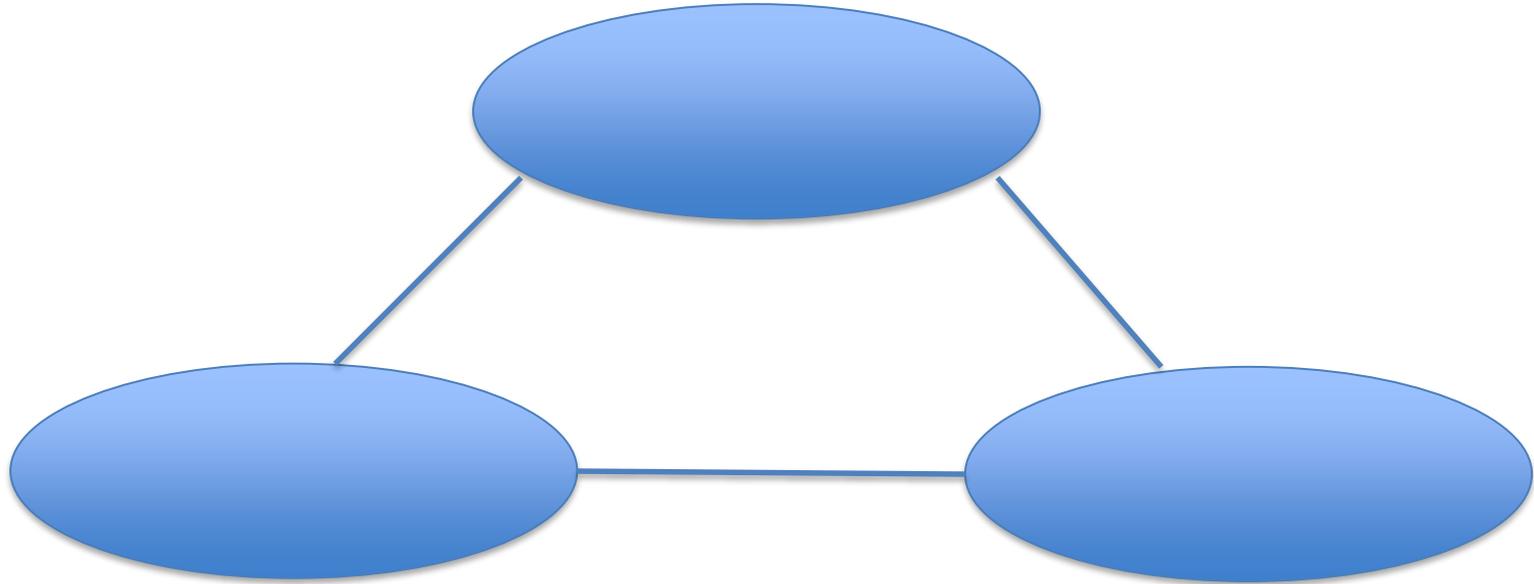


# The systemic challenge; an overview

---

Thomas Frydendahl  
Seconded National Expert  
Boards of Appeal

## The systemic challenge



## Lenient requirement for distinctive character

C-329/02 P ‘Sat.1’ § 41:

*‘The trade mark does not need to convey a specific level of linguistic or artistic creativity or imaginativeness.’*

T-460/05 ‘Bang & Olufsen’ § 45:

*‘... a minimum degree of distinctive character is sufficient to render inapplicable the ground for refusal set out in [ Article 7(1)(b) EUTMR]...’*

C-398/08 P ‘Vorsprung’ § 39:

*‘... cannot be required to display ‘imaginativeness’ or even ‘conceptual tension which would create surprise and so make a striking impression’ in order to have the minimal level of distinctiveness required...’*

T-24/00 ‘VITALITE’ § 24:

*‘... does not directly and immediately inform the consumer of [...] characteristics of [ the goods]. Consequently the link between the meaning of the word [...] and the goods in question [...] does not seem to be sufficiently close to be caught by the prohibition laid down [ Article 7(1)(c) EUTMR]. In fact [that] is a case of evocation and not designation for the purposes of that provision.*

## Public interest (The need to keep free / scope of protection)

### C-104/01 P ‘Libertel’ § 50-53:

*‘The possibility of registering a trade mark may be limited for reasons relating to the public interest.’*

*‘The various grounds for refusing registration [Article 7 EUTMR] must therefore be interpreted in the light of the public interest underlying each of them...’*

*‘... pursues an aim that is in the public interest, which requires that [ signs which are descriptive ] may be freely used by all...’*

### C-39/97 ‘Canon’ § 28:

*‘For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish...’*

### Preamble of the EUTMR, third paragraph:

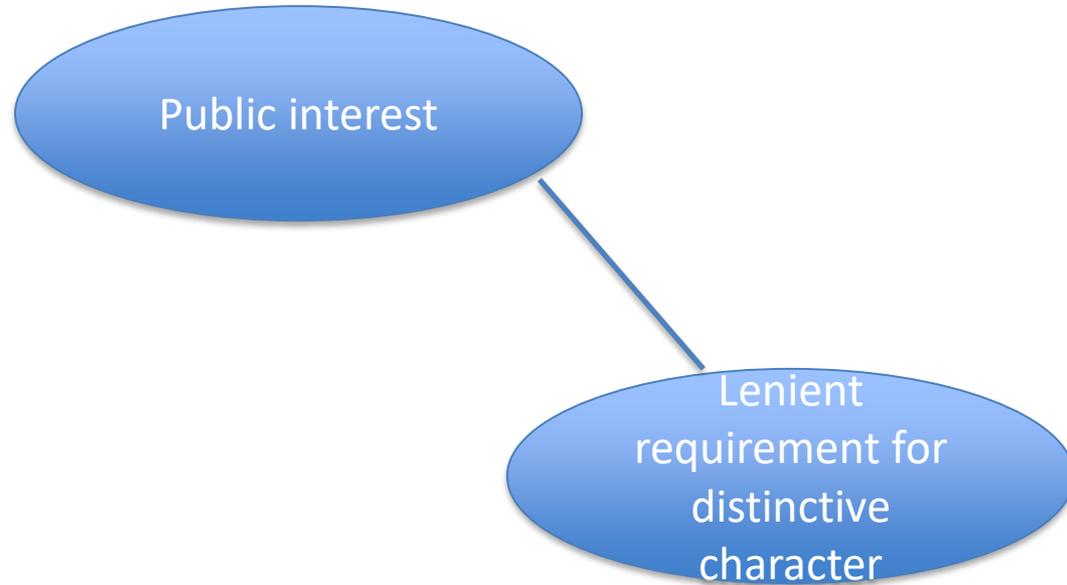
*‘[...]not only must barriers to free movement of goods and services be removed and arrangements be instituted which ensure that competition is not distorted, but, in addition, legal conditions must be created which enable undertakings to adapt their activities to the scale of the Community...’*

### C-251/95 ‘SABEL’ § 23-24 :

*‘ That global appreciation [...], must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components...’*

*‘... the more distinctive the earlier mark, the greater will be the likelihood of confusion’.*

## National systems



## Unitary character

### Article 1(2) EUTMR:

*‘An EU trade mark shall have unitary character. It shall have equal effect throughout the Union: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Union...’*

### C-514/06P ‘Armacell’ § 57:

*‘... the unitary character of the [EUTM] means that an earlier [EUTM] can be relied on in opposition proceedings against any application for registration of a [EUTM] which would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the [union].’*

## Unitary Character

### C-235/09 ‘DHL’ § 48:

*‘... if a [court] hearing a case [...] finds that the acts of infringement or threatened infringement of a Community trade mark are limited to a single Member State or to a part of the territory of the European Union, in particular because the applicant for a prohibition order has restricted the territorial scope of its action in exercising its freedom to determine the extent of that action or because the defendant proves that the use of the sign at issue does not affect or is not liable to affect the functions of the trade mark, for example on linguistic grounds, that court must limit the territorial scope of the prohibition which it issues’.*

### Article 14 EUTMR ‘Limitation of the effects of an EU trade mark’:

*1. An EU trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:*

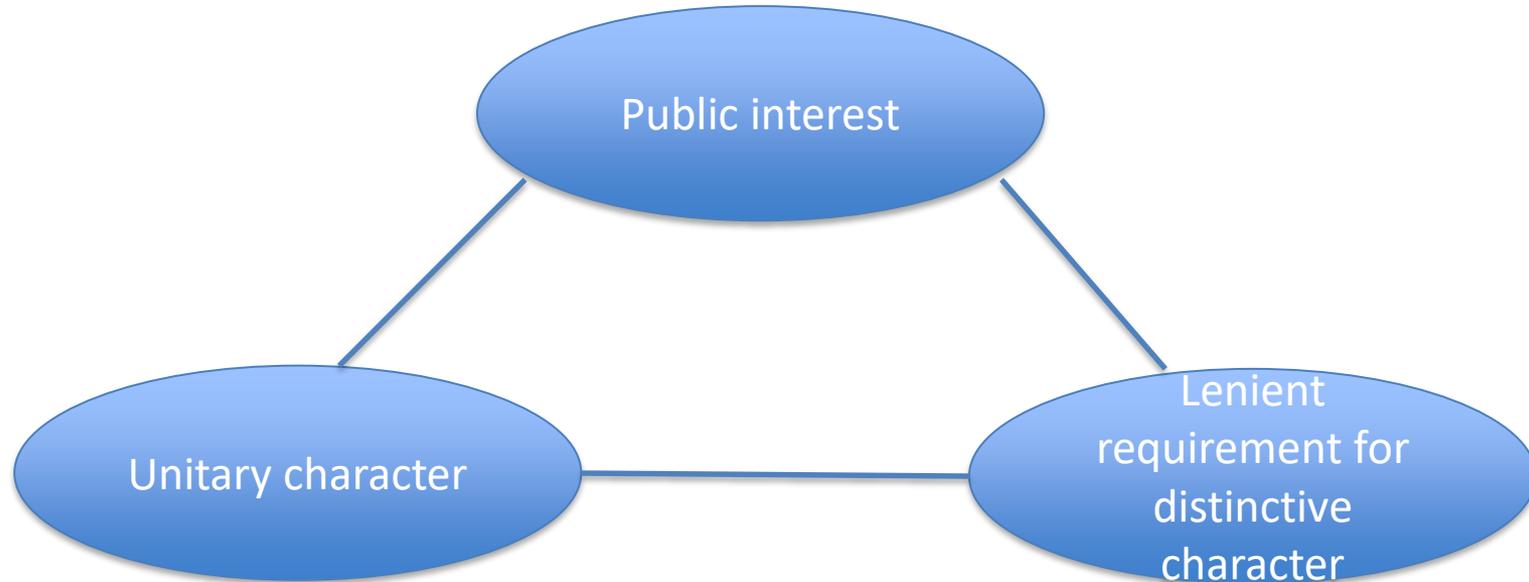
*(a) the name or address of the third party, where that third party is a natural person;*

*(b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of the goods or services;*

*(c) the EU trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of that trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.*

*2. Paragraph 1 shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.*

## The systemic challenge



## The systemic challenge

1: In a system with ‘Unitary character’ and in which the ‘public interest’ must be respected, it is impossible to have a ‘lenient requirement for distinctive character’.

T-290/15, § 38:

SMARTER  TRAVEL

*‘[considering the context of travel and related services]... the public will immediately understand the symbol, not as a speech bubble, but as a suitcase which is slightly modified at the bottom.’*

T-361/15, § 30:



*‘... the graphic elements do not present any characteristics likely to draw the consumers immediate attention as an indication of the origin of the contested goods and services, [it] follows that these elements are not capable, [...], to divert the relevant public from the descriptive message of the expression “choice chocolate & ice cream”, and this even if, [...], the public would perceive the figurative element as a wing.’*

## The systemic challenge

2: In a system which has ‘unitary character’ and in which there is a ‘lenient requirement for distinctive character’ it is impossible to respect the ‘public interest’.

T-218/10 (LOC):



As some consumers in the European Union will not understand the word components as descriptive

R 476/2016-2 (LOC):



French- Italian-, Greek, Hungarian- or Spanish- speaking consumers, neither sign has a meaning.

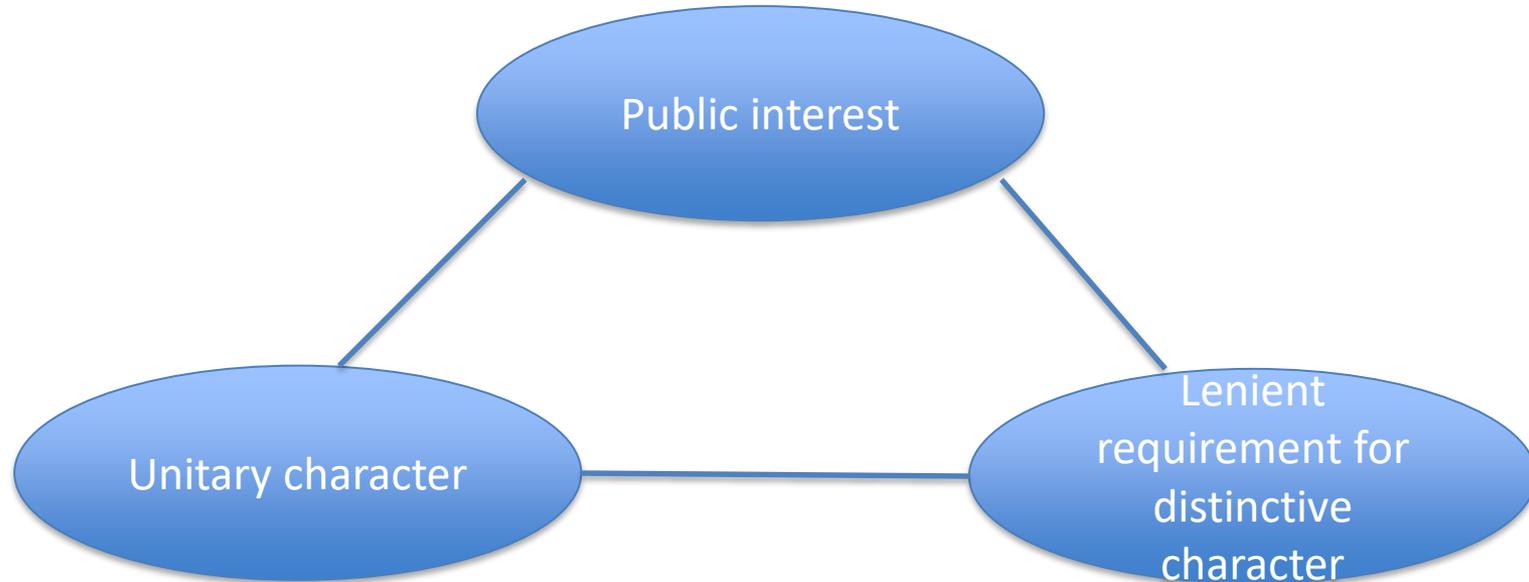
## The systemic challenge

3: In a system which has a 'lenient requirement for distinctive character' and which respects the 'public interest' it is impossible to comply with 'unitary character'.

T-55/15 (no LOC):



## The systemic challenge



Questions?





[www.euipo.europa.eu](http://www.euipo.europa.eu)



---

@EU\_IPO



---

EUIPO

Thank you