



FULL PROGRAMME

TRADE MARK LAW INSTITUTE

PROPORTIONALITY IN TRADE MARK LAW

6 AND 7 JUNE 2024

PROPORTIONALITY IN TRADE MARK LAW

Trade Mark Law Institute

The proportionality principle is enshrined in Article 3 of the European Enforcement Directive. The first sentence of paragraph 2 states that "measures, procedures and remedies" to enforce "intellectual property rights" must be "proportionate" in addition to being "effective" and "dissuasive". The second sentence of Article 3(2) teaches that this principle of proportionality requires, in particular, that the measures, procedures and remedies referred to must be "applied in such a way as to avoid the creation of barriers to legitimate trade and to provide safeguards against the abuse of such procedures."

Article 3 teaches that the principle of proportionality seeks to counterbalance the private interest of the IP right holder - who benefits from deterrent and effective law enforcement - and stands for the public interest which benefits from unimpeded legitimate trade and does not benefit from abusive litigation. The principle of proportionality is also found in the TRIPS Agreement of 1995, which implies that it should be respected not only on the basis of EU law, but is also subject to interpretation by the WTO. The TLI workshop seeks to explore the extent to which the principle of proportionality plays a role in trade mark cases where the interests of the trade mark holder are curtailed by the interest of third parties and society at large.

PROGRAMME

THURSDAY 6 JUNE 2024

Kapoenstraat 2, Maastricht

Room: 1.009

13.15 - 14.00 Lunch

14.00 - 14.15 Welcome

14.15 - 14.30 Reflection on Antoon Quaadvlieg's involvement in early TLI

By Charles Gielen (Emeritus professor of IP law at the University of Groningen,
Of Counsel Nauta Dutilh Amsterdam)

14.30 - 16.00 Session 1: Bad faith and unclean hands

Bad faith filings are difficult to assess, as one has to find that the applicant or proprietor did not intend to put the mark to legitimate use. The applicant's own behaviour or statements are often cited against him, but is does this result in proportionate outcomes if the sanction is that the mark is declared invalid?

Such bad faith or 'unclean hands' also play a role in commercial dealings. For example, when terms of licenses for the use of a trade mark in relation to goods produced by the trade mark owners are not commonly known. This means that third parties do not know under which circumstances the use of a mark is allowed or not. How can one avoid a misconception on the part of third parties, or indeed confusion among consumers, as to who is authorized to use the mark and whether the goods are indeed products authorized by the trade mark owner? Is it proportionate for a trade mark owner to enforce his trade mark rights against third parties who use the trade mark, while the trade mark owner himself has contributed to the likelihood of confusion?

Case law

- GC T-306/20, Hijos de Moisés Rodríguez González, SA v EUIPO (La Irlandesa 1943), ECLI:EU:T:2022:404
- Cour de Cassation, January 10, 2024, request for a preliminary ruling in Case C-17/24 CeramTec GmbH v CoorStek Bioceramics LLC (the original in French along with translations available on the curia site).
- CJEU 29 January 2020, C-371/18 (Sky v Skykick):
 - [CURIA - Documents \(europa.eu\)](#) en [Sky v Skykick judgment \(judiciary.uk\)](#)
 - [Trade marks registered with no intention to use - The IPKat](#)
- CJEU 11 June 2009 C-529/07 (Lindt):
 - [CURIA - Documents \(europa.eu\)](#)
- CJEU 12 September 2019 C-104/18 P (Koton):
 - [CURIA - Documents \(europa.eu\)](#)
 - [Conclusie AG Kokott CURIA - Documents \(europa.eu\)](#)

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- GC 21 April 2021 T-663/19 (Monopoly):
 - [CURIA - Documents \(europa.eu\)](#)
 - [The IPKat and discussion on IPKAT](#)
 - [Bad faith games: Hasbro rolls and loses | World IP Review](#)
 - [Lidl v Tesco – evergreening and non-use revocation](#)
- GC 8 May 2014 T-327/12 (Simca):
 - [CURIA - Documents \(europa.eu\)](#)
- GC 6 July 2022 T-250/21 (Nehera):
 - [62021TJ0250 \(europa.eu\)](#)
- EUIPO 5th BoA Pest Control Ltd. V Full Colour Black Ltd. [R 1246/2021-5](#)

Literature and reports

- J Davis & L Zelechowski, Bad Faith, Public Policy and Morality: How Open Concepts Shape Trade Mark Protection, IIC (2023) 54:859–890,
<https://doi.org/10.1007/s40319-023-01350-7>
- M Rietveld & K Scheerlinck, ‘Too bad(?)’ Recent case-law on trade mark applications in bad faith, 2/2021 BMM Bulletin jaargang 47, p. 84 – 93
- EUIPN, CP13 Common Communication, Trade Mark Applications Made in Bad Faith, https://www.tmdn.org/network/documents/10181/2556742/CP13_Common_Communication_en.pdf/1cdbc448-b8a6-4507-9f57-ed8b780593a1

Moderator

Anselm Kamperman Sanders

(Professor of Intellectual Property Law, Maastricht University)

Speakers

- Alexander Tsoutsanis (Attorney with DLA Piper)
“Bad faith, proportionality and (lack of) intent-to-use: between carpet-bombing the register and blind ambition”
- Tobias Cohen Jehoram (Professor Intellectual Property Law at Erasmus University Rotterdam),
“The many faces of bad intentions and it's limitations; from refiling to revival”
- Łukasz Żelechowski (Associate Professor of Intellectual Property Law and Civil Law, University of Warsaw),
“Filings unrelated to trade mark functions or concerning marks used in a deceptive manner. How much room is there for bad faith?”

16.00 - 16.30 Break

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- 16.30 – 18.00** **Session 2: Is there a role for technology to assist in proportionality assessment?**
- AI systems and tools are being developed at fast speed. Also for the search, registration process, examination and enforcement of trade marks, relevant tools are available on the market and developed by trade mark offices. However, the tasks such systems currently perform mainly regard probability assessments of similarity of signs on the basis of optical recognition and textual and semantic similarity and the similarity of goods and services based on textual and semantic similarity. The question arises whether proportionality assessments that are inherent in the assessment of distinctiveness, likelihood of confusion or harm to a reputed mark can also be supported by AI system.

Literature/case law

- Sevastianova, V.N. Trademarks in the Age of Automated Commerce: Consumer Choice and Autonomy. IIC 54, 1561–1589 (2023).
<https://doi.org/10.1007/s40319-023-01402-y>
- S. Gangjee, D. (2024). "Panoptic Brand Protection" Forthcoming EIPR.
- Samuel Dahan and others, 'Analytics and EU Courts: The Case of Trademark Disputes' in Tamara Capeta and Iris Goldner Lang (eds), *The Changing European Union: A critical view on the role of the Courts* (Hart Publishing 2022).
- Janssens, M.-C., & Dessers, V. K. (2022). The Artificially Intelligent Consumer in EU Trademark Law. In *Gestaltung der Informationsrechtsordnung. Festschrift für Thomas Dreier zum 65. Geburtstag* (pp. 143–160). C.H. Beck; München
- T. Vandamme, J. Cabay, O. Debeir, "A Quantitative Evaluation of Trademark Search Engines' Performances through Large-Scale Statistical Analysis", in X., *Proceedings of the Nineteenth International Conference on Artificial Intelligence and Law (ICAIL 2023)*, June 19–23, 2023, Braga, Portugal, ACM, New York (NY, USA), 2023, pp. 343-350
- Lim D (2022) Computational Trademark Infringement and Adjudication. In: Abbott R (ed) *Research Handbook on Intellectual Property and Artificial Intelligence*. Edward Elgar, Northampton, p 259–289,
https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4259241
- Farley, C-H, Trademarks in an Algorithmic World, 98 *Washington Law Review* 1123 (2023), American University Washington College of Law Legal Studies Research Paper Series, Available at SSRN: <https://ssrn.com/abstract=4699501>

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Moderator

Anke Moerland

(Associate Professor of Intellectual Property Law, Maastricht University)

Speakers

- Vera Sevastianova (Doctoral Researcher in Intellectual Property Law, Hanken School of Economics),
“Trademarks and AI: Understanding the New Shopping Environment for a Better Balance of Rights”
- Dev Gangjee (Professor of Intellectual Property Law, University of Oxford),
“Online Marketplaces and Algorithmic Injunctions – Who Needs an Infringement Test?”
- Julien Cabay (Associate Professor at Université Libre de Bruxelles and Université de Liège),
“Computing Likelihood of Confusion? Lessons from IPSAM”

19.00

Dinner

Marres Kitchen

Capucijnenstraat 98

6211 RT Maastricht

<https://marres.org/kitchen/>

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Kapoenstraat 2, Maastricht

Room: 1.009

9.00 - 10.30 **Session 3: Proportionality and enforcement of trade marks, in light of the circular economy**

The destruction of products that are infringing upon trade mark rights is a possible remedy trade mark owners can seek when infringing goods have been seized. The question arises whether it is proportionate to seek destruction for all types of infringing goods, for example where trade mark owners have not authorized the marketing in certain markets. Is market segmentation a valid reason to seek destruction? Should other concerns, like circularity of our economy and costs for society (where the responding party is not paying) that are connected with destruction, be taken into consideration for the proportionality assessment? And which party is equipped to decide whether such a request is proportionate: customs authorities or judges?

Case law

- Norwegian Supreme Court, Apple v Huseby, 2 June 2021, HR-2020-1142-A
- CJEU Hewlett Packard v Senetic, C-367/21, ECLI:EU:C:2024:61
- CJEU Mitsubishi v Duma, C-129/17, ECLI:EU:C:2018:594
- CJEU Class International v Colgate Palmolive, C-405/03, ECLI:EU:C:2005:616
- CJEU Van Doren + Q v Lifestyle Sports, C-244/00, ECLI:EU:C:2003:204
- CJEU C-416/05, Nokia v Wärdell, 14 December 2006
- BGH GRUR 2007, 1079 – Bundesdruckerei
- CJEU C-44/21, Phoenix Contact, 28 April 2022
- CJEU 13 October 2022, ECLI:EU:C:2022:791, C-335/21 (Perfumesco)
- Court of Appeal of The Hague, 11 October 2022, ECLI:NL:GHDHA:2022:1995 (Ferrari Kitcar)

Literature

- Wolf Meier-Ewert, The TRIPS Agreement and the Sustainable Disposal of IP-infringing goods – Lessons from WTO Dispute Settlement cases, in Jacques de Werra (ed), *Propriété intellectuelle et développement durable / Intellectual Property & Sustainable Development*, Volume 16, 2024, Schulthess Juristische Medien AG
- Charlotte J S Vrendenburg, Towards a Judicial Sustainability Test in Cases Concerning the Enforcement of Intellectual Property Rights, *GRUR International*, Volume 72, Issue 12, December 2023, Pages 1125–1131, <https://doi.org/10.1093/grurint/ikad100>
- J.B. Nordemann, 'Die Aufbrauchfrist im deutschen Wettbewerbs-, Marken- und Urheberrecht', *ZGE* 11 (2019), 309-323

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Literature

- A. Ohly, 'Three Principles of European IP Enforcement Law: Effectiveness, Proportionality, Dissuasiveness', in: J. Drexel et al. (eds), *Technology and Competition, Contributions in Honour of Hans Ullrich*, Brussels, Larcier 2009, 257-274
- Simon Geiregat, *Trading Repaired and Refurbished Goods: How Sustainable is EU Exhaustion of Trade Marks?*, *GRUR International*, Volume 73, Issue 4, April 2024, Pages 287–298, <https://doi.org/10.1093/grurint/ikad124>
- Martin Senftleben, *Developing Defences for Fashion Upcycling in EU Trademark Law*, *GRUR International*, Volume 73, Issue 2, February 2024, Pages 99–110, <https://doi.org/10.1093/grurint/ikad131>

Moderator

Charlotte Vrendenburg (Professor of Private Law / Intellectual Property Law at Radboud University, Nijmegen)

Speakers

- Jan Jacobi (Senior Associate IP & Technology at BarentsKrans), *"Rethinking the claim for destruction"*
- Peter Teunissen (Assistant Professor Intellectual Property Law, Radboud University, Nijmegen), *"Grace Periods in EU Trademark Law"*
- Wolf Meier Ewert (Counsellor at World Trade Organization (IP Division))

10.30 – 11.00 **Break**

11.00 – 12.30 **Session 4: Use of marks beyond indicating origin**

Trade marks are being used beyond the generally accepted function of indicating origin. Then the purpose is not to distinguish certain goods of one undertaking from goods of others, but to achieve other purposes, like preventing publication. The Benelux Treaty sets out such other use in Art. 2.20 para 2. Sub d. However, CJEU case law sets out a general balance of interests which is not reflected in sub d. The question therefore arises how proportionality is reflected in the Benelux Art. 2.20 para. 2 sub d.

Literature/case law

- *Jiskefet v Noblesse Uitgevers*, Hoge Raad 27 oktober 2023, [ECLI:NL:HR:2023:1484](https://www.eclii.nl/HR/2023/1484)
- *Ikea v Vlaams Belang*, pending CJEU case C-298/23
- *Dom Perignon / Cedric Art*, Benelux Court 23 September 2019, A 2018/01 (in French and in Dutch). Comment in English by Léon Dijkman on IP Kat

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11.00 – 12.30 **Moderator**

Charles Gielen (Emeritus professor of IP law at the University of Groningen,
Of Counsel Nauta Dutilh Amsterdam)

Speakers

- Dirk Visser (Professor of Intellectual Property Law, Leiden University),
“‘Jiskefet’, ‘IKEA’ and ‘Dom Perignon’”
- Annette Kur (Affiliated Research Fellow Intellectual Property and Competition
Law at the Max Planck Institute for Innovation and Competition),
“How (un)limited is ‘due cause’?”
- Irene Calboli (Professor of Law at Texas A&M University School of Law),
*“The never-ending issue of protecting “designs” as “trademarks” (and
beyond indicating origin)”*

12.30 **Closure and walking lunch**