**TRADE MARK LAW INSTITUTE**

Leiden-Nijmegen-Groningen-Amsterdam-Rotterdam

**5th TLI SYMPOSIUM**

**TERRITORIALITY IN TRADE MARK LAW, PROTECTION ACROSS BORDERS and LICENSING**

31 October – 1 November 2014

Faculty of Law, Erasmus University Rotterdam

Friday and Saturday: Faculty Club, Prinsenlandzaal, Campus Woudestein, Burgemeester Oudlaan 50, Rotterdam

<http://www.eur.nl/studiekeuze/erasmus_universiteit/bereikbaarheid_plattegronden/route_plattegronden_woudestein/>

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PURPOSE OF THE CONFERENCE

Trade mark law does not stand on its own, but is integral part of the legal, in particular civil law system. The purpose of this conference is to study and discuss some of the areas where trade mark law touches these other areas of the law, and maybe even comes into conflict with them.

The first day will focus on one of the essential characteristics of trade mark rights: their territorial scope. Despite that characteristic, we see the scope of protection extending beyond the territorial limitations of the registrations, as trade mark law has to face up to realities like repute extending beyond such territories, economic realities of markets, globalization of production and trade. How do the trade mark laws deal with these issues, and how should they be dealing with them? What tendencies do we recognize in case law and recent legislation (proposals)?

On the second day we will look at two specific fields of law, which have proven to be a major importance for determining the scope of trade mark protection and which play a major role in practice: contract law (with a specific emphasis on licenses) and competition law.

In particular the European Court of Justice seems to have the tendency to rule on matters of contract law in relation to intellectual property rights (f.i. ECJ 23 April 2009, C-59/08 Copad/Dior, ECJ 19 September 2013, C-661/11 Martin Y Paz, ECJ 3 July 2012, C-128/11 Usedsoft). We will discuss which direction this is likely to take and whether these are desirable developments, especially where license contracts are involved. Also, competition law tends to have its own, and increasing impact on licensing issues and contracts, and sometimes takes precedence over trade mark law. Where is this the case and which developments do we recognize?

Closely linked to this topic is the effect of the concept of free movement of goods within free trade zones, like the European Economic Area.

Finally, economic and political forces create new and specific legislation, for instance in the field of e-commerce, unfair trade practices and other consumer protection laws. We will discuss how this –sometimes inadvertently- affects trade mark law.

These topics will be introduced by an international group of scholars.

## PROGRAMME

# Friday, 31 October 2014

#### 13.30 Registration and coffee

14:00 Welcome to the Erasmus University Rotterdam by Professor Susan Stoter, Dean of the Faculty of Law

14.10 Aim of the Conference & Approach

*Prof. Tobias Cohen Jehoram, (Erasmus University, Trademark Law Institute)*

#### 14:20 Part 1: Trademarks: territoriality of rights

Chair: *Prof. Dirk Visser, Leiden University*

14:20 Introduction I. Trademarks: protecting trademarks with a reputation outside the territory (art 6bis PC, descriptiveness in other countries/languages, bad faith filing)

 *Prof. Dr. Graeme Dinwoodie*

14:50 Introduction II. Trademarks: genuine use requirements and territoriality, acquiring distinctive character and territoriality, practice at OHIM and national trademark offices

 *Prof.* *César Ramirez-Montes*

15:20 Discussion

16:20 Coffee Break

#### 16:35 Part 2: Cross border enforcement

Chair: *Prof. Antoon Quaedvlieg (Nijmegen)*

16:35 Introduction I. Enforcement in a globalized world (new Regulation and Directive proposals, ECJ Blomqvist)

*Prof. Guido Kucsko*

16:55 Introduction II. Goods in transit (ECJ case law and new Regulation and Directive proposals)

 *Prof. Henning Grosse Ruse*

17:20 Discussion

18:00 Summary and conclusion

19:30 Conference Dinner at Restaurant Boerengat, Oostzeedijk 272, 3063 CA Rotterdam (10-15 minutes walk from the campus; tram and taxi are options).

# Saturday, 1 November 2014

#### 9:00 Part 3: Trademark licenses

Chair: *Prof. Martin Senftleben, Free University Amsterdam*

9:00 Introduction I. To what extent does EU law limit the freedom to contract in trademark licenses? (exhaustion limitations, ECJ Copad/Dior, Martin Y Paz)

 *Prof. Dr.Jacques de Werra*

 9:25 Introduction II. Changing competition law restraints on trademark licences (vertical restraints,

 selective distribution, abuse of IP rights)

 *Prof. Giovanni Guglielmetti*

 9:45 Discussion

10:30 Coffee Break

#### 10:45 Part 4: Influences of other EU law concepts on Trademark Law

Chair: *Prof. Charles Gielen, Groningen University*

10:45 Introduction I. Partial harmonization on the free movement of goods; traditional approach to free movement of goods and national rights (Art 34 and 36 TFEU) in the light of the high level of IP law harmonization.

 *Prof Lionel Bently*

11:05 Introduction II. The influence of e-commerce legislation and unfair trade practices

 *Dr. Rogier de Vrey*

 11:25 Discussion

#### 12:15 Conclusion and summary of main results

12:45 Closing and Information on Future Projects

*Prof. Tobias Cohen Jehoram, (Erasmus University, Trademark Law Institute)*

13:00 Warm Conference Closing Lunch at the Student Pavilion on Campus