

## EU MARKS A QUARTER OF A CENTURY



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OF A CENTURY

Flip PETILLION  
(ed.)



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EU Marks a Quarter of a Century

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## ABOUT THE EDITOR

Flip Petillion is a leading domestic and international dispute resolution counsel and arbitrator. Over more than thirty years, Flip has built an outstanding reputation through his special focus on intellectual property rights, information technology, the Internet, communication and media. During his career, he witnessed first-hand the growing importance of intellectual assets for local and multinational clients. He observed the increasing harmonisation of intellectual property rights within the European Union. These developments led Flip to specialise in a wide array of intellectual property and related rights, including trade marks, copyrights, patents, designs, trade names, company names, domains, domain names, trade secrets and unfair competition. He has handled landmark intellectual property cases up to the European Court of Justice and has been at the forefront of Internet-related matters since the mid-1990s.

While he is particularly known for his endeavours on the contentious and enforcement side of intellectual property disputes, Flip also assists clients in relation to licensing and other IP-related contracts, advertising clearance, IP-driven transactions and strategic advice. Through a global clientele and positions within various important European and international organisations, such as ICC, ICDR (AAA), INTA, Marques, ECTA and ICANN, he has developed an extensive international practice and network. Flip also has an important background in alternative dispute resolution, having served as arbitrator, panellist and counsel in arbitration proceedings administrated by various international institutions. Many of his appointments were directly related to his expertise in the field of intellectual property and new technologies.

Flip regularly publishes on various topics related to intellectual property. He lectures at the Benelux BBMM Professional Education Program for Trademark and Design Attorneys, at the IP and ICT Masters program at Leuven University, and at the EUIPO Trade Mark and Design Education Programme. Flip is the editor of a yearly legal publication commenting significant IP case law. In 2018, he edited a book on the enforcement of intellectual property rights in Belgium, which involved the collaboration of 25 peers. In 2019, he edited a book on the enforcement of intellectual property rights in Europe,

which involved the collaboration of peers from all European Member States. He is a frequent speaker at professional and academic conferences and has published several articles relating to intellectual property and (alternative) dispute resolution.

After a decade of partnership in an international law firm, Flip established his own firm in the Autumn of 2017. PETILLION is an independent boutique firm focusing on national and international commercial dispute resolution and intellectual property. The firm provides a full array of international and domestic intellectual property legal services and acts before Belgian courts and before the European Court of Justice and the European General Court. With PETILLION, Flip is pursuing his vision of an independent firm, focused on efficiency and providing client-minded and effective solutions.

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**SIMION & BACIU** unites a team of seasoned attorneys and counsellors, with the drive and passion to deliver the best and most helpful results for its clients. With more than 20 years of experience, spanning over several complementary areas of law, our team offers a fresh, business-oriented approach and successfully

assists clients time and again. The firm focuses primarily on the following areas of law: Intellectual Property, Gaming & Gambling, Consumer protection & Advertising, Life sciences, Data Privacy and Personal Data Processing, Corporate, M&A, Technology&Media and Dispute Resolution.

\*

**Alexander Schnider** is a co-founding partner at GEISTWERT in Austria. For more than 20 years, Alexander has been focusing on intellectual property litigation with an emphasis on trademarks. His practice primarily involves IP litigation, both at national and EUIPO level, as well as IP transactions in a variety of industries, including interactive entertainment, media, software development, automotive, pharma, technology, and foodstuff/beverages. Alexander also provides IP strategy and portfolio management services and assists clients in monetizing their IP assets.

GEISTWERT comprises five partners whose shared interest in intellectual property brought them together. As experienced and recognized experts in the area of intangible rights and related fields, we founded GEISTWERT, a centre of expertise. This law firm is able to work with a high concentration of a rare type of specialized knowledge, allowing it to keep a close watch on the everyday changes showing up on the radar in the highly volatile area of intellectual property. As a veritable intellectual powerhouse, our main mission is to help clients and colleagues reach their goals in the best possible way.

Based on experience of up to twenty years in some of Vienna's renowned law firms, we can claim, quite immodestly, to be the best of the best. We were able to specialize and to become recognized IP and IT legal experts already early on in our careers. Having reached this point, the next logical step was to create our own competence centre.

Our 'post-material' age brings new challenges. The information society, globalization, the Internet, information technology, the brand orientation of companies, technical innovations and their patent protection, as well as the ever-greater economical stake of the creative industries, are some of the main issues of social change today. The increasing legal regulation of these innovation drivers is something that is being promoted worldwide. The pace at which changes are taking place in these closely interlocking fields has triggered political debates. As a consequence, the legal situation is constantly changing, and the judicial system is subject to growing complexity and fluctuations. The result is a high degree of uncertainty when it comes to legal matters.

Against this backdrop we seek to position ourselves as a competence centre that has a clear view of all the legal developments in the IP world, while constantly following the latest developments in information. Our mission is to support clients and colleagues in all matters related to IP and technology by offering the very best expertise. This, in short, is the value that GEISTWERT promises to provide.

\*

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**BECH BRUUN** is a full-service law firm serving a large range of operators in the Danish corporate sector, the Danish public sector as well as international corporations by way of its wide range of products and services. Numbering more than 500 experienced and highly specialised employees, Bech-Bruun ranks among the leading law firms in Denmark.

Bech-Bruun has in-depth experience across several key industry sectors and offers legal services within 13 practice groups having their own areas of expertise. Bech-Bruun also has a strong international focus and has, over many years, built a unique global network of leading law firms for cross-border legal assistance. Bech-Bruun's Chinese desk enables the firm to act for numerous Chinese clients in the Nordic markets and numerous Danish corporations in the Chinese market.

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PETILLION is an independent law firm with a focus on dispute resolution. PETILLION's multi-lingual team helps clients prevent, settle and to resolve commercial disputes through compliance counselling, contract drafting, negotiation, court litigation, arbitration or other forms of alternative dispute resolution (ADR).

Most of the disputes involve court litigation before national civil, commercial and administrative courts, before European courts and administrative bodies, in ad hoc arbitrations, and before leading national and international arbitration institutions around the world, such as the ICC (Paris, France), the ICDR (AAA) (New York, U.S.A.), the WIPO (Geneva, Switzerland), the FORUM (Minneapolis, U.S.A.), the CAC (Prague, Czech Republic), and the CEPANI (Brussels, Belgium).

PETILLION has a particular experience in specific sectors or industries such as Intellectual Property, Information Technology, Media & Entertainment, the Internet, and Fashion. The firm has also worked extensively on matters related to Postal, Telecoms, Energy, Construction and Real Estate, Automotive, Aviation and Aerospace, and Distribution.

\*

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**MASON HAYES & CURRAN LLP** is a business law firm with 95 partners and offices in Dublin, London, New York and San Francisco. As legal and regulatory responsibilities become more complex, progressive organisations need the right advice to help realise their ambitions. The expertise Mason Hayes & Curran LLP brings is rooted in unrivalled knowledge of the sectors in which its clients operate, so advice is always set in its commercial context.

\*

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**PREU BOHLIG** is an independent IP law firm with offices in Munich, Hamburg, Berlin, Düsseldorf, and Paris. PREU BOHLIG's team of more than 30 highly specialised lawyers provides legal advice to international corporations, small and medium sized companies and start-ups. The main focus is on patent, trademark and design law as well as on unfair competition and trade secret protection. PREU BOHLIG's lawyers advise on and act in infringement litigation, parallel invalidity proceedings and in product piracy matters. They also advise and represent clients in the fields of German and European pharmaceutical, medical device, cosmetics and food supplements law.

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**Šindelka & Lachmannová** is a boutique law firm focused on the enforcement and prosecution of intellectual property (trademark, designs, patents, domain names, copyright), IT law, pharma law and unfair competition.

Members of the firm have provided assistance in complex intellectual property enforcement matters both in and outside courts for leading companies in the fashion, media, automotive or tobacco industries. The firm has significant experience in anticounterfeiting matters, representing several premium luxury fashion brands. The firm has also been regularly assisting clients in domain matters both in courts and in alternative dispute resolution (ADR).

The firm's diverse client portfolio ranges from multinational corporations to innovative Czech small and medium-sized companies.

\*

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**WATERFRONT SOLICITORS LLP** is a highly successful niche Intellectual Property and Information Technology law firm located in London. The firm was set up in 2002 to provide an alternative option to businesses looking for legal advice in a structure that enabled it to cater effectively for clients both great and small. Since then, it has steadily grown in size and now provides advice across a

number of different areas of law. However, it still retains an intellectual property and technology sector focus. It also continues to act for the full spectrum of business clients, including individual entrepreneurs, SMEs and multinational corporations, including companies listed on the London Stock Exchange, the AIM and the NASDAQ, and government agencies.

A particular strength of the firm is the conduct of English intellectual property litigation, with cases regularly undertaken for clients in the various intellectual property courts and lists of the English High Court, including IPEC.

\*

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**GANADO ADVOCATES** has a long heritage. Founded originally in Valletta – Malta's capital city – the firm traces its roots back to the early 1900s. Today, it is one of Malta's foremost law practices and is consistently rated as a top tier firm by leading rating agencies and legal directories.

Ganado Advocates seeks to provide high standards of legal advisory services in a wide spectrum of international commercial and corporate activities, with particular focus on financial and maritime services. The firm has been consistently at the forefront of local legislative initiatives and has on several occasions over the years brought about major legislative change in many fields, not least in maritime, ship finance, banking, aviation, trusts and investment services.

\*

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VINGE is an independent full-service firm and provides legal advice and leading expertise in all legal and practice areas of business law and is today one of the largest law firms in Sweden. VINGE's IP team is the largest provider of full-service commercial and intellectual property law in Sweden. VINGE's IP team consists of experienced attorneys and lawyers with expertise in all areas of intellectual property law, such as litigation and arbitration, drafting and negotiating intellectual property agreements such as contracts for R&D, licensing, merchandising and franchising and co-existence, management of trademark and design portfolios and due diligence in the context of private and public company acquisitions.

# INTRODUCTION

1996 seems like yesterday. It is amazing to see how much has changed since then. April Fool's Day of that year coincided with the first European trade marks being effectively filed in the trade mark world. However, the efforts put into creating the recipient of these filings, namely the European Union Intellectual Property Office (EUIPO) (initially called the Office for Harmonization in the Internal Market or OHIM), were no joke.

Looking back, it is safe to say that these efforts paid off. I cannot resist but to present some numbers: from 46,700 EU trade mark applications in 1996 to 175,000 in 2020. According to the latest statistics, previous records are likely to be broken as the EUIPO received over 101,000 trade mark applications during the first six months of 2021.

EU trade mark law – and by extension, the trade mark law of the EU Member States – has evolved substantially during this period. After numerous directives and regulations harmonizing the substantive law of the Member States and creating the European trade mark, Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights marked an important step in the European Union's aim to streamline the means of enforcing these rights across the EU.

But the most significant evolution has undoubtedly been the EU Trade Mark Legislative Reform Package, comprising Directive 2015/2436 of 16 December 2015 to approximate the laws of the Member States relating to trade marks (EUTMD) and Regulation 2017/1001 of 14 June 2017 on the European Union trade mark (EUTMR).

Apart from changing the name from 'Community trade mark' to 'EU trade mark', significant changes included the removal of the graphical representation requirement resulting in the acceptance of new types of file to describe the sign for which trade mark protection is sought, such as audio-visual files. This evolution was necessary, as were all the other digitalisation efforts carried out by the EUIPO. However, discussions on whether a particular sign can be protected as a trade mark will not disappear, quite the contrary. The increase of accepted

file formats has certainly added complexity to the assessment of the protectable character of a sign as a trade mark.

Another important addition to the legal framework is the incorporation of the CJEU's findings in the *IP Translator* case<sup>1</sup>: the goods and services for which protection is sought must be identified by the applicant with sufficient clarity and precision. The use of general terms to describe the goods and/or services covered by a trade mark application, such as the general indications of the class headings of the Nice Classification, will only cover the literal meaning of the term or indication. All trade mark professionals know the importance of the description of goods and services covered by marks and its impact in trade mark disputes. Increasing clarity in that regard can only be encouraged.

Regarding the EUTMD specifically, it also limited the EU Member States' freedom with regard to their national trade mark law. Various optional provisions became mandatory, such as ensuring that bad faith is taken up as an absolute ground for invalidity. Since 2019, EU Member States must also provide for efficient opposition, revocation and invalidity procedures.

It is interesting to notice that the success of the EU trade mark resulted in a shift from a 'bottom-up' harmonization of national trade mark systems to a 'top-down' approach based on the EU trade mark system. With the EUTMD, EU Member States are now forced to include provisions in their national law which were initially developed for the EU trade mark system.

Apart from the legal framework, another notable evolution relates to the EU case law on trade marks, and more specifically the CJEU case law. Such case law has decreased drastically since 1 May 2019, due to new rules on whether or not to allow appeals to proceed in cases which have already been considered twice. In cases which were already subject to a decision of the EUIPO Board of Appeal and the EU General Court, any appeal must now be accompanied by a request that the appeal be allowed to proceed, not exceeding seven pages, in which the appellant sets out, clearly, the issue raised by the appeal that is significant with respect to the unity, consistency or development of EU law. As a consequence, far fewer appeals have been allowed by the CJEU. As much as we love guidance from Europe's Supreme Court, it is understandable to have filters in place to avoid appeals without sufficient grounds. In any event, the abundant case law of the EU General Court should continue to provide sufficient guidance in the future.

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<sup>1</sup> Judgment of the CJEU of 19 June 2012, *IP Translator*, C-307/10, EU:C:2012:361.

Of course, one of the reasons for the success and increasing numbers of EU trade mark applications has been the expansion of the European Union over the past quarter of a century. 13 Member States joined since the first European trade marks, and sadly one left. This is why a book celebrating the 25<sup>th</sup> anniversary of the EU trade mark had to include the views of trade mark experts from all over Europe.

This book starts with two contributions about the EUIPO's convergence efforts with the national trade mark offices and the impact of EU case law on national trade mark practice, respectively. It ends with an analysis of the impact of Brexit on EU trade marks.

In between these contributions, the evolution of the EU trade mark system is addressed through a wide variety of subjects of substantive law: trade mark functions, the distinctive character of a trade mark, signs which consist exclusively of the shape of the goods as an absolute ground for refusal of a trade mark, genuine use of a trade mark and its impact on the scope of protection, unregistered trade mark rights, bad faith registration, and misleading use of a trade mark.

Two more contributions cover procedural issues: appropriate jurisdiction of trade mark related disputes, and provisional and protective measures against EU trade mark infringement.

I believe that the wide variety of topics provides for a worthy celebration of the 25<sup>th</sup> birthday of the EU mark.

I thank all the authors for their endeavours. I also particularly express my appreciation to Diégo Noesen for his help in the follow-up of the editing and production of this book.

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