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**DOUBLE IDENTITY TRADEMARK PROBLEM:  
A COMPARATIVE ANALYSIS OF THE EUROPEAN UNION AND UNITED  
STATES LAW AND CASE LAW**

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## Abstract

The goal of this thesis is to examine the grounds on which two trademarks of different trademark owners are considered identical. Generally, the situation when the two trademarks are identical as regards their expression and the goods and services in connection with these are registered or used is called as the „*double identity*“ trademark problem. Every legitimate trademark owner shall try to avoid this situation in order to protect the functions of their trademark. These functions are discussed in the thesis as well. Having known these grounds is important for legitimate trademark owner to bring infringement and also they can serve as guidelines for those who have to defend their rights before the public authority or the court. Firstly, I discussed the provisions as regards the double identity trademark problem the in the international treaties, which were signed by the EU Member States and the US. Then, I examined legislation, case law and doctrinal debate as regards double identity trademark problem in the EU and the US jurisdiction individually. Finally, I compared the approach to the most problematic issues founded in both jurisdictions. I used the comparative analysis of the EU and the US jurisdiction because of their different legal history, offering unique approaches how to deal with the double identity trademark problem.

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## Introduction

Today, when companies want to attract consumers to buy their product or service, they spend a great expense not only on the product's quality development but also on massive marketing. Apart from famous marks which are privileged in this battle of other competing brands, newcomers to the market must work hard to be noticed by consumers. In order to attract consumers and to save money, some of these competitors copy the trademark of a rival.<sup>1</sup>

Therefore, the protection of these trademarks before unjust use is very important for their owners. In this thesis, I will focus on the factors which determine that some company or a person uses his trademark in contrary to somebody else trademark's owner and on the possible defense of such an impaired owner. More specifically, I will narrow down my research only to the use of a sign identical to the trade mark in relation to goods or services identical to that for which it is registered<sup>2</sup> or already used. This situation is known as the double identity problem and I will use this abbreviated term in the thesis to designate such a situation.

This problem causes various problems to the legitimate trademark's holder such as lower sales volume and prices, damaged brand value and company reputation, lower royalties and also higher cost spent on efforts to combat counterfeiting.<sup>3</sup> This issue is particularly important because, in today's battle of trademarks to attract new customers, the trademark in

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<sup>1</sup> Robert P. Merges and others, *Intellectual Property in the New Technological Age* (6<sup>th</sup> edn, Wolters Kluwer Law & Business 2012) 763.

<sup>2</sup> Blythe, Alice, 'Confusion online: does the test for trade mark confusion on the internet differ from that applied to infringement in other spheres?' (2014) 36(9) *European Intellectual Property Review* 563, 566.

<sup>3</sup> Organization for Economic Co-operation and Development, 'The Economic Impact of Counterfeiting and Piracy' (2007) 18 <<https://www.oecd.org/sti/38707619.pdf>> accessed 11 February 2017.

successful companies has a rising value. In particular, multinational companies are very protective to any motion which could lead to an infringement of their trademark. Moreover, producers rely upon trademarks increasingly as “*they have lost any direct contact with the consumer*”.<sup>4</sup>

The research question of my thesis is on what grounds either applicant or competent authority should consider two trademarks as being identical and what is the defense of an impaired trademark’s proprietor. I will consider the criteria determined in the European Union (‘EU’) and the United States (‘US’) legislation and in the decisions of the Court of Justice of the European Union (‘CJEU’) and the US courts. Also, I will emphasize the problematic issues pointed out by scholars in both jurisdictions.

I have decided to use a comparative methodology between the EU and US legal framework as these jurisdictions differ in their legal systems, the civil in the EU and the common law in the US. This different legal history has influenced the development of trademark law adopted by legislators and recognized or rather “found” by the US courts. However, presumably both jurisdictions offer adequate protection to trademark owners against the attacks of speculative competitors who want to benefit from using the trademark of these legitimate owners. Therefore, both jurisdictions may offer interesting solutions to this problem through the courts, the legislators or scholars. As a result, they could possibly enrich their approach with the one from a different legal system.

Following an application for the registration of a trademark is submitted or even after a trademark is registered, there is still a risk of refusal or declaration of the trademark as invalid

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<sup>4</sup> Amanda Michaels, *Intellectual Property Guides: A practical guide to trade mark law* (2<sup>nd</sup> edn, Sweet & Maxwell 1996) 9.

by the competent authority or a risk of facing an infringement claim from another competitor. This risk derives from the lack of distinction from an earlier trade mark. In the case when the two trademarks are either identical or too similar, the owner of the earlier trade mark can enforce their rights in order to protect their registered trademark. Therefore, it is a crucial point for an applicant to consider the existence of a likelihood of confusion <sup>5</sup> of two trademarks in order to avoid the potential situation of the proprietor's defense.

In the first chapter, I will introduce the relevant provisions as regards to double identity protection included in the international legal forum, where the EU and US are the members of the Paris Convention and of the Annex 1C Agreement on trade-related aspects of intellectual property rights ('TRIPS'). Both agreements have been the basis for later regulation in the EU and US.

In the second chapter, I will introduce the relevant provisions as regards to double identity protection in EU legislation. As regards to interpretation of these provisions, I will refer to the CJEU's case law and to lacunas in written law highlighted by scholars in the doctrinal debate. At the end of the second chapter, I will conclude my findings from the mentioned sources.

In the third chapter, I will introduce the relevant provisions as regards to likelihood of confusion in US legislation. As regards to interpretation of these provisions, I will refer to the US's case law and to the points raised by scholars. At the end of the chapter, I will conclude my findings from the mentioned sources.

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<sup>5</sup> 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 [2015] OJ L 336/1, art. 5.

In the fourth chapter, I will compare the EU and the US legal frameworks and provide the most obvious differences and discrepancies I have found. Finally, in the conclusion, I will summarize my research by comparing EU and US legal frameworks and emphasize the problematic issues in both jurisdictions.



## CHAPTER 1 – The International Legal Framework

The purpose of this chapter is to direct us to the provisions as regards to double identity protection included in the international legal forum. Where the EU and US are the members of international agreements in the field of trademark law from which derive binding covenants, I will discuss the relevant provisions as regards to the roots of double identity protection. Firstly, I will discuss these provisions in the more than one hundred years old, yet still effective Paris Convention and in the second part of this chapter I will discuss the more modern TRIPS agreement. The discussion on these provisions is important as we can see in them the basis for future regulation in both the territories of the EU and US.

### 1.1 Paris Convention

The first international agreement as regards to the protection of trademarks was the Paris Convention for the Protection of Industrial Property, signed in 1883 and entered into force in 1884 ('Paris Convention'). The Paris Convention is considered a "*cornerstone*"<sup>6</sup> of the international industrial property system.<sup>7</sup> From 1883 until today it has 177 Members, including the United States and all members of the European Union individually.<sup>8</sup> More than 125 years have passed yet this convention is still valid. Moreover, as the Director General of

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<sup>6</sup> Catherine Seville, 'The Principles of International Intellectual Property Protection: From Paris to Marrakesh' (2013) 5(1) The WIPO Journal: Analysis of Intellectual Property Issues 99.

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

<sup>8</sup> World Intellectual Property Organization, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=2](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=2) accessed 17 March 2017.

the World Intellectual Property Organization pointed that “*every subsequent treaty relating to industrial property has been inspired by the Paris Convention*”.<sup>9</sup>

The original text from 1883 of the Paris Convention did not deal with the conflict of two identical trademarks. Such a situation was for the first time dealt within the revision in 1925 and later modified in 1934 and 1958.<sup>10</sup> However, according to the new-implemented Article 6bis (1) only well-known trademarks were protected. According to this provision, the members were obliged to refuse the registration or to prohibit the use of a trademark which would constitute a reproduction or an imitation liable to create confusion, of a well-known mark used for identical goods.<sup>11</sup> In other words, the owner of a not well-known trademark did not have any means how to defend his trademark when the third person infringed his rights by using an imitation trademark for identical goods. So, what could such an owner of not well-known trademark do?

The Article 6quinquies (B) includes the reasons for denying registration or invalidation of trademark by the Member States, but does not say anything about the using of identical trademark for identical goods or services. However, this article as such is subject to Article 10bis which is reserved for protection against unfair competition. Therefore, the last resort of protection for an owner of a not well-known trademark whose rights were infringed by the third unauthorized party who used the identical trademark for identical goods and services was the unfair competition.

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<sup>9</sup> Kamil Idris, ‘WIPO Director General Hails 125th Anniversary of Historic International IP Treaty’ <[http://www.wipo.int/pressroom/en/articles/2008/article\\_0016.html](http://www.wipo.int/pressroom/en/articles/2008/article_0016.html)> accessed 17 March 2017.

<sup>10</sup> George H. C. Bodenhausen, *Guide to the application of the Paris Convention for the Protection of Industrial Property, as revised at Stockholm in 1967* (United International Bureaux for the Protection of Intellectual Property (BIRPI) 1969) 89.

<sup>11</sup> Until 1958 when the Paris Convention was revised, the trademarks for services were not discussed. Upon revision of the Paris Convention in 1958, according to the Article 6sexies, the Member States were not obliged to register service trademarks, but they were obliged to protect them.

The Paris Convention determines unfair competition only in general terms as any act of competition contrary to honest practices in industrial or commercial matters.<sup>12</sup> According to Article 10bis (3) three examples of unfair competition acts are stated. The first two relate to the anticompetitive acts of a competitor. The first example of an unfair act, one must be “*of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor.*”<sup>13</sup> The second one relates to false allegations in the course of trade in order to discredit a competitor.<sup>14</sup> The third one, implemented in 1958,<sup>15</sup> relates to the use of indications which, in the course of trade, are liable to mislead the public as to the nature and characteristics of the goods.<sup>16</sup>

It must be understood that even when the states have various legal definitions of unfair competitions, the scope of national protection against the unfair acts shall be in compliance with Article 10bis (2) (3) relating to prohibition of acts of unfair competition.<sup>17</sup> Therefore, the Member States shall assure effective protection against them and prohibit them in their domestic laws.<sup>18</sup> According to Gervais, it was the Article 10bis (3) of the Paris Convention that for the first time protected the owner of a trademark against infringement by unauthorized third parties.<sup>19</sup> But, as Correa rightly pointed out, the protection against unfair competition does not confer exclusive rights on the trademark owner against unfair

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<sup>12</sup> The Paris Convention, art 10bis (2).

<sup>13</sup> *ibid*, art 10bis (3)(1.).

<sup>14</sup> *ibid*, art 10bis (3)(2.).

<sup>15</sup> Bodenhausen (n10) 143.

<sup>16</sup> The Paris Convention, art 10bis (3)(3.).

<sup>17</sup> Bodenhausen (n 10) 144.

<sup>18</sup> The Paris Convention, art 10bis (1)(3).

<sup>19</sup> Daniel Gervais, *The Trips Agreement – drafting history and analysis* (Sweet & Maxwell 1998) 109-110. See also: F M Abbott, T Cottier, F Gurry, *International Intellectual Property in an Integrated World Economy* (2<sup>nd</sup> edn, Wolters Kluwer Law & Business 2011) 391.

competition acts.<sup>20</sup> Except for a few special cases, primarily relating to regulatory issues as regards the conditions of trademark registration, the rights deriving from ownership of the trademark was not determined in the Paris Convention.<sup>21</sup> Consequently, the Member States of the Paris Convention were free to decide what the concept of trademark rights should include.<sup>22</sup> But it is important to emphasize, that the International Court of Justice has never been addressed to interpret the provisions of the Paris Convention.<sup>23</sup> It seems to me, that Member States at that time did not consider the uniformity of trademark law, an important goal with which to provide appropriate legal protection to trademark owners.

In my opinion, according to Article 10bis (3)(1.) the first example of unfair acts reflects most closely the problem of double identity of two trademarks. These acts are of such a nature as to create the most confusion in a situation where two identical trademarks used or registered for identical goods or services conflict. The reason is that this subsection works with the phenomena of confusion, which is, as we will later see, the most crucial determinant of infringement by a third party against the owner of an identical trademark registered or used for identical goods or services.

To sum up, the Paris Convention, as the first convention to address intellectual industrial property, laid down general principles but does not govern specific issues relating to the trademark field. Except for well-known trademarks of which the creation of imitation for identical goods was prohibited, the other not well-known trademarks were left to the rules of unfair competition. For these there was a rule that the creation of confusion with the goods of

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<sup>20</sup> Carlos M. Correa, *Trade Related Aspects of Intellectual Property Rights: A Commentary on the TRIPS Agreement* (Oxford University Press 2007) 185.

<sup>21</sup> Bodenhausen (n 10) 15.

<sup>22</sup> *ibid.*

<sup>23</sup> Frederick M. Abbott, Thomas Cottier, Francis Gurry, *International Intellectual Property in an Integrated World Economy* (2<sup>nd</sup> edn, Wolters Kluwer Law & Business 2011) 374, 394.

a competitor should have been prohibited by the Member States. This rule became the crucial element within the other later specifications either in national legal systems or in the international level as regards to the double identity problem of identical trademarks.

## **1.2 TRIPS Agreement**

As was mentioned in the previous section, despite the Paris Convention being a very important piece of legislation at an international level, many issues remained unregulated and left to national laws of the Member States. Therefore, the countries attempted to fulfill this lacuna within the negotiations with a new, more precise international agreement. Eventually, the World Trade Organization was founded (WTO) in Marrakesh, Morocco on 15 April 1994 and along with its establishment, the Annex 1C Agreement on trade-related aspects of intellectual property rights ('TRIPS') was signed. All signatories, including the United States and the members of the European Union, agreed that TRIPS should not derogate existing covenants under the Paris Convention.<sup>24</sup> Moreover, TRIPS incorporated in its provisions reference to the Paris Convention as a part of a norm.

The most important provision of the TRIPS as regards to the double identity problem is dealt with the Article 16 relating to the rights conferred on a trademark owner. This provision is considered a "Paris-plus"<sup>25</sup> whereas as was mentioned in the previous subsection, this legal concept was not solved in the Paris Convention. Article 16 of the TRIPS represents the shift from the protection against the unfair competition under Article 10bis. (3) of the Paris

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<sup>24</sup> TRIPS, art 2(2.)

<sup>25</sup> Correa (n 20) 185.

Convention to the guarantee of the exclusive rights of the trademark owner against third parties.<sup>26</sup>

According to Article 16 of TRIPS, the exclusive right to prevent third parties from using identical sign for goods or services identical to those registered for the trademark is conferred on the owner of a registered trademark. The conditions when this trademark right is triggered are that the infringer uses the identical sign without the consent of the owner of a registered trademark, in the course of trade and such a use is capable of resulting in the likelihood of confusion. The most important sentence in this provision as regards to the double identity problem relates to the burden of proof. It states that in a case when a third party uses an identical trademark for identical goods or services, a likelihood of confusion shall be presumed.

In other words, the Article 16 (1) of the TRIPS shall define infringement of an unauthorised party against the owner of a registered trademark.<sup>27</sup> So, this formulation of exclusive rights for the trademark owner of a registered trademark along with the provision as regards the presumption of likelihood of confusion, grants a protection of a trademark's identity and a protection against confusion before the unauthorised use by a third party.<sup>28</sup> The Paris Convention did not grant such protection to a trademark owner.<sup>29</sup>

However, only infringement in the course of trade is qualified for the granting of such a protection to a trademark owner. Owing to Article 16 (1) of TRIPS not specifying the term

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<sup>26</sup> Matthias Schmidt-Pfitzner, *WTO – Trade – Related Aspects of Intellectual Property Rights* (Peter-Tobias Stoll, Jan Busche, Katrin Arend, Rüdiger Wolfrum, Vol. 7, Koninklijke Brill NV 2009) 317.

<sup>27</sup> Nuno Pires de Carvalho, *The TRIPS Regime of Trademarks and Designs* (2<sup>nd</sup> edn, Kluwer Law International 2011) 346.

<sup>28</sup> Schmidt-Pfitzner (n 26) 318.

<sup>29</sup> World Intellectual Property Organization, *Implications of the TRIPS Agreement on Treaties administered by WIPO* (WIPO Publication No 464 (E) 2012) 35 ;See also Schmidt-Pfitzner (n 26) 318.

“the course of trade”, the definition is left to the national legislators.<sup>30</sup> While a narrow interpretation of this term shall include use for economic purposes,<sup>31</sup> the broad interpretation relates to the legitimate interests of the trademark owner according to Article 17 of TRIPS.<sup>32</sup> According to Article 17 of TRIPS, members may provide limited exceptions to the rights conferred by a trademark when taking into account the legitimate interests of the trademark owner and of the third party. As Carvalho rightly pointed out, such a legitimate interest of the trademark owner is to preserve distinctiveness of the trademark.<sup>33</sup> Such an interest can be negatively affected not only within the course of trade of the third party but also beyond this scope, for example disparaging the trademark in a press report which misinforms the public.

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The difference between the exclusive rights and legitimate interests of a trademark owner is that, whereas under Article 16 of TRIPS the uses of identical trademark by a third party in the course of trade is a condition for the creation of presumption of likelihood of confusion, under Article 17 of TRIPS such a use outside the course of trade does not create such a presumption.<sup>35</sup> Therefore, the position of a trademark owner when defending their exclusive trademark rights against a third party using an identical sign in the course of trade is more convenient than defending his legitimate interest against the third party's unauthorised use of an identical sign outside the course of trade.

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<sup>30</sup> Schmidt-Pfitzner (n 26) 318.

<sup>31</sup> *ibid.*

<sup>32</sup> Nuno Pires de Carvalho, *The TRIPS Regime of Trademarks and Designs* (2nd edn, Kluwer Law International 2011) 348.

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

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

<sup>35</sup> *ibid.*, 349.

Regarding the likelihood of confusion this is a condition when the exclusive right of the trademark owner to defend the unauthorised use of an identical trademark by a third party is triggered. Whereas trademark protection is directed to those who were the first to use a distinctive sign in the trade,<sup>36</sup> the likelihood of confusion with some other identical sign is the occurrence which the trademark owner tries to avoid. Moreover, it is one of the principal functions of a trademark to create a separate and distinct impression and to serve as the identifier of the manufacturer of the goods without confusion.<sup>37</sup>

The likelihood of confusion when the third party uses an identical sign and identical goods or services to the legitimate owner is dealt with in the second sentence of Article 16 of TRIPS. According to this provision, when such a situation occurs, a likelihood of confusion is presumed. However, what is the meaning of such a presumption for the legitimate owner whose rights were infringed?

In actual fact, such a presumption has an impact on the proceeding of the court when such a legitimate trademark owner complains before the court against an infringer using an identical trademark. Carvalho discussed if this presumption is absolute or relative and, therefore, what would determine the evidentiary proceedings.<sup>38</sup> If relative, the defendant would be entitled to submit evidence that, in spite of the likelihood of confusion between the two identical trademarks, there was no factual confusion.<sup>39</sup> However, as Carvalho stated, this presumption is absolute, so it admits no space for the defendant to provide evidence to the contrary.<sup>40</sup>

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<sup>36</sup> Robert P. Merges, Peter S. Menell, Mark A. Lemley, *Intellectual Property in the New Technological Age* (6th edn, Wolters Kluwer Law & Business 2012) 765.

<sup>37</sup> Saul Lefkowitz, 'Double Trademarking – We've come a long way' (1983) 73 TMR 18.

<sup>38</sup> Carvalho (n 32) 351.

<sup>39</sup> *ibid.*

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



By contrast, other authors like Schmidt-Pfitzner, Staehelin and Knaak believe that the protection of a trademark's identity is not absolute.<sup>41</sup> It means that this presumption of likelihood is refutable, so that when the third parties furnish the evidence in their favour, they can use an identical trademark.<sup>42</sup> In other words, the burden of proof is shifted from the trademark's owner to the alleged infringer to prove the absence of likelihood.<sup>43</sup>

The issue to be emphasized is that according to Article 16 (1) exclusive rights are granted only to the owner of a registered trademark. However, the concept of a trademark's owner is not defined within TRIPS.<sup>44</sup> The reason for this is that there can be different conditions of ownership under domestic laws of individual countries.<sup>45</sup>

Finally, as previously mentioned, exclusive rights are granted to the owner of a registered trademark only. However, the last sentence within the Article 16 (1) of TRIPS limits the scope of protection by existing prior rights. Whereas in the majority of WTO Members the protection of trademark rights is based on registration, in the United States, for example, the trademark rights can be also acquired by actual use.<sup>46</sup> Therefore, according to Article 16 (1) of TRIPS, the exclusive rights shall not prejudice any existing prior rights. As regards to double identity, such a recognition of prior rights without regard to the exclusive rights of the owner of a registered trademark can result in a situation where there will be co-existence of

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<sup>41</sup> Schmidt-Pfitzner (n 26) 319.

<sup>42</sup> Knaak, in: Schricker & Beier (eds), 19, 23; Stucki, 45 as cited in Matthias Schmidt-Pfitzner, *WTO – Trade – Related Aspects of Intellectual Property Rights* (Peter-Tobias Stoll, Jan Busche, Katrin Arend, Rüdiger Wolfrum, Vol. 7, Koninklijke Brill NV 2009) 319.

<sup>43</sup> Abbott (n 23) 374, 375.

<sup>44</sup> *ibid*, 391.

<sup>45</sup> *ibid*, 392.

<sup>46</sup> *ibid*, 358.

identical signs for identical goods or services in separate markets within one single national territory.<sup>47</sup>

When comparing the Paris Convention and TRIPS, the latter grants exclusive rights to the trademark owner of a registered trademark not to use their trademark by unauthorised third parties. These rights are an extension of unfair competition rules under the Paris Convention. The other main element in Article 16 of TRIPS is the presumption of likelihood in the case of identical trademarks for identical goods or services. This shifts the burden of proof from the trademark owner to the infringer.

However, opinions differ, if the infringer rebuts this presumption should they prove that there is no likelihood of confusion. In my opinion, this protection should be absolute and not relative depending on the discretion of either a public authority or the court assessing the likelihood of confusion. So, the authority or the court should always find the presumption established when deciding on two identical trademarks for identical goods or services. The authority should cancel such an application for registration of a trademark and the court should grant protection to the prior owner of the identical trademark. The reason being the cost and time effectiveness of these proceedings when a more powerful player on the market could take advantage of their position and harm the less powerful ones.

In conclusion, when comparing the situation “no case brought” before the International Court of Justice, the World Trade Organization Appellate Body (‘Appellate Body’) established in 1995, is more popular as regards to hearing the cases. Among other states bringing the dispute regarding trademark protection before this body, the US and EU were also in both

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<sup>47</sup> Abbott (n 23) 356.

positions of complainants and respondents.<sup>48</sup> Presumably, the reason for the increasing number of disputes brought before the Appellate Body is that Member States have become aware that only by means of uniformity of the trademark law, may proper protection of trademark owners be provided.

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<sup>48</sup> For the further details see the Dispute Settlement 176 <[https://www.wto.org/english/tratop\\_e/dispu\\_e/cases\\_e/ds176\\_e.htm](https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds176_e.htm)> accessed 4 April 2017; the Dispute Settlement 174 <[https://www.wto.org/english/tratop\\_e/dispu\\_e/cases\\_e/ds174\\_e.htm](https://www.wto.org/english/tratop_e/dispu_e/cases_e/ds174_e.htm)> accessed 4 April 2017.

## CHAPTER 2 – EU Legal Framework

The purpose of this chapter is to discuss relevant provisions as regards to double identity protection in the EU jurisdiction. In order to do so, I will point out the interpretation problems which are subject to the court's discretion and the object of academic discussions. Firstly I will introduce relevant provision in secondary EU legislation. In the second section of this chapter I will discuss what the approach of the European Union the Court of Justice of the European Union ('CJEU') have been to the lacunas which derived from provisions relating to the double identity rule. In the third section of this chapter I will refer to the lacunas in the legal provisions as regards to double identity protection pinpointed by the scholars. Finally, in the fourth section of this chapter I will conclude findings from previous three sections of this chapter as regards to legislation, case law and academic debate about double identity rule.

### 2.1 EU Legal Sources

One of the very first goals of the founded European Economic Community in 1957 was to create a common market.<sup>49</sup> The purpose of trademark protection legislation in the common and later internal market is concisely expressed in the preamble of Regulation 207/2009 on the Community trade mark ('Regulation 207/2009') as legal conditions to enable undertakings to distinguish their products or services by identical legal instruments

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<sup>49</sup> Treaty establishing the European Economic Community [1957], art 2(4).

throughout the EU so they can adapt their activities.<sup>50</sup> The core principle of these legal instruments is the unitary character of the EU trademark,<sup>51</sup> meaning that it shall have equal effect throughout the EU.<sup>52</sup>

In other words, the EU trademark is not subject to the territorial differences existing in the Member States.<sup>53</sup> Moreover, it is in the interest of the EU to apply the unitary principle by the adoption of directives and regulations to achieve harmonization across all Member States.<sup>54</sup> It is important to emphasize that EU Member States are bound by the Paris Convention and the TRIPS Agreement, therefore the provisions of secondary legislation refer to these international agreements and they are consistent with them.<sup>55</sup>

It is important to state that the EU trademark should not be obtained otherwise than by registration.<sup>56</sup> Signs eligible for trademark protection are registered and, thus, acquire protection.<sup>57</sup> However, the European Union trademark law does not replace the laws of the Member States on trade mark protection,<sup>58</sup> however, there is the coexistence between national legal systems and the EU legal system.<sup>59</sup>

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<sup>50</sup> Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L 78/1, recital 2.

<sup>51</sup> *ibid*, recital 3.

<sup>52</sup> *ibid*, art 1(2).

<sup>53</sup> Anette Kur, 'Convergence after all? A comparative view on the U.S. and EU trademark systems in the light of the "trade mark study" (2012) 19 Journal of Intellectual Property Law 305, 306.

<sup>54</sup> Regulation 207/2009, recital 4.

<sup>55</sup> 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 [2015] OJ L 336/1, recital 41.

<sup>56</sup> Regulation 207/2009, art 6.

<sup>57</sup> Anette Kur, 'The EU Trademark Reform Package—(Too) Bold a Step Ahead or Back to Status Quo?' (2015) 19 Marquette Intellectual Property Law Review 19, 21.

<sup>58</sup> Regulation 207/2009, recital 6.

<sup>59</sup> Directive 2015/2436, recital 3.

As regards to trademark legislation, Regulation 207/2009 and the more recently updated Regulation 2015/2424 that amended Regulation 207/2009<sup>60</sup> are effective. Therefore, when I refer to the designation of Regulation 207/2009 I mean as amended according to the Regulation 2015/2424. The reason why Regulation 2015/2424 was adopted was the adoption of the Lisbon Treaty resulting in the updating of terminology.<sup>61</sup> Additionally, there was a need for better protection of designations of origin and geographical indications.<sup>62</sup> The content of paragraphs relating to double identity, firstly relative grounds for refusal and secondly rights conferred by a trade mark, has remained without significant change. Only the structure has changed slightly. However, the meaning of provisions has fully remained.

Therefore, Regulation 2015/2424 confirmed the strong absolute protection of the EU trademark in the case of the trademark being identical with another trademark and also the goods or services being identical.<sup>63</sup>

### ***2.1.1 Relative Grounds for Refusal of Trademark Registration***

As regards to relative grounds of refusal, the provision under Article 8(1)(a) of the Regulation 207/2009 states that when the trade mark is identical with the earlier trade mark and the goods or services are identical as well, upon opposition of the owner of the earlier trademark, such a trade mark shall not be registered.<sup>64</sup> The action which an impaired trademark owner should take is called opposition and is regulated under Article 41 of the

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<sup>60</sup> Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark [2015] OJ L 341/21.

<sup>61</sup> *ibid*, recital 2. For example, the term Community trademark was replaced by the term European Union trademark (EU trademark).

<sup>62</sup> *ibid*, recital 10.

<sup>63</sup> Regulation 207/2009, art 8(1)(a).

<sup>64</sup> *ibid*, recital 8.

Regulation 207/2009. This action must be expressed in writing and the grounds on which it is made must be specified.<sup>65</sup>

The grounds in a double identity case will be that the trademark to be registered is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected.<sup>66</sup> It is important to say that double identity of two trademarks is a relative ground for refusal of registration.<sup>67</sup> This means that if an owner does not oppose the registration of a trademark which infringes their rights as the owner of the earlier registered trademark, the Office may register such a trademark upon application.<sup>68</sup>

As regards to the application process, the Office<sup>69</sup> according to Regulation 207/2009 registers the EU trademark only when the application meets specific requirements<sup>70</sup> and no notice of opposition has been given within a period of three months following the publication of a trademark<sup>71</sup> or such an opposition has been rejected by the Office.<sup>72</sup> Therefore, the effect of opposition of impaired legitimate trademark owner is that if they file opposition against the registration of an infringer's trademark and this opposition is justified, such a trademark shall not be registered. Such an application should be refused by the Office.<sup>73</sup> The

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<sup>65</sup> Regulation 2015/2424, art 41(3).

<sup>66</sup> *ibid*, art 41(1)(a).

<sup>67</sup> *ibid*, art 8(1)(a).

<sup>68</sup> Kur (n 53) 310.

<sup>69</sup> Regulation 2015/2424, art 2(1): "*European Union Intellectual Property Office ("the Office") is hereby established.*"

<sup>70</sup> Regulation 207/2009, art 45.

<sup>71</sup> *ibid*, art 41(1).

<sup>72</sup> *ibid*, art 45.

<sup>73</sup> *ibid*, art 8(1)(a).

relative grounds for refusal of registration at the time of registration are closely linked and are the same as the grounds for a finding of infringement between two conflicting trademarks.<sup>74</sup>

As regards to the burden of proof either in opposition proceedings before the Office or before the court, there is an important correlation between the provision under Regulation 207/2009 Article 8(1)(a) dealing with the conflict of two identical trademarks and Article 8(1)(b) dealing with the conflict between two similar trademarks. The position of a trademark owner is more advantageous when a double identity case of two identical trademarks is concerned than the likelihood of confusion of two similar trademarks.<sup>75</sup> The reason is that, unlike the other relative grounds of refusal,<sup>76</sup> there is no need to provide evidence for a likelihood of confusion.<sup>77</sup>

However, if this protection seems to be absolute, it is not so<sup>78</sup> and there are cases when a defendant uses an identical trademark in relation to identical goods or services by an unauthorized third party without finding an infringement by the CJEU.<sup>79</sup> These “failures” not presumed in legislation will be discussed in the next chapter relating to the case law of the CJEU.

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<sup>74</sup> Tanya Aplin, Jennifer Davis, *Intellectual Property Law: Text, Cases and Materials* (1<sup>st</sup> edn, Oxford University Press 2009) 272.

<sup>75</sup> Martin Senftleben, ‘Function Theory and International Exhaustion – Why It Is Wise to Confine the Double Identity Rule to Cases Affecting the Origin Function’ (2014) 36(8) *European Intellectual Property Review* 518, 523.

<sup>76</sup> Lionel Bently, Brad Sherman, *Intellectual Property Law* (4<sup>th</sup> edn, Oxford University Press 2014) 976.

<sup>77</sup> Richard Davis, Ben Longstaff, Ashley Roughton, Tom St Quintin, Guy Tritton, *Tritton on Intellectual Property in Europe* (4<sup>th</sup> edn, Sweet and Maxwell 2014) 522.

<sup>78</sup> Bently and Sherman (n 76) 1049.

<sup>79</sup> Davis and others (n 77) 522.



### 2.1.2 Rights Conferred by a Trade Mark

As regards to the rights conferred by a trade mark on a proprietor under Article 9(1)(a) of the Regulation 207/2009 to prevent all unauthorized third parties from using in the course of trade identical sign in relation to identical goods or services, they are exclusive.<sup>80</sup> These exclusive rights are necessary for ensuring protection against confusion so that the owner's trademark is able *'to convey reliable information on the commercial origin of goods or services'*.<sup>81</sup>

But there are uncertainties regarding the interpretation of this provision as well. The example is interpretation of the concept of use in the course of trade.<sup>82</sup> The CJEU has been addressed in preliminary rulings also in this matter, which will be discussed in the next chapter.

Besides regulations, Directive 2008/95<sup>83</sup> and Directive 2015/2436<sup>84</sup> were adopted as legal instruments of harmonization in the individual national legal systems of Member States. Directive 2015/2436 is called recast because it clarified some provisions in Directive 2008/95.<sup>85</sup>

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<sup>80</sup> Regulation 207/2009 art (9)(1), art (9)(2)(a).

<sup>81</sup> Martin Senftleben, 'Adapting EU trademark law to new technologies: back to basics?' (2011) 140, in Christophe Geiger, *Constructing European Intellectual Property: Achievements and New Perspectives* (2013 Edward Elgar Publishing) Available at SSRN: <[https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1875629](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1875629)> accessed 22 March 2017.

<sup>82</sup> Davis and others (n 77) 521, 522.

<sup>83</sup> Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L 299/25.

<sup>84</sup> 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 [2015] OJ L 336/1.

<sup>85</sup> *ibid*, recital 1.

Altogether, the new regulation and new directive were the part of “*the EU Trademark reform package*.”<sup>86</sup> The EU Member States are obliged to follow the same rules in their national legal systems.<sup>87</sup> The International Trademark Association closely cooperated with the European Commission on the legislative proposals of the new amended secondary legislation and expressly approved un-amended wording of articles as regards to the double identity issue.<sup>88</sup> Therefore, as in the case of double identity provisions included in both regulations, the content of paragraphs relating to double identity has remained, except for more precise wording and changed placing of articles, without change. For this reason, I will refer in this thesis only to the new Directive 2015/2436.

The directives reflect the same principle of absolute double identity protection relating to relative grounds for refusal of application under Article 5(1)(a) and exclusive rights conferred on the trademark proprietor under Article 10(1), Article 10(2)(a) as included in the regulations. The wording and the meaning of the provisions Article 9(1), Article 9(2)(a) of Regulation 207/2009 and Article 10(1), Article 10(2)(a) of Directive 2015/2436 is the same. They say that, the proprietor shall be under protection of exclusive rights to his trademark in order to prevent some third party using an identical sign without their consent in relation to

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<sup>86</sup> European Parliament, ‘Briefing, EU Legislation in Progress’ [2015] <[http://www.europarl.europa.eu/thinktank/en/document.html?reference=EPRS\\_BRI\(2015\)573887](http://www.europarl.europa.eu/thinktank/en/document.html?reference=EPRS_BRI(2015)573887)> accessed 21 March 2017.

<sup>87</sup> Kur (n 57) 21.

<sup>88</sup> International Trademark Association, ‘Comments on the Proposed Revisions to the EU Community Trade Mark Regulation and Trade Marks Directive’ [2013] 3 <<http://www.inta.org/advocacy/documents/june2013intacommentseutmsystemsreview.pdf>> accessed 16 February 2017.

goods or services for which this owner registered their trademark. Moreover, such a protection should be ‘absolute’.<sup>89</sup>

However, there was discussion preceding the adoption of the wording of the double identity problem in Article 9(2)(a) of the Regulation 207/2009 and Article 10(2)(a) of the Directive 2015/2436. The original text in draft proposals limited the protection of the rightful trademark owner only to cases where the use of an identical sign for identical goods and services affects or is liable to affect the function of the trade mark to guarantee to consumers the origin of the goods or services.<sup>90 91</sup> The European Commission’s argument to precisely define the provision this way was that in both cases either in double identity or similarity it is only the origin function which matters.<sup>92</sup> Ultimately, such an amendment was not adopted and the provisions as regards to double identity remained without a change. Therefore, a situation, such as the counterfeiting of cheap fake luxury products that could not be confused with the original brand, shall not be exempted from the protection of the rightful trademark owner.<sup>93</sup>

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<sup>89</sup> Directive 2015/2436, recital 16; See also Annette Kur, ‘Trademarks Function, Don’t They? CJEU Jurisprudence and Unfair Competition Principles’ (2014) 45(4) International Review of Intellectual Property and Competition Law, 434-454.

<sup>90</sup> European Parliament legislative resolution of 25 February 2014 on the proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (recast) ([COM\(2013\)0162](#) – C7-0088/2013 – [2013/0089\(COD\)](#)) (Ordinary legislative procedure – recast) Art 10 (2) (a) < <http://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//NONSGML+TA+P7-TA-2014-0119+0+DOC+PDF+V0//EN>> accessed 12 February 2017.

<sup>91</sup> European Commission, ‘Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark’ (27.3.2013) 11 <[http://www.europarl.europa.eu/registre/docs\\_autres\\_institutions/commission\\_europeenne/com/2013/0161/COM\\_COM\(2013\)0161\\_EN.pdf](http://www.europarl.europa.eu/registre/docs_autres_institutions/commission_europeenne/com/2013/0161/COM_COM(2013)0161_EN.pdf)> accessed 12 February 2017.

<sup>92</sup> *ibid*, 8.

<sup>93</sup> International Trademark Association, ‘Comments on the Proposed Revisions to the EU Community Trade Mark Regulation and Trade Marks Directive’ (2013) 15 <<http://www.inta.org/advocacy/documents/june2013intacommentseutmsystemsreview.pdf>> accessed 16 February 2017.

Within Directive 2015/2436 the same relationship between identical and similar trademark applies as within Regulation 207/2009. It is important to reiterate, that the reason why it is so important to distinguish the cases of double identity from cases when two trademarks are similar is that in the case of double identity there is no need to prove confusion.<sup>94</sup> Therefore, once double identity is proved, the opponent does not have to prove likelihood of confusion to prevail over an infringer, since the protection conferred by Article 8(1)(a) of the Regulation 2015/2424 is absolute.<sup>95</sup> So, once the trademark is registered, it is protected against subsequent registration or use of identical signs or similar signs by which a likelihood of confusion is created.<sup>96</sup>

Moreover, if double identity is established, the evaluation of likelihood of confusion is not questioned by the Office and the opposition should be successful.<sup>97</sup> On the other hand, when double identity is not confirmed, the last resort for such a trademark owner is the likelihood of confusion on the part of the public which such a use of trademark by a third party would create according to Article 9(2)(b) of Regulation 2015/2424 and Article 10(2)(b) of Directive 2015/2436.

However, the question as to whether two trademarks are identical has been addressed to the Court of Justice of the European Union (CJEU) less frequently than the question as whether

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<sup>94</sup> Bently and Sherman (n 76) 976.

<sup>95</sup> European Union Intellectual Property Office, Guidelines for Examination in the Office, Part C, Opposition (2017) 4 <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/trade\\_marks\\_practice\\_manual/WP\\_1\\_2017/Part-C/02-part\\_c\\_opposition\\_section\\_2/part\\_c\\_opposition\\_section\\_2\\_chapter\\_1\\_general\\_principles/part\\_c\\_opposition\\_section\\_2\\_chapter\\_1\\_general\\_principles\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-C/02-part_c_opposition_section_2/part_c_opposition_section_2_chapter_1_general_principles/part_c_opposition_section_2_chapter_1_general_principles_en.pdf)>accessed 12 February 2017.

<sup>96</sup> Kur (n 57) 21.

<sup>97</sup> See (n 95).

the similarity of two trademarks result in a likelihood of confusion.<sup>98</sup> Which criteria and interpretation the CJEU applies when examining double identity I will describe in the next chapter. As regards the policy of the Office for Harmonization in the Internal Market (OHIM), they apply the criterion of being identical strictly.<sup>99</sup> This examination step is important as where there is no double identity between two conflicting trademarks, the trademark owner is not entitled to prevent the third party from using the same sign.

The EU legislation clearly states that the EU trademark should not be obtained otherwise than by registration<sup>100</sup> in order to acquire protection,<sup>101</sup> though there are also non-registered trademarks existing in the territory of EU. However, whereas there is no legislation harmonizing on the European Union level the protection of non-registered trademarks, the Member States may protect them by their own national legislation within their jurisdiction.

<sup>102</sup> So, some Member States grant protection to non-registered trademarks, such as trade names, for example, in Germany, Denmark, Finland, and the United Kingdom.<sup>103</sup>

The specific type of non-registered trademarks are well-known marks which enjoy a special regime of protection not only within the European Union legislation but also world-wide. The more general designation for a well-known mark within the European Union legislation is the “*earlier trade mark*”.<sup>104</sup> A well-known trademark is protected the same way under provisions

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<sup>98</sup> Aplin and Davis (n 74) 274.

<sup>99</sup> Davis and others (n 77) 523.

<sup>100</sup> Regulation 207/2009, art 6.

<sup>101</sup> Kur (n 57) 21.

<sup>102</sup> Danish Patent and Trademark Office, Workshop on the Revision of Trademark Law, Diqing (Yunnan Province), P.R. China from 13 to 15 May 2010, 10 <<file:///D:/Downloads/101--doccentre-trademarks-cc1-aw4-002-ravn-ctm-en.pdf>> accessed 16 February 2017.

<sup>103</sup> Charles Gielen, ‘Trademark dilution under European law’ (2014) 104 The Trademark reporter, 693, 698.

<sup>104</sup> Regulation 207/2009, art 8(2)(c).

included in Regulation 207/2009 <sup>105</sup> and Directive 2015/2436 <sup>106</sup> relating to the relative grounds of refusal of application and exclusive rights conferred on the proprietor as the registered trademark. But the issue of a well-known trademark is not the issue of this thesis, so where not necessary, I will not discuss it further.

In summary, the borderline between similar and identical trademarks is of vital importance since this derives from the burden of proof for the legitimate owner of a registered trademark. If two trademarks are considered identical, the owner is entitled to oppose a registration of the unauthorized third party's trademark without further evidence and also to prevent its using in the course of trade. In contrast, when two trademarks are considered similar, the legitimate owner is obliged to prove the likelihood of confusion in order to oppose the registration of such a trademark or to prevent the third party from using it. It is thought that the likelihood of confusion in a double identity case is so evident, that legislators simply removed the need to show the likelihood of confusion and it should be irrefutably presumed. <sup>107</sup> But this assumption of legislators was "*rather naïve*".<sup>108</sup> The arguments for why such an approach of legislators was not correct and what factors are taken into account in order to determine a double identity case, I will describe in the next chapter relating to the CJEU case law.

## 2.2 CJEU's Decisions

According to the Treaty on the Functioning of the European Union, the Court of Justice of the European Union ('CJEU') shall have jurisdiction to construe all acts of the institutions of

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<sup>105</sup> Regulation 207/2009, art 9(2)(c), art 8(5).

<sup>106</sup> Directive 2015/2436, art 5(3)(a), art 10(2)(c).

<sup>107</sup> Davis and others (n 77) 521.

<sup>108</sup> *Budějovický Budvar, národní podnik v Anheuser-Busch Inc.* [2012] ETMR 48 (CA) (Jacob LJ) as cited in: Davis and others (n 77) 521.

the EU.<sup>109</sup> Therefore, national courts within preliminary rulings proceedings have addressed to the CJEU questions relating to the interpretation of provision concerning to double identity. One of the reasons why the CJEU has intervened in the legal interpretation of Member States was that there were many means by which to circumvent these provisions as not envisaged by the EU legislators.<sup>110</sup>

Generally, when the CJEU examines whether there is infringement between two identical trademarks in relation to identical goods or services, they apply the following three criteria test. The first one is whether the trademarks are identical.<sup>111</sup> The second is whether the goods or services between two conflicting trademarks are identical.<sup>112</sup> The third one is whether the potential infringer uses the conflicting identical trademark in the course of trade.<sup>113</sup> This chapter will focus on the CJEU case law interpreting these three factors which derive from the relevant provision in the Regulation 207/2009 and the Directive 2008/95.<sup>114</sup>

It is important to state what the relationship between provisions on relative grounds for refusal of an application of a trademark and exclusive rights of the trademark owner included in both Regulation 207/2009 and the Directive 2015/2436 as regards to infringement. The grounds upon which the legitimate trademark owner is entitled, firstly, to prevent the use of an identical trademark by an unauthorized third party and, secondly, the registration of such a

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<sup>109</sup> Treaty on the Functioning of the European Union [2007] OJ C 326/49, art 267 (ex art 234 TEC).

<sup>110</sup> Davis and others (n 77) 521.

<sup>111</sup> Bently and Sherman (n 76) 975.

<sup>112</sup> *ibid.*

<sup>113</sup> Andrew Griffiths, 'The trade mark monopoly: an analysis of the core zone of absolute protection under Art.5(1)(a)' (2007) 3 Intellectual Property Quarterly 312, 323.

<sup>114</sup> Whereas as to date 24 March 2017 there has not been decided any case affected double identity according to new adopted Directive 2015/2436 by CJEU yet, I will use the designation Directive 2008/95 and provisions relating to double identity therein. As regards to Directive 2008/95, the art (1)(a) (relative grounds for refusal) correspond to art 5(1)(a) of Directive 2015/2436; art 5(1)(a) (exclusive rights conferred by a trade mark) corresponds to art 10(1), art 10 (2)(a) of Directive 2015/2436. As regards to Regulation 207/2009, as amended by Regulation 2015/2424, art 8(1)(a) (relative grounds for refusal) not amended; art 9(1)(a) amended only systematically as art 9(1), art (2)(a) of new amended regulation 207/2009.

trademark are the same.<sup>115</sup> Therefore, when the CJEU interprets the provisions as regards to infringement, they frequently refer to judgments relating to conflict at the time of registration.

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### 2.2.1 *Identical Trademarks*

The first important question when deciding whether there is infringement in the case of double identity is whether the two conflicting trademarks are identical. In the case of *LTJ Diffusion SA v. Sadas Vertbaudet SA*<sup>117</sup> (Diffusion) the CJEU confirmed absolute protection without further evidence in the case of double identity granted under Article 5 (1) (a) of Directive 2008/95.<sup>118 119</sup> Moreover, the court said that the criterion of identity between the two trademarks must be interpreted strictly.<sup>120</sup>

However, strict interpretation does not mean the result of a direct rigorous comparison between two trademarks made by the specialists in the field but rather from the perspective of an average consumer who does not examine the difference between two trademarks deeply.<sup>121</sup> Therefore, when two trademarks differ only in some insignificant features which are not noticed by an average consumer, they may still fall under a double identity case.<sup>122 123</sup> The

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<sup>115</sup> Aplin and Davis (n 74) 272.

<sup>116</sup> *ibid.*

<sup>117</sup> Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ECR I-2799.

<sup>118</sup> Directive 2015/2436, art 10(2)(a) .

<sup>119</sup> Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ECR I-2799, para 49.

<sup>120</sup> *ibid.*, para 50.

<sup>121</sup> *ibid.*, para 53.

<sup>122</sup> *ibid.*, paras 25-27. See also Bently and Sherman (n 76) 976.

<sup>123</sup> Bently and Sherman (n 76) 976.



evaluation as to whether the differences are insignificant and unnoticed by an average consumer is a matter of fact<sup>124</sup> and it is left to the national courts.<sup>125</sup>

The CJEU used the concept of hypothetical average consumer in their judgments in order to determine the case of double identity under Article 5(1)(a) of the Directive 2008/95.<sup>126</sup> However, such an average consumer must have certain specifics such as being reasonably well informed, observant and circumspect.<sup>127</sup> Therefore, “*the imperfect picture*”<sup>128</sup> of an overall impression from the comparison of two conflicting trademarks by such a consumer is determining in deciding as to whether a double identity case is in question.

However, in the judgment itself, a clear approach in how to deal with the hierarchy of the scope of trademark protection with identity in the first place and similarity in the second place is missing. Advocate General Jacobs prepared such a manual for a national court in his opinion on the case. He said that, firstly, the court should identify what is an overall impression of the average, reasonably-well informed, observant and circumspect consumer as regards to relevant conflicting trademarks.<sup>129</sup>

Secondly, that the national court should perform a global assessment of the “*overall impression*” of trademark features “*in particular by their distinctive and dominant components, in the perception of the average consumer.*”<sup>130</sup> If, on this basis, double identity

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<sup>124</sup> Bently and Sherman (n 76) 976, 977.

<sup>125</sup> Case C-278/08 *Die BergSpechte Outdoor Reisen und Alpinschule Edi Koblmüller GmbH v Günter Guni, trekking.at Reisen GmbH* [2010] ECR I-2517, para 53.

<sup>126</sup> Jennifer Davis, ‘Locating the average consumer: his judicial origins, intellectual influences and current role in European trade mark law’ (2005) 2 I.P.Q. 183, 188. See also: Andrew Griffiths, ‘The trade mark monopoly: an analysis of the core zone of absolute protection under Art.5(1)(a)’ (2007) 3 Intellectual Property Quarterly 319, 323.

<sup>127</sup> Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ECR I-2799, para 52.

<sup>128</sup> *ibid.*

<sup>129</sup> *ibid.*, para 49.

<sup>130</sup> *ibid.*, para 46.

is shown then the trademark owner's exclusive rights are automatically triggered. When only similarity is shown then a likelihood of confusion between two conflicting trademarks has to be investigated.<sup>131</sup>

To sum up, if two trademarks are identical then they should have been assessed as being so from the perspective of an average consumer on the grounds of his or her overall impression without regards to insignificant differences. However, as we will see in the following sections, particularly relating to the functions of trademark, the first criteria on which double identity is based can be circumvented.

### 2.2.2 *Identical Goods or Services*

According to Article 28(1) of the Regulation 207/2009 as amended, the applicant for trade mark registration shall classify the goods and services for which trade mark is applied in conformity with the system of classification established by the Nice Agreement.<sup>132</sup> The applicant shall identify the goods and services “*with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought.*”<sup>133</sup> Therefore, the correct identification of goods and services by an applicant when applying for registration of a trademark is crucial since the scope of protection for the trademark relies on this matter.

With regards to the second criteria, the CJEU examine whether the goods or services between two conflicting trademarks are identical. There is a general rule that, even when the earlier trademark includes more categories than the conflicting trademark but includes also those

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<sup>131</sup> Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ECR I-2799, para 49.

<sup>132</sup> Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks [1957].

<sup>133</sup> Regulation 207/2009, art 28(2).

categories same for both trademarks, then these goods or services are considered identical for purposes of double identity.<sup>134</sup>

This general rule was applied in the case *Claudia Oberhauser v OHIM*<sup>135</sup> in which the Court of First Instance ruled that 'denim clothing' within Class 25 was covered by the earlier mark correspond to 'clothing, footwear, headgear', as well as within Class 25 covered by the conflicting trademark.<sup>136</sup> The reason is that the goods within covered by 'clothing, footwear, headgear' also includes clothing made of denim.<sup>137</sup>

The Court of First Instance confirmed his reasoning in the previous case also in the case *Aventis Pharma SA v OHIM*<sup>138</sup>. The defendant in this case filed an application for registration of the EU trademark at OHIM.<sup>139</sup> The word mark PRAZOL covered the goods in Class 5 of the Nice Agreement and were described as 'Medicines'.<sup>140</sup> However, the applicant Aventis Pharma SA filed a notice of opposition for registration of the defendant's trademark with OHIM.<sup>141</sup> The applicant challenged this registration upon the existence of their own registered word trademark PREZAL covering 'pharmaceutical, veterinary and hygienic products', falling within Class 5 of the Nice Agreement.<sup>142</sup> The court found that the goods of these two trademarks were identical due to the fact that the goods covered by

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<sup>134</sup> Bently and Sherman (n 76) 977.

<sup>135</sup> Case T-104/01 *Claudia Oberhauser v OHIM and Petit Liberto, SA* [2002] ECR II-4359, CFI.

<sup>136</sup> Case T-104/01 *Claudia Oberhauser v OHIM and Petit Liberto, SA* [2002] ECR II-4359, CFI, para 32.

<sup>137</sup> *ibid.*, para 32.

<sup>138</sup> Case T-95/07 *Aventis Pharma SA v OHIM and Nycomed GmbH* [2008] ECR II-229, CFI.

<sup>139</sup> *ibid.*, para 1.

<sup>140</sup> *ibid.*, paras 2, 3.

<sup>141</sup> *ibid.*, para 5.

<sup>142</sup> *ibid.*, para 5.

‘pharmaceutical, veterinary and hygienic products’ are included in the goods covered by ‘Medicines’. <sup>143</sup>

As was mentioned before, there is less case law which relates particularly to the question as to whether the goods or services are identical for the purposes of provisions regarding double identity. <sup>144</sup> Rather the question whether the goods or services are similar has been addressed more frequently. <sup>145</sup>

It seems to me that the CJEU or the Court of First Instance have, in their decisions, used common sense and that they have not applied the law literally. The formalistic approach in this issue could lead to consequences arising from the law being easily circumvented by a potential infringer. Therefore, the legitimate trademark owner would have no right to defend their trademark exclusive rights when the infringer’s trademark would, in fact, cover the same but formally slightly different goods or services. Without doubt, such an approach taken by the courts would weaken absolute double identity protection.

### **2.2.3 *Functions of Trademark***

The third criteria taken into account by the courts when assessing double identity cases relates to the functions of trademark. As we will see in the decisions, step by step the CJEU’s discretion has changed regarding the interpretation of the trademark’s functions and the interests which should come under trademark protection. <sup>146</sup>

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<sup>143</sup> Case T-95/07 *Aventis Pharma SA v OHIM and Nycomed GmbH* [2008] ECR II-229, CFI, para 35.

<sup>144</sup> *Aplin and Davis* (n 74) 274.

<sup>145</sup> *Aplin and Davis* (n 74) 274.

<sup>146</sup> Pier Luigi Roncaglia, Giulio Enrico Sironi, ‘Trademark functions and protected interests in the decisions of the European Court of Justice’ (2011) 101 *The Trademark Reporter* 147, 148.

The first case I would like to refer is the case of *Arsenal Football Club v Reed* ('Arsenal').<sup>147</sup> Arsenal Football Club brought a claim before the court on the grounds that Mr. Reed sold scarves marked in large lettering with the word 'Arsenal' which is registered as a trade mark by the claimant for those and other goods.<sup>148</sup> The CJEU was addressed by the national court within the preliminary ruling with the question as to whether or not it was infringement of a trademark when Mr. Reed used a warrant notice at his stall stating that the goods concerned were not officially those of Arsenal FC.<sup>149</sup> The CJEU ruled that, since the sign identical to the mark is used within commercial activity with a view to economic advantage and not as a private matter, it fulfilled the condition 'in the course of trade' according to Article 5(1)(a) of the Directive 2008/95.<sup>150</sup>

Moreover, it also fell under Article 5(1)(a) of the Directive 2008/95 as regards to the identical name of the trademark and goods for which it is registered by claimant.<sup>151</sup> Therefore, despite the defendant's notice that the goods did not originate from Arsenal FC, the CJEU ruled that it was the exclusive right of the claimant, as the legitimate proprietor of the trademark, to prevent such use under said circumstances in order to rely on the double identity rule under Article 5(1)(a).<sup>152</sup> The court derived this decision from the rationale that the exclusive rights of a trademark owner is to ensure that the trademark can fulfill its functions.<sup>153</sup> In particular, the enforcement of such a right plays the role in such cases when a third party uses the sign that "affects or is liable to affect the functions of the trade mark, in particular its essential

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<sup>147</sup> Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273.

<sup>148</sup> *ibid*, para 2.

<sup>149</sup> *ibid*, para 57.

<sup>150</sup> *ibid*, para 40.

<sup>151</sup> *ibid*, para 40.

<sup>152</sup> *ibid*, para 63.

<sup>153</sup> *ibid*, para 51.

function of guaranteeing to consumers the origin of the goods.”<sup>154</sup> Therefore, under the circumstances described in this case, the use of identical signs with the trademarks in question was capable of endangering the guarantee of origin and hence the main function of the trademark.<sup>155</sup>

It seems that the CJEU has narrowed the double identity rule on cases when unauthorized use has not affected the trademark’s functions.<sup>156</sup> In other words, even if all the criteria for the double identity rule are satisfied as regards to identity of trademarks, the identity of goods or services and the use in the course of trade, when the conflicting trademark does not affect the essential function of trademark to guarantee the origin of the goods to consumers, the legitimate trademark owner is not entitled to enforce his exclusive rights.

On the other hand, this case, described as “*a victory for brand owners*”<sup>157</sup>, is considered a basis for the functional approach to trade mark infringement in double identity cases.<sup>158</sup> This functional test<sup>159</sup> as regards to affecting the essential function of a trademark opened up the possibility of using the double identity rule to protect any of the functions of a trade mark: origin/identification, guarantee, advertising, communication, and investment.<sup>160</sup> The reasoning of this argument is the language of the CJEU that emphasized that infringement must be of such a nature which affects the functions of the trade mark, *in particular*, its

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<sup>154</sup> Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273, para 51.

<sup>155</sup> Max Planck Institute, ‘EU: ECJ upholds use as trademark in the “Arsenal” case’ (2003) 34(1) International Review of Intellectual Property and Competition Law 117-118.

<sup>156</sup> Lisa P. Ramsey and Jens Schovsbo, ‘Mechanisms for limiting trade mark rights to further competition and free speech’ (2013) 44(6) International Review of Intellectual Property and Competition Law 671, 678.

<sup>157</sup> Norma M. Dawson, ‘Non-trade mark use’ (2012) 4 Intellectual Property Quarterly 204, 220.

<sup>158</sup> *ibid*, 218.

<sup>159</sup> *ibid*, 215.

<sup>160</sup> *ibid*, 220.

essential function of guaranteeing to consumers the origin of the goods.<sup>161</sup> The problem in interpreting how, exactly, the CJEU meant the phrase “in particular” in this decision, i.e. whether it was merely stressing the protection of the essential function or rather that it was demonstrative, was resolved in later cases.

The CJEU further confirmed that the protection of the essential trademark’s function is to guarantee to consumers the origin of the goods in the case of *Adam Opel v Autec* (‘Adam Opel’).<sup>162 163</sup> In this case, the claimant, the motor manufacturer Adam Opel was the proprietor of the national figurative trademark registered in Germany for motor vehicles and toys (“Opel logo”).<sup>164</sup> The defendant company Autec, manufactured and sold remote-controlled model cars under the trademark ‘Cartronic’.<sup>165</sup> One of these model cars bore the Opel logo on its radiator grill exactly like the original grill fitted to the Opel Astra V8 coupé vehicle.<sup>166</sup> Therefore, Adam Opel sought an order that Autec shall be prohibited from selling toy cars with the Opel logo based on an infringement of the Adam Opel trademark.<sup>167</sup>

The preliminary question for the CJEU was whether or not there was a double identity between the goods of the registered trademark of Adam Opel (as fitted to real Opel Astra V8 coupé cars) and Autec’s goods (toy model cars copying a real car in a reduced scale) and whether, therefore, Adam Opel could prevent use of such a nature.<sup>168</sup>

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<sup>161</sup> Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273, para 51; Dawson (n 157) 222.

<sup>162</sup> Case C-48/05 *Adam Opel AG v Autec AG* [2007] ECR I-1017.

<sup>163</sup> Griffiths (n 113) 320.

<sup>164</sup> Case C-48/05 *Adam Opel AG v Autec AG* [2007] ECR I-1017, para 4.

<sup>165</sup> *ibid*, para 5.

<sup>166</sup> *ibid*, paras 5, 6.

<sup>167</sup> *ibid*, paras 8, 9.

<sup>168</sup> *ibid*, paras 13, 14.

Despite of the opinion of Advocate General Ruiz-Jarabo Colomer, who considered the use for toys of a registered sign under the described circumstances as not constituting use as a trademark under Article 5(1)(a) of Directive 2008/95,<sup>169</sup> the CJEU decided the other way. The CJEU decided that where a trade mark is registered for motor vehicles and for toys, the affixing by Autec, without authorization of Adam Opel, of a sign identical to toy car models in order to faithfully reproduce those vehicles constituted double identity if such a use affected or was liable to affect the functions of the trademark as a trademark registered for toys.<sup>170</sup> Consequently, Adam Opel was not entitled to enforce their exclusive rights to prevent use of their trademark by Autec if the condition of affecting of trademark's function is not fulfilled.

However, determination as to whether the use at issue affects the functions of the Opel logo as a trademark registered for toys is left to the national court by reference to the average consumer of toys in Germany.<sup>171</sup> Therefore, the CJEU seems to have interpreted absolute protection under the double identity rule in quite a restrictive manner and did not presume possible future uses of the trademark once it has been registered.<sup>172</sup> It is important to say that the condition of affecting the trademark's functions as one for constituting infringement by an unauthorized party, related only to "the essential function" of Adam Opel's trademark as a trademark registered also for toys.<sup>173</sup>

Another, more important issue which derives from the decision is that CJEU somehow lectured not only Adam Opel but also other future appellants that "*Adam Opel does not*

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<sup>169</sup> Case C-48/05 *Adam Opel AG v Autec AG* [2007] ECR I-1017, Opinion of AG Colomer, para 46.

<sup>170</sup> Case C-48/05 *Adam Opel AG v Autec AG* [2007] ECR I-1017, para 47.

<sup>171</sup> *ibid*, para 25.

<sup>172</sup> Spyros Maniatis, Dimitris Botis, *Trade Marks in Europe: A practical Jurisprudence* (Thomson Reuters 2010) 493.

<sup>173</sup> Griffiths (n 113) 342.



*appear to have claimed that that use affects functions of that trade mark other than its essential one.*" <sup>174</sup> This illustrates uncertainty about specifying the certain functions to be protected under the double identity rule. <sup>175</sup>

Moreover, even if the CJEU was focusing on the essential function of a trademark in the cases of both *Adam Opel* and *Arsenal Reed*, it is hard to draw some conclusion between them. <sup>176</sup> Whilst in *Arsenal Reed* the sale of identical sign on souvenirs was liable to affect the essential function of the trademark as to designate the origin of the goods by consumers, in *Adam Opel* this question was left to the national court. Therefore, the exclusive rights of the trademark proprietor seem to be endangered and left to the discretion of the national court. Thus, the absolute protection deriving from the double identity rule was not confirmed in the *Adam Opel* case but rather left open and relative relying on the factual examination by the national court within German territory.

However, the approach of the CJEU focusing only on the trademark's essential function as an indication of origin, <sup>177</sup> changed in the decision of *L'Oréal SA v Bellure NV* ('*L'Oréal*'). <sup>178</sup> The facts in this case were that *L'Oréal*, producing and selling fragrances, is, in the United Kingdom, the proprietor of the well-known trademark, which are registered for perfumes including the *Trésor* perfume marks and the *Miracle* perfume marks. <sup>179</sup> One of the infringements alleged by the claimant was that the defendant imitated not only perfume but

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<sup>174</sup> Case C-48/05 *Adam Opel AG v Autec AG* [2007] ECR I-1017, para 25.

<sup>175</sup> Griffiths (n 113) 343.

<sup>176</sup> Griffiths (n 113) 343.

<sup>177</sup> Case C-533/06 *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* [2008] ECR I-4231, para 28.

<sup>178</sup> Case C-487/07 *L'Oréal SA, Lancôme parfums et beauté & Cie SNC, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd, Starion International Ltd* [2009] ECR I-5185.

<sup>179</sup> *ibid*, para 14.

also the bottle and packaging of the Trésor perfume sold by L'Oréal.<sup>180</sup> Moreover, the defendant used comparative advertising of the perfume by referring to L'Oréal's perfumes in lists which compared the claimant's products with the defendant's suggesting equivalence at lower costs.<sup>181</sup>

The first question for the preliminary ruling was whether the proprietor of a registered trademark is entitled to enforce the exclusive right so that they can prevent the use by a third party in comparative advertising, of an identical sign, even if such use is incapable of jeopardizing the essential function of the trademark.<sup>182</sup> And the second question closely linked to the first was whether the proprietor of a well-known trademark, such as L'Oréal is, can oppose such use, under the double identity rule where even that use is not capable of jeopardising the mark or one of its functions but still plays a significant role in the advertisement of the goods or services of the third party.<sup>183</sup>

The CJEU ruled that the use, when an advertiser such as Bellure, in a comparative advertisement, uses a sign identical with to the mark of a competitor L'Oréal, it can be regarded as use for the purposes of the double identity rule, so L'Oréal may prevent such use.

<sup>184</sup> As regards to the absolute protection of trademark, the CJEU referred to the previous cases, which held that rationale of the exclusive right under the double identity rule was the protection of the trademark specific interests such that the trademark can fulfill its functions.

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<sup>180</sup> Case C-487/07 *L'Oréal SA, Lancôme parfums et beauté & Cie SNC, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd, Starion International Ltd* [2009] ECR I-5185, para 17.

<sup>181</sup> Dawson (n 157) 222.

<sup>182</sup> Case C-487/07 *L'Oréal SA, Lancôme parfums et beauté & Cie SNC, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd, Starion International Ltd* [2009] ECR I-5185, para 51.

<sup>183</sup> *ibid.*

<sup>184</sup> *ibid.*, para 53.

<sup>185</sup> The most innovative part of the decision was that the CJEU covered under absolute protection not only the essential function of the trademark but also the other functions “*in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising.*” <sup>186</sup> However, the determination whether the defendant’s use of trademark is able to affect one of the mentioned functions, was left to the referring national court. <sup>187</sup>

This decision set out the principle of general application to comparative advertising which *prima facie* falls under the double identity rule. <sup>188</sup> However, the trend as regards to movement from the origin function theory and other functions theory based on the decisions of the CJEU is subject to criticism. <sup>189</sup> I will focus on the points of this criticism in the next section (Doctrinal debate).

To sum up, we can see the progress as regards to the scope of absolute protection under double identity rule in decisions of the CJEU. Firstly, it seemed that CJEU tried to narrow the scope only to the cases where the trademark’s origin function is adversely affected - the cases Arsenal and Adam Opel. However, while in the Arsenal case the CJEU confirmed that the trademark’s essential function may be adversely affected by selling a product bearing the

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<sup>185</sup> Case C-487/07 *L’Oréal SA, Lancôme parfums et beauté & Cie SNC, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd, Starion International Ltd* [2009] ECR I-5185, para 58; Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273, para 51; Case C-48/05 *Adam Opel AG v Autec AG* [2007] ECR I-1017, para 21.

<sup>186</sup> Case C-487/07 *L’Oréal SA, Lancôme parfums et beauté & Cie SNC, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd, Starion International Ltd* [2009] ECR I-5185, para 58; Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273, para 51; para 59; Case C-48/05 *Adam Opel AG v Autec AG* [2007] ECR I-1017, para 58.

<sup>187</sup> Case C-487/07 *L’Oréal SA, Lancôme parfums et beauté & Cie SNC, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd, Starion International Ltd* [2009] ECR I-5185, para 63.

<sup>188</sup> Trevor Cook, *EU Intellectual Property Law* (Oxford University Press 2010) 263.

<sup>189</sup> Bently and Sherman (n 76) 1057.

Arsenal sign by a third unauthorized party,<sup>190</sup> in the case of Adam Opel the CJEU left it to the referring court to examine this question.<sup>191</sup> It seemed that in five years the CJEU took a step back as regards to absolute double identity protection. In contrast, two years later in the case *L'Oréal*, the CJEU broadened the absolute protection also for other functions such communication, investment or advertising as well.<sup>192</sup> Obviously, the confusion regarding the recognition of other trademark's functions has not ceased.

The opinions on the legal fight as to what extent other functions of the trademark apart from the essential one as to indicate the origin of the goods or services, is discussed in the following section of this chapter.

### 2.3 Doctrinal Debate over EU Legal Framework

In this section I will refer to the lacunas in the EU legal provisions concerning double identity protection highlighted by scholars. The academic debate as regards to the double identity rule derives particularly from the CJEU approach which reflects a shift and broadening of the scope trademark protection under the double identity rule from the origin function to the other trademark functions' protection as well. However, it is also the EU secondary legislation itself that is criticized as well. The main issue I would like to discuss in this chapter is the scope of the trademark protection granted by the CJEU.

Senftleben is of the opinion that the CJEU, by continuously relaxing protection requirements,

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<sup>190</sup> Max Planck Institute, 'EU: ECJ upholds use as trademark in the "Arsenal" case' (2003) 34(1) *International Review of Intellectual Property and Competition Law* 117-118.

<sup>191</sup> Case C-48/05 *Adam Opel AG v Autec AG* [2007] ECR I-1017, para 25.

<sup>192</sup> Case C-487/07 *L'Oréal SA, Lancôme parfums et beauté & Cie SNC, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd, Starion International Ltd* [2009] ECR I-5185, para 58; Case C-206/01 *Arsenal Football Club plc v Matthew Reed* [2002] ECR I-10273, para 51; Case C-48/05 *Adam Opel AG v Autec AG* [2007] ECR I-1017, para 58.

*“has paved the way for the supermassive trademark protection.”*<sup>193</sup> He does not agree with the CJEU holding in the L’Oréal case where the court, besides the essential origin function, granted absolute protection under the double identity rule provision also to the communication, investment and advertising as a trademark’s functions.<sup>194</sup> He supposes that the Court transgressed the boundary lines drawn up under Article 5(1)(a) (exclusive rights conferred on a trademark proprietor) in Directive 2008/95, as these non-essential trademark functions are typical functions of marks with a reputation under Article 5(2) of Directive 2008/95 and which of protection is optional for Member States.<sup>195</sup> Therefore, by including these non-origin functions in the mandatory double identity rule under Article 5(1)(a) of Directive 2008/95, the CJEU *“eroded the freedom left to EU Member States”*.<sup>196</sup>

In contrast, Wurtenberger does agree with the CJEU decision in the L’Oréal case to some extent. He says that, while the disputes between a trademark owner and its competitors are influenced by the right of free speech, freedom of trade and the scope of trademark protection, the interest of the trademark owner should always be respected.<sup>197</sup> However, he admits that the CJEU judgment conveys the incorrect impression that the prevailing task of a trademark is to serve the consumers and lacks the resulting impact on trade mark owners.<sup>198</sup> On the other hand, he respects this decision from the perspective of fair competition saying that referring to well-established trademarks as L’Oréal clearly distorts competition to the detriment of both the trademark owners as well to all of the producers of competing

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<sup>193</sup> Martin Senftleben, ‘Trade mark protection - a black hole in the intellectual property galaxy?’ (2011) 42(4) International Review of Intellectual Property and Competition Law 383, 384.

<sup>194</sup> Senftleben (n 193) 384.

<sup>195</sup> *ibid.*

<sup>196</sup> *ibid.*

<sup>197</sup> Gert Wurtenberger, ‘L’Oréal v Bellure: An Opinion’ (2010) 5(10) Journal of Intellectual Property Law & Practice 746, 746.

<sup>198</sup> *ibid.*, 747.

products.<sup>199</sup>

Kur reasons that, in determining the scope of protection, it is important to follow the rules in unfair competition law rather than to argue about the various trademark functions.<sup>200</sup> So, the L'Oréal case has shown that including other functions under double identity rule *“does not automatically lead to enhanced protection.”*<sup>201</sup> Such a protection should be provided only exceptionally when the interests of trademark owner are *“seriously jeopardized”* and the competing third parties do not behave in accordance with the rules of fair competition.<sup>202</sup>

Finally, Griffiths as regards to the question whether these additional functions should be a case for extending legal protection accordingly adds that such a regulation requires a careful balancing act and it is justified only if it would *“facilitate the achievement and maintenance of ‘the system of undistorted competition’ envisaged in the Directive’s preamble”*.<sup>203</sup>

In my opinion, Kur's and Griffith's point as to finding a balance between the scope of the trademark protection and the rules of fair competition is right. It is a question of what impact putting non-essential functions directly into the provision of double identity rule would have on competition rules and on freedom of speech,<sup>204</sup> But, on the other hand, it would lead to clarity and to foreseeability of the decision either in national or EU jurisdiction. If not so, at least the CJEU could decide the cases in uniformity since fundamental different views on the

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<sup>199</sup> Gert Wurtenberger, 'L'Oréal v Bellure: An Opinion' (2010) 5(10) Journal of Intellectual Property Law & Practice 746, 747.

<sup>200</sup> Annette Kur, 'Trademarks Function, Don't They? CJEU Jurisprudence and Unfair Competition Principles' (2014) 45(4) International Review of Intellectual Property and Competition Law, 434, 434.

<sup>201</sup> Kur (n 200) 442.

<sup>202</sup> *ibid*, as cited in Case C-323/09 *Interflora Inc., Interflora British Unit v Marks & Spencer plc, Flowers Direct Online Ltd*, [2011] ECR I-08625, para 91.

<sup>203</sup> Griffiths (n 113) 321, 323.

<sup>204</sup> Senftleben (n 193) 384.

scope of protection bring legal chaos and so weaken the trademark owner's position in the market.

## 2.4 Concluding Notes EU Legal Framework

The trademark owners are granted exclusive rights to prevent a third party from using an identical trademark by directives and regulations relating to trade marks. Moreover, such a protection should be 'absolute', <sup>205</sup> so that once double identity is proved, the opponent does not have to prove likelihood of confusion, as it is in the case between two conflicting similar trademarks, to prevail over an infringer. <sup>206</sup> The burden of proof is the crucial element why it is important to distinguish the case of identity of two trademarks, known as the double identity rule, from the case when two conflicting trademarks are 'merely' similar. <sup>207</sup> Despite a discussion on the scope of double identity protection preceding the adoption of the EU Trademark reform package in 2015, the meaning of provisions as regards to the double identity rule within the new adopted Regulation 2015/2424 and Directive 2015/2436 have remained unchanged.

The interpretation of the double identity rule provisions, even set expressly in EU secondary legislation, is still in progress not only from the CJEU but also from the national courts which are usually addressed to examine the factual part of the case as regards the effect upon a trademark's function by infringement. In particular, the CJEU faces a question of the scope of

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<sup>205</sup> Directive 2015/2436, recital 16; See also Kur (n 200) 454.

<sup>206</sup> European Union Intellectual Property Office, Guidelines for Examination in the Office, Part C, Opposition (2017) 4 <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/trade\\_marks\\_practice\\_manual/WP\\_1\\_2017/Part-C/02-part\\_c\\_opposition\\_section\\_2/part\\_c\\_opposition\\_section\\_2\\_chapter\\_1\\_general\\_principles/part\\_c\\_opposition\\_section\\_2\\_chapter\\_1\\_general\\_principles\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-C/02-part_c_opposition_section_2/part_c_opposition_section_2_chapter_1_general_principles/part_c_opposition_section_2_chapter_1_general_principles_en.pdf)>accessed 12 February 2017.

<sup>207</sup> Bently and Sherman (n 76) 976.

protection covered by the double identity rule. The movement from protection only of the origin function of trademark to the protection of also other trademark functions is controversial. The use of an identical trademark may have an adverse affect on these non-essential functions, so the CJEU has confirmed infringement.

As to whether the legal fight over the of origin and additional non-essential functions of a trademark relating to double identity protection if as such should be recognized either by legislators and by the CJEU and national courts, scholarly opinions differ. The major respondent of the extension upon which other functions should be protected under absolute protection of the double identity rule as the origin function is Senftleben. He states that the CJEU, by recognizing and granting absolute protection also to the communication, investment and advertising a trademark's functions, is a step closer to "*the supermassive trademark protection*" and breaches the principle of subsidiarity.<sup>208</sup>

However, the majority of other scholars such as Kur, Griffiths and Wurtenberger try to find the right balance between trademark protection and the rules of fair competition. They are of the opinion that, when it is inevitably in order to follow fair competition rules, it is appropriate to protect non-essential trademark function under the absolute protection of the double identity rule. Therefore, it is obvious that these scholars, instead of reading literally the EU secondary legislation' provisions, try to reach its goal to maintain "*the system of undistorted competition*".<sup>209</sup>

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<sup>208</sup> Senftleben (n 193) 384.

<sup>209</sup> Griffiths (n 113) 320.



To sum up, it is obvious that this legal chaos has had a negative impact on the certainty and enforcement of trademark owners' exclusive rights as they are neither aware which rights are worth fighting for nor what the probability of success is before the court.

## CHAPTER 3 – US Legal Framework

In the United States as a common law jurisdiction, trademark protection is rather based upon prior adoption and the use of a trademark and exists independent of any statute.<sup>210</sup> In this chapter I will discuss the situation when a new competitor produces a mark which is too similar to an existing mark of the already established competitor in the marketplace.<sup>211</sup> I have intentionally not used the designation of double identity rule in the previous sentence. The reason is that in federal law the United States Trademark law is the Trademark Act of 1946 which is also known as the Lanham Act ('Lanham Act') and we will not find this concept explicitly in EU legislation, so it is rather the likelihood of confusion between two trademarks which matters and which is examined by the courts and discussed by scholars. However, in this chapter I will use the term "double identity" for convenience when it is appropriate.

In the first section of this chapter I will introduce the relevant provisions of the Lanham Act as regards to the concept of likelihood of confusion. In the second section I will focus on the interpretation of the concept 'likelihood of confusion' in accordance with the Lanham Act by US courts. In the third section I will discuss the opinions of scholars on problematic issues. Finally, in the fourth section, I will conclude the findings from all three sections of this chapter as regards to legislation, case law and academic debate.

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<sup>210</sup> Sheldon W. Halpern, Sean B. Seymore, Kenneth L. Port, *Fundamentals of United States Intellectual Property Law: Copyright, Patent, Trademark* (4<sup>th</sup> edn, Kluwer Law International 2012) 239.

<sup>211</sup> *ibid*, 325.

### 3.1 US legal sources

Until 1989, the establishment of trademark rights was based upon the first use of a mark in the United States.<sup>212</sup> Therefore, the US undertakings were disadvantaged against foreign competitors who may have obtained under the Paris Convention trademark rights without the requirement of use.<sup>213</sup> However, this situation changed when the United States Trademark law, the Trademark Act of 1946 also known as the Lanham Act ('Lanham Act'), was amended in 1988, effective from 1989.

Upon the amendment of the Lanham Act, the actual use of the mark in commerce was no longer a prerequisite to registration, so the filing of an application to federal the United States Patent and Trademark Office ('USPTO') became permitted only upon a bona fide intent to use a mark in commerce.<sup>214</sup> Such a new basis for filing an application is additional to the common law concept of existing use in commerce.<sup>215</sup>

It is important to say, that in addition to federal trademark system of protection, including the Lanham Act, each state in the US also has its own common law as well statutory system of registration and protection.<sup>216</sup> These statutes of particular US states may function as supplementary to the federal statutes when trademark owners fail to obtain protection under the Lanham Act.<sup>217</sup>

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<sup>212</sup> Carlisle E. Walters, 'Trademark Registration Practice in the United States Following the Trademark Law Revision Act of 1988' (1989) 58 Nordiskt Immateriellt Rättsskydd 265, 265.

<sup>213</sup> *ibid.*

<sup>214</sup> *ibid.*

<sup>215</sup> *ibid.*

<sup>216</sup> Halpern, Seymore and. Port (n 210) 251.

<sup>217</sup> *ibid.*, 252.

### 3.1.1 Likelihood of Confusion

As well as the physical requirement of use of the trademark in commerce, there is also a second criteria as regards to the distinctiveness of the trademark in order to meet requirements for federal registration with the USPTO.<sup>218</sup> The crucial determinant as to whether a trademark deserves protection is that it must be either “*inherently distinctive*”<sup>219</sup> or “*have acquired distinctiveness through use in commerce.*”<sup>220</sup>

In contrast with distinctiveness stands the likelihood of confusion. The likelihood of confusion is defined in the the Lanham Act as an unauthorized use of any counterfeit<sup>221</sup> of a registered mark in commerce which as such “*is likely to cause confusion, or to cause confusion, or to cause mistake, or to deceive.*”<sup>222</sup> This provision is placed within the Title VI – Remedies of the Lanham Act and as such is expressly recognized as an action for infringement of registered trademarks.<sup>223</sup>

Likelihood of confusion is not only the basis for infringement of registered trademark applying in both federal and state trademark law and also for unfair competition law,<sup>224</sup> but also the basis for refusal of registration by the USPTO for a trademark. It is important to state that in the US as common law jurisdiction, the owners of trademarks are not obliged to

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<sup>218</sup> Rochelle Cooper Dreyfuss, Roberta Rosenthal Kwall and others, *Intellectual Property: Cases and Materials on Trademark, Copyright and Patent Law* (2<sup>nd</sup> edn, Foundation Press 2004) 25, 26.

<sup>219</sup> Alexandra Morgan Joseph, ‘I cann’t believe it’s not better: Why new GTLDS are bad for brand owners and trademark law’ (2012) 20 Journal of Intellectual Property Law 149, 153. See Case *Abercrombie & Fitch Co. v. Hunting World, Inc.* [1976] 537 F.2d 4, 9 (2nd Cir.).

<sup>220</sup> *ibid*, 154. See Case *Abercrombie & Fitch Co. v. Hunting World, Inc.* [1976] 537 F.2d 4, 9 (2nd Cir.).

<sup>221</sup> Lanham Act, § 45 (15 U.S.C. § 1127): „*Counterfeit. A “counterfeit” is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark*”.

<sup>222</sup> Lanham Act, § 32 (15 U.S.C. § 1114)(1)(a).

<sup>223</sup> Marshall Leaffer, ‘Sixty Years of the Lanham Act’ in Hugh Hansen (ed), *U.S. Intellectual Property Law and Policy* (Edward Elgar Publishing Limited 2006) 112.

<sup>224</sup> *ibid*, 111.

register their marks in order to obtain protection.<sup>225</sup> The trademark' owners of unregistered trademarks can still obtain common law trademark' rights based on use of the mark in commerce.<sup>226</sup> While Section 32(1) of the Lanham Act applies as protection against the likelihood of confusion exclusively for a registered trademark, the Section 43(a) of Lanham Act applies as protection against likelihood of confusion for unregistered trademarks.<sup>227</sup>

As regards to Section 43(a) of the Lanham Act, it states that false designations of goods or services or any false designation of origin used in commerce, are forbidden for any person who would likely cause confusion with another person's goods or services and their origin.<sup>228</sup> This situation is shortly called as "*passing off*".<sup>229</sup> Likelihood of confusion is used as the test for infringement by the US courts in deciding whether the trademark is a false designation of origin under Section 43(a) of the Lanham Act.<sup>230</sup> A further explanation of how the courts apply this test is discussed in the following section.

In addition, in the US there exists special protection of famous marks against dilution provided by Section 43(c) of the Lanham Act.<sup>231</sup> It states that the owner of a famous distinctive mark shall be entitled to an injunction against another person who uses such a mark in commerce that is likely to cause dilution of the famous mark.<sup>232</sup> This occurs when

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<sup>225</sup> United States Patent and Trademark Office, 'Protecting Your Trademark - Enhancing your rights through, federal registration' (2014) 9 <<https://www.uspto.gov/sites/default/files/trademarks/basics/BasicFacts.pdf>> accessed 16 February 2017.

<sup>226</sup> *ibid.*

<sup>227</sup> Halpern, Seymore and. Port (n 210) 315, 317.

<sup>228</sup> Lanham Act, § 43 (15 U.S.C. § 1125)(a)(1)(A).

<sup>229</sup> *Big O Tire Dealers, Inc v. Goodyear Tire & Rubber Co.* [1976], 408 F. Supp. 1219 (D. Colo) 1247.

<sup>230</sup> Leafer (n 223) 112.

<sup>231</sup> Lanham Act, § 43 (15 U.S.C. § 1125)(c).

<sup>232</sup> Lanham Act, § 43 (15 U.S.C. § 1125)(c)(1).

*“the use of a similar or identical mark weakens the distinctiveness and selling power of a mark.”*<sup>233</sup> However, the protection of famous marks is not the topic of my thesis.

### **3.1.2 Infringement**

The core problem of trademark infringement actions brought according to the the Lanham Act is the conflict between a junior user’s trademark that is likely to cause confusion with a senior user’s trademark.<sup>234</sup> The junior user is a *“party who adopts and uses a trademark similar or identical to a mark previously adopted and used by the senior user.”*<sup>235</sup> On the other hand, the senior user is the first party who adopts and uses a particular trademark in connection with its goods or services.<sup>236</sup>

When an owner of either a registered or protectable unregistered trademark supposes that there is likelihood of confusion between their and another party’s trademark, they should consider bringing an infringement claim before the court. Such an infringer may argue that the plaintiff’s trademark is invalid which is the best argument since there is no infringement against a not valid trademark.<sup>237</sup> At this stage, the owner of the registered trademark takes advantage of their position, as registration is *“prima facie evidence of the validity of the registered mark.”*<sup>238</sup> In addition, the registration grants to the registrant *“exclusive right to use the registered mark in commerce or in connection with the goods or services specified in*

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<sup>233</sup> Rudolf Rayle, ‘The trend towards enhancing trademark owners’ rights – a comparative study of U.S. and German trademark law’ (2000) 7 Journal of Intellectual Property Law 227, 308 as cited in: McCarthy, § 24:69; Restatement (Third) of Unfair Competition § 25 cmt. c (1995).

<sup>234</sup> Michael J. Allen, ‘Who must be confused and when?: The scope of confusion actionable under federal trademark law’ (1991) 81 The Trademark Reporter 209, 209.

<sup>235</sup> *ibid.*

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

<sup>237</sup> Halpern, Seymore and. Port (n 210) 328.

<sup>238</sup> Lanham Act, § 33 (15 U.S.C. § 1115)(a).

*the registration.*”<sup>239</sup> Among other arguments of how infringers defend their marks is that their unregistered mark is inherently distinctive or that the plaintiff’s mark has become generic.<sup>240</sup>

Bringing a claim also plays another important role as regards to the enforcement of trademark rights of the owner. The reason is that the plaintiff’s unreasonable delay in bringing an action may trigger laches and acquiescence which means that the plaintiff has failed to enforce their trademark rights in time.<sup>241</sup> As regards to remedies which can be claimed by the plaintiff in their infringement claim may include injunctive relief, damages and also, in some cases, the award of costs and counsel fees.<sup>242</sup>

Whereas the US is a common-law based system, I have to find answers as regards to what criteria apply when qualifying likelihood of confusion and infringement, in case law. In order to do so, I will examine the questions what type of confusion, who might be confused and when they might be confused.<sup>243</sup> This is a subject of the following section.

### **3.2 US Courts’ Decisions**

In this section I will focus on the interpretation of the concept ‘likelihood of confusion’ in accordance with the Lanham Act by the US courts. To do so, I will examine the cases as regards to the trademark infringement actions claiming the conflict between the senior’s user

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<sup>239</sup> Lanham Act, § 33 (15 U.S.C. § 1115)(a).

<sup>240</sup> Halpern, Seymore and. Port (n 210) 328.

<sup>241</sup> *ibid*, 330.

<sup>242</sup> *ibid*.

<sup>243</sup> Allen (n 234) 210.

trademark adopting and using a particular trademark for particular goods or services as the first and the junior's user trademark.<sup>244</sup>

### 3.2.1 Type of Confusion

Generally, the courts have developed and recognized three types of confusion: confusion of source, confusion of sponsorship or affiliation<sup>245</sup> and the third one is reverse confusion.<sup>246</sup> As regards to a double identity case, confusion of source and reverse confusion are concerned.

The confusion of source is said to be the least controversial when applying the likelihood of confusion theory.<sup>247</sup> It covers the case when “*a consumer believes that the junior user's product is the senior user's product or that the junior user's product originates from the same source as the senior's user's product.*”<sup>248</sup>

Firstly, the courts have recognized the “*confusion as to the source of the products*”<sup>249</sup> only in the case when two companies used the same trademark for the same competing products (e. g. shampoos).<sup>250</sup> In the case of *Borden Ice Cream v. Borden's Condensed*<sup>251</sup> the court ruled that there was no unfair competition between using the same trademark “Borden” for ice cream when the other company used this trademark first for milk. Therefore, the milk company cannot exclude all other companies, including the ice cream company, from using

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<sup>244</sup> *ibid*, 209.

<sup>245</sup> This occurs when the goods are non-competing and are not substitutes for one another. Leaffer (n 223) 114.

<sup>246</sup> Leaffer (n 223) 113.

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

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

<sup>249</sup> Robert P. Merges, Peter S. Menkel, Mark A. Lemley, *Intellectual Property in the New Technological Age* (4<sup>th</sup> edn, Aspen Publishers 2006) 716.

<sup>250</sup> *ibid*.

<sup>251</sup> *Borden Ice Cream Co. et. al. v Borden's Condensed Co.* [1912], 201 F. 510 (7th Cir.) 515.



the name “Borden” unless they do business in the same kind of goods.<sup>252</sup> In my opinion, the decision is not surprising taking into account the year when it was decided. In 1912, there were fewer companies and, more importantly, fewer consumers to fight for by creating speculative and other brands’ infringing techniques.

However, these old “golden” times for companies parasitizing the developed trademark of other companies, have been since been eroded by precedent law. The courts have recognized that even in the case when two companies used the same trademark for different products (e. g. shampoo and conditioner), the consumers may still believe that they are buying the product of the other company and, as a result, the products are confused.<sup>253</sup> However, this case does not reflect a double identity case when two companies use the same trademark for the same product.

Regarding converse confusion, it is the case when a large company “steals” the trademark of a smaller company and uses it as its own.<sup>254</sup> In the case of *Big O Tire Dealers v. Goodyear Tire & Rubber*<sup>255</sup> the court examined whether Goodyear, as the world's largest tyre manufacturer, by using the word BIGFOOT, the trademark owned by the plaintiff, was liable for a false designation of origin by using the same trademark on the same product – tyres in a widespread advertising campaign.<sup>256</sup> The concurrent use of this trademark by both companies resulted in actual confusion among the consumers.<sup>257</sup> Finally, the plaintiff won the case and the defendant was forbidden to use the BIGFOOT trademark either in

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<sup>252</sup> *Borden Ice Cream Co. et. al. v Borden’s Condensed Co.* [1912], 201 F. 510 (7th Cir.), 514, 515.

<sup>253</sup> Merges, Mennel and Lemley (n 251) 716, 717.

<sup>254</sup> *ibid*, 720.

<sup>255</sup> *Big O Tire Dealers, Inc v. Goodyear Tire & Rubber Co.* [1976] 408 F. Supp. 1219 (D. Colo).

<sup>256</sup> *ibid*, 1222, 1223.

<sup>257</sup> *ibid*, 1229.

advertising or in commerce.<sup>258</sup> However, it is important to emphasize that assessment of confusion as to the source of the goods shall not be interpreted as finding a balance between strict interpretation and too broad an interpretation when “*a mere calling to mind of source*” shall not suffice.<sup>259</sup>

### 3.2.2 *Factors Determining Likelihood of Confusion*

Every federal circuit has created its own list of factors when they assess if there is likelihood of confusion between two products bearing the same trademark of different companies.<sup>260</sup> However, having compared these lists, they are similar.<sup>261</sup> Therefore, the list of factors which are taken into account by the courts when assessing likelihood of confusion is not conclusive; the courts may add or omit some of them in their discretion.<sup>262</sup>

Infringement under Section 43(a) of the Lanham Act was found in the case *Lois Sportswear v Levi Strauss*<sup>263</sup> over the pocket pattern of jeans.<sup>264</sup> The court held that Levi's arcuate pattern on the jeans' pocket functions as a source indicator.<sup>265</sup> The court, having assessed the likelihood of confusion between jeans of both companies featuring almost the same pattern on the jeans pockets, took into account not only a single factor but various factors which must

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<sup>258</sup> *Big O Tire Dealers, Inc v. Goodyear Tire & Rubber Co.* [1976] 408 F. Supp. 1219 (D. Colo), 1240.

<sup>259</sup> Rudolf Rayle, ‘The trend towards enhancing trademark owners’ rights – a comparative study of U.S. and German trademark law’ (2000) 7 Journal of Intellectual Property Law 227, 287 as cited in: J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 2:14 (1999).

<sup>260</sup> Halpern, Seymore and Port (n 210) 317, 318.

<sup>261</sup> *ibid*, 317.

<sup>262</sup> *Polaroid Corporation v Polarad Electronics Corporation*, [1961] 287 F.2d 492 (2nd Cir.), 495.

<sup>263</sup> *Lois Sportswear, U.S.A., Inc. v Levi Strass & Company, Levi Strauss & Company v Textiles Confessiones Europas, S. A.* [1985] 631 F. Supp. 735 (S.D.N.Y.).

<sup>264</sup> Dreyfuss and Kwall (n 218) 86, 92.

<sup>265</sup> *Lois Sportswear, U.S.A., Inc. v Levi Strass & Company, Levi Strauss & Company v Textiles Confessiones Europas, S. A.* [1985] 631 F. Supp. 735 (S.D.N.Y.), 741.

be considered together.<sup>266</sup> These factors known as “*The Polaroid Factors*”<sup>267</sup> were described in the case *Polaroid v Polarad*.<sup>268</sup>

The first factor is the strength of the mark and the others are: “*the degree of similarity between the two marks, the proximity of the products, the likelihood that the prior owner will bridge the gap, actual confusion, and the reciprocal of defendant's good faith in adopting its own mark, the quality of defendant's product, and the sophistication of the buyers*”.<sup>269</sup> After considering all these factors individually and together, the court held that Lois’ use of an arcuate mark on the pockets of their jeans infringed Levi’s trademark.<sup>270</sup> Despite additional labelling identifying Lois’, in order to distinguish the similar marks and avoid confusion among purchasers,<sup>271</sup> there was still a substantial likelihood of confusion among consumers, including those who had not purchased jeans, since they still could do so in the future.<sup>272</sup>

Furthermore, the court emphasized that the price difference is not a factor determining confusion among these prospective consumers.<sup>273</sup> This case is interesting also from the perspective that, step by step, the courts have shifted from the inquiry of likelihood of confusion firstly focused only on purchasers to the inquiry of likelihood of confusion also

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<sup>266</sup> *Lois Sportswear, U.S.A., Inc. v Levi Strass & Company, Levi Strauss & Company v Textiles Confessiones Europas, S. A.* [1985] 631 F. Supp. 735 (S.D.N.Y.), 741. See also *Lambda Electronics Corporation, and Veeco Instruments, Inc. v Lambda Technology, Inc.* [1981] 515 F. Supp. 915 (S.D.N.Y.), 925.

<sup>267</sup> *Lois Sportswear, U.S.A., Inc. v Levi Strass & Company, Levi Strauss & Company v Textiles Confessiones Europas, S. A.* [1985] 631 F. Supp. 735 (S.D.N.Y.), 741.

<sup>268</sup> *Polaroid Corporation v Polarad Electronics Corporation* [1961] 287 F.2d 492 (2nd Cir.).

<sup>269</sup> *ibid*, 495.

<sup>270</sup> *Lois Sportswear, U.S.A., Inc. v Levi Strass & Company, Levi Strauss & Company v Textiles Confessiones Europas, S. A.* [1985] 631 F. Supp. 735 (S.D.N.Y.), 747, 748.

<sup>271</sup> *ibid*, 654, 748.

<sup>272</sup> *ibid*, 748.

<sup>273</sup> *ibid*.

among two other major groups: potential purchasers and the general public.<sup>274</sup> This major group including potential purchasers and the public is subject to “*post sale confusion*”.<sup>275</sup>

Very specific position in the US among other factors has good faith of potential infringer in adopting of his trademark.<sup>276</sup> Beebe in his study states that in order to establish likelihood of confusion, the multifactor test exercised is rather empirical than formal.<sup>277</sup> Data from his survey show that even if it seems that the bad faith factor is considered in great extent by the courts, still this factor is considered as final in order to impose the limits on the approach when rather than “*tightly-focused fact-finding inquiry*”<sup>278</sup> of consumer likelihood of confusion the commercial morality would prevail.<sup>279</sup>

Among the Polaroid factors, there are also other factors exercised by the courts when assessing the likelihood of confusion between too similar products. One of them is “*similarity of advertising*”.<sup>280</sup> This factor played an important role in the case *Vibrant Sales v The New Body Boutique*,<sup>281</sup> where two companies produced an identical ‘waist reducing belt’, although, according to the defendants, the colour and the material was different.<sup>282</sup> The crucial point was when the defendant advertised their belt in a way using models looking

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<sup>274</sup> Allen, (n 234) 229.

<sup>275</sup> Rudolf Rayle, ‘The trend towards enhancing trademark owners’ rights – a comparative study of U.S. and German trademark law’ (2000) 7 Journal of Intellectual Property Law 227, 291. See also: *Insty\*Bit, Inc. v Poly-Tech Industries, Inc.* [1996] 95 F.3d 663 (8th Cir.) 669; *Computer Care v. Service Ssystems Enterprises, Inc. and Larry Aronson* [1996] 982 F.2d 1063 (7th Cir.) 1070.

<sup>276</sup> Wee Loon Ng-Loy, ‘An Interdisciplinary Perspective on the Likelihood of Confusion: Consumer Psychology and Trademarks in an Asian Society’ (2008) 98 The Trademark Reporter 950, 958.

<sup>277</sup> Barton Beebe, ‘An Empirical Study of the Multifactor Tests for Trademark Infringement’ (2006) 93(6) California Law Review 1581, 1647.

<sup>278</sup> *ibid.*

<sup>279</sup> *ibid.*

<sup>280</sup> Halpern, Seymore and Port (n 210) 319.

<sup>281</sup> *Vibrant Sales, Inc. v The New Body Boutique, Inc., Maximum Exposure Advertising, Inc., Harvey S. Fishman and Avram C. Freedberg* [1980] 496 F. Supp. 854 (S.D.N.Y.).

<sup>282</sup> *ibid.*, 847.

similar to the models of appellant in their original advertisement.<sup>283</sup> The court held that since there was no material difference between the belts and considering the manner of advertising by which the public would probably be confused, the defendant was liable for violation of Section 43(a) of the Lanham Act.<sup>284</sup>

With regards to actual confusion, one of the most determining factors is when evidence of this factor is able to prevail over consideration of other factors from the test of likelihood of confusion.<sup>285</sup> The courts, having considered likelihood of confusion often give to this particular factor “*considerable weight*”.<sup>286</sup> The actual confusion can be evidenced by presenting of the results of some survey among consumers or by their testimony.<sup>287</sup> If the result of this evidentiary proceeding is that enough of consumers have been actually confused, then some courts consider likelihood of confusion established and they do not investigate other factors.<sup>288</sup>

The number of confused consumers required in order to establish actual confusion differs and the courts decide according to their discretion; approximately, the proportion is above 15% of confused consumers.<sup>289</sup> However, where the transparency of the survey is doubtful in many

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<sup>283</sup> *Vibrant Sales, Inc. v The New Body Boutique, Inc., Maximum Exposure Advertising, Inc, Harvey S. Fishman and Avram C. Freedberg* [1980] 496 F. Supp. 854 (S.D.N.Y), 847.

<sup>284</sup> *ibid*, 851, 852.

<sup>285</sup> Mark D. Robins, ‘Litigation: Restraining Subjectivity Through A Factor-Based Approach to Valuing Evidence’ (2004) 2(2) *Northwestern Journal of Technology and Intellectual Property* 1, 1.

<sup>286</sup> *ibid*, 4.

<sup>287</sup> *Thane International, Inc. v Trek Bicycle Corporation* [2002] 305 F.3d 894 (9th Cir.) 902.

<sup>288</sup> *Thane International, Inc. v Trek Bicycle Corporation* [2002] 305 F.3d 894 (9th Cir.) 902. See also: Mark D. Robins, ‘Litigation: Restraining Subjectivity Through A Factor-Based Approach to Valuing Evidence’ (2004) 2(2) *Northwestern Journal of Technology and Intellectual Property* 1, 6.

<sup>289</sup> *RJR Foods, Inc. v. White Rock Corp.* [1979] 603 F.2d 1058 (2nd Cir.) 1061.

cases and depends on the portfolio of selected consumers, <sup>290</sup> some courts disregard this factor <sup>291</sup> for the reason that securing reliable evidence is “*practically almost impossible*”. <sup>292</sup>

Even I have not discussed all of these factors I can still say that one phenomenon is obvious from these cases; it is that the different practice of the courts is not uniform not only about which factors should be listed in the likelihood of the confusion test but also that they prefer some factors over others without significant arguments. Therefore, it is even harder to foresee the trend of the popularity and weight of these factors. In addition, in common law system it is not only the written law which is followed and interpreted by the courts but also the ratio decidendi of precedent decisions.

As a result, even the provisions relating to double identity cases in the Lanham Act stay without change; however, their interpretation may be radically different in decades to come due to technological progress and changes in consumer behavior. The price for that is legal uncertainty about enforceability of protectable trademark rights, either from registered or unregistered trademarks, against infringers. Criticism about the preferring of some factors from the test of proving the likelihood of confusion is discussed in the following section.

### 3.3 Doctrinal Debate over US Legal Framework

Having said in the previous section that the approach of the US courts, having inquired about the test of likelihood of confusion, differs from court to court, this topic is subject to debate by scholars. According to Beebe, not only in US but also in other jurisdictions where such a multifactor test for establishing of trademark infringement is applied, the judges have

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<sup>290</sup> *Lois Sportswear, U.S.A., Inc. v Levi Strass & Company, Levi Strauss & Company v Textiles Confessiones Europas, S. A.* [1985] 631 F. Supp. 735 (S.D.N.Y.), 744.

<sup>291</sup> *Harold F. Ritchie, Inc. v. Chesebrough-Ponds, Inc.* [1960] 281 F.2d 755 (2nd Cir.) 761.

<sup>292</sup> *Miles Shoes, Inc. v. R. H. Macy & Co., Inc.* [1952] 199 F.2d 602 (2nd Cir.) 603.

expressed concern with such a method.<sup>293</sup> Having considered the fact that such a test is more empirical than formal,<sup>294</sup> it is also limited by the cognitive capacity of judges.<sup>295</sup>

Moreover, the discussions are led not only over the appropriateness of multifactor test in common,<sup>296</sup> but also over the individual factors themselves and their interpretation. As Robins stated in relation to the factor of actual confusion, he considers it “*far from serving as a stable, objective determinant of likely confusion.*”<sup>297</sup> Further he seeks for provisions of uniform guidelines for how to apply a multifactor test whose correct application is left to the circuit courts<sup>298</sup> to achieve its goal.<sup>299</sup>

In my opinion, Robins’s point is absolutely correct, because having considered that the goal of Section 43(a) of the Lanham Act relating to protection before the false designation of goods and services, this will never be achieved when the court is not sure what the concept of likelihood of confusion shall cover.

Clark is of the opinion that in order to support “*judicial economy*”, the courts should rely predominantly on actual confusion as the one element of the multifactor test. As a result, the mark users would register their marks as soon as possible in order to give notice to others that a mark is already taken.<sup>300</sup> Presumably, such a federal registration would have the effect of

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<sup>293</sup> Beebe (n 277) 1648.

<sup>294</sup> *ibid*, 1647.

<sup>295</sup> *ibid*, 1649.

<sup>296</sup> Beebe (n 277) 1647.

<sup>297</sup> Mark D. Robins, ‘Actual Confusion in Trademark Infringement Litigation: Restraining Subjectivity Through A Factor-Based Approach to Valuing Evidence’ (2004) 2(2) *Northwestern Journal of Technology and Intellectual Property* 1, 123.

<sup>298</sup> Beebe (n 277) 1647.

<sup>299</sup> Robins DM (n 296) 123.

<sup>300</sup> Edwin S. Clark, ‘Finding Likelihood of Confusion with Actual Confusion: A Critical Analysis of the Federal Courts’ Approach’ (1992) 22(2) *Golden Gate University Law Review* 393, 411.

decreasing the number of claims brought before the court on the basis of trademark infringement.<sup>301</sup>

I consider the perspective of federal registration as the means to incentivize judicial economy appropriate because the argument that trademark is invalid is vastly used in courts' infringement claims.<sup>302</sup> Therefore, the potential infringer would reconsider not only his infringing activity but also his approach to suing or being sued before the court once he knows that relevant trademark is registered, so it is "*prima facie*" valid.<sup>303</sup> The federal registration would therefore serve as the means how to avoid cases of likelihood of confusion between the two trademarks.

### 3.4 Concluding Notes on US Legal Framework

With regard to summarizing the previous sections, I have observed that US legal protection against the double identity trademark problem is very complex and diffused in every aspect of either states' legal regulation or case law. One cannot say what is the scope of such a protection because even the courts struggle with this issue. The way the court deal with this situation is creating their own determinants for the establishment of infringement<sup>304</sup> or, in other words on what grounds to consider the likelihood of confusion between two trademark.

As a result, I absolutely agree with the point made by scholars when they request the provisions of uniform guidelines for the criteria that such an assessment should include<sup>305</sup>

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<sup>301</sup> Edwin S. Clark, 'Finding Likelihood of Confusion with Actual Confusion: A Critical Analysis of the Federal Courts' Approach' (1992) 22(2) Golden Gate University Law Review 393, 411.

<sup>302</sup> Halpern, Seymore and. Port (n 210) 328.

<sup>303</sup> Lanham Act, § 33 (15 U.S.C. § 1115)(a).

<sup>304</sup> Halpern, Seymore and Port (n 210) 317, 318.

<sup>305</sup> Beebe (n 277) 1647.



Otherwise, the product of this non-uniform approach is legal uncertainty which leads to the impairment of trademarks ownership and to infringers' taking advantage.

## CHAPTER 4 – A Comparison between EU and US Legal Frameworks

The purpose of this chapter is to compare the findings derived from previous chapters with regard to problematic issues in the US and EU trademarks' double identity, focusing on lacunas in legislation and what effect in reality they have.

Firstly, both systems have different legal systems which protect the trademark under different regimes. While in the EU it is mainly the registration system which prevails, in the US it is traditionally use of the trademark which matters<sup>306</sup> as demonstration of trademark ownership. In this way the EU system is more formal than the US. This applies also to interpretation of the double identity trademark problem because different interpretations offer different solutions of the problem.

With regard to interpretation of the problem itself, in the EU legislation the double identity problem is identified very strictly so it occurs when the two trademarks mirror their expression and the goods or services they are registered for. On the other hand, in the US it is a rather more relaxed likelihood of confusion test which serves as the means through which courts may assess if the trademark's infringement has occurred. However, in both jurisdictions the courts use their discretion to broaden or narrow the interpretation of the double identity problem as they feel. Therefore, in both jurisdictions the approach of courts is unpredictable. This is caused by non-uniform interpretation following different solutions of

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<sup>306</sup> Horst-Peter Gotting, 'Protection of well known unregistered marks in Europe and the United States' (2000) 31(4) International Review of Intellectual Property and Competition Law 389, 390.

how to protect infringed trademark owners. However, the result has a bad impact on legitimate trademark's owners who cannot be certain about the enforceability of their rights.

The most controversial issue in both jurisdictions is to find the right balance between the scope of protection for trademark owners and the rules of unfair competition.<sup>307</sup> The rules of unfair competition as shaped by the courts' decisions in both jurisdictions led to many issues being discussed by scholars. The most predominant issue in the EU over exclusive origin function trademark protection correlates with the absence of clearer and uniform list of factors determining the likelihood of confusion in the US. However, my opinion is, if such a plastic interpretation and identification of double identity trademark problem serve to just and to better protection of trademark owners' rights, it is appropriate. The effect in reality is the unforeseeability of such a protection.

The other important issue is burden of proof when a plaintiff alleges that double identity problem has occurred so the third party used plaintiff's trademark without authorization. While in the EU, this process is easy for the impaired trademark owner due to the absolute double identity rule, in the US it is much more complicated. In other words, in the EU, when not taking into account the adverse effect on the other functions of the trademark and shall the court consider only the origin function, the courts without further evidence establish double identity rule in order to protect this trademark owner.<sup>308</sup> On the contrary, in the US, the courts take into account many and various factors whose burden of proof shifts from the plaintiff to the defendant according to the discretion of the court.<sup>309</sup> Therefore, I presume that the effect in reality is that in the US it is much harder to prove the double identity of two

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<sup>307</sup> The rules of unfair competition were taken into account having assessed the infringement between two identical trademarks already under provisions of the Paris Convention. See (n 12, n 13). Also see Kur (n 200), Leaffer (n 223).

<sup>308</sup> Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ECR I-2799, para 49, 52.

<sup>309</sup> Robins (n 285) 113.

conflicting trademarks than it is in the EU. As a result, individuals and smaller companies may be more reluctant to bring a claim before the courts than in the US.

## Conclusion

The research statement of my thesis was on what grounds either applicant for trademark's registration, trademark's user or competent authority should consider two trademarks identical. In addition, I considered also the defense of an impaired trademark's owner when the third party used his trademark without his consent. I examined this question in the international legal forum, and in both the EU and US jurisdiction.

In the first chapter, I discussed the relevant provisions as regards the roots of double identity protection in the international Paris Convention and TRIPS Agreement, since both EU and US signed these agreements. Despite of not having stated it expressly, the Paris Convention left the problem of double identity of identical trademarks to the rules of unfair competition. Even though this approach is decades' years old, it is still very modern in recent approach of the courts, both in the EU and the US. TRIPS agreement for the first time granted exclusive rights to the owner of a registered trademark to prevent others from using somebody else' trademarks explicitly. The combination of the rules of unfair competition and of the written law has become the core of the reasonable and justified scope of legal protection for trademark owners.<sup>310</sup>

In the second chapter, I have examined EU legal sources, CJEU's decisions and the doctrinal debate over the most controversial issues in the EU double identity rule protection. The most debatable issue is the scope of absolute protection under double identity rule. There is an absence of right answer replied by legislators, CJEU or scholars. They do not have an

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<sup>310</sup> The rules of unfair competition were taken into account having assessed the infringement between two identical trademarks already under provisions of the Paris Convention. See (n 12, n 13). Also see Kur (n 200), Leafer (n 223).

uniform opinion. However, after having assessed infringement upon basis of the double identity trademark problem, it is to be seen that the trend in the EU is to broaden the absolute protection from origin' s trademark function to the protection of the other not essential functions as well, e. g. advertising.<sup>311</sup> However, some of the scholars do not agree with this solution and they object that this is the step closer to the “*supermassive trademark protection*”.<sup>312</sup>

In the third chapter, I made a research on the double identity trademark problem in the US regarding legislation, case law and also doctrinal debate over the problematic issues. If the conclusion is that the situation in predictability of the CJEU' decisions is not unanimous, in the US it can be considered even worse. In assessing the criteria establishing infringement regarding third party' s unlawful use of identical trademark, the circuit courts created their own approach, referred to as the multifactor test.<sup>313</sup> This multifactor test is applied to qualify the likelihood of confusion as the most important determinant of infringement. However, even these lists seem not to be uniform, many of the factors are the same and basically, they serve the same objective to protect trademark owners and to avoid likelihood of confusion with other trademarks either from consumers' or general public perspective.

In the fourth chapter, I compared the EU and US legal frameworks. My findings are that both jurisdictions offer unique approaches beyond the strict interpretation of written law. Despite the EU and the US having different legal systems they apply similar rules to some extent as regard to identification of double identity trademark problem. Where in EU the courts started

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<sup>311</sup> Dawson (n 157) 220.

<sup>312</sup> Senftleben (n 193) 384.

<sup>313</sup> Halpern, Seymore and Port (n 210) 317, 318.

to apply functional approach over the trademark protection, the multifactor test of likelihood of confusion responds to EU approach in its essence.

To conclude, it is in the best interests of all countries to provide as uniform trademark protection to trademark's owners as they can achieve, in particular in recent times of globalization.

## BIBLIOGRAPHY

Abbott MF, Cottier T, Gurry F, *International Intellectual Property in an Integrated World Economy* (2nd edn, Wolters Kluwer Law & Business 2011)

Allen JM, 'Who must be confused and when?: The scope of confusion actionable under federal trademark law' (1991) 81 *The Trademark Reporter* 209

Aplin T and Davis J, *Intellectual Property Law: Text, Cases and Materials* (1<sup>st</sup> edn, Oxford University Press 2009)

Beebe B, 'An Empirical Study of the Multifactor Tests for Trademark Infringement' (2006) 93(6) *California Law Review* 1581

Bently L and Sherman B, *Intellectual Property Law* (4<sup>th</sup> edn, Oxford University Press 2014)

Blythe A, 'Confusion online: does the test for trade mark confusion on the internet differ from that applied to infringement in other spheres?' (2014) 36(9) *European Intellectual Property Review* 563

Bodenhause HCG, *Guide to the application of the Paris Convention for the Protection of Industrial Property, as revised at Stockholm in 1967* (United International Bureaux for the Protection of Intellectual Property (BIRPI) 1969)

Carvalho NP, *The TRIPS Regime of Trademarks and Designs* (2nd edn, Kluwer Law International 2011)

Clark SE, 'Finding Likelihood of Confusion with Actual Confusion: A Critical Analysis of the Federal Courts' Approach' (1992) 22(2) *Golden Gate University Law Review* 393

Colomer DRJ, Opinion of Advocate General to the Case C-48/05 *Adam Opel AG v Autec AG* [2007] ECR I-1017

Cook T, *EU Intellectual Property Law* (Oxford University Press 2010)

Correa MC, *Trade Related Aspects of Intellectual Property Rights: A Commentary on the TRIPS Agreement* (Oxford University Press 2007)



Danish Patent and Trademark Office, Workshop on the Revision of Trademark Law, Diquing (Yunnan Province), P.R. China from 13 to 15 May 2010, 10 <<file:///D:/Downloads/101--doccentre-trademarks-cc1-aw4-002-ravn-ctm-en.pdf>> accessed 16 February 2017

Davis J, 'Locating the average consumer: his judicial origins, intellectual influences and current role in European trade mark law' (2005) 2 I.P.Q. 183

Davis R and others, *Tritton on Intellectual Property in Europe* (4<sup>th</sup> edn, Sweet and Maxwell 2014)

Dreyfuss CR, Kwall RR and others, *Intellectual Property: Cases and Materials on Trademark, Copyright and Patent Law* (2<sup>nd</sup> edn, Foundation Press 2004)

Dawson MN, 'Non-trade mark use' (2012) 4 Intellectual Property Quarterly 204

European Parliament legislative resolution of 25 February 2014 on the proposal for a directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (recast) ([COM\(2013\)0162](#) – C7-0088/2013 – [2013/0089\(COD\)](#)) (Ordinary legislative procedure – recast) Art 10 (2) (a) <<http://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//NONSGML+TA+P7-TA-2014-0119+0+DOC+PDF+V0//EN>> accessed 12 February 2017

European Commission, 'Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark' (27.3.2013) 11

<[http://www.europarl.europa.eu/registre/docs\\_autres\\_institutions/commission\\_europeenne/com/2013/0161/COM\\_COM\(2013\)0161\\_EN.pdf](http://www.europarl.europa.eu/registre/docs_autres_institutions/commission_europeenne/com/2013/0161/COM_COM(2013)0161_EN.pdf)> accessed 12 February 2017

European Parliament, 'Briefing, EU Legislation in Progress' [2015] <[http://www.europarl.europa.eu/thinktank/en/document.html?reference=EPRS\\_BRI\(2015\)573887](http://www.europarl.europa.eu/thinktank/en/document.html?reference=EPRS_BRI(2015)573887)> accessed 21 March 2017

European Union Intellectual Property Office, Guidelines for Examination in the Office, Part C, Opposition (2017) 4 <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/trade\\_marks\\_practice\\_manual/WP\\_1\\_2017/Part-C/02-](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_1_2017/Part-C/02-)

[part\\_c\\_opposition\\_section\\_2/part\\_c\\_opposition\\_section\\_2\\_chapter\\_1\\_general\\_principles/part\\_c\\_opposition\\_section\\_2\\_chapter\\_1\\_general\\_principles\\_en.pdf](#)>accessed 12 February 2017

Gielen Ch, 'Trademark dilution under European law' (2014) 104 *The Trademark reporter*, 693

Gervais D, *The Trips Agreement – drafting history and analysis* (Sweet & Maxwell 1998)

Gotting HP, 'Protection of well known unregistered marks in Europe and the United States' (2000) 31(4) *International Review of Intellectual Property and Competition Law* 389

Griffiths A, 'The trade mark monopoly: an analysis of the core zone of absolute protection under Art.5(1)(a)' (2007) 3 *Intellectual Property Quarterly* 312

Halpern WS, Seymore BS and Port LK, *Fundamentals of United States Intellectual Property Law: Copyright, Patent, Trademark* (4<sup>th</sup> edn, Kluwer Law International 2012)

Idris K, 'WIPO Director General Hails 125th Anniversary of Historic International IP Treaty' <[http://www.wipo.int/pressroom/en/articles/2008/article\\_0016.html](http://www.wipo.int/pressroom/en/articles/2008/article_0016.html)> accessed 17 March 2017

International Trademark Association, 'Comments on the Proposed Revisions to the EU Community Trade Mark Regulation and Trade Marks Directive' [2013] 3 <<http://www.inta.org/advocacy/documents/june2013intacommentseutmsystemsreview.pdf>> accessed 16 February 2017

Joseph AM, 'I cann't believe it's not better: Why new GTLDS are bad for brand owners and trademark law' (2012) 20 *Journal of Intellectual Property Law* 149

Kur A, 'Convergence after all? A comparative view on the U.S. and EU trademark systems in the light of the "trade mark study' (2012) 19 *Journal of Intellectual Property Law* 305

Kur A, 'The EU Trademark Reform Package—(Too) Bold a Step Ahead or Back to Status Quo?' (2015) 19 *Marquette Intellectual Property Law Review* 19

Kur A, 'Trademarks Function, Don't They? CJEU Jurisprudence and Unfair Competition Principles' (2014) 45(4) *International Review of Intellectual Property and Competition Law*, 434

Leaffer M, Hansen H (ed), 'Sixty Years of the Lanham Act' in *U.S. Intellectual Property Law and Policy* (Edward Elgar Publishing Limited 2006)

Lefkowitz S, 'Double Trademarking – We've come a long way' (1983) 73 *The Trademark Reporter* 18

Maniatis S, Botis D, *Trade Marks in Europe: A practical Jurisprudence* (Thomson Reuters 2010)

Max Planck Institute, 'EU: ECJ upholds use as trademark in the "Arsenal" case' (2003) 34(1) *International Review of Intellectual Property and Competition Law* 117

Merges PR, Menell SP, Lemley AM, *Intellectual Property in the New Technological Age* (4<sup>th</sup> edn, Aspen Publishers 2006)

Merges PR, Menell SP, Lemley AM, *Intellectual Property in the New Technological Age* (6<sup>th</sup> edn, Wolters Kluwer Law & Business 2012)

Michaels A, *Intellectual Property Guides: A practical guide to trade mark law* (2<sup>nd</sup> edn, Sweet & Maxwell 1996)

Ng-Loy LW, 'An Interdisciplinary Perspective on the Likelihood of Confusion: Consumer Psychology and Trademarks in an Asian Society' (2008) 98 *The Trademark Reporter* 950

Organisation for Economic Co-operation and Development, 'The Economic Impact of Counterfeiting and Piracy' (2007) 18 <<https://www.oecd.org/sti/38707619.pdf>> accessed 11 February 2017

Ramsey PL and Schovsbo J, 'Mechanisms for limiting trade mark rights to further competition and free speech' (2013) 44(6) *International Review of Intellectual Property and Competition Law* 671

Rayle R, 'The trend towards enhancing trademark owners' rights – a comparative study of U.S. and German trademark law' (2000) 7 Journal of Intellectual Property Law 227

Robins DM, 'Actual Confusion in Trademark Infringement Litigation: Restraining Subjectivity Through A Factor-Based Approach to Valuing Evidence' (2004) 2(2) Northwestern Journal of Technology and Intellectual Property 1

Roncaglia LP and Sironi EG, 'Trademark functions and protected interests in the decisions of the European Court of Justice' (2011) 101 The Trademark Reporter 147

Schmidt-Pfitzner M, *WTO – Trade – Related Aspects of Intellectual Property Rights* (Peter-Tobias Stoll, Jan Busche, Katrin Arend, Rüdiger Wolfrum, Vol. 7, Koninklijke Brill NV 2009) 317

Senftleben M, Geiger Ch (ed) 'Adapting EU trademark law to new technologies: back to basics?' (2011) 140 Available at SSRN: [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=1875629](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1875629) accessed 22 March 2017

Senftleben M, 'Function Theory and International Exhaustion – Why It Is Wise to Confine the Double Identity Rule to Cases Affecting the Origin Function' (2014) 36(8) European Intellectual Property Review 518

Senftleben M, 'Trade mark protection - a black hole in the intellectual property galaxy?' (2011) 42(4) International Review of Intellectual Property and Competition Law 383

Seville C, 'The Principles of International Intellectual Property Protection: From Paris to Marrakesh' (2013) 5(1) The WIPO Journal: Analysis of Intellectual Property Issues 99

United States Patent and Trademark Office, 'Protecting Your Trademark - Enhancing your rights through, federal registration' (2014) 9 <https://www.uspto.gov/sites/default/files/trademarks/basics/BasicFacts.pdf> accessed 16 February 2017

Walters EC, 'Trademark Registration Practice in the United States Following the Trademark Law Revision Act of 1988' (1989) 58 Nordiskt Immateriellt Rättsskydd 265

World Intellectual Property Organization,  
<[http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=2](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=2)> accessed 17 March 2017

World Intellectual Property Organization, *Implications of the TRIPS Agreement on Treaties administered by WIPO* (WIPO Publication No 464 (E) 2012)

Wurtenberger G, ‘L’Oréal v Bellure: An Opinion’ (2010) 5(10) Journal of Intellectual Property Law & Practice 746

## Table of Cases

Adam Opel AG v Autec AG (C-48/05) [2007] ECR I-1017

Aventis Pharma SA v OHIM and Nycomed GmbH (T-95/07) [2008] ECR II-229

Arsenal Football Club plc v Matthew Reed (C-206/01) [2002] ECR I-10273

Big O Tire Dealers, Inc v. Goodyear Tire & Rubber Co. [1976], 408 F. Supp. 1219 (D. Colo)

Borden Ice Cream Co. et. al. v Borden’s Condensed Co. [1912], 201 F. 510 (7th Cir.)

Claudia Oberhauser v OHIM and Petit Liberto, SA (T-104/01) [2002] ECR II-4359

Computer Care v. Service Systems Enterprises, Inc. and Larry Aronson [1996] 982 F.2d 1063 (7th Cir.)

Die BergSpechte Outdoor Reisen und Alpinschule Edi Koblmüller GmbH v Günter Guni, trekking.at Reisen GmbH (C-278/08) [2010] ECR I-2517

Harold F. Ritchie, Inc. v. Chesebrough-Ponds, Inc. [1960] 281 F.2d 755 (2nd Cir.)

Interflora Inc., Interflora British Unit v Marks & Spencer plc, Flowers Direct Online Ltd, (C-323/09) [2011] ECR I-08625

Insty\*Bit, Inc. v Poly-Tech Industries, Inc. [1996] 95 F.3d 663 (8th Cir.)

Lambda Electronics Corporation, and Veeco Instruments, Inc. v Lambda Technology, Inc. [1981] 515 F. Supp. 915 (S.D.N.Y)

Lois Sportswear, U.S.A., Inc. v Levi Strass & Company, Levi Strauss & Company v Textiles Confessiones Europas, S. A. [1985] 631 F. Supp. 735 (S.D.N.Y.)

L'Oréal SA, Lancôme parfums et beauté & Cie SNC, Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd, Starion International Ltd (C-487/07) [2009] ECR I-5185

L TJ Diffusion SA v Sadas Vertbaudet SA (C-291/00) [2003] ECR I-2799

Miles Shoes, Inc. v. R. H. Macy & Co., Inc. [1952] 199 F.2d 602 (2nd Cir.)

O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited (C-533/06) [2008] ECR I-4231

Polaroid Corporation v Polarad Electronics Corporation [1961] 287 F.2d 492 (2nd Cir.)

RJR Foods, Inc. v. White Rock Corp. [1979] 603 F.2d 1058 (2nd Cir.) 1061.

Thane International, Inc. v Trek Bicycle Corporation [2002] 305 F.3d 894 (9th Cir.)

Vibrant Sales, Inc. v The New Body Boutique, Inc., Maximum Exposure Advertising, Inc, Harvey S. Fishman and Avram C. Freedberg [1980] 496 F. Supp. 854 (S.D.N.Y)

## **Table of Legislation**

Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L 78/1

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 [2015] OJ L 336/1

Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L 299/25

Lanham Act (1946)

Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957)

Paris Convention (1883)

Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark [2015] OJ L 341/21

Treaty establishing the European Economic Community [1957]

Treaty on the Functioning of the European Union [2007] OJ C 326/49

TRIPS Agreement (1994)