoge Raad of the Netherlands would also like to ascertain which requirements the graphic representability of a sound sign must meet.

⁴³ At this point, reference should be made to the judgment CJEU 12.12.2002, C-273/00, Sieckmann vs Deutsches Patent- u. Markenamt, which is discussed in more detail under point 2.3.4. „smells”.

The Court referred at this point to the Sieckmann decision⁴⁴ in which the conditions for a graphical display of non-visually perceptible signs as trade marks are mentioned. In particular, signs which are not perceivable by sight must be limpid, specific, permanent, comprehensible and dispassionate⁴⁵ if they are to function as trade marks with the help of figures or lettering.

The Court notes that it is for the national court to decide, on a case-by-case basis, whether the sign is suitable for the use as a trade mark. However, the Court may give indications as to in what circumstances statements made in written or musical linguistic are to be regarded as visual representations of acoustic signs within the meaning of Article 2 of the Directive.

First of all, the applicant for a trade mark application must declare in the filing that it is a sound sign. A description of the sound sign by written language could theoretically satisfy the requirements of graphic representability within the meaning of Article 2. However, this is not the case in the original proceedings since the cock crows or the first notes of “Für Elise” are too unclear and ambiguous.

With respect to the visual representation of sound signs by onomatopoeia, the problem is that they are perceived differently from one Member State to another. For example, the crows of a cock are described with Kukeluku in one Member State and Kikeriki in another. Therefore, a plain onomatopoeia as such without further explanation cannot be a graphic portrayal of a sound sign.

Even a series of notes without further descriptions does not amount to a graphic illustration within the meaning of Article 2 of the Directive due to a lack of clarity. It would be impossible to recognise a melody here. This changes, however, if a staff including bar, clef, pause sign, prefix, etc. is used. This type of representation fulfils the requirements because it is complete, understandable, easily comprehensible and dispassionate. The competent agencies and economic operators can use such a representation to identify exactly for which sign the request for filing is made.

⁴⁴ now to be found in Art 14 of the amended Directive (EU) 2015/2436 (TMD).

⁴⁵ CJEU 12 December 2002, C-273/00, Sieckmann vs Deutsches Patent- u. Markenamt, point 55.

2.2.4. *Smells*

With regard to the ability of signs to represent a mark, the explanations on olfactory marks are also interesting. They certainly represent an exceptional case, but their distinctiveness was generally accepted. Nevertheless, the representability of odours in a register could be problematic.⁴⁶

CJEU 12 December 2002, C-273/00, Sieckmann vs Deutsches Patent- u. Markenamt⁴⁷

That judgment relates to a dispute between Mr Sieckmann and the Deutsches Patent- und Markenamt (meaning the Patent and Trade Mark Office in Germany), which refused to allow Mr Sieckmann to register an odour trademark for a variety of services.

In this decision, too, the Court of Justice deals with questions of interpretation with regard to Article 2 of Directive 89/104/EEC⁴⁸, i.e. the exemplary enumeration of possible signs which may constitute trade marks. And Article 3⁴⁹, the grounds for refusal of registration and invalidity, also becomes conclusive.

Mr Sieckmann applied for registration of a trade mark in respect of services relating to promotion, business development, teaching, amusement, housing and other services. Mr Sieckmann attached to the application form a specification of the mark, namely that it was an odorous mark of the chemical material methyl cinnamate, the chemical structural formula of which was attached. He also stated that patterns of the odorous mark were in the regional laboratory and attached to the application a container containing the smelling model. Overall, the application form indicated that the fragrance was 'balsamically fruity with a slight hint of cinnamon'.⁵⁰

⁴⁶ *Schuhmacher/Rauch*, *Europäisches Marken-, Muster- und Urheberrecht* (2017) page 9.

⁴⁷ The information in the whole following section derive exclusively from this judgment (CJEU 12 December 2002, C-273/00, *Sieckmann vs Deutsches Patent- u. Markenamt*), available at:

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=47585&pageIndex=0&doclang=DE&mode=lst&dir=&occ=first&part=1&cid=12800472>.

⁴⁸ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks; now in Article 3 of the amended Directive (EU) 2015/2436 (TMD).

⁴⁹ now to be found in Article 4 of the Directive (EU) 2015/2436 (TMD).

⁵⁰ CJEU 12.12.2002, C-273/00, paragraph 13.

The competent German authority refused registration on the ground that it questioned the visual displayability of the mark applied for and, consequently, its capacity as a trade mark.

The national court also had concerns as to assessing whether an smell mark could satisfy the criteria for graphic presentation and referred the matter to the European Court of Justice.

First of all, the German court wishes to know whether a sign which is not per se visibly discernible is registrable as a trade mark.⁵¹ As in the above-mentioned observations on the Shield Mark judgment, the Court of Justice held earlier in Sieckmann's decision that Article 2 of the Directive lists only signs which are of a visually perceptible nature, but that that list is merely a list of examples. Although that list does not mention odours, it does not preclude them from the outset. It may therefore be theoretically possible, provided that a smell can be represented by graphics.

Such a graphic depiction of the sign would have to precisely identify it by means of characters or stripes. The purpose of the requirement of visual depiction is to specify the mark itself and its extent of protection. Subsequently, the mark and its scope of protection must be clearly and unequivocally visible to public administrations and other traders.

In order to ensure a sensible usage of the trade mark register, the graphic representation of a trade mark must therefore be complete in itself, easily comprehensible and unmistakable. Since the owner of trademark rights usually enjoys such a trademark for a long time, the durability of the graphic representation is of importance. Last but not least, an individual and subjective perception of the sign must be excluded, which is why the means of depicting the sign graphically must be both indivisible and impartial.

Non-visually perceptible signs may therefore function as trade marks within the meaning of Article 2, provided that the above conditions of graphic representability are met.

The second question by the referring court now refers directly to odours. That is to say, whether Article 2 of the Directive must be understood as implying that, in the case of an odour sign such as that at issue in the given case, the visual reproduction criteria are met by a chemical formula, a literal description, the lodging of an odour probe or a mix of those methods.

With concern to the chemical formula, it can be said on the one hand that it is not understandable enough. Furthermore, a chemical formula refers only to the matter itself and

⁵¹ similar question as in 2.2.3.

less to its smell. In addition, there is a lack of clarity and unambiguity. Consequently, it cannot function as a graphic representation.

A literal description of an aroma might, in principle, be an affirmative graphic representation, but it would be neither satisfactorily impartial nor satisfactorily precise.

With regard to the deposit of a pattern of the smell there is a lack of graphic display and furthermore a pattern of the odour changes over time and is not permanent.

Even the combination of a chemical formula, a literal description and an aroma sample cannot satisfy the requirements of graphic representability.

As a result of the above methods, an olfactory sign cannot be registered as a trade mark.

2.2.5. Descriptiveness

Article 4 para 1 lit c TMD and Article 7 para 1 lit c EUTMR contain provisions on descriptiveness in the sense of descriptive indications. In general, these cannot be used as monopoly for the designation of goods and services due to the public interest. This barrier to registration is based on the notion that such signs can be freely used in the same way by all market participants (The Principle of Keeping Free, “Freihaltebedürfnis”). The use of such signs should not be limited to one company. Often this ground for refusal overlaps with lack of distinctiveness, but it is independent and pursues a different purpose. The following are known decisions in this context.⁵²

CJEU 4 May 1999, C-108/97 and C-109/97, Windsurfing Chiemsee Produktions- und Vertriebs GmbH v Boots- and Segelzubehör Walter Huber, Franz Attenberger⁵³

⁵² *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 14; *Boggild/Staunstrup*, Community Trade Mark Law (2015), § 5.02 page 84.

⁵³ The information in the whole following section derive exclusively from this judgment; available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=44567&pageIndex=0&doclang=DE&mode=lst&dir=&occ=first&part=1&cid=13013517>.

This decision deals with questions of interpretation of Article 3 para 1 lit c and para 3 of the Directive 89/104/EEC.⁵⁴ The questions arose in disputes between the applicant 'Windsurfing Chiemsee' and the defendants 'Huber' and 'Attenberger' concerning the usage of the word 'Chiemsee' in their selling of sports clothing.

Article 3 para 1 lit c⁵⁵ of the Directive relates to grounds for refusals for trade mark registrations, especially for trade marks, which are solely out of signs, that help to determine the nature, qualities, amount, destination, value, geographical source or time-of-manufacture of the goods or services or other attributes of the goods in trade. Paragraph 3⁵⁶ provides nevertheless a registration option. Accordingly, a trade mark will not be refused registration if, before filing, it has become distinctive through practice.

"Windsurfing Chiemsee", located at Chiemsee, offers sportswear and other sporting products designed by an affiliated company. The goods carry the description "Chiemsee". "Chiemsee" was registered as a figurative mark with different graphical designs and additions. Inferring conclusions from the submissions, there is no German trade mark which protects the term "Chiemsee" per se. The German authorities saw the term as an indicator of geographic provenance and therefore not registrable as a trade mark. However, the graphic design of the term with graphic additions was registered as a figurative sign.

The defendants Huber and Attenberger later also sold sportswear under the name "Chiemsee", but used other graphic additives. "Windsurfing Chiemsee" turned against the labeling "Chiemsee" by Huber and Attenberger due to the danger of confusion. The defendants argued that the term "Chiemsee" as an indication of place of origin had to be kept free and was not protectable, so that they could use the designation with another graphic representation.

The German court then referred a number of questions to the Court of Justice. First, it asks under what conditions Article 3 para 1 lit c of the Directive prevents registration of a trade mark which comprises solely a name which is geographical in nature. In particular, the Court asks whether the use of Article 3 para 1 lit c is conditional on there being a specific, actual or genuine requirement of the availability of the indication and what the link must be between the relevant place and the products for which registration of the geographical indication of that place as a trade mark is sought.

⁵⁴ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks; now amended by Directive (EU) 2015/2436 (TMD).

⁵⁵ now regulated in Art 4(1)(c) of Directive (EU) 2015/2436 (TMD).

⁵⁶ now to be found in Art 4(4) of Directive (EU) 2015/2436 (TMD).

As regards the questions of interpretation raised, the Court observes that Article 3 para 1 lit c of the Directive does not permit registration as trade marks of geographical names which refer not only to places which the target public at the present identifies with the group of products in question, but also to geographical names which may in future be used by the economic operators targeted as signs indicating the provenance of the products concerned.

Furthermore, under that provision, in situations in which the pertinent target of people does not actually relate the geographical name in issue to the class of goods concerned, it is for the responsible national authority to ascertain whether it is rational to believe that such a name may, in the opinion of the persons concerned, able to indicate the geographical provenance of the products. In this examination, the level of awareness with the geographical indication among the target public and the features of the region and the products in question are particularly important. The Court concludes that the link between the product concerned and the geographical place is not necessarily based on the production of the products at that place.

Furthermore, the national court wishes to know which criteria must be met, under Article 3 para 3 of the Directive, for a mark to attain distinctiveness through use. In particular, whether the criteria differ according to the degree of availability needed and whether that provision imposes criteria on the manner in which distinctiveness through usage have to be obtained.

The Court notes that, under Article 3 para 3, the distinctive character of the mark acquired through use means that the mark is capable of designating the product in respect of which the application for registration is made as coming from a specific trader and thereby of differentiating that product from those of other traders.

Furthermore, it is inadmissible to distinguish distinctiveness according to the interest found in keeping the geographical name free for other companies to use it.

Article 3 para 3 provides, according to the Court of Justice, that, in order to ascertain whether the mark has attained distinctive character through use, the competent national authority has to consider, in an encompassing perspective, the factors which may demonstrate that the mark has acquired the capacity to identify the product concerned as belonging to a particular company.

If the competent authority considers that a large percentage of the target public recognises the product as coming from a specific enterprise because of the trade mark, it must conclude that the condition for registration of the trade mark is fulfilled.

In summary, the ECJ found that geographically descriptive marks are not by their very nature deemed to be incapable of registration, but with the proviso that it is for the registrant to prove that, as a result of use, the final consumer has associated the mark with the registrant's products.

The situation is different with the word mark "Cloppenburg" for retailing activities, which is also the name of a city in Lower Saxony. The city "Cloppenburg" was so little known at the time of application for registration that the target public did not connect the retail services designated by the mark "Cloppenburg" with the city and was not likely to do so in the future. Therefore, the mark was permitted immediate registration even without evidence of its recognition by the public.⁵⁷

The following judgment of the ECJ can be regarded as counterpoint to the "Windsurfing Chiemsee" decision.

CJEU 20 September 2001, C-383/99 P, Procter & Gamble Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), "Baby Dry"⁵⁸

The relevant provision of this judgment is Article 7 of the Regulation (EC) No 40/94⁵⁹ of 20 December 1993 on the Community Trade Mark, regulating grounds for refusals for trade mark registrations as Art 3 of the Directive 89/104/EEC. It's paragraph 1 lit c concentrates as well on the refusal ground of descriptive signs of trade marks. Article 7 para 3 enables the registration, however, if the trade mark has become distinctive concerning the products for which registration was filed throughout it's use.

The office examiner denied the registration and this decision was confirmed by the Board of Appeal of OHIM. It said that Baby Dry is composed solely of terms which might be used to

⁵⁷ GC 25 October 2005, T-379/03, Peek & Cloppenburg KG v OHIM; *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 17.

⁵⁸ The information given on this case derive solely from this judgment; available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=46602&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=4959475>.

⁵⁹ Regulation (EC) No 40/94⁵⁹ of 20 December 1993 on the Community Trade Mark; now amended by Regulation (EU) 2017/1001 (EUTMR).

determine the purpose of the diapers and also lacked of distinctiveness (Article 7 para 1 lit b of the Regulation (EC) No 40/94). The board also rejected Procter & Gamble's submission, that the mark had attained distinctiveness because of its use on the bases of the argument, that Procter & Gamble should have argued that already towards the office examiner.

The ECJ held that trade marks which lack of distinctive nature or which consist solely of signs which describe their intended purpose or quality, in trade, cannot be registered. However, under Article 12 of Regulation No 40/94⁶⁰, a trade mark did not entitle its proprietor to forbid a third person from disclosing information relating to the intended purpose, nature or quality of the goods, as long as such use was in line with normal trade practice. Also, the purpose of the prohibition on registering marks with exclusively descriptive signs results from the lack of function of such signs to identify products of the companies from which they originate in the absence of distinctiveness. Article 7 para 1 lit c of the Regulation therefore applies only to signs which, in the everyday language of consumers, may identify the goods in the application for registration, either expressly or by alluding to one of their features. A trade mark containing those signs may be refused registration only if it does not possess other signs or indications and, furthermore, if the exclusively descriptive signs it contains are not arranged in such a way as to be capable of distinguishing the sign as a whole from the usual one. Since, in the present case, the mark consists of words, any descriptiveness must be established individually not only for each single word but also for the entirety. Any noticeable discrepancy in the wording of a word combination for which registration is filed between that wording and that used in everyday language of consumers to identify the product or its characteristics is capable of conferring on it a distinctive character which is necessary for registration. However, registration of a word combination as a Community trade mark is not possible if it is exclusively descriptive in only one of the languages used in trade within the Community.

Therefore, as regards 'Baby Dry', an english speaking person must be considered to be the end consumer. The question is, if the word combination 'Baby Dry' is the normal manner of expression in relation to the designation of baby diapers. The Court held that the word combination undoubtedly refers to the functions of diapers and that the two words individually are also customary in describing the function of diapers, but the composition of the two words is not a well-known english term to designate the product.

⁶⁰ now regulated in Article 14 Regulation (EU) 2017/1001 (EUTMR).

As a result, combinations of words such as "Baby Dry" cannot thus be considered descriptive in their entirety. They are rather the result of a verbal inventive step which conveys distinctiveness to the mark and cannot be refused registration on the basis of Article 7 para 1 lit c.

Another landmark decision in relation to descriptiveness is the following.

CJEU 23 October 2003, C-191/01 P, Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm. Wrigley Jr. Company⁶¹

The present contested decision concerned the word combination “Doublemint” filed by Wrigley for registration as a Community trade mark, in particular for chewing gum, and refused by OHIM. As in the “Baby Dry” judgment, the relevant provisions are Article 7 (grounds for refusal) and Article 12 of Regulation (EC) No 40/94⁶², and reference is therefore made to the abovementioned considerations. OHIM's reasoning was that the combination of the two words did not contain any supplementary creative or inventive components and was therefore descriptive of the product, which is why it was not registrable under Article 7 para 1 lit c of the Regulation.

In that decision, too, the Court points out that Article 7 para 1 lit c of the Regulation excludes from registration trade marks which consist solely of descriptive indications of the product. Accordingly, signs and indications which have the function, in trade, of describing the features of the product are regarded as unsuitable for carrying out the trade mark's function as an indicator of origin. According to that decision, that is without detriment to a potential acquisition of distinctiveness by usage in accordance with Article 7 para 3. Article 7 para 1 lit c seeks above all to achieve the general objective of keeping descriptive indications available for use by everyone. Any such descriptive information shall not be the sole property of one enterprise. According to the Court, Article 7 para 1 lit c does not require that the descriptive indications of which the trade mark is composed be actually used descriptively for the goods cited in the application at the time of filing. It is enough that the signs or indications could be

⁶¹ all information in the following section come from the given judgment, which can be looked up at <http://curia.europa.eu/juris/document/document.jsf?text=&docid=48358&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=5104895>.

⁶² now regulated in Article 7 and 14 Regulation (EU) 2017/1001 (EUTMR).

utilised for that aim. Accordingly, a word sign may be refused registration if at the very least one of its potential meanings identifies a feature of the product.

Article 7 para 1 lit c is not concerned with whether the word signs used are solely descriptive. The criterion is rather whether the word combination is capable of being used by other traders to indicate a feature of their wares.

The existence of descriptive indications was further affirmed in the following judgments. "NOTFALL" (meaning emergency) for groceries and nutrition supplements, medical products etc., because the wording implies a link between an urgent emergency situation and the labelled goods by pointing to a scenario in which immediate help is required.⁶³ Furthermore, in the instance of the term "EXACT" for computer software and hardware, computer programs etc., the adjective is instantly perceived by english-speaking persons at least as an hint that the products mentioned guarantee preciseness.⁶⁴ "REHABILITATES" for nutrition supplements, because the word implies that the products can assist in recovering a good state of health and therefore it only explains the purpose.⁶⁵ In the case of "NORWEGIAN GETAWAY" for cruise ships, the first word indicates Norway and its culture and the second word is a reference to a short trip. The overall expression therefore has the clearly descriptive meaning "short holiday in Norway" (CJEC 23 January 2014, T-513/12).⁶⁶

2.2.6. *Genericness*

Under Article 4 para 1 lit d TMD and Article 7 para 1 lit d EUTMR, a further ground for refusal of registration is applicable where trade marks consist of signs or indications which have become customary in the current language. This ground for refusal is also based on the general public's need to preserve availability (The Principle of Keeping Free,

⁶³ GC 12 November 2014, T-188/13; *Majchrzak*, Die Gemeinschaftsmarke. Absolute Eintragungshindernisse, ÖBl 2015/53.

⁶⁴ GC 22 May 2014, T-228/13; *Majchrzak*, Die Gemeinschaftsmarke. Absolute Eintragungshindernisse, ÖBl 2015/53.

⁶⁵ GC 11 December 2014, T-712/13; *Majchrzak*, Die Gemeinschaftsmarke. Absolute Eintragungshindernisse, ÖBl 2015/53.

⁶⁶ GC 23 January 2014, T-513/12; *Majchrzak*, Die Gemeinschaftsmarke. Absolute Eintragungshindernisse, ÖBl 2015/53.

“Freihaltebedürfnis). Terms which are in general use should not be reserved for one, single company. The interpretation must again take into account the function of designation. Generic terms cannot fulfil the function of identification. There is also an overlap with the grounds for refusal of distinctiveness and merely descriptive indications.⁶⁷

GC 16 March 2006, T-322/03, Telefon & Buch Verlagsgesellschaft mbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Herold Business Data GmbH & Co. KG „Weisse Seiten“⁶⁸

“Telefon & Buch“ applied to OHIM for registration of the word sign “Weisse Seiten” as a Community trade mark. This applied in particular for goods and services such as "paper, printed matter, reference works, business directories and services of a publishing house". The registration took place. An application for a declaration of invalidity with regard to goods and services such as the above mentioned was confirmed both before the Cancellation Division of OHIM as well as the first board of Appeal of OHIM. The General Court confirmed the decision of the OHIM.⁶⁹ Article 7 para 1 lit d of Regulation No. 40/94⁷⁰ regulates the ground for refusal because of genericness. Meaning, that a trade mark which consists solely of signs or indications which have become customary in the relevant language or in the bona fide and established practices of trade cannot be registered. The question now arose, if “Weisse Seiten” is a generic name and therefore not registrable.

The General Court held, that the customary nature of a trade mark can consequently be evaluated only in relation to the products or services covered by the mark, even if the provision in issue does not explicitly refer to them, and in relation to the perception of the relevant class of persons.⁷¹

The relevant public is the typical purchaser of the product who is usually knowledgeable and attentive. The relevant public is the public in which trade in the products in respect of which

⁶⁷ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 17.

⁶⁸ available at:

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=57695&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=5168515>.

⁶⁹ *Schumacher* in *ecolex* 2006/447, EuG 16.3.2006, T-322/03.

⁷⁰ Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark; now amended by Regulation (EU) 2017/1001 (EUTMR).

⁷¹ The information on this segment and the following derives from the judgment’s sections 49 to 77.

registration is applied for takes place. Eventually, signs, which are normally used in ordinary speech to identify the products falling within the scope of that mark, are not suitable for identifying and differentiating the products from those of a specific company. In these proceedings, OHIM declared "Weisse Seiten" invalid, in respect of printed matter, classified directories and reference books. The customary character of "Weisse Seiten" must therefore be examined in the light of those goods.

As mentioned above, the typical purchaser has to be taken into account. Since 'Weisse Seiten' consists of German words, the typical user in the present case is an average German-speaking person. It is therefore a question of whether the term 'Weisse Seiten' has become, for the relevant class of persons, the normal common term for telephone directories of private individuals. The court concludes that the term is used in everyday life with regard to the products, it is generic. According to the General Court, this also applies to electronic telephone connections. Concerning the relevant time, the time of filing of the trade mark application is decisive. The trade mark "Weisse Seiten" therefore falls within the scope of the absolute ground for refusal set out in Article 7 para 1 lit d of the Regulation and cannot be registered.

The following decision illustrates an example when revocation occurs due to a trade mark which has become a generic. The relevant provision for this is Art 20 lit a EU Trademark Directive⁷², which states that a trade mark should be accountable to revocation after registration, if the mark has become the normal designation in the trade for a good or service for which it is registered and it lacked actions of the proprietor to prevent it.

OGH 29 January 2002, 4 Ob 269/01, „Walkman“

That decision of the Oberster Gerichtshof (Supreme Court) of Austria concerned the word mark 'Sony Walkman' protected for Austria. The proprietor of the word mark and the plaintiff used it to designate portable cassette players. The company took action against infringements of trademark rights by other manufacturers. In everyday language, "Walkman" quickly established itself as the general term for portable cassette recorders. This was particularly the

⁷² Directive (EU) 2015/2436 (TMD).

case in trade and at exhibitions. "Walkman" was also mentioned in German-language dictionaries for portable cassette players. In its catalogue, the defendant now offered portable cassette recorders under the name "Walkman", which did not originate from the plaintiff. The plaintiff then claimed an injunction against the use of the trade mark and damages.⁷³

The plaintiff submitted that the relevant public was aware of the plaintiff's trade mark and that it had taken all possible measures to prosecute infringements of that mark. In that regard, the supreme Court of Austria holds that the loss of a trade mark right as a result of the development of the trade mark into a generic name is not based on forfeiture but on the objective fact of the transformation of the trade mark into a name customary in the trade on the basis of the perception of the public. The use of the trade mark by a third party which is unlawful does not prevent a change in the perception of the public. It depends on the nature and understanding of the relevant public. This is to be understood as the public in which the sign is to be used or has effects.⁷⁴

The Supreme Court holds that, as far as the public is concerned, reference must be made not only to the perception of the final consumer, but also to that of manufacturers and distributors. Those products for which the disputed trade mark has been applied for are for the most part traded between electrical retailers as suppliers and consumers as buyers. Therefore, the understanding of retailers of the term "Walkman" on the one hand and of consumers on the other hand must be considered.⁷⁵

The previous instances held that, although traders know that the contested sign is a registered trade mark of Sony, the sign is nevertheless commonly used in trade as a generic term for portable cassette players. This is because no alternative term is available to designate competing products, since the applicant's trade mark is the only common name for such products. It appears to be a monopoly. Such a situation no longer justifies privileged use of the sign. The Supreme Court also agrees with the previous instances that the loss of function of the plaintiff as owner of the trademark within the meaning of § 33 b MSchG is attributable to the plaintiff. § 33 b MSchG is the implementation of Article 20 lit a EU Trade Mark Directive into Austrian law. Although the plaintiff has taken legal action against individual traders for trademark infringements, it has done nothing to ensure that a sign other than the own trademark prevails among the public as generic term. For example, it has remained

⁷³ OGH 29 January 2002, 4 Ob 269/01; ÖBl 2002/38, 185.

⁷⁴ *Schanda*, eolex 2002/201; OGH 29 January 2002, 4 Ob 269/01i.

⁷⁵ OGH 29 January 2002, 4 OB 269/01i, MR 2002, 169.

inactive although the term "Walkman" was used as a generic term in dictionaries and has thus to accept the loss of trademark rights.⁷⁶

In the following decision, the ECJ attached particular importance to the understanding of the trade mark as a generic name of the final consumer, unlike the decision "Walkman", which also takes into account the understanding of retailers.

CJEU 6 March 2014, C-409/12, Backaldrin Österreich The Kornspitz Company GmbH v Pfahnl Backmittel GmbH⁷⁷

This reference for a preliminary ruling was made in the context of a dispute between the two Austrian undertakings Backaldrin (Österreich The Kornspitz Company) GmbH and Pfahnl Backmittel GmbH concerning the word mark "Kornspitz" registered for Backaldrin. The word mark was registered in respect of bread, grain preparations, flour, pastry etc. The relevant provisions of that decision were Article 12 para 2 lit a of Directive 2008/95/EC⁷⁸, according to which a trade mark is liable to revocation if, as a result of the conduct of its proprietor, it has become the common name in the trade of a good or service for which it has been registered. Backaldrin manufactured under that trade mark a baking composition which was delivered mainly to bakers. They processed the baking mixture into an oval bun. Backaldrin gave both the bakers and their grocers permission to sell the buns under the name "Kornspitz". Pfahnl knew that "Kornspitz" was listed as a trademark. Pfahnl, however, stated that the end consumers understood "Kornspitz" as the term commonly used to describe the bun. That comes from the fact that bakers supplied by Backaldrin will never draw the attention of final consumers to the fact that the sign "Kornspitz" is registered as a trade mark or comes from the baking preparation. Pfahnl filed an application for revocation of the trade mark (§ 33b Markenschutzgesetz). The Cancellation Division of the Austrian Patent Office upheld that application. Backaldrin filed an appeal against that decision with the Oberster Patent- und Markensenat. The Oberster Patent- und Markensenat decided to hold the proceedings in abeyance and submitted three questions to the ECJ.

⁷⁶ *Schanda*, *ecolex* 2002/201: OGH 29 January 2002, 4 Ob 269/01i.

⁷⁷ <https://eur-lex.europa.eu/legal-content/DE/TXT/?uri=CELEX%3A62012CJ0409>.

⁷⁸ now governed by Article 20(a) of Directive 2015/2436 (TMD).

By the first question, the Court was asking whether Article 12 para 2 lit a should be understood as meaning that a trade mark may be revoked in relation to a product in respect of which it is registered if, as a result of the conduct or inactivity of its owner, it has become, from the point of view of the final consumer of that product, the common name for that product. In that context, the Court held that that article governs a case in which a trade mark is no more suitable for performing its role as an indication of origin⁷⁹, which is, in principle, the fundamental function of a trade mark in order to attribute goods and services to a particular undertaking. The provision in Article 12 para 2 lit a therefore refers to cases in which the trade mark has ceased to have distinctive character because it has become the customary term. In that case, the trade mark is revocable so that its proprietor can no longer assert the rights granted to him. In the original case, the final consumers consider the product, namely the buns called "Kornspitz", to be the usual term for that product. They are not informed of the circumstance that those buns consist of a baking composition originating from Backaldrin under the trade mark 'Kornspitz'. The perception is based on the fact that the traders of the buns do not indicate that it is a registered trade mark. It was therefore held that the mark Kornspitz could not perform the main function of an indication of origin in the trade in buns known as "Kornspitz" and that it could be revoked if the loss of the distinguishing feature was attributable to the conduct of the trade mark proprietor. The loss of distinctiveness from the point of view of the final consumer was therefore liable to revocation of the rights of the trade mark proprietor. The mere knowledge of the origin by bakers and traders may not prevent revocation. The answer to the first question referred must therefore be that Article Article 12 para 2 lit a of Directive 2008/95 must be understood as requiring, in a situation comparable to that at issue in the main proceedings, that a trade mark for a good in respect of which it is registered may be revoked if, as a result of the behaviour or lack of action of its owner, the trade mark has become, from the point of view of the final consumer of that good, the customary term for that good.⁸⁰

By its second question, the national court asks whether Article 12 para 2 lit a of Directive 2008/95 should be understood as meaning that it may be regarded as 'inactivity' within the meaning of that provision for the proprietor of a trade mark to refrain from persuading traders to use the trade mark more for the purposes of commercialising a product for which the trade mark is registered. In that regard, the Court observes that the proprietor may be deprived of

79 CJEU 29 April 2004, C-371/02, *Björnekulla Fruktindustrier*.

80 also in *Haybäck*, *Neues zum Recht am geistigen Eigentum*, *Jahrbuch Europarecht* 2015, 269.

the distinctive character of the trade mark only if the loss is due to his acts or omissions. Inaction includes all inactions by which the owner of a trade mark fails to exercise adequate care to preserve the distinctiveness of his trade mark. The fact that Backaldrin has not taken any steps to persuade sellers to inform their customers that the sign used to designate the product in question is registered as a trade mark could be regarded as inactivity and it is for the national court to assess that situation. The answer to the second question referred must therefore be that Article 12 para 2 lit a of Directive 2008/95 must be understood as implying that it may be regarded as inaction for the purposes of that provision that the owner of a trade mark refrains from persuading sellers to make greater use of the trade mark for the commercialisation of a product for which it is registered.

By its third question, the national court seeks to ascertain whether Article 12 para 2 lit a of Directive 2008/95 is to be understood as meaning that a declaration of revocation of a trade mark requires clarification of the question whether other terms exist for a product in respect of which that mark has become the customary term in the trade. In that regard, the Court held that it was irrelevant whether there were alternative designations for the goods or service in question. That would not affect the loss of distinctive character of the mark as a result of its development into a customary term in the course of trade. The answer to the third question referred is therefore that Article 12 para 2 lit a of Directive 2008/95 must be understood as meaning that a declaration of revocation of a trade mark does not require clarification of whether there are different terms for a good for which the trade mark is now the customary term in the trade.

The answer to the third question is particularly interesting because the Austrian Supreme Court has so far attached great importance to the aspect of an equivalent alternative term.⁸¹

The Supreme Court of Austria stated, for example, in its decision of 6 July 2004, 4 Ob 128/04h, "*Memory*", that the loss of trade mark rights as a result of the development of a trademark into a generic term is based on the sole fact of the conversion of the trade mark into a generally used term on the basis of the public perception (in that regard the decision is equal). The decisive reason for this development, however, would be that the market participants do not have an equivalent alternative term available in order to name competing products to the marked goods of the trade mark owner, i.e. the trade mark is the only common

⁸¹ *Majchrzak/Graf*, Möglicher Verfall der Marke Kornspitz, Öbl 2014/28.

designation. However, it would not be required for the preservation of trade mark law that the alternative terms to the trade mark used in everyday language are equally valid in every respect, in particular to the degree of their usage.⁸²

2.2.7. Lack of distinctiveness

Article 4 lit b TMD and Article 7 para 1 lit b EUTMR set out rules on the ground for refusal of registration due to lack of distinctiveness. This ground is particularly important since distinctiveness serves the main function of trade marks. The public interest of the ground for refusal because of lack of distinctiveness is to guarantee the identity of origin of the product designated by the trade mark. Signs must be examined as to their distinctiveness by taking account of the overall impression given by them.⁸³ The criteria of distinctiveness are generally equal for all categories of trade marks. It has to be taken into consideration though, that the relevant public's perception may differ across all categories and some categories may require a more intense degree of distinctiveness.⁸⁴ In the case of word marks and figurative marks, the issue of lack of distinctiveness usually only plays a role if in the individual case the word mark is descriptive or a generic term or the figurative mark is only a simple graphic design. In the case of new forms of trade marks, such as three-dimensional shape marks, however, distinctiveness is not automatically a given. This was also the case in the following decision.⁸⁵

CJEU 22 June 2006, C-24/05 P and C-25/05 P, August Storck KG v Office for Harmonisation in the International Market (Trade Marks and Designs), OHIM “Werthers”⁸⁶

The present decision deals with the question of the protectability of the shape of a sweet and its wrapper presentation. OHIM rejected both applications on the ground of lack of distinctive character. The GC upheld that decision, as did the CJEU on the following grounds.

⁸² *Gamerith*, 4 Ob 128/04h, ÖbI 2005/27.

⁸³ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 11.

⁸⁴ *Boggild/Staunstrup*, Community Trade Mark Law (2015), § 5.02 page 84.

⁸⁵ *Schuhmacher*, Verkehrsgeltungsnachweis bei 3-D-Marken, ecolex 2007/61.

⁸⁶ available at <http://curia.europa.eu/juris/liste.jsf?language=en&num=C-24/05P>.

The distinctiveness of a trade mark within the meaning of Article 7 para 1 lit b of Regulation (EC) No 40/94⁸⁷ is assessed, on the one hand, in relation to the goods or services for which registration is sought and, on the other hand, in relation to the perception of the target public. The target public is composed of the average user of those goods or services, who is deemed to be to some extent well advised and attentive and considerate. The assessment criteria for the distinctive character of three-dimensional marks composed of the shape of the product itself are the same as those governing the other categories of trade mark. However, it should be noted that the target public's perception of marks which consist of the manifestation of the shape of the goods themselves can be different from that of a word or figurative mark consisting of a sign which is independent of the appearance of the product it designates. is assessed, on the one hand, in relation to the goods or services for which registration is sought and, on the other hand, in relation to the perception of the target public. The target public is composed of the average user of those goods or services, who is deemed to be to some extent well advised and attentive and considerate. The assessment criteria for the distinctive character of three-dimensional marks composed of the shape of the product itself are the same as those governing the other categories of trade mark. However, it should be noted that the target public's perception of marks which consist of the manifestation of the shape of the goods themselves can be different from that of a word or figurative mark consisting of a sign which is independent of the appearance of the product it designates.

Average users are not in the habit of reaching presumptions about the origin of goods based on their shape or the shape of the wrapping in the event of lack of graphical or word elements, and it could therefore be more difficult to demonstrate and establish distinctiveness in relation to such a three-dimensional mark than in relation to a verbal or figurative mark. Therefore, only a trademark which deviates extremely from the standard or customs of the trade and thereby fulfils its function of designating origin is also distinctive within the meaning of Article 7 para 1 lit b of the Regulation.⁸⁸

However, it is not excluded that a three-dimensional mark may obtain distinctive character by usage if it is used in combination with a verbal mark or a figurative mark. This is the scenario where the mark is composed of the shape of the good or of the wrapping and it is systematically accompanied by a word mark under which it is commercialised.

⁸⁷ now: Regulation (EU) 2017/1001 (EUTMR).

⁸⁸ EuGH 22.6.2006, C-24/05 p, ÖBl-LS 2007/110.

For a mark to acquire distinctive character in consequence of the use made of it, it is essential that the relevant consumers should be able to identify the product as coming from a particular company and that this identification should be based on the usage of the mark as a trade mark. In that regard, only the use of the mark which enables the public to identify the product as originating from a particular company is relevant, but not any use whatsoever.

In determining whether a mark has gained distinctiveness through usage, account must be taken of all the factors in which the target public is confronted with the mark. The relevant public is confronted with the trade mark not only at the time when it makes its decision to purchase, but also before that time, for example through advertisements or at the time of consumption of the product. The average consumer's degree of attentiveness is highest at the time when he prepares and makes his choice between the various goods of the category at issue, so that the question whether or not the average user is confronted with the mark at the time of purchasing is of special significance in assessing if the mark has gained distinctiveness in consequence of the use made of it.

In the present decision, however, August Storck KG had not succeeded in sufficiently demonstrating the reputation of the mark, so that the refusal on the ground of lack of distinctiveness was correct.⁸⁹

Not in relation to a trademark of shape, but in relation to an advertising slogan, the existence or absence of distinctive character was discussed in the following decision.

CJEU 21 January 2010, C-398/08p, Audi AG v Office for Harmonisation in the International Market (Trade Marks and Designs) (OHIM), “Vorsprung durch Technik” (advertising slogan)⁹⁰

Audi intended to apply for registering the word mark, namely the advertising slogan 'Vorsprung durch Technik', as a Community trade mark for various categories as vehicles, leather goods, clothing, means of transport, advertising, paper goods, telecommunications and

⁸⁹ *Schuhmacher*, Verkehrsgeltungsnachweis bei 3-D-Marken, ecolex 2007/61.

⁹⁰ Information in this section derive solely from the judgement itself, available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=74658&pageIndex=0&doclang=en&mode=lst&dir=&occ=first&part=1&cid=5190504>.

other classes of the Nice Agreement. However, the OHIM examiner found that the slogan 'Vorsprung durch Technik' was a direct factual statement for most of the classes in relation to certain products and services concerning technology. The slogan would be conceived by the target consumer solely as a promotional description. The mark applied for would therefore be devoid of any distinctive character.

The Board of Appeal upheld the decision, except in respect to Class 12 (Vehicles and means of transport), where Audi had demonstrated distinctiveness through use. The General Court upheld the decision. Audi appealed against this decision to the ECJ.

In this regard, the ECJ stated that, according to consistent jurisprudence of the ECJ, the distinctiveness of a trade mark within the meaning of Article 7 para 1 lit b requires that the mark must be capable of distinguishing the product in respect of which it is sought to be registered as coming from a certain company and of distinguishing that good from those of other companies. In that regard, account must be taken of the viewpoint of the relevant class of persons.⁹¹ Registration of a trade mark consisting of signs or references which are otherwise used as advertising slogans, statements of quality or incentive effects to buy the products to which the mark relates is not, in principle, excluded by the mere fact of such use. The evaluation of the distinctiveness of such marks may not be subject to a stricter standard than that applied to other signs. Furthermore, the evaluation of distinctiveness is the same for all classes of trade marks, but it must be borne in mind that the target public's awareness of the categories is not the same. It may therefore be harder to assess distinctiveness for some classes.

The General Court ruled that advertising slogans does not have to be fanciful or contain a surprise effect in order to achieve the minimum degree of distinctiveness required under Article 7 para 1 lit b. The General Court ruled that although the slogan "Vorsprung durch Technik" can be described as fanciful, it does not yet acquire distinctive character as a result. This would only succeed if this imaginative play on words also served directly as an indication of commercial origin. In the present case, however, the target public tends to regard the mark as an advertising slogan. The term "technology" would be understood very broadly, and the phrase "Vorsprung durch" would have a more laudatory character. The ECJ held in that regard that the mere fact that a mark is perceived by the public as an advertising slogan is not sufficient to conclude that that mark is devoid of any distinctiveness. A mark may

⁹¹ see also CJEU 22.6.2006, C-24/05 P and C-25/05 P, August Storck KG v OHIM.

therefore be regarded by the public as both an advertising slogan and an indicator of the commercial source.

Trade marks consisting of signs or indications which are otherwise used as advertising slogans may also be suitable to indicate to the consumer the commercial origin of the goods at issue. This provided that they are not descriptive. Even if the slogan "Vorsprung durch Technik" were to contain a factual statement indicating that the production and delivery of better products is achieved through technical supremacy, this could not justify the assumption that the mark applied for is by nature lacking distinctive character.

The ECJ concluded that the Audi slogan was able to distinctive character and could be registered as a trade mark. It therefore annulled the decisions of the General Court and the Board of Appeal of OHIM.

In this context, a decision of the German Federal Court of Justice (Bundesgerichtshof) is interesting. In its decision of 24 April 2008, the Federal Court of Justice dealt with the question of whether a portrait of Marlene Dietrich is distinctive.

BGH 24 April 2008, I ZB 21/06, Picture of Marlene Dietrich⁹²

The applicant applied to the German Patent and Trade Mark Office for registration of the figurative mark of a Marlene Dietrich image for various categories of goods and services, in particular paper goods, DVDs, computer programs, sound and image carriers, clothing, entertainment, etc. The trade mark office refused the application on the ground of lack of distinctive character. The Federal Patent Court also dismissed the appeal. The German Federal Court of Justice ruled as follows in this context.

The portrait of a (deceased or living) person is in principle eligible for trademark protection. Both the name and the image of a person may be capable of distinguishing goods and services of one company from those of another company. The main function of a trademark is to guarantee the identity of origin of the marked products. However, a sign is devoid of the necessary distinctive character if it is limited to a descriptive indication of the goods and

⁹² available at:

<https://dejure.org/dienste/vernetzung/rechtsprechung?Gericht=BGH&Datum=24.04.2008&Aktenzeichen=I%20ZB%2021/06>

services claimed. A mere factual indication is not perceived by the target public as an indication of the origin of the goods or services of a particular undertaking. A portrait of a famous person is devoid of any distinctive character for those goods and services where the public establishes a factual connection with the person depicted and therefore perceives it as (merely) descriptive of the person and not as an indication of the origin of the goods or services concerned from a particular undertaking.⁹³

Further examples of lack of distinctiveness are as follows. The slogan "SPÜRBAR ANDERS" (meaning appreciably different) lacks distinctiveness because of its banality and because the consumer is merely supplied with an unmistakable message which is to be regarded as a mere marketing slogan and therefore does not distinguish products of different origin.⁹⁴ "WASH&COFFE" for the business of a washing salon as well as for restaurant services, because the trade mark applied for indicates that the services applied for are offered together.⁹⁵ Coca-Cola Company was also unsuccessful in filing an application for a three-dimensional bottle without a ripple for bottles and non-alcoholic beverages, since the shape is composed of its mixture of elements which are normally used in trade for these goods, so that they lack distinctiveness.⁹⁶ In addition, the term "Premiere" for nutritional additives, as well as toys and food for animals has been found to be devoid of any distinctive character because of the promotional meaning of the term "premier", which indicates superior quality.⁹⁷ Similarly, "BIOLATTE" for nutritional additives is not registrable, since "bio" is simply a trivial preposition and the term "latte" is linked, at least by the Italian-speaking audience, to "milk", which could be an ingredient of the respective products for which registration is sought.⁹⁸ The OGH (Austrian Supreme Court) recently adopted a liberal approach in this context. Although it also confirms that the absence of any distinctive character constitutes a ground for refusal, it says, however, that a generous standard must be applied in this respect.

⁹³ BGH 24.4.2008, I ZB 21/06, MIR 2008, Dok. 291.

⁹⁴ GC 4 October 2017, T-126/16, I. Fc Köln v EUIPO; *Sattler*, Aktuelle Entwicklungen der Rechtsprechung zum Europäischen Markenrecht von Mitte 2017 bis Mitte 2019, EuZW 2019, 845.

⁹⁵ GC 14 July 2014, T-5/12; *Majchrzak*, Die Gemeinschaftsmarke. Absolute Eintragungshindernisse, ÖBl 2015/53.

⁹⁶ GC 24 February 2016, T-411/14, Coca Cola v OHIM; *Sattler*, Aktuelle Entwicklungen der Rechtsprechung zum Europäischen Markenrecht von Mitte 2017 bis Mitte 2019, EuZW 2019, 845.

⁹⁷ GC 19 June 2019, T-479/18; *Bartos*, Rechtsprechung des EuGH und EuG in EUIPO-Verfahren, ÖBl 2019/59.

⁹⁸ GC 5 June 2019, T-229/18; *Bartos*, Rechtsprechung des EuGH und EuG in EUIPO-Verfahren, ÖBl 2019/59.

Accordingly, even the slightest degree of distinctiveness is sufficient to overcome this trade mark barrier.⁹⁹

Excursus: Proof of reputation

Where there are grounds for refusal of registration based on descriptiveness, genericness or lack of distinctiveness, this limit may be overcome by providing evidence of the reputation in accordance with Article 7 para 3 EUTMR or Article 4 para 4 TMD.¹⁰⁰ In the judgments already discussed, the issue of proof of reputation has already been partially addressed.

In the case of descriptive indications, an examination is made to determine whether the target public, or a significant proportion of it, no longer regards the sign as having a descriptive character in relation to the goods or services at issue by virtue of its use, but already recognises an indicator of origin from a particular company.¹⁰¹

It is also possible that signs which are not inherently distinctive as such may attain derivative distinctiveness on the basis of their reputation with the relevant public (if there were immediate distinctiveness, one would speak of original distinctiveness). The reputation must have been gained in the course of use for the goods or services at stake (actual distinctiveness). However, it is not a prerequisite that the relevant public is able to identify the specific company. The key point is that the targeted public can link the trade mark with the products of a particular origin. For this purpose, however, the simple fact that the mark is universally known without reference to the product is not regarded as being enough. Enforcement must have been carried out in the target public, but it is satisfactory if enforcement has been completed in a substantial part of the relevant public and that part is able to identify the mark as originating from a specific undertaking. It depends on an overall picture of all factors, such as the intensity of use, the geographical distribution and duration, the market percentage held etc.¹⁰²

⁹⁹ OGH 23 August 2018, 4 Ob 46/18w; *Schumacher*, Zur Unterscheidungskraft, Originalität und zum Mindestmaß an Interpretationsaufwand, ÖBl 2019/11.

¹⁰⁰ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 17.

¹⁰¹ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 17.

¹⁰² *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 13.

In the abovementioned 'Coca Cola' case¹⁰³, Coca Cola has not succeeded in demonstrating that the ripple-free bottle has gained distinctiveness as a result of its use in the course of trade. The trade questionnaires which were presented could not confirm whether they had been conducted on the basis of a ribbed or a rippleless bottle. In addition, the GC decided at that time that a questionnaire in ten of the then 27 Member States was not enough to establish distinctiveness for a considerable proportion of the target public across the whole European Union.¹⁰⁴

The GC is generally very strict as regards the proof of reputation. On 15 December 2016, for example, it ruled that it was not enough to demonstrate distinctiveness for 10 of the then 15 Member States with regard to a chocolate bar. Even if half of the total EU citizens of the left five member states still consider the sign as an allusion to the source of the goods, this is not enough. Accordingly, the lack of proof of distinctiveness in one EU Member State cannot be counterbalanced by a remarkably strong level of established distinctiveness in another, more populated Member State.¹⁰⁵

2.2.8. Shape or other characteristics of the product

According to Article 4 para 1 lit e TMD and Article 7 para 1 lit e EUTMR, signs which consist merely of the shape of goods or of another characteristic feature which is inherent in the goods themselves (first indent), which is necessary to obtain a technical result (second indent) or which gives substantial value to the goods (third indent) are also excluded from registration. This ground for refusal establishes an absolute need for trade marks to remain available (The Principle of Keeping Free, “Freihaltebedürfnis”), which cannot be overridden by recognition in the trade. In principle, a sign which constitutes the shape of a product is capable of being registered as a trade mark. The purpose of the ground for refusal is to avoid that the exclusive and enduring right conferred by a trade mark can serve to perpetuate other

¹⁰³ GC 24 February 2016, T-411/14, Coca Cola v OHIM.

¹⁰⁴ *Sattler*, Aktuelle Entwicklungen der Rechtsprechung zum Europäischen Markenrecht von Mitte 2017 bis Mitte 2019, EuZW 2019, 845.

¹⁰⁵ GC 15 December 2016, Mondelez UK Holdings & Services Ltd v EUIPO, Nestlé, available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=186272&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1>; *Sattler*, Aktuelle Entwicklungen der Rechtsprechung zum Europäischen Markenrecht von Mitte 2017 bis Mitte 2019, EuZW 2019, 845.

rights for which the EU legislator wanted to grant a restricted period of protection. A distinction is therefore drawn between technical property rights (patents and utility models) and copyright and design rights. Due to this wide interpretation, purely product-dependent shape marks are seldom possible. For a trade mark to be registered, features that go beyond technical functionality are required.¹⁰⁶ Following decisions shall grant an insight into the jurisdiction of the CJEU regarding shape and functionality based trade mark applications.

CJEU 18 September 2014, C-205/13, Hauck GmbH & Co. KG v Stokke A/S and others¹⁰⁷

That preliminary ruling was issued in the context of a dispute between Hauck GmbH & Co KG and Stokke A/S and others. In 1972, the Stokke Group launched a children's high chair, the "Tripp Trapp", which was granted copyright protection in Germany. The chair is characterised by inclined support struts to which components of the chair are fixed. In 1998, Stokke also applied to the Benelux Intellectual Property Office to register the chair's external design as a three-dimensional trademark, which was registered for chairs. Stokke sued Hauck for infringement of its trade mark and copyright, as Hauck marketed similar chairs. The action for copyright infringement was granted by a Dutch court, which ruled that the application for registration of the trademark was invalid in accordance with Hauck's application. The Dutch court held that the trade mark of the highchair was a sign composed solely of its shape and falling within the ground for refusal of registration laid down in Article 3 para 1 lit e of Directive 89/104/EEC¹⁰⁸ and invalidated the trade mark.

The case was submitted to the Hogen Raad of the Netherlands, which made three references to the ECJ for a preliminary ruling.

First, the Hogen Raad wished to know whether the provision should be interpreted as meaning that the ground for refusal applies only to a sign composed solely of the shape which is essential for the functioning of the product or also to a sign composed solely of the shape which has one or more fundamental characteristics for the use of the product which consumers may also look for in the products of other undertakings.

¹⁰⁶ *Schuhmacher/Rauch*, *Europäisches Marken-, Muster- und Urheberrecht* (2017) pages 18, 19.

¹⁰⁷ available at:

<http://curia.europa.eu/juris/document/document.jsf?text=&docid=157848&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=7864127>.

¹⁰⁸ predecessor of TMD, now to be found in Art 4 para 1 lit e TMD.

The ECJ stated that the grounds for refusal to register set out in Article 3 must always be read in the general interest. According to Art 3 para 1 lit e first indent, signs which solely comprise the shape of goods which is dictated by the nature of the goods themselves are not registrable. This obstacle does not apply if the trade mark application relates to a shape of goods for which another fanciful feature, not immanent to the function typical of the genre of the goods, is significant or substantial. Accordingly, shapes whose main features are immanent to the function of the product typical of the genre which consumers may be seeking are in principle excluded from registration.

The national court also asked the ECJ whether the third indent of Article 3 para 1 lit e must be interpreted as meaning that this ground for refusal applies to a sign composed solely of the shape of a product having numerous features which may, in different ways, give it considerable value, and whether the impression of the shape of the goods by the relevant public must be taken into consideration in that analysis. Under that provision, signs composed of the shape which gives considerable value to the product are not registrable. It is aimed at ensuring that the sole and lasting (trade mark) right cannot be used to eternalise other rights for which the Union legislature wished to limit the period of protection. The ECJ replied that the ground for refusal provided for in Article 3 para 1 lit e third indent of the Trade Marks Directive is applicable to a sign which is composed solely of the shape of a good having various features each of which, in different ways, is capable of conveying considerable value to it. The relevant public's perception of the shape of the product is only part of the evaluation criteria.

Thirdly, the Hoge Raad asked whether Article 3 para 1 lit e should be read as meaning that the grounds for refusal of registration set out in the first and third indent are jointly applicable, which the ECJ denied, referring to the autonomy or independence of the three grounds for refusal of registration. If one of the three criteria is met, the sign cannot be registered as a trade mark.¹⁰⁹

With regard to the second indent of Article 4 para 1 lit e TMD, the following decision has been taken.

¹⁰⁹ whole section: Haybäck, Neues zum Recht am geistigen Eigentum, Jahrbuch Europarecht 2015, 261; *Wiltschek*, Zur Eintragungsfähigkeit einer Formmarke, ÖBl 2015/16; *Zemann*, EuGH zu formbezogenen Markenregistrierungshindernissen, *ecolex* 2014/417.

The decision was issued in the course of proceedings between Koninklijke Philips Electronics NV and Remington Consumer Products Ltd. Philips invented a razor with three rotating heads in 1966 and applied for a trade mark in 1985, comprising a graphical illustration of the shape and nature of the upper surface of such a razor, made up of three round heads with rotatory knives arranged in the form of an synchronistic triangle. That mark was granted registration under the Trade Marks Act of England due to the use made of it. In 1995 Remington also developed and marketed a razor with three triangular rotating heads in a comparable form. Philips brought an action for infringement of its trade mark right and Remington applied for a declaration of invalidity of the trade mark which had been registered for Philips. The High Court of Justice (England and Wales) declared Philips' trade mark application invalid. Philips challenged that decision before the Court of Appeal, which ordered it to refer four questions to the ECJ for a preliminary ruling.

The national court is asking, first of all, if there exists a category of marks which cannot be prevented by Article 3 para 1 lit b to d and para 3 of Directive 89/104/EEC¹¹¹ but are nevertheless prohibited by Article 3 para 1 lit a¹¹² of that Directive on the basis that they are not suitable for differentiating the product of the owner of the mark from those of other companies. The ECJ states that there exists no category of trade marks which are not precluded from being registered on the basis of Article 3 para 1 lit b to d and para 3 of the Directive, but are precluded from being registered on the basis of Article 3 para 1 lit a of the Directive, because they are not suitable for differentiating the products of the owner of the trade mark from those of different companies.

Secondly, the national court asked essentially if the shape of a product (for which the sign was granted registration) is able to differentiate that product within the meaning of Article 2 of the Directive only if that shape has some arbitrary additive feature, for example, an ornamentation without functional significance. The ECJ denied this. According to Article 2, the relevant shape must merely be suitable to differentiate the goods of the trademark owner from those of other companies.

¹¹⁰ available at: <https://eur-lex.europa.eu/legal-content/EN/ALL/?uri=CELEX%3A61999CJ0299>.

¹¹¹ predecessor of TMD, now to be found in Art 4 para 1 lit b-d TMD.

¹¹² now Art 4 para 1 lit a TMD.

Thirdly, the national court asked whether, in cases where an operator was the sole provider of certain goods and services, prolonged usage of a sign comprising the shape of these products could be enough to render the sign distinctive within the meaning of Article 3 para 3 of the Directive if, as a consequence of that usage, a significant part of the target public links the shape to that operator and not to any other undertaking. The ECJ affirmed this. Where an operator was the sole provider of certain products on the market, extended usage of a sign comprising the shape of these products can in general be enough to confer distinctiveness on the sign within the meaning of Article 3 para 3 of Directive 89/104/EEC if, as a consequence of such usage, a significant part of the targeted public links the shape with that operator and with no other company, or assumes that goods with this shape originate from that operator. It is nevertheless for the referring court to ascertain whether the conditions laid down in that provision are fulfilled are supported by concrete and credible information, whether account is taken of the perception of the category of products or services at issue in the mind of the reasonably attentive and knowledgeable average consumer, and whether it is through use of the mark as a trade mark that the targeted public perceives the goods as coming from a specific company.

The national court is asking by its final question whether the second indent of Article 3 para 1 lit e of the Directive must be understood as meaning that a sign composed solely of the shape of a good is incapable of being registered under that provision if it is proven that the main functional characteristics of that shape are allocable exclusively to the technological function. It also asks whether that certain ground for refusal can be overruled by showing that there exist other possible forms which could achieve the same technological function. According to the ECJ, the second indent of Article 3 para 1 lit e of the Directive must be understood as meaning that a sign composed solely of the shape of the goods is not capable of being registered under that provision if it is proven that the main functional characteristics of that shape are exclusively allocable to the technological function. Furthermore, proof that there are alternative shapes capable of producing the same technological function does not remove the ground for refusal or invalidity under that provision.¹¹³

CJEU 12 June 2018, C-163/16, Christian Louboutin ao v Van Haren Schoenen BV¹¹⁴

¹¹³ The information for the whole section come from the judgement itself and *Gamerith*, CJEU 18 June 2002, C-299/99, ÖBI 2003/15.

¹¹⁴ available at: <http://curia.europa.eu/juris/liste.jsf?language=de&jur=C,T,F&num=C-163/16&td=ALL>.

This reference for a preliminary ruling concerns the interpretation of Article 3 para 1 lit e third indent of Directive 2008/95/EC¹¹⁵. It is the result of infringing proceedings between Chrisitan Louboutin and Van Haren Schoenen BV concerning the trading of shoes which are regarded as being in breach of the trade mark of which Louboutin is the owner. On 28 December 2009, Mr Louboutin lodged an application with the Benelux Intellectual Property Office for registration of a Benelux trade mark in respect of the class of goods 'footwear'. The mark was visualised by means of a figurative representation together with the explanation that the mark is composed of the colour red affixed to the sole of a shoe as illustrated in the picture.

By its question, the Rechtbank Den Haag sought to obtain an answer to the question whether Article 3 para 1 lit e third indent of the Directive must be understood as meaning that a sign such as that in dispute in the case in the main proceedings, which is composed of the paint deposited on the sole of a high-heeled shoe, is composed solely of the 'shape' within the meaning of that provision. The ECJ held in that regard that that provision must be read as meaning that a sign such as that in the present proceedings cannot be composed solely of the 'shape' within the meaning of that provision. The ECJ examined whether a positional mark can also be a "shape" and rejected this. However, this gap in the regulation was closed by the reform of the TMD, as the European legislator also extended the scope of the provision to other characteristic features.¹¹⁶

The decision of the European Court of Justice of 16 September 2015¹¹⁷ is also remarkable: here, too, the Court was reluctant to recognise a shape mark. Cadbury had objected to the fact that the ribbed KitKat chocolate bar shape was registered as a shape mark in the United Kingdom on behalf of Nestlé. The ground for refusal in this case might be that one feature of the shape (the bar) is determined by the product itself, but other characteristics (the ribs) are required to achieve a technological function (Article 3 para 1 lit e of Directive 89/104/EEC¹¹⁸). The ECJ clarifies that technological function means only the function itself,

¹¹⁵ now governed by Article 4 para 1 lit e of Directive 2015/2436 (TMD).

¹¹⁶ Information on this section derive from the judgment, as well as *Sattler*, Aktuelle Entwicklungen der Rechtsprechung zum Europäischen Markenrecht von Mitte 2017 bis Mitte 2019, EuZW 2019, 845.

¹¹⁷ CJEU 16 September 2015, C-215/14, Société des Produits Nestlé v Cadbury UK Ltd, available at: <http://curia.europa.eu/juris/liste.jsf?language=de&num=C-215/14>.

¹¹⁸ now regulated in Art 4 para 1 lit e TMD.

not also the fabrication method. However, the shape mark can only be granted registration if distinctiveness is given independently of other features, such as the words "KitKat" or the red packaging.¹¹⁹

However, it has to be emphasised at this point that Art 4 para 1 lit e TMD is also applicable to signs other than three-dimensional signs which are not eligible for registration if they are of a kind, technical or value. For example, the sound of a motor as a sound mark for vehicles.¹²⁰

2.2.9. Public policy and morality

Signs which are contrary to public policy or morality are also excluded from registration under Article 4 para 1 lit f TMD and Art 7 para 1 lit f EUTMR. This includes in particular signs that are potentially offensive to religious beliefs or signs with pornographic content. It is important and remarkable here that the ground for refusal is to be interpreted on the basis of European standards, but at the same time the grounds for refusal from registration of a Union trade mark are already fulfilled if the certain barrier exists in only one part of the European Union. It is therefore sufficient if a sign has an offensive meaning in one language.¹²¹ The aim of this provision is to prevent the registration of trade marks, where conferring of a dominant position would be in breach of the rule of law or would be considered by the target public to be wholly contrary to the fundamental moral standards of the community.¹²²

GC 15 March 2018, T-1/17, La Mafia Franchise v EUIPO

The legal predecessor of La Mafia Franchises, La Honorable Hermandad, filed an application to the European Union Intellectual Property Office (EUIPO) for registration of the Union trade mark 'La Mafia se sienta a la mesa' (meaning: the Mafia takes a seat at the table) for the class of catering services. Italy brought an application for annulment of that mark in 2015,

¹¹⁹ Grünberger/Podszun, Die Entwicklung des Immaterialgüterrechts im Recht der Europäischen Union in Jahr 2015 (Teil II), GPR 2016, 87.

¹²⁰ Jaeger/Weller, Das neue europäische Markenrecht, ecolex 2015, 1066.

¹²¹ Schuhmacher/Rauch, Europäisches Marken-, Muster- und Urheberrecht (2017) page 19.

¹²² Decision No EX-15-2 of the President of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) of 8 July 2015, available at: <https://www.wipo.int/edocs/lexdocs/laws/en/eu/eu211en.pdf>.

claiming that the mark was against both public policy and morality. EUIPO decided to grant the application, stating that the mark encouraged the criminal organisation identified by the name "Mafia" and downplayed it by expressing sociability. In addition, the trade mark failed to meet the required seriousness. La Mafia Franchises applied to the GC for annulment of the EUIPO decision, which dismissed the action.

In the decision, the GC stated that the words 'la Mafia' were the dominant component of the mark in dispute and were associated throughout the world with the Mafia as a criminal organisation and its operations, which, in the view of the GC, comprised brutality, threats of murder, laundering of money and trading in drugs and weapons. The court regarded this as a breach of the fundamental core values of the EU, namely human dignity and freedom rights, which constitute the cultural, ethical and moral legacy of the EU. Furthermore, the Mafia's activities represented a grave danger to security and order in the whole area of the European Union. Although, by filing the application for registration of the trade mark 'La Mafia se sienta a la mesa', the applicant argues that the mark 'La Mafia se sienta a la mesa' may have been linked more to the film 'The Godfather' than to the provocation of an insult, the negative perception of that mark by the relevant public must be examined individually. The recognition gained by the mark is also negligible. Nor does the fact that it occurs in numerous novels and movies hinder the awareness of the offences committed by the Mafia. Furthermore, the GC joined Italy and the EUIPO in their view that the trade mark is overall suitable to portray the Mafia in a favourable manner, thus downplaying its practices and thereby offending and insulting the victims of the Mafia, their families and the EU as a whole. The GC therefore upheld the EUIPO's declaration of invalidity of the mark at issue.¹²³

GC 20 September 2011, T-232/10, Couture Tech Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Design) (OHIM)¹²⁴

In 2006, Couture Tech Ltd, a company associated with the international activities of a Russian fashion designer, applied to the Office for Harmonisation in the Internal Market

¹²³ Information of this whole section derive from *Raab*, EuG: Mafia-Marke verstößt gegen die öffentliche Ordnung, MMR 2018 (April); *Majchrzak/Bartos*, Rechtsprechung des EuGH und EuG in EUIPO-Verfahren, ÖBl 2018/28; *Schramek*, Neues zur Unionsmarke aus Alicante und Luxemburg, Jahrbuch Geistiges Eigentum 2019, 153.

¹²⁴ available at:
<http://curia.europa.eu/juris/document/document.jsf?text=&docid=109802&pageIndex=0&doclang=DE&mode=req&dir=&occ=first&part=1>.

(OHIM) for registration of a figurative sign as a Community trade mark. OHIM rejected that application because the mark was made up of an identical reproduction of the coat of arms of the former Union of Soviet Socialist Republics (USSR). On the basis of provisions of law and official practice in certain Member States, namely Hungary, Latvia and the Czech Republic, OHIM found that the represented symbols were regarded as offensive to public policy and morality by a significant part of the target public in the part of the European Union under Soviet domination. Couture Tech Ltd brought an action before the GC for annulment of that decision. In its judgment, the GC held that, in interpreting the notions of 'public policy' and 'accepted principles of morality', consideration must be given not only to the circumstances shared by all the member states but also to the specific circumstances in each of them which are capable of having an influence on the awareness of the target public in the territory of those states. The GC finds that the Board of Appeal has not erred in concluding, on the basis of an analysis of aspects of the circumstances in Hungary, that the mark applied for is unlawful or detrimental to public policy or to accepted principles of morality in the mind of the target public. According to the Hungarian legal provisions, the hammer and sickle and the pentagonal red star are regarded as 'symbols of despotism', the use of which is against public policy. Accordingly, the GC dismissed the action.¹²⁵

GC 24 January 2018, T-69/17, Constantin Film Produktion GmbH v EUIPO¹²⁶

The German film title "Fack Ju Göhte" was also classified as unregistrable by the GC on 24 January 2018 due to its offence against public morals. The relevant public would equate the sign with the English expression "fuck you" and associate it with the surname of Goethe. Since the English expression 'fuck you' is originally attributed a sexual significance and is used in another context as an expression of anger, disappointment or disrespect for another person, it is characterised by vulgarity overall. The general public relevant in this respect could find this offensive. Although the element 'Göhte', which is similar to the name Goethe, makes it possible to determine the 'addressee' of the first two words, it is not capable of reducing the vulgarity. Nor does the choice of a particular spelling give the sign any satirical,

¹²⁵ information derive from the judgement itself as well as: *Redaktion beck-aktuell*, Verlag C.H. Beck, EuG: Sowjetisches Staatswappen nicht als Gemeinschaftsmarke eintragungsfähig, becklink 1016165.

¹²⁶ GC 24 January 2018, T-69/17, Constantin Film Produktion GmbH v EUIPO, available at: <http://curia.europa.eu/juris/liste.jsf?language=de&td=ALL&num=T-69/17>.

joking or playful content. The fact that several million people in the German speaking member states have seen the film "Fack Ju Göhte" does not mean that the sign will not shock the relevant public. An appeal is currently pending before the ECJ on C-214/18 p.¹²⁷

2.2.10. Suitability for deception

The ground for refusal of suitability for deception is where a sign is capable of misleading the public as to the kind, quality or geographical origin of the goods or services. The relevant provisions are to be found in Article 4 para 1 lit g TMD and Art 7 para 1 lit g EUTMR. It is measured in terms of the perception of the relevant public. Where the signs are directed at the general public, the average consumer is deemed to be reasonably well informed, observant and circumspect, in accordance with general principles relating to consumers.¹²⁸

As an example of a sign which has been classified by the GC as being deceptive, "Klosterstoff" can be mentioned. The word mark should be registered for non-alcoholic beverages, especially non-alcoholic beer. However, the word element "Stoff" is associated with alcohol and is therefore misleading, giving the consumer the idea that this non-alcoholic drink includes alcohol.¹²⁹

The ECJ clarified in its decision of 8 June 2017 that for the application of Article 7 para 1 lit g it is not the behaviour of the trade mark owner after registration that is relevant, but only whether the registered trade mark itself is liable to mislead the consumer as to its quality.¹³⁰

The jurisdiction of the Austrian Supreme Court (OGH) goes along with this. It also confirms that, in assessing whether a mark is likely to deceive, the only relevant factor is how the target

¹²⁷ information of this section derive from the judgement as well as: *Sattler*, Aktuelle Entwicklungen der Rechtsprechung zum Europäischen Markenrecht von Mitte 2017 bis Mitte 2019, EuZW 2019, 845; *Terlitza*, EuG 24.1.2018, T-69/17, ÖBl-LS 2018/23.

¹²⁸ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 19.

¹²⁹ GC 26 October 2017, T-844/16, *Alpirsbacher Klosterbräu Glauner GmbH & Co KG v EUIPO*, available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=199382&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1>; *Majchrzak/Bartos*, Rechtsprechung des EuGH und EuG in EUIPO-Verfahren, ÖBl 2018/5.

¹³⁰ CJEU 8 June 2017, C-689/15, *W.F. Gözze Frottierweber GmbH, Wolfgang Gözze v Verein Bremer Baumwollbörse*, available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=191306&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1>; *Sattler*, Aktuelle Entwicklungen der Rechtsprechung zum Europäischen Markenrecht von Mitte 2017 bis Mitte 2019, EuZW 2019, 845.

public understands the indication conveyed by the mark. It is irrelevant whether these indications are objectively true and whether the applicant is in good faith. The possibility of deception is sufficient. The perception of the informed consumer must be taken into account. If an application is unclear, the applicant must accept the interpretation which is most unfavourable to him. The ground for refusal of registration based on deceptiveness exists even if single components of a combined mark may give rise to misconceptions about the content of the goods marketed under this mark. In the specific case at hand, the trademark "Immobilienring" was at issue, which also gives the impression to reasonable consumers that the range of services offered by a company in the field of real estate business is characterised by this trademark. The trademark was therefore not registrable for a "Offene Handelsgesellschaft".¹³¹

One issue related to deception is that of bad faith trademark applications. In its decision of 11 June 2009, the ECJ for the first time listed criteria regarding the applicant's bad faith in applying for Union trade marks. According to the ECJ, the submission of an application for a Union trademark is especially considered to be bad faith if the person filing the application is aware or must be aware that a third person is currently making use of an equal or comparable sign in at a minimum of one member state for an equal or comparable product or for a product that is mistakably comparable to the sign for which the application has been lodged. Moreover, in cases where it is the applicant's aim to hinder that third person from carrying on using such a sign and where there is an objective aim to benefit from the level of legal rights which the third person's sign and the sign for which registration is sought enjoy.¹³² In its judgment of 14 May 2019, the GC added further criteria. In its reasoning, it states that the EUIPO should in particular also consider the application of the sign since its establishment and its origin, as well as the commercial and economic objectives on which an application is based. The timeline of happenings and the subjective motives of the applicant are also noteworthy, but subject to the proviso that they can be substantiated by objective evidence. In

¹³¹ *Schanda*, OGH 13 February 2001, 4 Ob 316/00z, ecolex 2001/157.

¹³² CJEU 11 June 2009, C-529/07, *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*, available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=74488&pageIndex=0&doclang=de&mode=lst&dir=&occ=first&part=1&cid=494497>.

the present case, the applicant wished to take advantage of the reputation of a well-known footballer by filing the application for registration of the word "NEYMAR".¹³³

2.2.11. National emblems

Another limit to trade mark protection is the ground for refusal of national emblems (like sovereign or quality marks, flags, official symbols), regulated in Article 4 para 1 lit h TMD and Article 7 para 1 lit h and i EUTMR (in conjunction with Art 6ter PVÜ).¹³⁴

In a decision concerning an application for registration of a maple leaf (Canadian emblem) as a Community trade mark, the ECJ stated the following. Art. 6ter of the Paris Convention lays down a provision prohibiting the reproduction of a national emblem in the so-called heraldic sense, i.e. reproductions which have the heraldic intension which differentiates the emblem from other signs. Even a trade mark which fails to accurately imitate a State emblem may fall under Article 6ter of the Paris Convention if it is understood by the target public as a reproduction of such a sign. Not every dissimilarity between the mark applied for and the State emblem, as found by a heraldic expert, will inevitably be noticed by the general public, which may consider the mark to be an reproduction of the emblem at issue, despite disparities at the level of some heraldic elements.¹³⁵

In the case of a word and figurative mark consisting of a blue and red lettering with the text "European Network Manufacturing", backed by a circle of red and white stars, the GC ruled as follows. In this case, it might be an reproduction of the flag of Europe. The heraldic characterisation of the flag of Europe is as follows: On a blue background a circular pattern of 12 pentagonal stars, their tips not touching. Consequently, it is not contested that the mark in question does not comprise an identical imitation of the flag of Europe. By contrast, the mark in dispute can only be viewed as a reproduction in the heraldic meaning of the European flag.

¹³³ *Sattler*, Aktuelle Entwicklungen der Rechtsprechung zum Europäischen Markenrecht von Mitte 2017 bis Mitte 2019, EuZW 2019, 845; GC 14 May 2019, T-795/17, *Moreira v EUIPO "Neymar"*, available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=214045&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=4676073>.

¹³⁴ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 20.

¹³⁵ CJEU 16 June 2007, Joined Cases C-202/08 P and C-208/08 P, *American Clothing Associates NV v OHIM*, available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=74227&pageIndex=0&doclang=DE&mode=req&dir=&occ=first&part=1>; *Kur/Dreier*, European Intellectual Property Law: Text, Cases and Materials (2013) page 189.

It replicates the only motif of the flag, a circular arrangement of pentagonal stars, the tips of which do not touch.

Furthermore, on the basis of a comprehensive assessment, it cannot be ruled out that the relevant target public might think that the products and services covered by the mark in question are subject to an authorisation or guarantee from the European Union or are in some other way associated with it. It is therefore clear that the disputed mark causes the impression to the public that there is a connection between the trade mark applicant and the European Union..¹³⁶

2.2.12. Designations of origin, geographical indications, traditional terms for wine, traditional specialities guaranteed, earlier plant variety rights

The grounds for refusal referred to in Article 7 para 1 lit j - m EUTMR are reference law rules. In the case of lit j, trade marks containing designations of origin and geographical indications which are not registrable under other provisions are excluded from registration. Lit k contains regulations for traditional names for wines, lit l for traditional specialities guaranteed and lit m for variety indications which were protected earlier.

For lit m, it is decisive whether a variety indication has already been protected earlier elsewhere. A variety indication is considered to be "earlier" if it has already been registered in another register before the filing date of the Union trademark application.¹³⁷ To give an example here, the term "Kordes' Rose Monique" has been classified as registrable for roses and rose plants. The ECJ stated that lit m aims to guarantee the free availability of plant variety descriptions and to forbid them from being monopolized. In the Dutch plant variety protection register, protection for a rose variety with the name "Monique " existed from July 2005. Nevertheless, that element has no leading role in the sign as a whole, since the only

¹³⁶ GC 13 March 2014, T-430/12, Heinrich Beteiligungs GmbH v OHIM; Knapp-Untermoser, Aktuelle Entscheidungen des EuG in Markensachen (u.a. Nachahmung der Europaflagge), available at: <http://media-law.at/?p=982>.

¹³⁷ whole section: *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 20.

differentiating and prevailing word element "Kordes" can identify the commercial source of the goods, while the name "Monique" stays publicly accessible.¹³⁸

2.2.13. Excursus: relative grounds for refusal

In addition to the absolute grounds for refusal listed in points 2.2.1. to 2.2.12., the TMD and EUTMR also provide for relative grounds for refusal. These are characterised by the proviso that they are only to be taken into account in the event of an opposition by the owner of an earlier trade mark. Accordingly, registration of a trade mark is precluded if it is the same as an earlier trade mark registered for the same goods or services (Art 8 para 1 lit a EUTMR, Art 5 para 1 lit a TMD).¹³⁹

On the other hand, there is no possibility of registration if the trade mark is identical with or comparable to an earlier trade mark and there is a likelihood of confusion because of the identity or similarity of the goods or services (Art 8 para 1 lit b EUTMR, Art 5 para 1 lit b TMD).¹⁴⁰ For example, on 17 February 2016, the ECJ found that there was a likelihood of confusion between two figurative marks on the basis of visual resemblance. The earlier figurative mark had three parallel-running bands (directed to the left) and the figurative mark in application was composed of two parallel-running bands, directed in the opposite direction, for registration for sports shoes. According to the GC, the overall visual effect produced by the signs is comparable because of the common elements, in particular the lateral transverse bands, which are positioned in the same way, and the same width and parallel orientation, which contrast with the basic colour of the shoe. On the other hand, the existing disparities can be recognised only by the orientation, whether to the left or to the right, and by the number of bands. However, those differences are not sufficient to eliminate the similarity between the signs.¹⁴¹ An enhanced degree of distinctiveness as a result of usage is not to be recognised when comparing the signs. However, enhanced distinctiveness in consequence of

¹³⁸ GC 18 June 2019, T-569/18; *Bartos*, Rechtsprechung des EuGH und EuG in EUIPO-Verfahren, ÖBl 2019/59.

¹³⁹ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 21.

¹⁴⁰ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 21.

¹⁴¹ *Sattler*, Aktuelle Entwicklungen der Rechtsprechung zum Europäischen Markenrecht von Mitte 2017 bis Mitte 2019, EuZW 2019, 845; CJEU 17 February 2016, C-396/15 P, *Shoe Branding Europe BVBA, Adidas AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM).

usage may be taken into consideration in order to identify the dominant features of the earlier sign.¹⁴²

Finally, registration shall also be refused if the trade mark is the same as or is similar to an earlier trade mark with a reputation and is to be registered for goods or services which are dissimilar but where the use of the trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark without justifying grounds (Art 8 para 5 EUTMR, Art 5 para 3 TMD).¹⁴³ Accordingly, well-known marks enjoy broader protection. The recognition of the trademark for this purpose doesn't have to be spread over an overall national territory, but it is enough if the trademark has a recognised reputation in a considerable part of the country.¹⁴⁴

The requirement of the "earlier" mark is met if there are registered or applied for national or Union marks with earlier priority and famous marks. The EUTMR allows for opposition procedures in the event of relative grounds for refusal. The first step of this procedure is a resemblance analysis, which also encompasses national trade marks by the respective authorities. After the resemblance analysis the application is published and owners of earlier identical or comparable trade marks receive notification (Art 38 EUTMR). Thereupon the owner of an earlier trade mark is entitled to lodge an opposition against it within a period of three months.¹⁴⁵

In order to be able to draft an opposition, no sole ownership is required. This was recently decided by the GC in a decision in which the parties were members of a music band. This band had achieved popularity in Spain and the Union. Some members of the group had applied for registration of the band name as a Union trade mark. Another former member of the band, who was proven to use the word in the music sector, filed an opposition. The GC decided that an opposition did not require evidence that the opponent was the sole owner of the well-known mark.¹⁴⁶

¹⁴² *Majchrzak/Bartos*, Rechtsprechung des EuGH und EuG in EUIPO-Verfahren, ÖBl 2019/18.

¹⁴³ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 21.

¹⁴⁴ CJEU C-375/97 *General Motors Corporation v Yplon SA*; *Seville*, Intellectual Property. International and Comparative Law Quarterly (2011) page 1050.

¹⁴⁵ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 21.

¹⁴⁶ *Sattler*, Aktuelle Entwicklungen der Rechtsprechung zum Europäischen Markenrecht von Mitte 2017 bis Mitte 2019, EuZW 2019, 845; GC 11 December 2017, T-249/15, *JT v European Union Intellectual Property Office (EUIPO)*, Eduardo Carrasco Pirad.

If an opposition is filed, the opposition procedure will determine whether the application should be refused (Art 41 and 42 EUTMR).¹⁴⁷ In opposition procedures, the opposing party has the possibility, but not the obligation, to furnish proof of the opposition. If there is a lack of evidence and arguments from the parties, particularly with regard to similarity, EUIPO may demand that the parties provide documents in order to decide on any possible likelihood of confusion.¹⁴⁸ The grounds for refusal may also be raised after the registration of the mark as a ground for invalidity (Art 53, 54 EUTMR). The TMD also provides in its Art 43 the possibility of opposition procedures upon filing. The assessment of the relative grounds for refusal involves an abstract comparison of the two conflicting marks. The grounds for refusal of registration relating to the identity, the risk of confusion and the protection of the mark with a reputation correspond to the exclusion rights of the owner of the trade mark, which are to be dealt with equally.¹⁴⁹

The relative grounds for refusal therefore serve different purposes from the absolute grounds for refusal and are aimed at protecting different interests. Whereas the absolute grounds for refusal of registration are to maintain the availability of the mark for all the trade operators and thus to ensure the general interest or to secure distinctiveness, the relative grounds for refusal of registration seek to protect the specific interests of the owners of the earlier marks in respect of which registration is sought.¹⁵⁰

¹⁴⁷ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 21.

¹⁴⁸ *Folliard-Monguiral/Rogers*, European Union trade mark round-up 2017, Journal of Intellectual Property Law&Practice, 2018 Vol.13, No 5 page 365.

¹⁴⁹ *Schuhmacher/Rauch*, Europäisches Marken-, Muster- und Urheberrecht (2017) page 21.

¹⁵⁰ CJEU 22 October 2015, C-20/14, BGW Beratungs-Gesellschaft Wirtschaft mbH v Bodo Scholz, available at: <http://curia.europa.eu/juris/document/document.jsf?text=&docid=170310&pageIndex=0&doclang=DE&mode=lst&dir=&occ=first&part=1&cid=314679>.

3. Conclusion

The aim of this master thesis was to give a broad overview of the existing absolute grounds for refusal of registration of a trade mark, for which an application has been filed. An insight into the functions of a trade mark, the concept of trade mark capacity and the potential economic value of a registered trade mark illustrate the importance of a detailed set of rules on grounds for refusal of registration of trade marks. The more precise the provisions regarding applications for trade mark rights are, the more transparency and legal certainty can be achieved by means of a clear allocation of rights sought.

The system of the abovementioned grounds for refusal is thus characterised by an interplay between distinctiveness, reputation and the need to preserve availability. Those types of grounds for refusal may be partially remedied, even if a ground for refusal exists, by proof of reputation. A second group of regulations is based on the enforcement of public policy objectives. This includes the provisions on sovereign and national emblems and trade marks containing indications contrary to public policy and morality. This is to be distinguished from the ground for refusal of registration for deceptive signs. There is also a separate concept behind the registration obstacle concerning the designation of wines, spirit drinks and geographical indications. In addition, the relative grounds for refusal also entail their own idea of protection, granting an individual person, the owner of the earlier trade mark, protection rights.¹⁵¹

Although each of those grounds for refusal is independent of the others, there is an overlap in scope because of the inherent connections between them. Accordingly, the "independence" of the grounds for refusal must be interpreted as meaning that each ground for refusal demands its own separate examination.¹⁵² With regard to the territorial requirements, it can be stated in summary that grounds for refusal of registration already become relevant if they exist in only part of the Community.

¹⁵¹ *Koppensteiner*, Markenrecht (2012) Erwerb des Markenrechts point 6.

¹⁵² *Koppensteiner*, Markenrecht (2012) Erwerb des Markenrechts point 7.

All in all, however, this master thesis should also be proof that trademark law, and in particular the field of grounds for refusal of registration when applying for a trade mark, is already very sophisticated and well developed. Each of the grounds for refusal of registration contained in the catalogue of barriers is substantiated by decisions of the European Court of Justice or the General Court, which made the legislator's objective more comprehensible and easier to apply in the future. As the Master thesis contains decisions of the European Court of Justice from 1999 onwards until 2019, it was also intended to illustrate that the system of how the European Court of Justice approaches a decision has not undergone any major changes in the last twenty years. This means that there have been no significant divergences from previous decisions by the Court itself. But at national level, too, the highest courts are guided by the case law of the European Court of Justice, so that harmonisation and alignment throughout the Union is already very advanced.

It is questionable whether the catalogue of barriers to registration will be extended in the future. However, due to the recent amendment of the TMD and the EUTMR, which aimed to include the obstacles brought about by the Internet, this is not to be expected, at least not in the near future.

The current legal situation regarding limits to trade mark protection creates a fair balance between the rights of trade mark owners and the scope for action of third parties and, in my opinion, offers a high standard of legal protection.

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5. Abstract

Die in der Markenrechtsrichtlinie und der Unionsmarkenverordnung enthaltenen Regelungen über die absoluten Eintragungshindernisse von Zeichen oder Marken spielen eine bedeutende Rolle im Rahmen des Erwerbs von Markenrechten. Sie sollen den Schutz und die Gewährleistung der Fähigkeiten und Funktionen einer Marke sicherstellen. Auch der wirtschaftliche Wert, den Marken für ein Unternehmen darstellen können, soll durch die Eintragungshindernisse garantiert werden. Durch die genauen Regelungsinhalte der Markenrechtsrichtlinie und der Unionsmarkenverordnung wurde europaweit für Transparenz und Rechtssicherheit auf diesem Gebiet gesorgt.

Das System der Eintragungshindernisse zeichnet sich durch ein Zusammenspiel von Unterscheidungskraft von Zeichen, Freihaltebedürfnis und Bekanntheit aus. Die jeweiligen unterschiedlichen Eintragungshindernisse verfolgen auch unterschiedliche Ziele und Schutzinteressen. Während einige Hindernisse die Ursprungsidentität von der mit der Marke gekennzeichneten Produkte gewährleisten sollen, zielen andere Hindernisse darauf ab, dass Zeichen oder Angaben von allen Wirtschaftsteilnehmern genützt werden können im Sinne eines Freihaltebedürfnisses. Wieder andere Eintragungshindernisse sollen jedoch für den Schutz von öffentlicher Ordnung und Moral sorgen. Die andersgearteten Zielsetzungen der Eintragungshindernisse spiegeln sich auch darin nieder, dass die einzelnen Schranken von einander unabhängig sind und auch unabhängig voneinander beurteilt werden sollen. Naturgemäß bestehen aber dennoch viele inhaltliche Überschneidungen zwischen den Schranken selbst.

Das zuvor genannte genaue Regelungssystem des europäischen Gesetzgebers wird unterstützt durch die Rechtsprechung des Europäischen Gerichtshofs. Es liegen unzählige Entscheidungen zu den einzelnen Eintragungshindernissen vor. Das Ziel dieser Arbeit war einen Überblick über die Methodik der Entscheidungen des Europäischen Gerichtshofs zu schaffen, wofür Entscheidungen der letzten zwanzig Jahre herangezogen wurden. Auch höchstgerichtliche Entscheidungen aus dem deutschsprachigen Raum fanden Einzug in die Masterarbeit.

The rules contained in the Trade Marks Directive and the Union Trade Mark Regulation on the absolute grounds for refusal of registration of signs or trade marks play an important role in the context of the acquisition of trade mark rights. They are intended to protect and guarantee the capabilities and functions of a trade mark. The economic value which trade marks may represent for a company is also to be ensured by the grounds for refusal of registration. The precise regulatory content of the Trade Mark Directive and the Union Trade Mark Regulation has ensured transparency and legal certainty in this area throughout Europe.

The system of grounds for refusal of registration is characterised by an interplay between the distinctiveness of signs, the need to preserve availability and reputation. The different grounds for refusal also pursue different objectives and protection interests. While some obstacles are intended to guarantee the identity of the origin of the products bearing the trade mark, other obstacles are intended to ensure that signs or indications can be used by all economic operators in accordance with the need to keep them available. However, still other grounds for refusal of registration are intended to protect public order and morals. The different objectives of the grounds for refusal are also reflected in the fact that the individual barriers are independent of each other and should also be assessed separately. However, there are naturally many overlaps in content between the barriers themselves.

The aforementioned precise regulatory system of the European legislator is supported by the case law of the European Court of Justice. There are countless decisions on the individual barriers to registration. The aim of this work was to provide an overview of the methodology of the decisions of the European Court of Justice, using decisions of the last twenty years. Decisions of the highest courts in the German-speaking area were also included in the Master's thesis.