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**THE RELATION OF 3D TRADEMARKS AND DESIGN RIGHTS
IN THE LIGHT OF EUROPEAN UNION LAW AND LEGAL
PRAXIS**

Bachelor's thesis

European Union and international law

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I declare that I have compiled the paper independently
and all works, important standpoints and data by other authors
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Abstract

The aim of this research is to explore and analyse the interconnection of three-dimensional trade marks and design rights within the European Union law and legal praxis. Thesis seeks to analyse the scope of protection afforded by three-dimensional trade marks and design rights. The main research question is constructed as follows: is the scope of protection more comprehensive for three-dimensional trade mark registration than for design registration? The thesis is based on traditional legal dogmatic method i.e. description and the analysis of the existing law. The aim is to clarify and analyse the current legislation to the reader, in the light of known and existing legislation. In principle, three-dimensional trade marks enjoy a broader scope of protection than designs in general. Eternal protection offers a good incentive to register a three-dimensional shape as a trade mark whereas registered design can be protected up to 25 years. Thus getting a 3D shape registered as a trade mark has some very significant advantages in the field of intellectual property.

Abbreviations

CJEU	Court of Justice of the European Union
ECJ	European Court of Justice
EGC	The General Court of the European Union
EU	European Union
EUIPO	European Union Intellectual Property Office
EUTMR	European Union trade mark regulation
IP	Intellectual property
OHIM	The Office for Harmonization in the Internal Market
TMD	Trade mark directive

Introduction

Three-dimensional trade marks protecting the shape of goods has been addressed many times by the Court of Justice of the European Union (CJEU) and national courts have been relatively active in requesting preliminary rulings from the CJEU. Current legislation relating to intellectual property has been harmonized throughout the European Union with directives and regulations and they have been aimed to facilitate the needs of business owners and consumers in relation to daily trading and life.¹ Due to age of digitisation the need for IP protection has been growing and subsequently the field of law has been facing new challenges.

This thesis seeks to explore and analyse the interconnection of three-dimensional trade marks and design rights within the European Union law and legal praxis. The thesis will analyse the scope of protection afforded by three-dimensional trade mark and design registration and seek to clarify which of the aforementioned provide more protection to the products concerned. The thesis will also analyse a situation where the aforementioned rights overlap and whether or not the overlaps cause difficulties in the field of law concerned.

For the purposes of this research, the research questions are constructed in the following manner:

- **Is the scope of protection more comprehensive for three-dimensional trade mark registration than for design registration?**
- **Where does the aforementioned IP rights overlap each other and what are the possible consequences?**
- **How often and on what legal basis the infringement concerning three-dimensional trade mark and registered design has been discovered?**

The structure of the thesis is as follows:

In the first chapter of the thesis, the author walks the reader through the requirements of trade mark and design registration e.g. legal framework for each right is opened up and relevant legislation is explained in a simple manner. The author aims to introduce the main principles and requirements that are necessary, when one aims to seek for registration for their products using the

¹ Craig, P., de Búrca, P. (2015). *EU Law, Text, Cases and Materials 6th edition*, Oxford University press, p 608.

aforementioned rights. Subsequently, the concept of likelihood of confusion is explained and represented since the concept is a key factor when the scope of protection is determined.

The second chapter of the thesis introduces the scope of protection afforded by trade mark and design registration and the overlapping areas between the two rights in question are represented. The author explains the key criteria and tools of how the scope of protection should be determined and evaluated.

The third chapter of the thesis aims to introduce the infringement proceedings related to the IP rights in question, by analysing the infringement proceedings and the case law of the CJEU. By comparing infringement proceedings in relation to three-dimensional trade marks and designs, the author seeks to determine and clarify the strength that each IP right provide to the products concerned.

The thesis is based on traditional legal dogmatic method i.e. description and the analysis of the existing law. The aim is to clarify and analyse the current legislation to the reader, in the light of known and existing legislation.

The sources of this research are based on legal text books and legal articles relevant in the respective field of law. The author has also tried to select mostly relatively new articles. The sources based on legal articles are collected from databases such as Heinonline and Westlaw. In addition, legal provisions and case law are referenced where relevant.

In relation to trade mark and design law of the European Union, the thesis deals specifically with three-dimensional trade marks and registered Community designs, due to the reason of restricted space available. Three-dimensional trade marks can appear in different forms and design law encompasses also unregistered designs. The differences are explained shortly in this thesis but the focus is still principally on the aforementioned aspects of the third dimension and registered Community designs.

1. EUROPEAN UNION TRADE MARK AND DESIGN LAW

1.1 Introduction to trademark law

Trade mark is a form of intellectual property law i.e. a right provided by law which can distinguish your goods and services from those of other traders and undertakings. Trade mark is an essential indicator of origin for the product in question, representing the quality of the associated products. Hence, the central purpose of trade mark law is to authorize rights holders and consumers to differentiate the source of identical goods or services with a different origin. In order for trade mark to fulfil its role as indicator of commercial source, it is required that they must possess a basic feature to differentiate goods or services according to their commercial origin, and the protection provided by trademark must allow exclusive rights for the proprietor to prevent others from using signs which are identical or similar with the protected mark and because they are used for the same goods or services, are liable to create a likelihood of confusion.² It is common knowledge and accepted fact that trademarks are one form of intellectual property rights which has more in common with industrial designs than with the enormous and scattered area of marketing regulations.³

Earlier in the history, the legal protection was granted by use instead of the state and so it formed a part of the private sector.⁴ This was seen unacceptable in a community which was changing, industrializing, and growing with a fast pace. Therefore it was a clear requirement to have a formal system provided by a central authority. Thus trade mark laws over Europe developed and formed a system in which they rely on registration. Though, it must be noted that the rights which result from the registration are however private rights, but they will need to be applied by the rights holder.⁵

² Kur, A. (2012). Convergence after all? A Comparative View on the U.S. and EU Trademark System in the Light of the "Trade Mark Study". - *Journal of Intellectual Property Law*, p 306.

³ *Ibid.*

⁴ Pila, J., Torremans, P. (2016). *European Intellectual Property Law*. Oxford University Press. p 363.

⁵ *Ibid.*, p 364.

1.1.1 Legal framework for the protection of trade marks

Relevant legislation protecting trade marks within the EU can be found from national legislation, EU legislation and international conventions. The EU Member States are bound by certain international conventions since the trade mark law of the European Union is subordinate to those conventions e.g. Paris Convention for the Protection of Industrial Property and the TRIPS Agreement.⁶ Therefore, it can be stated that certain hierarchy exists between the aforementioned institutional levels. In its entirety, IP rights are protected as human and fundamental rights⁷ to the extent that these IP rights are treated as property, a human right to intellectual property can be established in the burden to protect property interests.⁸ Based on the aforementioned, when balancing IP rights against other fundamental and human rights, certain principles are applied when the scope of the rights conferred on the IP right proprietors is determined.

At the EU level, the relevant legislation relating to trade marks encompasses the European Union trade mark regulation (hereinafter EUTMR)⁹ 2017/1001/EU and the European Union trade mark directive 2015/2436/EU¹⁰ (hereinafter TMD), approximating the laws of the Member States relating to trade marks. The directive obliges EU Member States to harmonize their laws so as to conform with the provisions set out therein.¹¹ The aforementioned TMD comes fully into force after the 15th of January 2019 once the previous directive will be officially repealed. The previous Directive 2008/95/EC¹² remains yet in force and is applicable. Once a EU trade mark has been granted, it is not subject to territorial divides in the manner separating the Member States. As is stated in Article 1(2) of the EUTMR:

An EU trade mark shall have a unitary character and it shall have equal effect throughout the union. However 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

⁶ OJ L 336/1, 16.12.2015, Recital 41.

⁷ Chapman, A., Russell, S. (2002). *Core Obligations: Building a Framework for Economic, Social and Cultural Rights*. Intersentia. p 316-317.

⁸ International Covenant on Civil and Political Rights, Article 17
www.treaties.un.org/doc/publication/unts/volume%20999/volume-999-i-14668-english.pdf

⁹ OJ L 154/1, 14.06.2017.

Trade marks registered under the EUTMR are protected in the whole EU and protection is gained by submitting a single application. To draw a distinction between the EUTMR and the Directive, unregistered trade marks are not protected under the regulation.

¹⁰ OJ L 336/1, 16.12.2015.

¹¹ *Ibid.*

¹² OJ L 299/25, 22.10.2008

be prohibited, save in respect of the whole Union. This principle shall apply unless otherwise provided for in this Regulation.

The aforementioned directive and regulation are also of essential importance to this thesis. The legal praxis of the CJEU acts as an essential importance in this thesis, since the wording of the EU provisions relating to likelihood of confusion is not so clear and strict and thus leaves room for interpretation for national legislators.¹³ Hence the case law of the CJEU is necessary in guiding the interpretation of the law.¹⁴

On an international level, trade mark protection is based on the aforementioned Paris Convention¹⁵ and the TRIPS Agreement, which is seen as enforcement mechanism in the field of international intellectual property.¹⁶ In addition to the previous conventions, the protection is based on Trademark Law Treaty, the Madrid Agreement and the Protocol relating to it.¹⁷ In addition to these major conventions, the Nice Agreement on the Classification of Goods and Services¹⁸ provides a standard for classification of goods and services, hence being a more specific convention. Regarding EU as a whole and its trade mark system, the main objective is to have a functioning internal market which thus requires broad harmonising of the trade mark legislations of the Member States.

At the national level, the legislation of the Member States of the European Union are designed to implement the system of the TMD. As stated above, the directive is not fully harmonising and leaves room for interpretation and thus legal praxis of the EU is a necessary tool for the Member States authorities in the interpretation of the directive.

¹³ Morris, P. S. (2012). Guess what Gucci? Post-Sale Confusion Exists in Europe. – *Valparaiso University Law Review*, Vol. 47, No. 1, p 11.

¹⁴ Palm, J. (2002). Tavaramerkki, kilpailu ja alkuperä. *Suomalainen Lakimiesyhdistys*. p 140.

¹⁵ Frankel, S., Gervais, D. J. (2016). *Advanced Introduction to International Intellectual Property*. Edward Elgar Publishing. p 17.

¹⁶ *Ibid.*

¹⁷ Frankel (2016), *supra nota* 15, p 106.

¹⁸ Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks 1957. www.wipo.int/classification/nice/en/ (4.2.2018).

1.1.2 Requirements for protection

The EUTMR and TMD impose very similar requirements for the registrability of trade marks. The goal was to draft two very alike regimes, in terms of substantive law and as mentioned earlier, the wording of their provisions is frequently identical.

There are three requirements for a sign to be validly registered:

- (a) it must fall within the definition of a registrable mark;
- (b) it must not be excluded by one of the absolute grounds of refusal;
- (c) it must not be excluded by one of the relative grounds of refusal.

In the case of three-dimensional trade mark, several aspects need to be taken into consideration. Firstly the difference between a three-dimensional trade mark and a common or traditional trade mark needs to be evaluated. Three-dimensional trade marks are assessed in the same manner as other types of trade marks. In practice this means that certain criteria need to be fulfilled i.e. the distinctive character and capability of being represented.¹⁹

1.1.2.1 Capability of being represented

After the new TMD, the requirement for graphical representation has been replaced with a requirement on graphical representation on the register.²⁰ Previously the goal of this requirement was to ensure the basic function of a trade mark: differentiate the origin of products and services. The wording of the previous directive²¹ required trade marks to be able to be represented graphically and it is still in force. The new TMD however might oblige Member States to interpret graphical representation as representation on the register. According to ECJ, the object of the graphical representation on the register is to define the mark itself in order to determine the precise subject of the protection to its proprietor. The CJEU has held that mark in the register must be “self-contained, easily accessible and intelligible”.²² The court also held that verbal

¹⁹ Seville, C. (2016). *EU Intellectual Property Law and Policy*. 2nd ed. Cheltenham:Edward Elgar Publishing. p 282.

²⁰ OJ L 336/1, 16.12.2015, Article 3 (1) (b).

²¹ OJ L 299/25, 22.10.2008, Article 2

²² Court decision, 12.12.2002, Sieckmann v Deutsches Patent- Und Markenamt, C-273/00, ECLI:EU:C:2002:748, paras 48, 52.

characterisation of the mark is not sufficient since representation without the need for former knowledge of the product is required.

1.1.2.2 Distinctive character and the likelihood of confusion

Overall, the distinctiveness requirement means that the main purpose of a trade mark is to indicate the source and the quality of the associated goods and services from those of other traders.²³ The level of distinctiveness varies on the characteristics of the mark and therefore it specifies the scope of protection afforded by the mark. The Finnish Supreme Court stated in a case concerning distinctiveness of three-dimensional trade marks that, distinctiveness of the trade marks which were based directly on the shape of the good itself was weak and that the protection granted to the marks should therefore be interpreted narrowly.²⁴ In principle, all types of trade marks are evaluated with the same rules and principles. The directive nor the regulation draws a distinction between different types of trade marks. Hence, in order to assess the distinctive character of three-dimensional trade marks, the criteria are no different from traditional or other types of marks.

Likelihood of confusion has to be globally assessed and every factor relevant to the individual case has to be taken into consideration. A likelihood of confusion exists if the relevant public may confuse the commercial origin of the goods or services in question. The greater the likelihood of confusion will be in a case where the distinctiveness of the earlier mark is stronger.²⁵ The ruling of the Finnish Supreme Court stems from the decision of the CJEU. The CJEU ruled that the likelihood of confusion is greater when the earlier mark on the market possesses a more distinctive character and thus marks with a highly distinctive character enjoy a wider scope of protection on the market than marks with less distinctive character.²⁶ Therefore, marks with highly distinctive character can be named as strong marks and marks with weak level of distinctiveness as weak marks.²⁷ The concept of likelihood of confusion is not precisely defined by law, the framework is provided by the directive but the concept depends on different circumstances that are different in each case, so precise and accurate defining is not possible with current legislation.

²³ Pila (2016). *supra nota* 4, p 373.

²⁴ Korkein Oikeus, KKO:2017:42, 13.06.2017, point 12.

²⁵ Korkein Oikeus, KKO:2004:49, 27.05.2004, points 6-10.

²⁶ Court decision, 11.11.1997, SABEL BV v Puma AG, Rudolf Dassler Sport, C-251/95, ECLI:EU:C:1997:528, para 24 and 29.09.1998 ; Court decision, 29.09.1998, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer, C-39/97, ECLI:EU:C:1998:442, para 18.

²⁷ Jehoram, T. et al. (2010). *European Trademark Law and Harmonized National Trademark Law*, Kluwer Law International, para 5.

1.1.2.3 Likelihood of association

Likelihood of association cannot be confused with likelihood of confusion. The wording of EUTMR and the directive state that the likelihood of confusion encompasses the likelihood of association with the earlier mark²⁸ It was defined by the CJEU as a situation where the public considers the sign to be similar to the trade mark, because of which the perception of the sign calls to memory of the trade mark, although the two are not confused by the public.²⁹ However the court pointed out that the fact that the likelihood of confusion includes the likelihood of association, though it is not an alternative to the likelihood of confusion, but it works as a tool to define its scope.³⁰ Thus, the concept of likelihood of association is purely a factor that has to be considered when the likelihood of confusion is evaluated in the concrete case. Hence, it is a sub-set of the concept of likelihood of confusion and does not have much significance alone.

1.2 Introduction to design law

In broad terms, designs are concerned about how an article looks like or is intended to look like. Designs deal with the shape of the products and thus they are closely related with the concept of a trade mark for a three-dimensional shape.³¹ The concept of a design is defined as:

The product's presentation (whole or a part), resulting from the features of, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation³²

Therefore, a design is an element of appearance in products and thus the definition is quite wide. The recital 14 of the directive confirms this wide approach since it indicates that no aesthetic quality is required, meaning that arbitrary, but non-appealing, features can also be covered by the definition. In contrast, in the US the definition of industrial design appears to be extremely important when legislators decide upon under which intellectual property right the design can be

²⁸ OJ L 154/1, 14.06.2017 Article 8 (1) (b).

²⁹ Court decision, *supra nota* 22, para 16.

³⁰ *Ibid.*, para 18.

³¹ Pila (2016). *supra nota* 4, p 483.

³² OJ L 289/28, 28.10.1998, Article 1(a).

sufficiently protected.³³ It appears that there is no generally applicable definition of “industrial design” but in traditional legal terms it is described as the external appearance of articles.³⁴ As a result, an appearance that is legally defined as design in the EU does not automatically count as a design in the US legal wording.

1.2.1 Legal framework for the protection of designs

National laws of the EU Member States on designs has been harmonized with the European Parliament and Council Directive 98/71/EC³⁵ on the legal protection of designs. The directive runs in parallel with a regulation creating a community design (Council Regulation (EC) No. 6/2002 of 12.12.01 on Community designs).³⁶ The substantive provisions of both instruments are identical and put in place a system of registered designs, that grant its owner exclusive rights. In addition, the regulation also has an unregistered design component but due to the limited length of this research, the unregistered designs are not of essential importance.

The directive on the legal protection of designs sets minimal standards as to the scope of protection and eligibility for industrial designs. Novelty and individual character are the key requirements for a product to be eligible for protection.³⁷ After the protection is acquired, the owner then has exclusive right to use it and to prevent others from using it.³⁸ The duration of protection may not exceed 25 years from the date of filing and in order to keep the product protected, the application has to be renewed every five years.³⁹ In comparison to unregistered design, the duration has a significant difference. Unregistered design is valid for only 3 years.⁴⁰ Nevertheless, some room has been left for interpretation since the Member States of the European Union are free to independently regulate the “procedural provisions concerning registration, renewal and invalidation of design rights and provisions concerning the effects of such invalidity.”⁴¹

³³ Schickl, L. (2013). Protection of Industrial Design in the United States and in the EU: Different Concepts or Different Labels? - *The Journal of World Intellectual Property*, p 16.

³⁴ Afori, F. (2007). Copyright infringement without Copying – Reflections on the Theberge Case. – *Ottawa Law review*, No. 39, p 1107.

³⁵ OJ L 289/28, 28.10.1998.

³⁶ OJ L 3/1, 05.01.2002, as amended by Council Regulation 1891/2006 OJ L 386/14, 29.12.2006.

³⁷ OJ L 289/28, 28.10.1998, Article 3(2).

³⁸ *Ibid.*, Article 12.

³⁹ *Ibid.*, Article 10.

⁴⁰ Cornwell, J. (2016). Under-referred, under-reasoned, under-resourced?: Re-examining EU design law before the Court of Justice and General Court. – *Intellectual Property Quarterly*, Vol. 2016, No. 4, p 4.

⁴¹ OJ L 289/28, 28.10.1998, Recital 6.

The design directive alone would have retained the territorial nature of design protection and thus it was considered important to “allow goods embodying designs to flow freely within the internal market,”⁴² therefore it was deemed essential to organise a uniform form of design protection.⁴³ As mentioned above, the Community design regulation introduced the system of registered and unregistered Community designs. The registration of Community design was possible after 1 April 2003.⁴⁴ Since then, companies and individuals have been able to seek for protection at the European level without having to apply for registration for each Member State at national level. More specifically, in the case of registered Community designs, it is possible to acquire protection throughout the Community with one application in one language.⁴⁵ Under the Community design regulation, a single registered design right is granted in essence and this comprises the whole area of the EU. That system is administered by the European Union Intellectual Property Office (EUIPO), which is based in Alicante, Spain, and which also administers the Community trade mark. Likewise the Community trade mark, the Community design right has a unitary character.⁴⁶

1.2.2 Requirements for protection

It is worth setting out the starting point for these requirements for protection *expressis verbis*:

1. Community design is protectable and eligible to protection only when it is new and has individual character.
2. A design applied to a product which forms a component part of a sophisticated product shall only be considered to be new and to have individual character:
 - (a) if the part, once it has been incorporated into the sophisticated product, stays visible during basic use of the latter; and
 - (b) to the extent that those shown traits of the component part fulfil in themselves the requirements as to novelty and individual character.
3. “Normal use” within the meaning of the abovementioned point (2)(a), shall mean use by the end user, except maintenance, servicing or repair work.⁴⁷

⁴² See, explanatory memorandum to Design Directive.

⁴³ OJ L 386/14, 29.12.2006, Recital (1) (3)(4)

⁴⁴ *Ibid.*, Article 107.

⁴⁵ *Ibid.*, Article 35, 98.

⁴⁶ *Ibid.*, Article 1(3).

⁴⁷ *Ibid.*, Article 4.

The latter part of the Article indicates that the design must remain visible. Meaning that the features which are visibly shown, must remain visible. This is then followed up by two requirements which are the key requirements for Community design protection: novelty and individual character.

1.2.2.1 Novelty

According to Article 5 of the Community design regulation and Article 4 of the directive, in order for a product to be registerable it must be new. Furthermore, the Regulation requires worldwide absolute novelty regarding the design and the novelty requirement is satisfied if no identical design or whose features differ only in immaterial details, has been made available to the public before its filing date or the date of priority. The novelty requirement is not fulfilled if the design is deemed to have been made available to the public if it has been published.⁴⁸ Article 7(2) of the regulation introduces a 12 month grace period, meaning that disclosure of the design does not exclude the possibility for design protection until the application is filed within 12 months of disclosure. Features which are dictated purely by technical function or which allow for mechanical connection to another product are disregarded when considering both novelty and individual character.

1.2.2.2 Individual character

In addition to being new, the registered design system requires the design to have individual character which is defined as follows:

Individual character exists in a design if the produced overall impression differs from the overall impression given to such user by unspecified design which has been disclosed to the public before the date of filing the application for registration or in case where priority is claimed.⁴⁹

In contrast to novelty, individual character sets a more precise standard on the design than the test of novelty and in practice it is wider and harder test to apply.⁵⁰

⁴⁸ Seville (2016). *supra nota* 19, p 233.

⁴⁹ OJ L 386/14, 29.12.2006, Article 6.

⁵⁰ Seville (2016). *supra nota* 19, p 236.

To conclude, the individual character requirement is met if an informed user gets a different overall impression compared to pre-existing designs. The regulation does not in itself provide a legal definition as to who constitutes an informed user, but CJEU has given a definition for the concept in the case *PepsiCo v. Grupo Promer Mon Graphic and OHIM* decision: “not to a user of average attention, but to a particularly observant one, either because of his personal experience or his extensive knowledge of the sector in question”⁵¹ Thus, the Court found that the definition for informed user is laying somewhere between that of the average consumer as used and applicable in trademark matters, who need not have any knowledge and who makes no direct comparison between the trade marks at hand, and the sectoral expert, who is a professional with detailed technical expertise and the person skilled in the art as used in patent matters. Furthermore, individual character is a distinction in the overall impression on the informed user.⁵² Individual character in practice is likely to assimilate novelty.⁵³

⁵¹ Court decision, 20.10.2011, *PepsiCo v Grupo Promer Mon Graphic*, C-281/10 P, ECLI:EU:C:2011:679.

⁵² Conea, A. M. (2011). The Requirements for Protection of the Community Design. – *Lex ET Scientia International Journal*. Vol 9, No. 2, p 134.

⁵³ Massa, C. H., Strowel A. (2003). Community Design: Cinderella revamped. – *European Intellectual Property Review*, p 77.

2. SCOPE OF PROTECTION AND THE OVERLAPS

2.1 Scope of trade mark protection

In case the shape of a product is enough distinctive and original, design protection is the simplest method of IPR protection, albeit the scope of protection is limited and relatively short in duration compared to trade marks. When determining the scope of protection related to trade marks, the functions are a necessary and useful tool.⁵⁴

The separation function distinguishes the proprietor's goods or services from that of competitors based on the trade mark. Hence, the consumer assumes when seeing the trade mark, to be from specific, before known or unknown business.⁵⁵ It can be stated that the separation function has a bigger value since it is directly based on law. The separation function is followed up by the origin function. The origin function indicates that the goods or services stem from certain anonymous economic origin. The central point is that the trade mark indicates the product to be coming from a specific company who is responsible from the quality of the product.⁵⁶ Thus, there is no need for the consumer to get the information about the origin of the product before buying it. The function of the trade mark is to guarantee for the consumer the origin of the product equipped with the mark itself. The origin function is supported by the quality function, i.e. the function representing qualities connected with the goods or services and assuring that the goods or services meet up with the expectations. It is also supported by investment and advertisement functions, which relate to the protection of investments of the proprietor in manufacturing and developing the goods or services and goodwill related to it.⁵⁷

The separation function, i.e. separating the proprietor's goods or services from that of competitors based on the trade mark, is said to enable the origin function.⁵⁸ The origin function then again enables the quality function as well as the investment or advertising functions.⁵⁹ In that way, the separation function and the origin function occur often together and so it is not wrong to speak

⁵⁴ Pakarinen, M. (2006). *Tavaramerkin oikeudellinen suoja-ala ja tavaramerkin käyttö verkkotunnuksessa*. IPR Series A:2. IPR University Center. p 30.

⁵⁵ Salmi, H. et al. (2008). *Tavaramerkki*. Talentum. p 50.

⁵⁶ *Ibid.*, p 51-52.

⁵⁷ Pihlajarinne, T. (2010). *Toisen tavaramerkin sallitty käyttö*. Lakimiesliiton kustannus. p 53-54.

⁵⁸ *Ibid.*

⁵⁹ *Ibid.*

generally together with separation and origin function in the same context.⁶⁰ In the judgement of the CJEU the court stated that: “The essential function of the trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him to distinguish the goods or service from others which have another origin.”⁶¹ The scope of core protection provided by trade mark legislation is determined by the origin function of trade mark protection and it also helps in guiding the interpretation of trade mark law.

Additionally there are competition, investment, advertisement and communication functions. The above mentioned functions however, have been argued to exist⁶² but these functions have been confirmed to exist in the CJEU case law.⁶³ The protection of the aforementioned functions extends the scope of protection to trade marks. Thus it can be stated that the origin function is the most important function of trade mark protection at the moment as it includes the separation and quality functions.

To conclude this chapter, the scope of trade mark protection is determined individually in each case and every aspect of each case has to be taken into account. It is safe to say that each sign protected by the trade mark enjoys a different scope of protection. The scope of protection cannot be determined and given in advance, since it is a fact based issue.⁶⁴

2.2 Scope of protection for registered Community design

The scope of protection for registered Community design is set out in Article 10 of the Community design regulation.

1. The scope of protection which is given by a Community design shall contain unspecified designs which does not generate on the informed user a different overall impression
2. When the scope of protection is being assessed, the degree of freedom of the designer in making his design shall be taken into examination

⁶⁰ *Ibid.*, p 49.

⁶¹ Court decision, 23.03.2010, Google France and Google, C-236/08, ECLI:EU:C:2010:159, para 82.

⁶² Salmi. et al. (2008). *supra nota* 55, p 50-59.

⁶³ Court decision, 18.06.09, L’Oreal and Others, C-487/07, ECLI:EU:C:2009:378, paras 58-59.

⁶⁴ Vukašin, P. (2017). The Scope of trade mark as a subjective right in the European Union Law. – *TEME: Casopis za Društvene Nauke*, Vol. 41, Issue. 1, p 205.

The concept of different overall impression on the informed user in the context of whether a design has individual character has been cleared out in the case *PepsiCo v Grupo Promer*.⁶⁵ It turns out that recital 14 of the regulation, referring to the same test as for scope of protection, but in the context of the aforementioned individual character, has dominant influence in the judgement. Recital 14 of the Regulation states that:

“The assessment as to whether a design has individual character should be based on whether the overall impression produced on an informed user viewing the design clearly differs from that produced on him by the existing design corpus, taking into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs and the degree of freedom of the designer in developing the design”

The influence of the recital 14 of the regulation appears to be significant in relation to the legal praxis of the European Union.⁶⁶ It indicates that a registered design enjoys a broader scope of protection where the design is clearly different to the design corpus and subsequently a narrower scope of protection where the difference is only minor in contrast to the design corpus, but in order to determine the scope of protection, the recognition of a potentially extensive corpus of prior art is required.⁶⁷ Therefore, the scope of protection of a registered design is narrow.⁶⁸

2.2 The overlaps between registered Community design and European Union trade mark

In the European Union it has become a common standard to protect designs as three-dimensional trade marks with taking advantage of the loose registration practice run by the EUIPO (previously OHIM).⁶⁹ This standard has been made available since it is possible to protect a shape of product or their packaging as a three-dimensional trade mark.⁷⁰ In case the registration of three-

⁶⁵ Court decision, 20.10.2011, *PepsiCo v Grupo Promer Mon Graphic*, C-281/10P, ECLI:EU:C2011:679.

⁶⁶ Smyth, D. (2013). How is the scope of protection of a registered Community design to be determined? – *Journal of Intellectual Property Law & Practice*, Vol. 8, No. 4, p 270.

⁶⁷ *Ibid.*, p 271.

⁶⁸ *Ibid.*

⁶⁹ Schickl (2013), *supra nota* 33, p 27.

⁷⁰ Carboni, A. (2006). The overlap between registered Community designs and Community trade marks. – *Journal of Intellectual Property Law & Practice*, Vol. 1, No. 4, p 256.

dimensional trade mark is valid, it can protect a design indefinitely. The aforementioned works as well as an incentive for individuals and companies to seek for trade mark protection for their designs due to the indefinite protection.⁷¹ Conversely, business owners are using the Community design protection system to protect subject matter which is normally, in the field of intellectual property law used to be registered as a trade mark.⁷² This chapter of the thesis aims to consider the overlaps between the two Community systems, going through the circumstances in which a design may be registered as a trade mark and the other way around.

The definitions of the two rights gives an immediate impression about overlaps, e.g. graphic symbols and get-up, whose appearance may be protected by a Community design are covered by Article 3 of the Community design regulation. Furthermore, the aforementioned get-up and graphic symbols are also signs capable of being represented on the Register of European Union trade marks.⁷³ Additionally, the shape of goods or their packaging are signs as described by the definition of EUTMR and are also conceivably protectable as a Community design. However, the additional requirements as explained in the previous chapters, for a product to be registered as EU trade mark or Community design, limit the scope of possible overlaps between the rights but is not wholly excluded.⁷⁴ These additional requirements state that European Union trade mark is more challenging of its subject matter than the Community design.⁷⁵ Article 8 in the Community design regulation forbids a restricted range of features where a designer is left with no choice of design due to the technical result or mechanical fit that needs to be achieved accordingly, while the EUTMR simultaneously prohibits shapes which are devoid of distinctive character or those which give substantial value to them as well as few other signs. This view is confirmed in the case *Philips v Remington*, Advocate General Colomer stated that the technical function exclusion for shapes is more demanding and comprehensive in EUTMR than in the Community design regulation.⁷⁶

⁷¹ Blackett, T. (1998). *Trademarks*. Macmillan press Ltd. p 45.

⁷² *Ibid.*

⁷³ OJ L 154/1, 14.06.2017, Article 4.

⁷⁴ Carboni (2006). *supra nota* 70, p 258.

⁷⁵ *Ibid.*

⁷⁶ Court decision, 18.06.2002, Philips Electronics v Remington Consumer Products, C-299/99, ECLI:EU:C:2002:377, para 34.

2.3 Invalidity of a registered Community design based on likelihood of confusion with earlier three-dimensional trade mark

In the legal context, it is restricted to use a sign to which Community law or the law of the Member State has conferred rights to the holder of the sign to prohibit such use.⁷⁷ The design regulation states that such use leads to declaration of invalidity of the sign. Subsequently, the EUTMR stipulates that the proprietor of an EU trade mark shall prevent all third parties from using signs which are identical or similar to the goods or services for which the EU trade mark is registered if there exists a likelihood of confusion on part of the public.⁷⁸

In the case *Su-Chen v OHIM—AM Denmark*, The General Court of the European Union (EGC) confirmed the invalidity of a registered Community design.⁷⁹ The decision was based on likelihood of confusion with an earlier three-dimensional trade mark. The applicant stated that a third party's registered Community design should be declared invalid since his rights were infringed by the way referred in Article 9 of the Community trade mark regulation (currently EUTMR) and in Article 25 of the Community design regulation. As a result of the case, the judges found that there was a likelihood of confusion as required by the trade mark regulation.

The number of cases concerning a conflict between trade marks and designs in EGC has increased lately but *Su-Chen* case appears to be the only one so far in which the EGC has ruled a registered design to be invalid on grounds of likelihood of confusion with an earlier three-dimensional trade mark.⁸⁰ The ruling is considered to be somewhat significant since trade mark owners from now on have the possibility to supplement their trade mark portfolios with design registrations.⁸¹ This practice has been made possible due to the recent rulings of EGC and the standard of taking advantage out of this is on line with the decisions made by the court.

⁷⁷ OJ L 3/1, 05.01.2002, Article 25 (1) (e).

⁷⁸ OJ L 154/1, 14.06.2017, Article 9 (2) (b).

⁷⁹ Court decision, 25.04.2013, *Su-Chen v OHIM*, T-55/12, ECLI:EU:T:2013:219

⁸⁰ Clark, B. (2014). Keeping it clean: invalidity of a registered Community design based on likelihood of confusion with earlier 3D Community trade mark. – *Journal of Intellectual Property Law & Practice*, Vol. 9, No. 2, p 107.

⁸¹ *Ibid.*, p 108.

3. INFRINGEMENT PROCEDURES

3.1 Design rights and their infringement

Article 12 of the design directive and article 19 of the regulation provide the rights conferred by a design that is new and has individual character. The principle goes as follows:

“The registration of a design/A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having its consent from using it. The aforementioned use shall cover, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.”⁸²

Thus the traditional IP approach is that an exclusive right is granted to the owner and the design cannot be used without the consent of its owner. The question what amounts to use is explained above as stated in the directive and in the regulation. The rights which are granted to the owner are only clear in the case where the alleged infringer uses an exact copy of the design and uses it for similar or identical products. Different approach has to be taken in the case where slightly different and merely similar design is used. The directive and the regulation provide guidance in this situation. As mentioned earlier in this research, article 10 of the regulation determines the scope of protection for the rights holder and takes us back to the question and standard of individual character. A design that provides a different overall impression will not cause infringement and may be entitled to registration in its own right. Therefore, any design that is not enough different to be entitled to its own protection will lead to a finding of infringement.⁸³ In other words, a similar design that provides a different overall impression will not cause infringement since it may be entitled to registration in its own right.⁸⁴

Infringement cases are generally always destined to compare designs as applied to products rather than designs alone since designs are registered for a product or a class of products. A similar design applied to a very different product is far more likely to generate a different overall impression than

⁸² OJ L 3/1, 05.01.2002, Article 19.

⁸³ Pila (2016). *supra nota* 4, p 493.

⁸⁴ *Ibid.*

the same similar design applied to the same exact products.⁸⁵ However it is not clear how to make the abstraction of the product to assess the overall impression created by the allegedly infringing design. Hence it will be up to the courts (CJEU) to identify the boundaries. In the case *Procter & Gamble Co. v Reckitt Benckiser* the defendant had design applied to sprayers for air-freshener products. The canister for the defendant's product was inspired by the claimant's design for its 'Febreze' canister. The court firstly identified the concept of informed user and then focused to the concept of a different overall impression. As an outcome the court found out that the similarities are clearly only found at a general level and was therefore held that a different overall impression was created on the informed user and based on that, the infringement case failed.

The most important thing to bear in mind is that the process done by the court is often and in most cases a visual exercise e.g. what counts is what the court can see.

3.2 Infringement of the trade mark

The rights conferred by a EU trade mark may be enforced against others from the date of publication of registration of the trade mark. Article 5 of the TMD and article 9 of the EUTMR set the basic criteria for an infringement action. If a trade mark is already registered and on the register, it is an infringement to use the same mark for the same goods or services. In case the marks and the product in question are similar instead of identical and the later use of the earlier mark is likely to cause confusion to the public, this will be seen as infringement.⁸⁶

Article 9 of the EUTMR provides that:

1. The registration of an EU trade mark shall confer on the proprietor exclusive rights therein.
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

⁸⁵ *Ibid.*

⁸⁶ *Ibid.*

- a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;
- b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark
- c) the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark.

The practical approach to the concept of infringement is slightly different from the concept used to determine whether a mark has been infringed by using the relative grounds for refusal.⁸⁷ The relative grounds for refusal has the effect that the owner of the earlier mark may prevent the registration of a later mark where use of that mark would infringe the rights of the earlier mark owner. Thus, in the practical approach certain additional matters has to be taken into consideration. Firstly, the claimant's mark has to be identified and the way in which the mark has been used by the claimant is also of essential importance regarding the assessment of infringement. The defendant's use of the sign is also relevant since likelihood of confusion and the taking of unfair advantage must be appreciated globally, taking into account all relevant factors relevant to the case.⁸⁸

The most important factor when infringement is being assessed is use in the course of trade. Article 9 of the EUTMR sets a non-exhaustive list of situations where a sign is used and the use may be prohibited. It is as follows:

- a) affixing the sign to the goods or to the packaging of those goods;
- b) offering the goods, putting them on the market, or stocking them for those purposes under the sign, or offering or supplying services thereunder;
- c) importing or exporting the goods under the sign;

⁸⁷ Seville (2016). *supra nota* 19, p 355.

⁸⁸ Court decision, *supra nota* 26, para 22.

- d) using the sign as a trade or company name or part of a trade or company name;
- e) using the sign on business papers and in advertising;

The question is often represented as whether there is ‘use’ within these categories. Use indicates that the sign is being used by a third party in commercial means. Commercial means is the key factor in finding the infringement.⁸⁹ This has been confirmed by the CJEU in the case *Arsenal v. Reed* where the court held that use has to appear in the context of commercial activity, economic advantage in sight and not as a private matter.⁹⁰ Hence the rights conferred require use by the defendant in relation to the goods and services covered by the mark.

Another relevant factor in infringement proceedings is the origin function. Use which compromises the guarantee of origin may be prevented since the origin function guarantees the origin of the goods or services to consumers and is therefore the essential function of the mark. As being stated in the chapter 2 of this research, the quality function is understood as a guarantee that goods sold under the specific mark have been produced under specific company which is responsible for their quality. Therefore consumers have certain expectations concerning the quality of the goods. If unauthorised goods carrying a specific mark do not have the expected qualities, the quality function of the mark will be damaged and the rights of the owner has been infringed. In addition, the advertising function plays a major role in commercial strategies of undertakings. If advertising function of a mark which might be used to inform and persuade consumers, is being used by third parties for making advertising messages, it might endanger the proprietor’s commercial strategies and therefore this could be an infringement.⁹¹ The investment function of a mark which attracts consumers and their loyalty, might as well be the subject of infringement in a case where unfavourable effects on the investment function from a third party’s use of an identical mark allow the proprietor to prevent such use.⁹²

⁸⁹ Seville (2016). *supra nota* 19, p 357.

⁹⁰ Court decision, 12.11.2002, *Arsenal Football Club Plc v. Reed*, C-206/01, ECLI:EU:C:2002:651

⁹¹ Seville (2016). *supra nota* 19, p 361.

⁹² *Ibid.*

Conclusion

This thesis sought to ascertain the interconnection of three-dimensional trade marks and design rights within the European Union law and legal praxis. The main focus on this thesis was on the scope of protection for each of the aforementioned rights and hence the strength of the protection afforded by each right was analysed and the areas where these rights overlap was discussed. Lastly, the infringement procedures concerning each right was examined.

Three-dimensional trade marks are, in principle, evaluated in the same way as other types of trade marks. However there are some differences due to their inherent nature. Nevertheless, capability of being represented and distinctive character appears to be the key requirements in showing the origin of the products and services. According to ECJ, future changes to the requirement of representation are after all inevitable since the precise subject of the protection to its proprietor in defining the mark is important. The distinctive character appears to be extremely important in defining the scope of protection for three-dimensional trade marks. The stronger the protection will be for a mark if it possesses highly distinctive character and therefore a mark with a highly distinctive character enjoys a wider scope of protection on the market. In addition, three-dimensional shape registered as a trade mark, offers protection for an indefinite period of time if the owner of the right wants so. This offers significant advantages when compared to design registrations.

Likelihood of confusion plays an important role in the trade mark industry. The commercial origin for IP owners appears to be highly valued and therefore any infringement concerning the commercial origin has to be taken seriously by the IP owners. Likelihood of confusion works together with the distinctiveness principle and naturally, the greater the likelihood of confusion will be in a case where the distinctiveness of earlier mark is stronger.

Designs are focused on how an article looks like and therefore designs are closely linked with three-dimensional shapes. For a product to be qualified as a design it has to fulfil a standard for novelty and individual character required by the design directive. The free movement of goods is a highly valued standard within the internal market of the European Union. Hence a regulation concerning designs was adopted and in 2003, the registration for Community design was possible. Afterwards, protection for designs covering the whole EU has been available.

The scope of protection for a registered design varies depending on the corpus of prior art and due to the aforementioned, the scope of protection is somewhat narrow. Although in a situation where the design differentiates clearly from the design corpus it leads to a broader scope of protection. In addition, a registered design can be protected for up to 25 years and it has to be renewed every 5 years.

The overlapping areas between design protection and trade marks take different forms but mostly they overlap since it has been made possible to protect a shape of a product or their packaging as a three-dimensional trade mark. In addition, the protection of subject matter is usually done by using the trade mark system but in some cases the subject matter may be protectable by using the Community design system. Furthermore, a design can in some cases infringe the rights of a trade mark holder. This was confirmed in the case *Su-Chen v. OHIM* where the design was declared invalid, based on likelihood of confusion with an earlier three-dimensional trade mark.

Infringement of a registered design is highly dependent on the context of the case. On a simple case, where a third party uses an exact copy of the design, the infringement is easy to establish. However, where the alleged infringer uses slightly different and merely similar designs than the rights owner, the infringement becomes harder to substantiate. In that case the concept of overall impression and target audience plays an important role. Infringement concerning EU trade marks differs from the practical approach to the standard approach where relative grounds for refusal of registration are used to determine whether an infringement has happened or not. The practical approach is slightly different. In the aforementioned, the concept of use plays an important role. Thus use may vary between private use and use in the course of business and often this distinction is the crucial factor in determining the infringement. In the case *Arsenal v. Reed*, the CJEU confirmed that use has to happen in commercial means and economic advantage has to be the motive of the alleged infringer.

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