Chapter 5: Rights involving Commercial Goodwill

Introduction

5-1 Various rights recognised in the intellectual property field stem from national laws on the protection of commercial goodwill, from laws designed to prevent "passing off" and from the prohibition of unfair competition. As a result, the following categories of rights have developed:

- trade marks
  - registered marks
  - unregistered marks
- geographical designations
  - appellations of origin
  - indications of source
- rights based on unfair competition law
  - general rights
  - rights in the field of advertising

In many of these fields there are laws having a uniform effect throughout the European Union.

Trade Marks

5-2 In European Union law there are three sources of law governing trade marks:

- the first Directive harmonising national trade marks laws[1],
- the Community Trade Mark Regulation[2] (and implementing regulations) and
- the case law of the Court of Justice of the European Communities.

Much of the case law antedates the first Directive and is largely incorporated or reflected in the Directive. Most of the case law since the Directive concerns the interpretation of some of its specific provisions. Case law on the interpretation of the Regulation has recently begun to develop: so far, it has been mainly concerned with the question of distinctiveness, which is discussed later in this Chapter.[3]

5-3 In the European Union's scheme of trade mark law, two systems exist side by side. National laws continue to exist, but are subject to harmonisation. At the same time, there is a Community system of trade mark protection for trade marks valid throughout the territory of the European Union and subject to centralised rules, administered by a centralised office. There are several reasons for having two systems. One is that, for many products and services, national trade marks adequately fulfil traders' needs. The very nature of a product or service may be local; and it could be unreasonable to expect traders with an inherently local business to take out a multi-national trade mark. "The Community law relating to trade marks does not replace the laws of the Member States on trade marks; it would not in fact appear to be justified to require undertakings to apply for registration of their trade marks as Community trade marks; national trade marks continue to be necessary for those undertakings which do not want protection of their trade marks at Community level."[4] A second reason is that, if national trade mark systems were subsumed in a unitary trade mark system, there would as a result be many

identical or confusingly similar marks which would either have to co-exist within the same extensive territory or, if this were legally feasible, be in some way curtailed; neither of these would be an attractive outcome.[5] In practice, the adjustments needed to replace national systems entirely would be complex, expensive, possibly unjust and certainly hard to justify. The pattern set by the trade mark system, of having parallel forms of protection at both national and European levels, seems likely to be followed in other fields of intellectual property, where similar considerations apply. At the time of writing, the Commission has proposed a similar approach in measures designed to protect, respectively, utility models and designs.

Harmonisation of national laws

5-4 In the years between the establishment of the European Economic Community in 1958 and the First Directive on the harmonisation of national trade mark laws, which came into force on 28 December, 1991, it had become increasingly evident that there were problems in reconciling the requirements of national trade mark laws and the requirements of Community law on the free movement of goods. A series of cases in the Court of Justice had illustrated how national trade mark laws were being relied upon to prevent alleged infringers from importing goods from one Member State to another; and, while there may have been cases in which the protection of intellectual property rights made infringement actions necessary and justifiable, the effect was to create obstacles to intra-Community trade.

5-5 At first, the Court was understandably cautious and limited itself to the view that, while Community law left trade mark rights "untouched", it might influence the way in which those rights were exercised.[6] Later, the Court emphasised more strongly the difference between the existence of the trade mark right and the exercise of the rights and added:

> The national rules relating to the protection of industrial and commercial property have not yet been standardised within the Community framework, so that the national character of this protection could create obstacles both to the free movement of trade marked goods and to the rules on competition.[7]

One such obstacle would be a tendency to "partition the market", a phrase used by the Court in a case involving trade marks with a common origin.[8] The case is considered further below in connection with the second Hag case[9], and later in a case involving trade marks considered by the German authorities to be confusingly similar.[10] Meanwhile, the Court had made it clear that an obstacle to the free movement of goods might arise when a trade mark owner could prevent importation of a product into his own Member State when it had been lawfully marketed in another Member State.[11] The same could not, however, be said where the product had been imported from a non-member state.[12]

5-6 Several subsequent cases dealt with the trade mark problems arising when goods are re- packaged under the same or different trade marks.[13] A further case dealt with the question of trade marks having a common origin and reversed the main part of the Court's earlier decision.[14] In the last main case before the Directive came into force, the Court of Justice considered the question of confusing similarity and decided that this was

a matter to be decided by the national authorities[15]; however, this case is of limited interest in view of both the terms of the Directive and the case-law on the subject since the Directive came into force.[16]

The First Directive

5-7 At the end of 1991, the First Council Directive of 21 December 1988 to approximate[17] the laws of the Member States relating to trade marks came into force.[18] It is entitled the "first" directive, as the institutions responsible for proposing and adopting it envisaged the possibility of further harmonisation in due course. For the time being, however, it did not appear to them to be necessary to undertake full-scale harmonisation of the trade mark laws of the Member States; it was sufficient for harmonisation to be limited to those national provisions of law which directly affected the functioning of the internal market.[19] One of the matters on which the Commission had to defer action, possibly to a later harmonisation measure, concerned the criteria for determining what constituted "confusing similarity". Different national criteria may constitute a barrier to trade.[20] At the time of the case, an informal enquiry by the Commission indicated that none of the Member States' trade mark offices, other than Germany's, would have treated these two names as confusingly similar. In the absence of harmonisation in this area, it is possible that case law in the Court of Justice and decisions by the Office responsible for the Community Trade Mark may provide some guidance. A case directly concerned with confusion between similar trade marks came before the Court of Justice shortly before the Trade Mark Directive came into force.[21] Although the Court's decision was consistent with the subsequent requirements of the Directive, the cases which followed the date on which the Directive came into force are more relevant to the present state of the law in that they were decided on the basis of the Articles of the Directive dealing with confusing similarity.[22]

5-8 Those national provisions of trade mark law which, according to the Community legislators, directly affected the common market were as follows:

- registration of and application for trade marks[23],
- the signs of which a trade mark might consist[24],
- the grounds for refusing to register a trade mark or for declaring a registered trade mark invalid[25],
- the rights conferred by a trade mark[26],
- the limitation of the effects of a trade mark[27],
- the exhaustion of trade mark rights[28],
- the right to license a trade mark[29],
- the effects of acquiescence in the use of a later trade mark[30],
- the obligation to use a trade mark[31],
- the grounds for revoking a trade mark[32] and
- collective marks, guarantee marks and certification marks.[33]

Purpose of harmonisation

5-9 As might be expected from the case law preceding the adoption of the trade mark Directive, the primary purpose of harmonisation was to reconcile the protection afforded by national laws with the aims of the European Community. As the Directive itself expresses it: "the trade mark laws at present applicable in the Member States contain disparities which may impede the free movement of goods and freedom to provide services and may distort competition within the common market; it is therefore necessary, in view of the establishment and functioning of the internal market, to approximate the laws of Member States".[34] The Directive contains a reminder of the "solutions and advantages which the Community trade mark system may afford to undertakings wishing to acquire trade marks"[35]; but it is left to the Regulation establishing the Community trade mark system to explain why national systems should remain in being.[36]

5-10 In justifying the need for harmonisation, the Directive makes it clear that Member States still have a certain amount of latitude in the regulation of their national trade mark laws. Member States are, for instance, entitled to maintain a system of unregistered trade marks - that is, trade marks acquired through use rather than through registration, - the Directive being concerned in this respect only with the relationship between registered and unregistered trade marks.[37] Moreover, the Directive does not exclude the application to trade marks of provisions of law of the Member States other than trade mark law, such as the provisions relating to unfair competition, civil liability or consumer protection.[38] Specifically, Member States remain free:

- to fix the provisions of procedure concerning the registration, the revocation and the invalidity of trade marks acquired by registration;
- to determine, for example, the form of trade mark registration and invalidity procedures,
- decide whether earlier rights should be invoked either in the registration procedure or in the invalidity procedure or in both;
- if they allow earlier rights to be invoked in the registration procedure, to have an opposition procedure or an ex officio examination procedure or both; and
- to determine the effects of revocation or invalidity of trade marks.[39]

Following these provisos, the Directive points out that attainment of the objectives at which this harmonisation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States.[40]

5-11 Since the date on which the Directive came into force, there has been some case law on the interpretation of its provisions and, in particular, on:

- the likelihood of confusion between similar trade marks[41];
- the exhaustion of trade mark rights[42]; and
- the revocation of a trade mark.[43]

5-12 In two cases the Court of Justice has given its interpretation of the provisions of the Directive concerned with confusing similarity. In the first, it held that:

> The criterion of "likelihood of confusion which includes the likelihood of association with the earlier mark" contained in Article 4(1)(b) of First Council Directive 104/89, to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion within the meaning of that provision.[44]

In the second, the Court held that:

> On a proper construction of Article 4(1)(b) of First Council Directive 104/89, to approximate the laws of the Member States relating to trade marks, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion. There may be a likelihood of confusion within the meaning of Article 4(1)(b) of Directive 104/89 even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically linked undertakings.[45]

5-13 Several cases govern the exhaustion of rights and, in particular, the consequences of:

- re-packaging goods[46];
- re-labeling goods[47];
- advertising and marketing goods in a different commercial context[48];
- importing goods from a non-member state and re-importing them within the Community[49];
- re-importing goods from a state with rules on international exhaustion.[50]

5-14 If, under a Member State's laws on unfair competition, a trade mark is revoked because it is liable to mislead consumers, this revocation is consistent with the provisions of the Directive; but it is up to the national court to "examine whether the risk of misleading consumers is sufficiently serious to be able to override the requirements of the free movement of goods".[51]

The Community Trade Mark Regulation

5-15 Under the Community Trade Mark Regulation, there are substantive rules which broadly match *mutatis mutandis* those contained in the Directive; and there are procedural and administrative rules for the establishment of the Office and the treatment of applications, including the arrangements for appeals. The rationale of the parallel system of trade mark protection has already been stated.[52] More specifically, "legal conditions must be created which enable undertakings to adapt their activities to the scale of the Community, whether in manufacturing and distributing goods or in providing services; for those purposes, trade marks enabling the products and services of undertakings to be distinguished by identical means throughout the entire Community,

regardless of frontiers, should feature among the legal instruments which undertakings have at their disposal".[53]

5-16 It is the object of the Regulation to enable applicants to register[54] Community Trade Marks, which have a "unitary character" and "equal effect throughout the Community".[55] For this purpose, the Regulation establishes an "Office for Harmonisation in the Internal Market (Trade Marks and Designs)".[56] Much of the Regulation is concerned with substantive law, such as:

- the signs of which a Community Trade Mark may consist[57],
- persons who can be proprietors of a Community Trade Mark[58],
- absolute grounds for refusing registration[59], including
  - lack of any distinctive character[60] and
  - possession of a descriptive, generic or deceptive character,
- relative grounds for refusing registration[61], particularly where there is an earlier mark which is identical or confusingly similar to the mark applied for and proprietor of the earlier mark opposes the application,
- the rights conferred by a Community Trade Mark[62],
- limitation of the effects of a Community Trade Mark[63],
- the exhaustion of rights conferred by a Community Trade Mark[64],
- the use of Community Trade Marks[65] and
- the transfer[66] and licensing[67] of Community Trade Marks.

5-17 Further provisions of the Regulation provide for the application and registration procedures, including

- the filing of applications[68],
- questions of priority and seniority[69],
- examination, search and registration[70],
- duration, renewal and alteration of Community Trade Marks[71],
- surrender, revocation and invalidity of Community Trade Marks[72],
- appeals
  - from the administrative divisions of the Office to the Board of Appeal[73] and
  - from the Board of Appeal to the Court of Justice[74],
- Community collective marks[75],
- miscellaneous procedural provisions[76],
- jurisdiction and procedure in legal actions relating to Community Trade Marks[77],
- the relationship between Community Trade Marks and national laws[78],
- the organisation of the Office[79] and
- rules implementing the Regulation and determining fees.[80]

5-18 An unsuccessful attempt was made to challenge the legality of the Regulation in respect of its treatment of working languages.[81]

Unregistered trade marks

5-19 Except to the extent already indicated[82], unregistered trade marks are not subject to special rules at the European Union level. At national level, they may be protected by passing-off laws, unfair competition laws or *sui generis* laws, and as such may be recognised by the Court of Justice in litigation.[83]

Geographical designations

5-20 Geographical designations are subject to strict and detailed rules at European Union level, in particular in the wine sector; but these rules have been framed in the context of the Treaty provisions on the Common Agricultural Policy[84] and not in the context of intellectual property rights. It is explicitly stated in the Community Trade Mark Regulation that the Regulation does not affect the Council Regulation on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.[85] It has also been held by the Court that the latter Regulation on geographical designations "does not preclude the application of national legislation which prohibits the potentially misleading use of a geographical indication of source in the case of which there is no link between the characteristics of the product and its geographical provenance".[86] Two broad types of geographical designation are recognised in international law:

- appellations of origin[87] and
- indications of source.[88]

Appellations of origin are the designations covered in the European Union by specific regulations. Indications of origin are for the most part covered by national laws in accordance with bilateral or multilateral treaties to which Member States are parties.

Rights arising from rules on unfair competition

5-21 Although attempts have been made from time to time to harmonise the Member States' laws on rights arising from the rules on unfair competition, there being a general rule accepted by all the Member States in the context of the Paris Convention[89], no Directives have so far been adopted in this field; and the case law is minimal. Even the two directives on advertising, referred to below, were drafted less with the protection of intellectual property rights in mind than with the protection of consumers' interests.

Misleading advertising

5-22 Originally, what became the Directive on Misleading Advertising[90] was intended to cover comparative advertising as well; but difficulties arose over the reconciliation of advertising law and trade mark law, particularly the almost universal provision of trade mark law prohibiting the use of a trade mark in the course of trade without the owner's consent.[91] The question of comparative advertising was therefore deferred and the Directive adopted on misleading advertising alone.[92]

Comparative advertising

5-23 Fourteen years after the adoption of the original directive, a Directive on Comparative Advertising was adopted.[93]

Note on the "distinctiveness" of trade marks

5-24 Under the Community Trade Mark Regulation, "trade marks which are devoid of any distinctive character" are not to be registered.[94] Many cases have found their way to the Court of First Instance, after being rejected by the examiner at the Office and by the Office's Board of Appeal. Three cases, illustrating the types of case involved, concerned applications for the following names:

COMPANYLINE
OPTIONS
TRUSTEDLINK

The fourth concerned the shape of a bar of soap.

5-25 In the COMPANYLINE case, the Court said:

> In this case, the sign is composed exclusively of the words "company" and "line", both of which are customary in English-speaking countries. The word "company" suggests that what is in point are goods or services intended for companies or firms. The word "line" has various meanings. In the insurance and financial services sector it denotes, amongst other things, a branch of insurance or a line or group of products. They are thus generic words which simply denote a line of goods or services for undertakings. Coupling them together without any graphic or semantic modification does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable of distinguishing the applicant's services from those of other undertakings. The fact that the word "Companyline" as such does not appear in dictionaries - whether as one word or otherwise - does not in any way alter that finding. Consequently, the sign "Companyline" is devoid of any distinctive character.[95]

5-26 In the OPTIONS case, the Court said:

> The principle of the unitary character of the Community trade mark is expressly applied in Article 7(2) of Regulation EC/40/94 which provides that a trade mark is not to be registered notwithstanding that the grounds of non-registrability [laid down in Article 7(1)] obtain in only part of the Community. Article 7(3) of Regulation EC/40/94 must be read in the light of that principle. On that basis, in order to have the registration of a trade mark accepted under Article 7(3) of Regulation EC/40/94, the distinctive character acquired through the use of that trade mark must be demonstrated in the substantial part of the Community where it was devoid of any such character under Article 7(1)(b), (c) and (d) of that regulation. In the present case, the applicant has not disputed the lack of distinctiveness of the word OPTIONS in the French language. Nor has it claimed that the trade mark OPTIONS has been used in such a way that it has acquired a distinctive character in a substantial part of the Community, in this case in France.

In those circumstances, the Office cannot be criticised for having refused registration of the word OPTIONS as a Community trade mark.[96]

5-27 In the TRUSTEDLINK case, the Court said, first:

> The applicant claims that the various absolute grounds for refusal provided for in Article 7(1)(b), (c) and (d) of Regulation EC/40/94 must be interpreted in conjunction with each other, so that it is clear that a trade mark is distinctive if it is neither descriptive (subparagraph (c)) nor customary (subparagraph (d)). That argument cannot be accepted. As the Office rightly pointed out, each of the absolute grounds for refusal connected with lack of distinctiveness, descriptiveness and customary usage has its own sphere of application and they are neither interdependent nor mutually exclusive. As is clear from Article 7(1) of Regulation EC/40/94, for a sign to be ineligible for registration as a Community trade mark, it is sufficient that one of the absolute grounds for refusal applies (see Case T-163/98 *Procter & Gamble* v *OHIM* (*Baby-Dry*), paragraph 29; and Case T-19/99 *DKV Deutsche Krankenversicherung* v *OHIM* (*Companyline*), paragraph 30). Even if those grounds are applicable separately, they may also be applied cumulatively.

The Court went on to analyse the question of distinctiveness as such:

> The sign in question is made up exclusively of the words “trusted” and “link”, both of which are customary in English-speaking countries within and outside the Community. The word “link” means that which connects. It has a particular meaning in the field of information technology in that it refers, in particular, to the links connecting thevarious data servers on the Internet. Since the Internet, and more particularly the World Wide Web, are merely a vast network of electronic data transmission based on links connecting various servers or leading to another page within the same document, the word “link” must be regarded as generic in this context. Indeed, 'link is one of the only terms available to designate the essential technical feature of that communication technology. Furthermore, that specific meaning is clear even for non-English-speaking persons as well, obviously, as for specialists in the field of information technology. The sign TRUSTEDLINK has, therefore, the meaning of a reliable link or a link which can be relied on. The joining of “trusted” and “link”, whether written separately or as one word, thus merely describes the desired quality of a link, in this case reliability. Consequently, the sign in question is made up of two words, one of which is generic and merely designates an essential technical feature of electronic commerce and the second of which indicates the desired quality thereof. Coupling them together without any graphic or semantic modification does not imbue them with any additional characteristic such as to render the sign, taken as a whole, capable of distinguishing the applicant's goods and services from those of other undertakings. Moreover, the fact that the term TRUSTEDLINK as such does not appear in dictionaries - whether as one word or otherwise - does not in any way alter that finding (*Companyline*, paragraph 26). Consequently, the sign TRUSTEDLINK is devoid of any distinctive character.

Finally, the Court looked at the question whether the issue was affected by previous registration in the United States:

As regards the applicant's assertion that the registration of the term TRUSTEDLINK as a trade mark in the United States constitutes proof of its distinctiveness, the terms of the Court's judgment in Case T-122/99, *Procter & Gamble* v *OHIM* (soap bar shape), paragraphs 60 to 63, should be recalled. The Court stated in that decision that, according to the first recital in the preamble to Regulation EC/40/94, the purpose of the Community trade mark is to enable 'the products and services of undertakings to be distinguished by identical means throughout the entire Community, regardless of frontiers and that registrations already made in the Member States are therefore a factor which may only be taken into consideration, without being given decisive weight, for the purposes of registering a Community trade mark. It is clear from that judgment that a national registration does not bind the Office and it must therefore be concluded that the Board of Appeal did not err in law in taking the view that it is not bound by the registration in the United States.[97]

5-28 In the soap bar shape case, the Court allowed the appeal. It said:

Since the contested decision infringed the rights of the defence in applying the two absolute grounds on which it relied of its own motion, the Court need not examine the merits thereof. For the purposes of those proceedings, therefore, it is necessary only to rule on the merits of the absolute ground for refusal based on the sign's consisting exclusively of the shape which results from the nature of the goods themselves, provided for in Article 7(1)(e)(i). On this point the applicant argues essentially that the shape in dispute is not the usual shape of a bar of soap and that the Board of Appeal is interpreting too broadly an exception to the general rule that a mark may consist of a shape. The Office accepts that Article 7(1)(e)(i) is manifestly inapplicable to the shape claimed by the applicant. Under Article 7(1)(e)(i), signs which consist exclusively of the shape which results from the nature of the goods themselves are not to be registered. It need only be observed that, as the Office has rightly pointed out before the Court, the shape claimed bends inwards along its length and has grooves which do not come about as a result of the nature of the product itself. It is common ground that there are other shapes of soap bar in the trade without those features. The Board of Appeal therefore erred in law in relying, as an absolute ground for refusal, on the idea that the mark consists exclusively of a shape which results from the nature of the goods themselves, as provided for in 7(1)(e)(i). To that extent, the plea must therefore be upheld.[98]

5-29 The definition of a trade mark was also considered by the Court in a case brought between private parties and not involving the Trade Mark Office.[99]

[1] First Council Directive EEC/104/89 to approximate the laws of the Member States relating to trade marks. The text of the Directive is set out in the Annex.
[2] Council Regulation EC/40/94 on the Community trade mark. The text of the Regulation is set out in the Annex. The note at the beginning of the Annex refers to the Implementing Regulation, the Regulation on Fees and the Regulation on the procedure of the Board of Appeals.
[3] See paragraphs 5-16 and 5-24ff.
[4] Fifth Recital, Council Regulation EC/40/94.
[5] The Commission had in mind some of the problems involved in the Benelux trade mark system, under which the Belgian, Dutch and Luxembourg trade mark systems were subsumed in a single system.
[6] Joined Cases 56, 58/64 *(Consten & Grundig v Commission).* Trade mark: GINT.
[7] Case 40/70 *(Sirena Srl v Eda Gmbh).* Trade Mark: PREP.
[8] Case 192/73 *(Van Zuylen Freres v Hag)(Hag I).* Trade mark: HAG (coffee).
[9] Case 10/89 *(CNL-Sucal v HAG) (Hag II).*
[10] Case 119/75 *(Terrapin v Terranova).* Trade marks/names: TERRAPIN, TERRANOVA.
[11] Case 16/74 *(Centrafarm v Winthrop).* Trade mark: NEGRAM.
[12] Case 51/75 *(EMI v CBS).*
[13] Case 102/77 (Hoffmann La Roche v Centrafarm); Case 3/78 (Centrafarm v American Home Products); Case 270/80 (Polydor v Harlequin Record Shops); and Case 1/81 (Pfizer v Eurimpharm).
[14] Case 10/89 (CNL-Sucal v HAG) (Hag II).
[15] Case C-317/91 *(Deutsche Renault v Audi).*
[16] Tenth Recital and Article 4(1)(b), Council Directive EEC/104/89; and Case C-251/95 *(Sabel v Puma).*
[17] The word "approximate" is used in the EC Treaty and in the Directive. However, it is not the correct English word for this purpose; and, apart from direct quotations from the Treaty, the title and the text, this book uses the more appropriate word, "harmonise".
[18] Article 16, First Council Directive EEC/104/89.
[19] Third Recital, Council Directive EEC/104/89.
[20] As in *Terrapin v Terranova,* cited above.
[21] Case 317/91, *Deutsche Renault AG v Audi AG.* Renault produced vehicles called ESPACE QUADRA. Audi produced vehicles called the QUATTRO.
[22] See the cases referred to in paragraph 5-12 below.
[23] Article 1, Council Directive EEC/104/89.
[24] Ibid, Recital 7 and Article 2.
[25] Ibid, Recitals 7 and 10 and Articles 3 and 4.
[26] Ibid, Recital 9 and Article 5.
[27] Ibid, Article 6.
[28] Ibid, Article 7.
[29] Ibid, Article 8.
[30] Ibid, Recital 11 and Article 9.
[31] Ibid, Articles 10 and 11.
[32] Ibid, Articles 12 to 14,
[33] Ibid, Article 15.
[34] Ibid, Recital 1.
[35] Ibid, Recital 2.
[36] Recital 5, Council Regulation EC/40/94.
[37] Recital 4, First Council Directive EEC/104/89.
[38] Ibid, Recital 6. For a case in which national laws on consumer protection and unfair competition affected trade mark rights, see Case C-313/94, *Fratelli Graffione v Ditta Fransa.*
[39] Ibid, Recital 5.
[40] Ibid, Recital 7.
[41] Ibid, Article 4.
[42] Ibid, Article 7.
[43] Ibid, Article 12.
[44] Case C-251/95, *SABEL BV v Puma AG.*

[45] Case C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.
[46] Joined Cases C-427, 429 and 436/93, *Bristol-Myers Squibb et al v Paranova*.
[47] Case C-349/95, *F Loendersloot Internationale Expeditie v George Ballantine & Son Ltd et al*.
[48] Case C-337/95, *Parfums Christian Dior SA v Evora BV*.
[49] Case C-352/95*, Phytheron International SA v Jean Bourdon SA*.
[50] Case C-355/96, *Silhouette International Schmied GmbH & Co KG v Hartlauer Handels- gesellschaft mbH)* See also Cases C -414ff/99, *Davidoff v A & G Imports*; and Case C-173/98, *Sebago et al v GB-Unic SA*. Cf EFTA Court Case E-2/97, *Mag Instrument Inc v California Trading Company Norway*.
[51] Case C-313/94 *(Fratelli Graffione SNC v Ditta Fransa).* Trade mark: COTONELLE.
[52] See paragraph 5-3.
[53] Recital 2, Council Regulation EC/40/94.
[54] Ibid, Article 6.
[55] Ibid, Article 1(2).
[56] Article 2, ibid. This is an undatisfactory title. The Regulation is not an instrument of harmonisation; it establishes a system parallel to the harmonised national systems. The reference in the Office's title to "designs" anticipates the Regulation on the protection of industrial designs, which has not yet been adopted.
[57] Ibid, Article 4.
[58] Ibid, Article 5.
[59] Ibid, Article 7.
[60] For the case law on "distinctiveness", see paragraphs 5-24ff.
[61] Article 8, Council Regulation EC/40/94.
[62] Ibid, Article 9.
[63] Ibid, Article 12.
[64] Ibid, Article 13.
[65] Ibid, Article 15.
[66] Ibid, Articles 17 and 18
[67] Ibid, Article 22.
[68] Ibid, Articles 25 to 28.
[69] Ibid, Articles 29 to 35.
[70] Ibid, Articles 36 to 45. The search report drawn up by the Office covers only Community Trade Marks; but applications are subject to national searches in those Member States which have indicated their decision to undertake them: ibid, Article 39(2).
[71] Ibid, Articles 46 to 48.
[72] Ibid, Articles 49 to 56.
[73] Ibid, Articles 57 to 62.
[74] Ibid, Article 63. See paragraphs 5-24ff.
[75] Ibid, Articles 64 to 72.
[76] Ibid, Articles 73 to 89.
[77] Ibid, Articles 90 to 104.
[78] Ibid, Articles 105 to 110.
[79] Ibid, Articles 111 to 139.
[80] Ibid, Articles 140 and 141.
[81] Case T-107/94, *Kik v Council*. See Article 26(3), Council Regulation EC/40/94.
[82] See paragraph 5-10.
[83] As in Case 55/80, *Dansk Supermarked v Imerco*.
[84] Articles 32 to 38, EC Treaty.
[85] Article 142, Council Regulation EC/40/94, referring to Council Regulation EEC/2081/92.
[86] Case C-312/98, *Schutzverband gegen Unwesen in der Wirtschaft eV v Warsteiner Brauerei Haus Cramer GmbH & Co. KG.*
[87] Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, 1958, as revised in 1967.
[88] Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, 1891, revised in 1911 and 1967.
[89] Article 10bis, Paris Convention for the Protection of Industrial Property, 1883, revised in 1900-1967.

[90] Council Directive EEC/450/84.
[91] That is, under national trade mark laws at the time when the Directive was adopted. Later, the national rule was reflected in Article 5(1), First Council Directive EEC/104/89.
[92] Intellectual property rights are referred to in Article 3(c), Council Directive EEC/450/84.
[93] Directive EC/55/97 of the European Parliament and the Council.
[94] Article 7(1)(b), Council Regulation EC/40/94.
[95] Case T-19/99, *DKV Deutsche Krankenversicherung AG v Office for Harmonisation in the Internal Market*.
[96] Case T-91/99, *Ford Motor Company v Office for Harmonisation in the Internal Market*.
[97] Case T-345/99, *Harbinger Corporation v Office for Harmonisation in the Internal Market*.
[98] Case T-122/99, *Procter & Gamble v Office for Harmonisation in the Internal Market*.
[99] Case C-517/99, *Merz & Krell GmbH & Co.*