

## TRADEMARK LAW INSTITUTE

### Conference ‘Selected Problems of the EU Trademark Law Reform’

Vrije Universiteit Amsterdam, November 4 and 5, 2016

#### **Programme**

Friday, November 4, 2016

**Room: Initium building, De Boelelaan 1077, 2A-45/47 (2<sup>nd</sup> floor)**

13.30 Registration and coffee

14:00 Welcome and Information on Trademark Law Institute  
*Prof. Martin Senftleben, Trademark Law Institute (Amsterdam)*  
Aim of the Conference  
General Approach

14:15 Part 1: Broadened Functionality Doctrine: From Shapes to Product Characteristics in General

Chair: *Prof. Antoon Quaedvlieg, Trademark Law Institute (Nijmegen)*

14:15 Introduction I  
*Prof. Irene Calboli, Singapore/Texas A&M*

14:30 Introduction II  
*Prof. Annette Kur, Munich*

14:45 Discussion

15:45 Coffee Break

16:15 Part 2: Referential Use: From Implicit Limits of Protection to Explicit Limitation of Protection

Chair: *Prof. Dirk Visser, Trademark Law Institute (Leiden)*

16:15 Introduction I  
*Prof. Ansgar Ohly, Munich*

16:30 Introduction II  
*Prof. Graeme Dinwoodie, Oxford*

16:45 Discussion

18:00 Closing

19:00 Conference Dinner

Saturday, November 5, 2016

**Room: Initium building, De Boelelaan 1077, room 2A-45/47 (2<sup>nd</sup> floor)**

9:30 Part 3: Impact of Fundamental Rights: From External to Internal Balancing

Chair: *Prof. Tobias Cohen Jehoram, Trademark Law Institute (Rotterdam)*

9:30 Introduction I

*Prof. Christophe Geiger, Strasbourg*

9:45 Introduction II

*Prof. Robert Burrell, Sheffield*

10:00 Discussion

11:00 Coffee Break

11:15 Part 4: Seizure of Goods in Transit: From Internal Market Control to World Policing

Chair: *Prof. Martin Senfleben, Trademark Law Institute (Amsterdam)*

11:15 Introduction I

*Dr. Henning Große Ruse Khan, Cambridge (tbc)*

11:30 Introduction II

*Prof. Vincenzo Di Cataldo, Catania*

11:45 Discussion

12:45 Closing and suggestions concerning future projects

13:00 Conference Lunch

## Directions

### **Airport to Hotel/Vrije Universiteit Amsterdam**

Arriving at Amsterdam Schiphol Airport, the easiest (and fastest) way to get to the Vrije Universiteit Amsterdam is to take the train to Amsterdam South (Amsterdam Zuid). Trains leave every 10-15 minutes at platform 1 or 2. Amsterdam South is the first stop after Schiphol Airport. The ride will take about 7 minutes.

Important: Make sure you take a train to Amsterdam SOUTH (ZUID). Do not take a train to Amsterdam CENTRAL (CENTRAAL). This would be the wrong direction.

### **Hotel**

Unfortunately, the budget available for the Conference does not allow the TLI to provide accommodation for participants who are not speakers. Please make your own arrangements for a hotel room in Amsterdam. In the vicinity of the Vrije Universiteit Amsterdam you find several (business) hotels offering rooms at different rates. The Crowne Plaza Amsterdam South Hotel, George Gershwinlaan 101, 1082 MT Amsterdam, +31 20 504 3666, for example, is very close to the university.



From the train station Amsterdam South, you leave the station building in the direction of the Vrije Universiteit Amsterdam, cross the Gustav Mahlerplein and the Gustav Mahlerlaan. You will then arrive at the George Gershwinplein where you have the Crowne Plaza Hotel at your left (walking time: 3 minutes). From here, it is only a 5 minutes walk to the university.

### **Conference Room**

The conference will be held in room **2A-45/47** on the second floor of the **Initium** building of the Vrije Universiteit Amsterdam, De Boelelaan 1077.



The picture above shows the Initium building, as you see it when walking from the train station Amsterdam South or arriving at the tram/metro station *De Boelelaan/VU*.

### **Dinner**

The conference dinner on Friday will be held in restaurant Bolenius, George Gershwinlaan 30, 1082 MT Amsterdam, +31 20 404 4411, <https://www.bolenius-restaurant.nl/>.



The picture above shows the entrance area of restaurant Bolenius. The restaurant is very close to the Crowne Plaza Amsterdam South hotel. The backside of the hotel and the restaurant are located at the same square. Restaurant Bolenius is also very close to the Initium building (5 minutes walking distance) and Amsterdam South Station (also 5 minutes).

## Description

### Topics

The December 2015 amendment of EU trademark law has not led to a fundamental reconfiguration of the protection system. However, a closer look at selected legislative changes shows that the amended legal provisions raise delicate questions. The Conference focuses on four potential problem areas:

- the broadening of the functionality doctrine in Article 4(1)(e) TMD and Article 7(1)(e) EUTMR leads to an outright exclusion of product characteristics, including the shape of a product, which result from the nature of the goods, are necessary to obtain a technical result or give substantial value to the goods. Depending on the interpretation of this broadened EU functionality doctrine, the extension of the provision to all kinds of product characteristics may restrict the availability of trademark protection in many cases. In any case, the assessment factors which the CJEU developed in *Hauck/Stokke* seem to offer much room for a broad application of the functionality doctrine. Taken to the extremes, the attachment of a trademarked logo to goods, such as the use of the Ralph Lauren logo on T-shirts, could be seen as a product feature adding substantial value. Hence, the question arises whether the broadening of the functionality doctrine is a desirable development, and whether the interpretative challenges arising from this development can satisfactorily be solved;
- the introduction of a general referential use defence in Article 14(1)(c) TMD and Article 12(1)(c) EUTMR leads to the question whether the reliance on inherent limits of protection under the former legislation, such as the test of adverse effect on a protected function in double identity situations, has become obsolete. Having created an elastic concept of actionable “use as a trademark”, the CJEU only managed to preserve room for referential use under the double identity rule of the former legislation by using the unwritten requirement of adverse effect on a protected trademark function as a balancing tool. The keyword advertising decisions in *Google/Louis Vuitton* and *Interflora/Marks & Spencer* illustrate this use of the function theory. Under the amended EU trademark legislation, infringement cases concerning referential use, arguably, can be solved more convincingly on the basis of

the new explicit limitation. Reliance on a limitation, however, may have other repercussions, such as a shift of the burden of proof. Whereas the trademark proprietor must show that all criteria of *prima facie* infringement are fulfilled, it is the defendant's task to produce evidence supporting the invocation of the referential use defence. Hence, the question arises whether the development of a broader referential use defence was a step in the right direction, and how the conceptual contours of the defence should be drawn to allow its appropriate application;

- as a higher-ranking, overarching norm, fundamental rights, in particular (commercial) freedom of expression and freedom to conduct a business, may always impact on decision-making in the field of trademark law. With the amended EU trademark legislation, however, a new stage in the recognition of the impact of fundamental rights has been reached. Recital 27 TMD and Recital 21 EUTMR leave no doubt that the new trademark legislation “should be applied in a way that ensures full respect for fundamental rights and freedoms, and in particular the freedom of expression.” Against this background, the question arises whether this development in the field of trademark law can be placed in the context of a broader trend in intellectual property law to lend more and more weight to fundamental rights and include them in the regular assessment of concrete cases instead of limiting their application to exceptional circumstances. Moreover, the question arises which impact the recognition of “full respect for fundamental rights and freedoms” might have on cases that have to be decided under the amended legislation. Will this explicit fundamental rights guarantee have a direct influence on the further development of EU trademark law?;
- finally, the new exclusive right against counterfeit goods in transit which is granted in Article 10(4) TMD and Article 9(4) EUTMR raises delicate questions in the light of the international guarantee of the freedom of transit in Article V GATT. With the new exclusive right, the EU legislator sought to neutralize the status quo which had been reached after the decision in *Philips and Nokia*, requiring a risk of release for free circulation in the internal market. The questions arising from this legislative decision must not be underestimated. In the area of patent law, the transit seizure in the *Losartan* case (concerning the seizure of a shipment of generic medicine on its way from India to Brazil by customs authorities in Amsterdam, based on European patent rights of DuPont and Merck Sharp & Dohme) even led to a request for consultations before the WTO. Therefore, it is an open question whether the amended EU trademark legislation offers sufficient safeguards against an encroachment upon the international freedom of transit to be deemed permissible. On the one hand, this question concerns the scope and configuration of the international guarantee of free transit. On the other hand, it raises the question of potential differences between patent and trademark rights. While patent protection concerns a product, such as a pharmaceutical product, as such, trademark rights only relate to signs that are attached to the product as an identifier of commercial source. Arguably, the risk of a corrosive effect of transit seizures is thus reduced as well.

In the different sessions of the TLI Conference, these issues will be addressed and discussed in more detail. As always, the discussion is likely to lead to additional insights and bring to light additional challenges.

### **(Some) Background Reading**

L. Bently, "From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property", in: G.B. Dinwoodie/M.D. Janis, *Trademark Law and Theory: A Handbook of Contemporary Research*, Cheltenham: Edward Elgar 2008

R. Burrell/D. Gangjee, "Trade Marks and Freedom of Expression: A Call for Caution", IIC 41 (2010), 544

I. Calboli, "Betty Boop and the return of aesthetic functionality: a bitter medicine against 'mutant copyright'?", EIPR 36 (2014), 80

T. Cohen Jehoram, "The Function Theory in European Trade Mark Law and the Holistic Approach of the CJEU", *The Trademark Reporter* 102 (2012), 1243

G.B. Dinwoodie, "Lewis & Clark Law School Ninth Distinguished IP Lecture: Developing Defenses in Trademark Law", *Lewis and Clark Law Review* 13/1 (2009), 99

C. Geiger, "Trade Marks and Freedom of Expression – the Proportionality of Criticism", IIC 38 (2007), 317

H. Große Ruse-Khan, "An international trade perspective on transit seizures", *BMM Bulletin* 39 (2013), 142

H. Große Ruse-Khan/T. Jaeger, "Policing Patents Worldwide? EC Border Measures Against Transiting Generic Drugs under EC and WTO Intellectual Property Regimes", IIC 40 (2009), 502

A. Kur, "Too Pretty to Protect? Trade Mark Law and the Enigma of Aesthetic Functionality", in: J. Drexler et al. (eds.), *Technology and Competition: Contributions in Honour of Hanns Ullrich*, Paris: Larcier 2009, 139 (updated 2011 version available at <http://ssrn.com/abstract=1935289>)

A. Kur, "Too Common, Too Splendid, or "Just Right"? Trade Mark Protection for Product Shapes in the Light of CJEU Case Law", *Max Planck Institute for Innovation & Competition Research Paper* No. 14-17 (available at <http://ssrn.com/abstract=2526124>)

A. Kur, "Trademarks Function, Don't They?", IIC 45 (2014), 434

A. Ohly, "Interfaces between trade mark protection and unfair competition law – confusion about confusion and misconceptions about misappropriation?", in: N. Lee/G. Westkamp/A. Kur/A. Ohly (eds.), *Intellectual Property, Unfair Competition and Publicity: Convergence and Development*, Cheltenham: Edward Elgar 2014, 33

L. Ramsey/J. Schovsbo, "Mechanisms for Limiting Trade Mark Rights to Further Competition and Free Speech", IIC 44 (2013), 671

M.R.F. Senftleben, "Function Theory and International Exhaustion: Why it is Wise to Confine the Double Identity Rule in EU Trade Mark Law to Cases Affecting the Origin Function", EIPR 36 (2014), 518

M.R.F. Senftleben, “Wolf in Sheep’s Clothing? Trade Marks Rights Against Goods in Transit and the End of Traditional Territorial Limits”, IIC 38 (2016), forthcoming

M.R.F. Senftleben/L. Bently/G. Dinwoodie/C. Geiger/J. Griffiths/A. Kur/A. Ohly/A. Peukert/M. Ricolfi/J. Schovsbo/K. Weckström/Ł. Żelechowski, “The Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition: Guiding Principles for the Further Development of EU Trade Mark Law”, EIPR 37 (2015), 337

## **List of Participants**

### Speakers

1. Irene Calboli
2. Annette Kur
3. Ansgar Ohly
4. Graeme Dinwoodie
5. Christophe Geiger
6. Robert Burrell
7. Henning Große Ruse Khan
8. Vincenzo Di Cataldo

### Participants

9. Elzbieta Traple
10. Willem Hoyng
11. Martin Husovec
12. César Ramírez-Montes
13. Luigi Mansani
14. Jaap Spoor
15. Robin Jacob
16. Marco Ricolfi
17. Giovanni Guglielmetti
18. Andrew Griffiths
19. Lukasz Zelechowski

20. Lotte Anemaet
21. Tomas Westenbroek
22. Antoon Quaedvlieg
23. Paul Geerts
24. Dirk Visser
25. Paul van der Kooij
26. Tobias Cohen-Jehoram
27. Martin Senftleben