

After a welcoming word from Tobias Cohen Jehoram, Tomas Westenbroek from BOIP kicked off the Roundtable by giving his view on the new definition of a trademark. The requirement of graphic representation is deleted in the proposals for the new trade mark legislation. However, the requirements as set by the ECJ in the Sieckmann-ruling will still apply, according to Westenbroek. New applications would first have to be examined in light of those requirements, before examining the application further. He also notices that the ECJ's ruling about the Apple store seems not to be in accordance with the Sieckmann-requirements, since the ECJ considers as follows: 'that the representation, by a design alone, *without indicating size of proportions*'. Westenbroek also notices that the proposed addition '*or other characteristics*' to the grounds of exclusion in the latest compromise proposal may prove interesting with regards to the 'new' trademarks that will be able to be registered under the proposed legislation. The 'new' trademarks such as sound marks, may turn out to be such characteristics. Westenbroek questions whether and to what extent descriptiveness will play a role when it comes to sound marks. He gives a few examples, for instance: the sound of a ringtone for ringtones and the sound of a motor for motors. He also points out that comparing sound marks in opposition procedures might prove to be rather difficult; in case of two singing birds, would BOIP have to consult an expert in order to know if the sounds are indeed similar? Westenbroek points out some uncertainties that the proposed legislation may bring with it. One might think about questions such as: which (digital) formats will be acceptable? How to conduct research? Westbroek ends his presentation with the statement that legal certainty should always prevail and that the Sieckmann-requirements should still apply.



*Tomas Westenbroek stated that legal certainty should always be the main focus.*

After Westenbroek, Franc Enghardt from Novagraaf takes the chair. He talks about the impact of the IP translator-ruling and gives some practical examples with regards to classification and the problems a practitioner might face when it comes to both existing registrations and new applications. The Commission

proposed the following provision: *'Proprietors of European trade marks applied for before 22 June 2012 which are registered solely in respect of the entire heading of a Nice class, may declare that their intention on the date of filing had been to seek protection in respect of goods or services beyond those covered by the literal meaning of the heading of that class, provided that the goods or services so designated are included in the alphabetical list for that class of the edition of the Nice classification in force at the date of filing.'* However, in the latest Compromise Proposal this provision is deleted. OHIM's current practice, where applications/registrations for the class heading filed before 22 June 2012 automatically extend to all goods or services on the alphabetical list of that class, might be considered not to be in accordance with the IP Translator ruling and the proposed provision by the Commission could have made things more clear. Enghardt proposes to not take any chances when it comes to classification and to always 'limit' where possible and to refile where necessary.

With regards to collective marks, Enghardt gives some statistics and states that the proposed changes in the new legislation, namely having both certification and collective marks, might be something for BOIP to follow. In the Benelux, there seems to be a more 'hybrid' collective mark that leans more towards a certification mark. Having a more clear system might prove useful, according to Enghardt.



*Franc Enghardt: better safe than sorry when it comes to classification: limit or refile in order to make sure that the classification is clear and precise.*

Tobias Cohen Jehoram was next in line to speak. He starts by discussing the double identity-rule. The Commission had proposed to add, under article 9 sub a CTMR, *'and where such use affects or is liable to affect the function of the European trade mark to guarantee to consumers the origin of the goods or services'*, thus limiting the scope of that protection. However, in the Interflora case, the ECJ has held all functions to be relevant under sub a. Cohen Jehoram further clarifies the Commission's reasoning and also gives some counterarguments, without taking a personal standpoint in the matter, but rather to address this much debated issue. Cohen Jehoram then addresses some of the rights conferred in the legislation as proposed, including the fact that a trade mark owner may take relevant action against use of his trade mark

as a company name. Cohen Jehoram questions whether this does not narrow the scope of what the ECJ stated in the Céline-ruling, since the ECJ considered that the trade mark owner can act against the use of a trade name when this use should be understood as indicating a link between the goods and services offered and a trade mark. Counterfeit is also an important topic within the proposals for the new trade mark law. Cohen Jehoram addresses the fact that under the proposed provisions, the trade mark owner shall be entitled to prevent importation of goods where only the consigner acts in the course of trade and points out that this particular provision is in accordance with the Blomqvist/Rolux ruling of the ECJ. Cohen Jehoram ends with discussing the very hotly debated topic of goods in transit. Under the proposed provisions, the trade mark owner will be able to prevent third parties from bringing in goods into the customs territory of the European Union, regardless of whether they are released for free circulation there. The Parliament had proposed to add that the provision should not apply if the third party proves that the final destination of the goods is a country outside of the Union. However, according to Cohen Jehoram, this would in fact contradict the objective of the proposed provision.



*Prof. Tobias Cohen Jehoram: 'goods in transit' remains a hotly debated topic*

Freyke Bus, IP judge at the District Court of The Hague, is the last one to have her say about some of the proposed changes in the new drafts. She shortly addresses the topic of the use of a trade name and does not think that the criterion of the Céline-ruling will lose territory here, but will remain to play a role. She then addresses the 'new' limitations as mentioned in the proposals. First of all, the sign of a non-distinctive sign or indication will not be trade mark infringement. Bus wonders whether this actually brings something new to the table; she notes that this is not more than logical. Bus further clarifies some of the other limitations as mentioned in the new legislation. She specifically addresses that the provision that states that the limitations may only apply where the use of the third party is in accordance with honest practices in industrial or commercial matters. That use shall not be considered to be in accordance with honest practices when it takes unfair advantage of the distinctive character of the repute of the trade mark without due cause. Bus states that she does not see how it would be possible to take unfair advantage *with* due cause; that would

make the advantage fair. Bus also addresses the limitation of referral in parody and wonders if the fact that in the latest proposals this limitation is not mentioned is not a missed chance. She gives some examples of referral in parody, leaving the public to make up its mind about this particular topic.



*Freyke Bus: does unfair not imply that there is no due cause?*

After all the speakers took the floor, a discussion between speakers and public followed. Some interesting issues were addressed. The fact that the grounds for exclusion are broadened was something that sparked quite some discussion. In particular because of the wording of the proposed provision, which leaves room for interpretation. Bus asked the question whether the exclusion grounds would also apply to a beautiful logo, since the attractiveness of the logo gives the sign 'substantial value'. Westebroek reasoned that this will not be the case, but some members of the audience noted that 'other characteristics' could also see to signs other than shapes. One of the members of the audience pointed out that the Court of Justice already seems to apply the grounds for exclusion to 2-D marks, referring to in the P-case and the recent Louis Vuitton 'buckle' case.

The Sieckmann-requirements were also talked about some more. One of the members of the audience asked Westebroek why he found that the ECJ did not apply the Sieckmann-criteria in the Apple Store ruling, since it was never necessary to indicate actual size or proportions. Another member of the audience agreed with this statement and said that it was not necessary to indicate actual size or proportion, since it was merely a depiction of a three-dimensional mark. The discussion on the Apple Store case was closed by a member of the audience stating that, regardless of whether the ruling is in accordance with the Sieckmann-requirements, the Apple Store as depicted might not be able to function as a trade mark either way, since the sign at hand is far too complex.

Next topic to be discussed was the double identity-rule. There was not so much a discussion on this topic, but rather an open dialogue. Most of the attendees seemed to be in agreement about the fact that the proposal of the Commission with regards to adding the origin function under sub a, is not advisable. One of



the audience members pointed out that, in the end, it all comes down to the burden of proof for the trade mark owner. Cohen Jehoram also pointed out that the text as proposed by the Commission might be in breach of article 16 TRIPS.

The last topic that was addressed was goods in transit. A member of MARQUES said that MARQUES considers the text of the Commission to be the best one. However, a compromise had to be made in order to ensure that the goods in transit would play an important role in the new legislation. Cohen Jehoram agreed, but also pointed out that the latest texts in the Compromise Proposal do in fact not differ that much from the proposed provision by the Commission.

In the Compromise Proposal of July 18<sup>th</sup>, the proprietor of a European Union trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into the Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the European Union trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trademark. However, the entitlement of the trade mark proprietor lapses if evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination. Bus pointed out that goods in transit are not all counterfeit products and then raised the question how much evidence would be enough. A member of the audience replied by saying that that it would be up to the judge to decide how much evidence would be enough. Bus responded by stating that an agreement with a third party to that effect will probably prove to be sufficient and that she wonders how effective this evidence-rule actually is.

All and all, a very successful INTA Roundtable, where it was made clear that the new drafts for the EU trademark Directive and Community Trade Mark regulation leaves much room for discussion. The new legislation is awaited with anticipation!



*Enjoying drinks afterwards*

