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CONFLICTS BETWEEN NON-TRADITIONAL MARKS

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The University of Strasbourg does not intend to give any approval or disapproval to the opinions expressed in this paper. These opinions are to be considered as their author's own.

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List of Abbreviations

BoA	Board of Appeal
CJEU	Court of Justice of the European Union
CFR	Code of Federal Regulations
CTMR	Community Trade Mark Regulation
ECJ	European Court of Justice
Ed.	Edition
<i>e.g.</i>	<i>Exempli gratia</i> (for instance)
EGC	European General Court
EU	European Union
EUIPO	European Intellectual Property Office
EUIPN	European Intellectual Property Network
EUTMR	European Intellectual Trade Mark Regulation
<i>i.e.</i>	<i>Id est</i> (that is to say)
OHIM	Office for Harmonization in the Internal Market
p.	Page
pp.	Pages
TMEP	Trademark Manual of Examining Procedure
US	United States
USPTO	United States Patent and Trademark Office
v.	Versus

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Introduction

“Almost anything at all that is capable of carrying meaning” can be a trade mark¹. This is the position adopted by the legislator who accepted to register shapes, colours or sounds as trade marks.

One could argue that the diversity of intellectual property rights already makes it possible for shapes to be protected as design, music or video by copyright, and that a protection under trade mark law is not necessary. Nevertheless, trade marks have become valuable assets for companies to attract consumers and investors. Besides, designs are a limited-in-time right which do not require a strict assessment to be registered, and therefore enjoy a very weak protection. To offset these uncertainties and to adapt to market trends and meet the needs of businesses, the European legislator saw fit to allow the registration of these new types of so-called non-traditional or non-conventional marks.

First of all, it is necessary to define what these non-traditional marks are, and what kind of conflicts we are talking about. Non-traditional marks can be shapes, colours, patterns, position signs, slogans, sounds, multimedia, holograms and motion signs. We could make a difference between the first ones, which registration dates back to many years, and sound, multimedia, motion and hologram which have been the subject of a recent reform. But these marks are not new either.

The amending Regulation (EU) No 2015/2424² of the European Parliament and of the Council, which entered into force on March 23th, 2016, and has now been codified 2017/1001 (the European Union Trade Mark Regulation or EMTR), which enshrines this reform, provides in its Recital 13 that "any sign capable of being registered “in such a way as to enable the

¹ ADAM, M., SCARDAMAGLIA, A., quoting *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162 (1995) in “NON-Traditional Trademarks. An Empirical Study”, in CALBOLI, I., SENFTLEBEN, M., *The protection of Non-Traditional Trademarks, Critical Perspective*, Oxford University Press, 1st Edition, 2018, p 70

² Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) [2015] OJ L 341/21 (since 30 September 2017 no longer in force)

competent authorities and the public to determine the clear and precise subject-matter of the protection afforded to its proprietor"³ can be a trade mark.

In essence, the modification of Article 4 EUTMR only removes the requirement of graphic representation originally required in order to qualify for trade mark protection. Indeed, according to former Article 4 CTMR (now EUTMR), "any sign capable of being represented graphically"⁴ in a "clear, precise, comprehensive, easily accessible, intelligible, durable and objective manner"⁵ may constitute a trade mark. It is now possible to apply for a multimedia, motion or sound mark by submitting a mp4 or mp3 file⁶. Prior to the amendment, a representation by a succession of images in the first two cases, and musical notes in the second case, were the sole options. The criteria of precision and clarity were therefore difficult to meet, and few companies could pretend to it. Therefore, this reform only facilitates access to trade mark law for these types of signs, without providing answers to the expectations of those who thought they could register, among others, tastes and smells. The latter cannot be registered in accordance with the required criteria of clarity and precision. Nevertheless, there is nothing to prevent an evolution of the current practice when technology permits so⁷.

These issues are not entirely new. For instance, the Singapore Treaty, adopted in 2006, already allowed States, including the European Union, to register non-traditional marks⁸. At the time, these reforms were – and continue to be – the subject of much debate⁹. The main criticisms are

³ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark [2017] OJ L154/1

⁴ Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark [2009] OJ L078/1, art. 4

⁵ C-273/00, Sieckmann, 12/12/2002, ECLI:EU:C:2002:748. See also EUTMR No 2017/1001, Article 4(b) accordingly to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), itself replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1))

⁶ Decision No EX-20-9 of the Executive Director of the Office of 03/11/2020 on communication by electronic means; Guidelines of the Office, Part B

⁷ RIBEIRO DA CUNHA, I., RANDAKEVICIUTE-ALPMAN, J., *New types of marks available after the European Union Trade Mark Reform An Analysis in the light of the U.S. Trade mark law*, 10 (2020) JIPITEC 375, para. 54

⁸ Singapore Treaty on the Law of Trademarks, 27 March 2006, art 2(1) <https://wipo.lex.wipo.int/en/text/290013>; Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks, para 3, 27 March 2006 <https://wipo.lex.wipo.int/en/text/290013>

⁹ See for instance MISHRA, N., "Registration of Non-Traditional Trademarks", *Journal of Intellectual Property Rights*, Vol 13, January 2008, pp. 43-50; PHILIPS, J., *Trade Marks at the Limit*, Ed. Edward Elgar Publishing

the depletion of the registers, the appropriation of concepts by trade mark law and the constitution of monopolies contrary to public interest. However, these discussions will not be the subject of this thesis or at most will be interspersed throughout the analysis. Nor will we dwell on the other intellectual property rights with which these marks could be protected.

Our analysis will focus on conflicts between these non-traditional marks. In the light of the Office's Guidelines, the EUIPN's Common Practice and Common Communication¹⁰, and existing case law, we will review how the EUIPO and the European Courts assess the likelihood of confusion between two non-traditional marks, and between a word or figurative mark and a non-traditional mark, and notably according to what criteria of similarity. By analogy, we will also assess the degree of protection afforded to these marks, depending on their ability to enforce their rights upon relative grounds.

Indeed, conflicts of trade marks imply the confrontation of two rights. We will limit our review to the issue of likelihood of confusion pursuant to Article 8(1)(b) EUTMR. We will therefore include invalidity actions upon article 60(a) of EUTMR in conjunction with Article 8(1)(b), which aims to invalidate a trade mark on the basis of a likelihood of confusion.

Thus, now that it is established that shapes, colours, patterns, slogans, sounds, multimedia and movements can be protected as trade marks, the question remains as to the scope of this protection. By changing trade mark law on the basis of mere registration considerations, the legislator failed to address the consequences of granting such rights would entail. Indeed, although this is changing, the average consumer is still less likely to recognise the commercial origin of goods and services by means of a hologram or a shape for example. However, the perception of the average consumer, who is used to words or logos, is crucial in identifying the degree of distinctiveness of such marks. The latter is one of the major criteria for determining whether there is a likelihood of confusion between two trademarks. As a result, many actions brought by proprietors of non-traditional trade marks are rejected. The European courts are applying an increasingly strict methodology, based *ab initio* on the traditional criteria applicable

Limited, 2006; CALBOLI, I., SENFTLEBEN, M. R. F., *The Protection of Non-traditional Trademarks: Critical Perspectives*, Ed. Oxford Press university, 1st Edition, 2018

¹⁰ European Intellectual Property Network (EUIPN), *Common Practice and Common Communication, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021

to word and figurative marks. This is the traditional *in abstracto* methodology, *i.e.* an analysis based on a comparison of the signs as registered and not in relation to the use made of them¹¹.

One may advance that given the particular nature of these marks, the methodology of the assessment of the likelihood of confusion should be adapted. For instance, colour marks are intended to be affixed on products and cannot be evaluated solely on the basis of a register. In this respect, many countries, such as Canada and the United States, seem to be more in tune with a reality-based trade mark law. From the very beginning of registration, the acquisition of distinctiveness through use is a prerequisite in the United States, in order to ensure that the relevant public identifies not only the product but the manufacturer or seller of that product. Therefore, in proceedings before the USPTO or the Courts, judges assess the likelihood of confusion between two marks on the basis of concrete aspects. This strengthens the scope of protection of such trade marks as they are considered *ab initio* to be distinctive.

However, account shall be taken of the time-wasting and costly efforts that must be made by the proprietors to substantiate such distinctiveness, which leaves little room for manoeuvre for small businesses or individual entrepreneurs. Furthermore, the current technology tools may lack performance to monitor these new types of trade marks and give them the opportunity to oppose them. Eventually, the legislator has raised the hopes of companies and entrepreneurs, making them believe that this reform would allow them to establish a monopoly on products as such, packaging or jingles. The reality is quite different. However, we should bear in mind that the intense merchandising strategies of companies, the constant evolution of technology, the strong consumer habits and, by analogy, the evolution of consumer perception, allow us to remain optimistic about a future higher degree of protection for these trade marks. In any case, the readjustment of trade mark law around the reconciliation of registration and use is at stake.

Professors Calboli and Senftleben consider that all these ongoing and future issues concerning the protection of non-traditional trade mark remain "one of the most relevant issues of modern trademark law, and will become an even more relevant topic of analysis and debate in the years to come"¹².

¹¹ Guidelines of the Office, Part C Opposition, Section 2, Chapter 1, 3.1

¹² CALBOLI, I., SENFTLEBEN, M., « Acknowledgement », in CALBOLI, I., SENFTLEBEN, M., *The protection of Non-Traditional Trademarks, Critical Perspective*, Oxford University Press, 1st Edition, 2018, p. 7

Currently, there is little literature and doctrine on this subject. Indeed, since the entry into force of the Directive, it is premature to study the impact of the registration of such marks in the context of opposition proceedings – at least for hologram, multimedia, motion and sound marks. Nevertheless, the collective work on the protection of non-traditional marks edited by Professor Calboli and Professor Senftleben, already provides many answers to the challenges ahead. This critical work sheds light on the disparity of decisions as regards non-traditional marks, not only between countries but also within the jurisdictions of the European Union. In particular, D. S. Gangjee's contribution highlights one of the major problems of the limited scope of protection of these trade marks, which is the way in which they are registered¹³. M. Handler's discussion of the importance of an assessment of the likelihood of confusion that gives primacy to the trade mark as used is also noteworthy¹⁴.

In this paper, we will show that the low degree of protection of non-traditional EU trade marks, lightened in the context of opposition proceedings in which they are involved, tackles the way in which these trade marks were registered, and the current EU *in abstracto* approach to assess the likelihood of confusion in the context of these conflicts.

In the light of European and American practices on non-traditional marks, we will first analyse the current *in abstracto* approach taken by the European jurisdictions to assess the likelihood of confusion between involving non-traditional marks in the framework of opposition proceedings (I). We will then propose a different methodology based on an *in concreto* approach (II).

¹³ *Ibidem*, HANDLER, M., “What Should Constitute Infringement of a Non-Traditional Mark? The Role of “Trademark Use”.”, pp 165-184

¹⁴ *Ibidem*, GANGJEE, Dev S., “Paying the price of admission”, pp 59-88

Part I - The limits of the current *in abstracto* assessment of the likelihood of confusion involving non-traditional marks

Traditionally, to assess the likelihood of confusion, the Office makes a global assessment of several factors analysed one-by-one, *i.e.* the similarity between the goods and services, the degree of attention of the relevant public, the similarity between the signs taking into account their distinctive and dominant elements, the degree of distinctiveness of the earlier trade mark, and if relevant, other factors.¹⁵ According to the principle of interdependence, those factors are weighed up. A lesser degree of one factor can be offset by a greater degree of another factor.¹⁶ To that extent, the finding of a low similarity between the signs can be offset by the high distinctive character of the earlier mark. As for non-traditional marks and as stated in the Guidelines and confirmed in the *Common Practice* related to new types of trade marks¹⁷, no specific criteria apply to assess the similarity and the likelihood of confusion between non-traditional trade marks.¹⁸

Due to their inherent nature, one could have thought that the European jurisdictions would have adapted its methodology to determine whether two non-traditional trade marks in conflict can be confused. Nevertheless, the current practice has not changed much comparing to the one applied to word and figurative marks, unless it has become much stricter.

We will focus our analysis on two of the *Sabèl* factors which are particularly relevant in the finding of likelihood of confusion of non-traditional marks, *i.e.*, the comparison of the signs and the assessment of the inherent distinctiveness of the earlier trade mark.

Indeed, the current practices undermines the non-traditional elements in the comparison of the signs (Chapter 1) and does not recognise the distinctive character of the earlier sign (Chapter 2).

¹⁵ C-251/95, *Sabèl*, 11/11/1997, EU:C:1997:528, § 22

¹⁶ C-39/97, *Canon*, 29/09/1998, EU:C:1998:442, § 17

¹⁷ European Intellectual Property Network (EUIPN), *Common Practice, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021, p.47

¹⁸ Guidelines of the Office, Part C Opposition, Section 2, 3.4.1.7

Chapter 1. The current practice undermines the non-traditional elements in the comparison of the signs

According to the Court of Justice of the European Union in its *Sabèl* judgement, “global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components”.¹⁹ An element or component of a trade mark is a part of this trade mark which is likely to be remembered by the relevant public as it is more striking at first glance. The more dominant and/or distinctive the common elements, the stronger the similarity and the higher the risk of confusion. It is a well-established case law that a sign which is visually striking is more likely to attract the attention of the relevant consumer²⁰. Likewise, words and outstanding figurative components are deemed to catch its attention²¹. Nevertheless, non-traditional marks are always deemed to be seen, nor they bear words or figurative elements. They are inherently different by their nature and are composed of other elements. When comparing two non-conventional signs, those elements are most of the time, if not always, disregarded. The purpose of this chapter is to highlight the unfortunate prevalence of dominant and distinctive elements in the comparison of non-traditional marks (Section 1) and the prevalence of the visual and aural similarities in the overall assessment of the degree of similarities between them (Section 2).

¹⁹ 11/11/1997, C-251/95, *Sabèl*, EU:C:1997:528, § 23

²⁰ Guidelines of the Office, Part C Opposition, Section 2, Chapter 4, 3. 5

²¹ *Ibidem*, 3. 3

Section 1. The unfortunate predominance of the dominant and distinctive elements in the comparison of the signs

In this Section, we will highlight the predominance of the word and/or figurative elements in complex non-traditional marks (I). We will then highlight that, if not strictly identical, pure shape marks and colour per se marks are more likely to be considered dissimilar (II).

I. The predominance of the word and/or figurative elements in complex non-traditional marks

As mentioned above, when comparing two words and/or figurative marks it is a well-established case law that account is taken first and foremost of the distinctive and dominant elements of the trade marks so as to assess the visual, phonetical and conceptual similarities between them²². Particularly, words prevail over figurative elements, unless the former are illegible, or unless the latter are more likely to be memorised by the relevant consumer due to their outstanding position, size, or colour in the sign²³. The same principle applies to non-traditional marks in an even stricter way, at the expense of their other specific elements. We will therefore divide our (I) as following: the predominance of the word in the comparison of non-traditional marks (A) and the predominance of the figurative elements in this comparison (B).

²² *Idem*

²³ *Ibidem*, 3.4.1.2

A. The predominance of the word in the comparison of non-traditional marks

The word elements have a stronger impact on the relevant consumer than the figurative ones. Indeed, the latter is more likely to refer to the verbal element than to describe the trade mark on the basis of its figurative elements.²⁴

According to the Guidelines, to compare a word mark and a figurative mark containing word elements, account is taken of the number of letters shared in the same order. Albeit the letters are stylised and depicted in upper or lower case, in bold or italics, in different typefaces and with additional figurative elements, similarity can be found²⁵. The wording should be strongly stylised so that the letters are illegible or at least not recognisable²⁶.

Since the same rule applies to non-traditional marks²⁷, the impact of their own elements is almost inexistent (1). Particularly, we will highlight the wider scope of protection granted to earlier low distinctive word marks when compared to non-traditional complex marks (2).

1. *Ignoring the non-traditional elements of non-traditional marks*

To illustrate, we will use the example of complex shape, multimedia, motion and hologram marks.

Complex shape marks. The practice regarding shape marks shows that what really matters is the word affixed on it. The other elements are often considered as secondary or laudatory and are disregarded in the framework of the comparison.

Laboratoire Pierre Ricaud formed a successful opposition on the basis of its word mark RENAISSANCE, against a three-dimensional mark representing a packaging of a serum portraying the profile of a woman and many word elements, among which the striking RENNESENCE (see below).²⁸


²⁴ T-312/03, Selenium-Ace, 14/07/2005, EU:T:2005:289, § 37

²⁵ See for instance T-552/10, 25/10/2012, EU:T:2012:576; R 409/2009-1, 04/02/2010; R 994/2009-4, 15/07/2010

²⁶ Guidelines of the Office, Part C Opposition, Section 2, Chapter 4, 3.4.1.2

²⁷ European Intellectual Property Network (EUIPN), *Common Practice, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021, p. 47

²⁸ B 3078328, RENAISSANCE / Biotissima RENNESENCE Professional Anti-Aging Care instant action (3D: cosmetic boxes), 18/12/2019

RENAISSANCE	
Earlier French TM no. 3 263 538	Contested EUTM no. 17 971 527

The goods covered by the earlier mark are, among others, *beauty care products, revitalizing and toning balms, facial masks and beauty masks, lotions and creams, and anti-wrinkle masks* in Class 3.

Contrary to the assessment of the Opposition Division according to which the trade mark RENAISSANCE was only “mildly allusive to some of the goods at issue, such as anti-aging creams”, the term is a common name used in the sector of cosmetics and is descriptive of one of the characteristics of the goods *i.e.*, to regenerate the skin, to look younger. When searching “renaissance masque” on Google, numerous are the results of branded creams and masks containing RENAISSANCE. The same applies to “reborn mask” (see examples below²⁹).



(a)



(b)



(c)



(d)

As for the contested trade mark, the Opposition Division started with “the box does not possess any specific characteristics and will therefore be considered non-distinctive”. The Opposition Divisions also stated that the figure of a woman was descriptive of the characteristics of goods

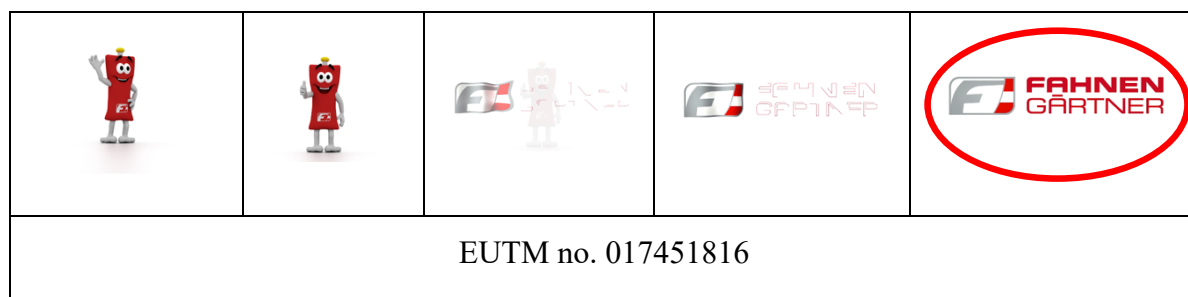
²⁹ From the left to the right, screenshots from oskiaskincare.com (a), amazon.com (c), rejouisens-pro.com (b), shoprootscience.com (d)

designed for women. Lastly, all the other elements of the sign were purely descriptive or decorative. Therefore, according to the practice of the Office, the comparison relied on the verbal elements, RENAISSANCE against RENNESENCE. The result of this comparison is that the non-traditional elements of the mark are effectively totally ignored.

Furthermore, in the perspective of a French average consumer, the verbal element RENAISSANCE is certainly descriptive of an anti-age cream and certainly less distinctive than the packaging with its stylized letters and colours.

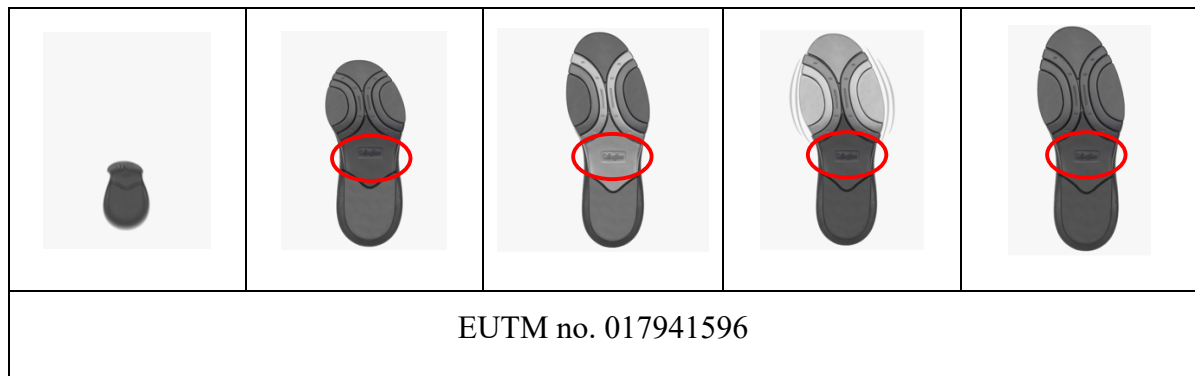
The very object of shape marks is to grant a protection on packaging. It is therefore difficult to understand that in the course of an opposition proceeding, the shape is totally ignored and excluded from the comparison of the signs. If the trade mark was not distinctive from the outset, what was the point in granting its registration?

Complex multimedia marks. A multimedia mark is the reunion of visual elements (words, images, movements) and sounds (sung or spoken verbal elements, musical elements, true-to-life sounds and other sounds).³⁰ In the framework of the comparison of signs, albeit the proprietor of a multimedia trade mark may think all the components of this trade mark are protected, only the word has a real value over the others.³¹



³⁰ *Ibidem*, Section 4.1

³¹ European Intellectual Property Network (EUIPN), *Common Practice, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021, pp. 66-68



Complex motion marks. Accordingly, the same reasoning applies to motion trade marks which movements and transformations are secondary in the framework of the comparison.³²


Complex hologram marks. Likewise, a hologram trade mark may be composed of visual elements and an holographic effect. Notwithstanding, “an identical or similar holographic effect in itself will normally not lead to a finding of visual similarity, unless similarity can be found in the verbal or figurative elements of the signs under comparison”.³³ The total abstraction made of an identical holographic effect tackles the interest to register such a sign.

³² *Ibidem*, p. 59

³³ *Ibidem*, p. p.69

2. *The wider scope of protection granted to earlier low distinctive word marks*

The same issues rise within the framework of the comparison of a non-traditional mark with an earlier non-distinctive mark. In the context of an opposition brought by *Corporação Industrial do Norte, S.A (CIN)* based on the word mark *COLORMIX*, the Company successfully partially opposed the below shape mark as regards paintings goods in Classes 2 and 17.³⁴

<p>COLORMIX</p>	
Earlier Portuguese TM no. 517 334	Contested EUTM no. 17 921 405

Despite the assessment of the low distinctive character of the earlier trade mark and of the high degree of attention of the relevant public, the Opposition Division stated that all the other elements of the contested trade marks were purely decorative, descriptive and not distinctive³⁵. Therefore, the comparison relied only in the verbal elements *COLORMIX* / *COLOMIX* according to the traditional methodology.

Again, the shape of the packaging was entirely ignored despite the fact that the earlier mark was specifically registered as a shape mark.



³⁴B 3070138, *COLORMIX* / *COLOMIX* 2:1 Standard Klarlack Kratzfest 2:1 Standard Стандартный 2k Clearcoat As Бесцветный Лак As Transparente Ag 1 Inhalt Liter Helios(3d), 12/05/2020

³⁵ *Idem*, p. 8

B. The prevalence of figurative elements once again ignoring the non-traditional elements

In the absence of word elements or when the figurative element is more likely to attract the attention consumer given its size, colour, position or because the word element lacks any distinctive character, the figurative element dominates the comparison of the signs.

Accordingly, in *Peau de vache*, the Court stated that “the weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them”.³⁶

	
Earlier Benelux TM no. 580 538	Contested CTM no. 000132134

To that extent, complex trade marks composed of several components – word or not – can share a striking figurative element on which the comparison must rely.³⁷



Again, the same principles apply to non-traditional marks. For instance, if “both multimedia marks consist of an identical depiction of a cow’s face opening its mouth, with different graphically depicted verbal elements [,] the marks are visually similar to a certain extent”.³⁸ Accordingly, a multimedia trade mark is similar to any type of trade marks (e.g. word, figurative, shape, hologram trade marks) since they share a distinctive figurative element notwithstanding the dissimilarity of the verbal elements. As for shape marks, the following example illustrates a relevant case between two wine producers in this regard (see the trade

³⁶ T-153/03, *Peau de vache*, 13/06/2006, EU:T:2006:157, § 32

³⁷ Guidelines for Examination in the office, Part C Opposition, Section 2, Chapter 4, 3.1

³⁸ European Intellectual Property Network (EUIPN), *Common Practice, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021, p. 79

marks in the table below). In the framework of this unsuccessful opposition³⁹ for identical goods in Class 33, account was only taken of the figurative elements. Given the obvious descriptive character of the verbal element ROJO in relation with wine, the Opposition Division concentrated the assessment of the similarity on the figurative elements.

Earlier shape mark	Contested shape mark
 <p>EUTM no. 3 539 962</p>	 <p>EUTM no. 16 808 743</p>

The Opposition Division stated that the shapes are not distinctive since they are “the most common shape in the wine sector”⁴⁰. The same was assessed as for the black colour of the bottle and the red colour of the verbal elements⁴¹. The latter is also devoid of any distinctive character as they are a mere description of red wine. Particularly, the division in two-lines of ROJO in the earlier sign is merely decorative.⁴² To that extent the Opposition Division concluded that the trade marks “only coincide in irrelevant aspects”.⁴³

Once again, the Opposition Division ignored the non-traditional element of the earlier mark which indeed was registered in relation to its shape. Account was taken of the dominating “pattern-like impression”⁴⁴ in the contested trade mark. The letters were considered highly stylised and therefore not legible by a part of the relevant public.

³⁹ Decision on opposition, B 2 951 625, ROJO/ROUGE, 27/09/2018

⁴⁰ *Ibidem*, p. 4

⁴¹ *Idem*

⁴² *Idem*



⁴³ *Ibidem*, p. 6

⁴⁴ *Ibidem*, p. 5

II. The unwritten rule that to find a likelihood of confusion between pure shape marks and colour *per se* marks must be identical

The comparison between two pure shape marks or colour *per se* marks relies on its visual aspect. The review of the case law reveals that in most cases, the signs are considered to be dissimilar.

Shape marks. In a case involving identical goods and an average attention of the relevant consumer, the board had to consider the similarity of the two signs depicted below⁴⁵.

Earlier shape trade mark	Contested shape trade mark
 CTM no. 690 016	 CTM no. 2 993 012

The Board concluded that the two bottles are dissimilar on the basis of the difference of the “helical twist”⁴⁶ and the difference of the design of the neck⁴⁷. Taking into account that the trade marks are not going to be seen side by side by the relevant consumer, the assessment is certainly questionable. In particular, considering that, in a purchase situation, the relevant consumer will not focus his attention on tiny details, and will have to resort to an imperfect recollection and memory⁴⁸.



⁴⁵ R 1529/2006-1, FLASCHE (3D-MARKE) / FLASCHE (3D-MARKE), 16/07/2009

⁴⁶ *Ibidem*, § 32

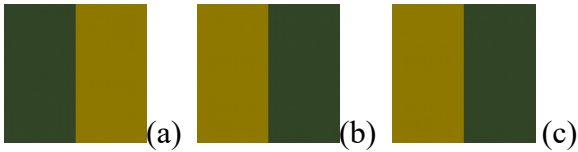

⁴⁷ *Idem*

⁴⁸ C-342/97, Lloyd Schuhfabrik Meyer, 22/06/1999, ECLI:EU:C:1999:323, § 26 ; C-291/00, LT Diffusion, 2003, ECR I-2799, § 52

Colour marks. First, it should be noted that there is no successful enforcement of a colour mark *per se* against another colour mark *per se* in the framework of the EU case law. The only one successful opposition of a single colour against another single colour trade mark was before the French PTO which held that the dissimilarities between the shades of colours were so weak that the relevant public would confuse them for services related to telecommunications in Class 33. The comparison was based on a Pantone 212c colour against a Magenta colour.⁴⁹

Earlier figurative mark	Contested colour mark
 <p>CTM no. 212 787</p>	 <p>French TM no. 04 3 331 734</p>

Nevertheless, the only other case law concerning two-colour marks as such is in line with the well-established case law that if they are not visually identical, it is not possible to enforce the trade marks.

Earlier colour marks	Contested colour mark
 <p>(a) (b) (c)</p>	

⁴⁹ Decision of the French PTO hold on 03/10/2005, OPP 05-0902, Couleur rose Pantone 212c / Magenta

In the above case⁵⁰, the Board of Appeal stated that only the sign (a) shared a low similarity with the contested one⁵¹. The other ones were totally dissimilar insofar as the arrangement of the colour combination was different.⁵² The result of the assessment is certainly debatable. Again, the consumer will have to rely on its imperfect memory. But more importantly, the difference in structure is not highly persuasive since the product may be placed in different configurations. In addition, the colour can change from one material to another. Therefore, to consider that they have a low similarity is rather extreme. From this review of limited case law, it appears that an opposition will only be granted in a case that the signs are identical.

⁵⁰ Decion of the BoA, R0755/2009-4, 20/10/2010

⁵¹ *Ibidem*, § 23

⁵² *Ibidem*, § 22

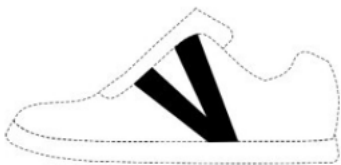
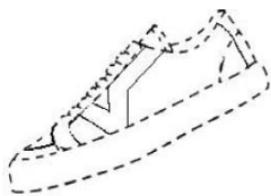
Section 2. The unfortunate prevalence of the visual and aural similarities in the overall assessment of the degree of similarities between the signs

The overall assessment of the degree of similarities of two signs depends on the weight of their visual, aural and conceptual similarities. Aural dissimilarities between two signs can be balanced by high visual and conceptual similarities. To that extent, it is a well-established case law that all of these factors are considered in the comparison of two signs⁵³.

Nevertheless, the practice undermines the conceptual comparison of the signs which has no weigh in the assessment of the overall degree of similarities between the signs (I). More broadly, this three-step comparison test seems limited as regards non-traditional marks (II).

I. The consequences of the supposedly impossible conceptual comparison

Most of the time, the European jurisdictions consider that some simple figurative elements do not convey any message as it was assessed by the General Court in *Deichmann v EUIPO - Vans* case.⁵⁴ The latter stated that the positional element could not be perceived as the letter “V” in any of the shoes due to its unusual tilt as positioned on the shoe (Deichmann’s shoe) and to the unusual length of the line (Vans’ shoe). For the same reasons, the aural comparison could not be made.

Deichmann’s earlier trade mark	Vans’ contested trade mark
 EUTM no. 6 041 081	 EUTM no. 010263895

⁵³ Guidelines for Examination in the office, Part C Opposition, Section 2, Chapter 4, 3.5

⁵⁴ T-638/16, *Deichmann SE v EUIPO*, 06/12/2018, ECLI:EU:T:2018:883

In this regard, and by extension, the practice of the Office tends to give more importance of the visual and/or aural similarities than the conceptual ones, in the comparison of non-traditional marks. In the case of complex non-traditional marks, the strong conceptual similarity between the signs are most of the time left aside. They do not encompass the low visual and aural similarities of the sign. If we take the example of the bottles ROJO and ROUGE⁵⁵, they are conceptually really similar as they are sold for red wines. Nevertheless, the Opposition Division considered that these similarities were irrelevant as this is not distinctive – it took into account the visual dissimilarities of the positioning of the ROJO and the ROUGE, which position were considered purely decorative. Among elements which are normally not taken into account in the comparison of signs, the European current practice is therefore likely to give advantage to the visual ones. Nevertheless, it might not be appropriate insofar as it is common that companies offer to sale a line of products which are sold with the same word declined in various languages. The relevant consumer could therefore be confused that the bottles of wine have the same commercial origin.

The absence of the conceptual comparison by the European jurisdictions is quite questionable insofar as figurative elements or shapes can convey a message. The semantic content of figurative marks is what the figurative elements represents.⁵⁶ Accordingly, the same principles apply to shapes.⁵⁷



French TM no. 344278



EUTM no. 018333084

The bottle above represented is reminiscent of an amphora and Guerlain's lipstick recently registered is reminiscent of a boat's hull.⁵⁸

⁵⁵ See above, Part I, Chapter 1, I, B, Decision on opposition, B 2 951 625, ROJO/ROUGE, 27/09/2018

⁵⁶ See for instance 25/03/2010, T-5/08 & T-7/08, EU:T:2010:123; 21/04/2010, T-361/08, EU:T:2010:152

⁵⁷ Guidelines of the Office, Part C Opposition,

⁵⁸ T-488/20, Guerlain v EUIPO, 14/07/2021, ECLI:EU:T:2021:443

Also, motion and multimedia featuring some figurative elements are able to convey a signification to the consumer, which can be enhanced due to the movement.⁵⁹ To quote the *Common Practice* relative to the convergence of the practice of the Offices as regards new types of trade marks, a figurative mark depicting a basketball player throwing a ball is identical to a basketball player throwing a ball in motion.⁶⁰ Therefore, if those trade marks convey a concept, the latter should be part of the assessment made by the judge.

Likewise, the European practice excludes the conceptual aspect of the comparison of two colours. The statement of the Court of Justice in *Libertel*⁶¹ is particularly relevant in this regard. Albeit the decision dates from 2003, the observations are still applicable in view of the current practice. The Court held that the relevant consumer is not “in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour per se is not, in current commercial practice, used as a means of identification.”⁶² It further stated that “a colour per se is not normally inherently capable of distinguishing the goods of a particular undertaking”⁶³. It seems the European jurisdictions consider that a colour as such does not convey any message to the relevant consumer, except if it is characteristic of the goods and the services⁶⁴, *i.e.*, green for organic products, blue for the ocean or green and yellow for agricultural products⁶⁵, and is therefore descriptive. It is only when it has acquired distinctiveness through use that the trade mark can be identified as originating from a single source such as the Lila colour for the chocolate Milka. However, many scientific – as well as marketing – studies have described the importance of the colour psychology in branding and advertising.⁶⁶ The table below classifies the emotions and feelings produced by colours.

⁵⁹ European Intellectual Property Network (EUIPN), *Common Practice, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021, p 77

⁶⁰ *Idem*

⁶¹ C-104/01, *Libertel Groep BV v Benelux-Merkenbureau* (‘Libertel’), 2003, ECR I- 3793, §63

⁶² *Ibidem*, §65

⁶³ *Ibidem*, §65

⁶⁴ Guidelines of the Office, Part C Opposition, Chapter 4, Section 2, 7.3

⁶⁵ T-137/08, *BCS v OHIM – DEERE*, 28/10/2009, ECLI:EU:T:2009:417, § 58

⁶⁶ See for instance DR. SAJID REHMAN KHATTAK, HAIDER ALI, YASIR KHAN, & MUKHARIF SHAH. (2021). Color Psychology in Marketing. *Journal of Business & Tourism*, 4(1), 183–190.

<https://doi.org/10.34260/jbt.v4i1.99>

THE PSYCHOLOGY OF COLOR

From the natural world to the artifice of technology, our lives are painted in a kaleidoscope of colors, each with the ability to affect our psyche in predictable ways. The psychology of color is a powerful tool in design and branding alike. We've compiled a list of the 12 most commonly used colors along with emotive guidelines for each. Remember, none of these emotional responses are objectively fixed to any given color. When it comes to the psychology of color, context and culture matter.

RED POSITIVE Power Passion Energy Fearlessness Strength Excitement NEGATIVE Anger Danger Warning Defiance Aggression Pain	ORANGE POSITIVE Courage Confidence Warmth Innovation Friendliness Energy NEGATIVE Deprivation Frustration Frustration Frivolity Immaturity Ignorance Sluggishness	YELLOW POSITIVE Optimism Warmth Happiness Creativity Intellect Extraversion NEGATIVE Irrationality Fear Caution Anxiety Frustration Cowardice	GREEN POSITIVE Health Hope Freshness Nature Growth Prosperity NEGATIVE Boredom Stagnation Envy Blandness Enervation Sickness
TURQUOISE POSITIVE Communication Clarity Calmness Inspiration Self-expression Healing NEGATIVE Boastfulness Secrecy Unreliability Reticence Fence-sitting Aloofness	BLUE POSITIVE Trust Loyalty Dependability Logic Serenity Security NEGATIVE Coldness Aloofness Emotionless Unfriendliness Uncaring Unappetizing	PURPLE POSITIVE Wisdom Luxury Wealth Spirituality Imaginative Sophistication NEGATIVE Introversion Decadence Suppression Inferiority Extravagance Moodiness	MAGENTA POSITIVE Imaginative Passion Transformation Creative Innovation Balance NEGATIVE Outrageousness Nonconformity Flippancy Impulsiveness Eccentricity Ephemerality
BROWN POSITIVE Seriousness Warmth Earthiness Reliability Support Authenticity NEGATIVE Humorlessness Heaviness Unsophisticated Sadness Dirtiness Conservativeness	BLACK POSITIVE Sophistication Security Power Elegance Authority Substance NEGATIVE Oppression Coldness Menace Heaviness Evil Mourning	GRAY POSITIVE Timelessness Neutrality Reliability Balance Intelligence Strength NEGATIVE Unconfident Dampness Depression Hibernation Lack of energy Blandness	WHITE POSITIVE Cleanliness Clarity Purity Simplicity Sophistication Freshness NEGATIVE Sterility Coldness Unfriendliness Elitism Isolation Emptiness

67

In that regard, one can admit that colours convey concepts apart of purely descriptive purpose as mentioned above. The European jurisdictions' practice to automatically exclude this possibility is therefore questionable.

To conclude, the European jurisdictions have too often left aside the concepts inherent to non-traditional marks which has certainly led to questionable assessments of their inherent distinctiveness and by extension, of their scope of protection.

II. The limited three-step comparison test

Humans have several senses, including sight and hearing, as well as cognitive faculties. Since a trade mark has to convey a message so as to be recognised as such by the relevant consumer⁶⁷, and since it must be visually or phonetically striking to be remembered by him, the three-step comparison test is from high importance and should not be neglected. Nevertheless, due to their specificities, this three-step test made *in abstracto*, i.e., on the sole basis of the sign as registered, is not applicable to all non-traditional marks.

⁶⁷ LISCHER, B., "Brand Color Psychology: The Power of Color in Branding". www.ignytebrands.com

⁶⁸ C-104/01, Libertel Groep BV v Benelux-Merkenbureau ('Libertel'), 2003, ECR I- 3793

Visual comparison. Sounds cannot be compared visually. The comparison must rely on the aural similarities and the conceptual one, if possible⁶⁹.

Aural comparison. By definition, pure figurative elements cannot be pronounced, as mentioned in the Guidelines “at the very most, [their] visual or conceptual content can be described orally”⁷⁰. To that extent, they are not subject to a phonetical assessment. The reason is the unreliable interpretation that will be made by the different parts of the relevant public, which are likely to describe the trade mark in various ways.⁷¹ This could lead to sweeping assessments of the likelihood of confusion between the signs. By extension, patterns, motion and multimedia signs composed exclusively of figurative elements, shapes as such and sounds without words and colours *per se*, cannot be compared aurally.

Conceptual comparison. As explained above, by relying only on the visual perception or on the aural’s one, the assessment of similarities is made according to blurred assessments trying to compensate the lack of other criteria. The relevant consumer is even more likely to be confused.

In conclusion, given that non-traditional signs are not perceived at first sight by the relevant consumer concerned as indicating the original commercial of a good or service, it is rather problematic that the threshold to compare signs is not met. Indeed, it is not for nothing that the practice tends to take into account all three of them as one can overcome another and therefore, totally change the overall impression of the signs.

⁶⁹ European Intellectual Property Network (EUIPN), *Common Practice, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021

⁷⁰ Summary of the Judgment of Case T-424/10, Dosenbach-Ochsner AG Schuhe und Sport v OHIM, 2012, ECLI:EU:T:2012:58, §1

⁷¹ Guidelines of the Office, Part C Opposition, Chapter 4, 3.4.2.1

Chapter 2. The current practice does not recognise the distinctive character of earlier non-traditional marks

It is a trite law that “the more distinctive the earlier trade mark, the greater will be the likelihood of confusion”.⁷² To that extent, “trade marks with a highly distinctive character enjoy a broader protection than trade marks with a less distinctive character”.⁷³ On the contrary, the scope of protection of trade marks with low distinctiveness is narrower. The distinctive character is inherent or acquired. Indeed, the use of the trade mark may increase its low distinctive character.⁷⁴ This possibility is of high importance to address the low inherent distinctiveness assessed by the European jurisdictions.

Nevertheless, when determining the inherent distinctiveness of the earlier mark, the current practice does not recognise the distinctiveness of numerous elements of the latter, if not all of them taken separately. It is to be noted that regarding the trade mark as a whole, the Office or the Courts will at least attribute them a low distinctive character⁷⁵, but will almost never go beyond – which will impeach them from opposing a contested trade mark. Besides, the representation of a shape or a colour in the register can differ a lot from the reality. Nevertheless, the practice of the Office does not take into account these potential differences. Therefore, it is very difficult to prove their genuine use in an opposition proceedings or to show they have acquired an enhanced distinctive character.

Accordingly, Chapter 2 will be presented as following: the schizophrenic approach towards the inherent distinctive character of non-traditional marks (Section 1) and non-traditional trade marks do not have a sufficient inherent distinctive character to prove that they exist on their own (Section 2).

⁷² 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24

⁷³ C-39/97, Canon, 29/09/1998, EU:C:1998:442, § 18

⁷⁴ T-581/13, Royal County of Berkshire POLO CLUB (fig.) / BEVERLEY HILLS POLO CLUB et al., 26/03/2015, EU:T:2015:192, § 49

⁷⁵ Guidelines of the Office, Part C, Section 2, Chapter 5, 2.2

Section 1. A schizophrenic approach towards the inherent distinctive character of non-traditional marks

One would have expected that the assessment of the distinctive character of the trade mark by the Office would be consistent through the entire life cycle of the trade mark. If the Office registers a trade mark, it is assumed that it enjoys the minimum level of distinctive character required by law. Unfortunately, this approach is not consistently forwarded. In opposition proceedings, the Office adopts a strict position in view of the average consumer's perception (I) and in view of the public interest (II). This turns into undesired results as it will be seen in the following sections.

I. A strict assessment in view of the average consumer's perception

To determine the distinctive character of a trade mark, the relevant time is at the moment of the decision⁷⁶. Yet, it is an *in abstracto* approach that does not take into account the real perception of the trade mark in the course of trade with respect to the goods and services they are registered for. Furthermore, the current practice, even if it is evolving,⁷⁷ is to consider that non-traditional marks are less likely to be perceived by the relevant consumer as identifying the commercial origin of goods or services⁷⁸. To that extent, it is a well-established case law that the earlier trade mark is considered distinctive to a low degree. In the above-detailed case law⁷⁹ as regards the combination of colours green and yellow, the colour green was reputed non-distinctive since it was a common colour used in the agriculture sector. But what is striking is that the Board of Appeal quoted a previous case law in which it has been assessed that the green and yellow were non-distinctive for tractors, but still, by rejecting the opposition, confirmed the right of the contested non-distinctive sign to be protected by trade mark law.

Moreover, as it was held in *Llyod Shufabrik*, to guarantee the identification of the commercial origin of one undertaking, the sign must be able to be memorised by the relevant consumer. To

⁷⁶ Guideline of the Office, Part C, Section 2, Chapter 5, 2.1

⁷⁷ See for instance, 12/03/2021, R 1996/2020-5, THE SOUND OF THE THEME OF THE JAMES BOND MOVIE (sound mark), p. 7

⁷⁸ Case T-796/16, CEDC International sp. z. o. o. v EUIPO – Underberg AG, 23/09/2020, JUDGMENT OF THE GENERAL COURT (Ninth Chamber), para 145: “Average consumers are not in the habit of making assumptions as to the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it may therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark”

⁷⁹ See Part 1, Chapter 1, Section 1, II, Decisions of the BoA, R0755/2009-4, 20/10/2010

that extent, and because of the impossibility for non-traditional marks to be visually, aurally and conceptually perceptible, they have less chance to be remembered by the public.⁸⁰ According to the Sieckmann criteria⁸¹, the impression must be durable on the relevant consumer so that he can remember it. Judges have interpreted this criterion literally. Indeed, regarding motion and multimedia marks, the Common Practice indicates that the consumer “would not perceive motion marks as indicators of commercial origin if they do not create a lasting impression on the consumer”⁸². In this regard, we argue that motions marks will “generally” be considered at least lowly distinctive in the framework of opposition proceedings, since they are composed of a “distinctive verbal and/or figurative element moving or changing its position colour and/or elements, even though the movement or change of position itself may not be distinctive”⁸³. By analogy, when comparing motions marks, the “mere coincidence in the change of position or change of colours [of the transformations and movements] in itself will usually have a lower impact on the comparison of trade marks, and will not, in principle, lead to a finding of visual similarity”⁸⁴.

Also, too many non-traditional marks not even containing any word or figurative element were registered before the second decade of the 21st century. The recognition of these bottles as originating from a particular undertaking is certainly questionable. Still, it appears that the liberal practice of the Office has changed over time.






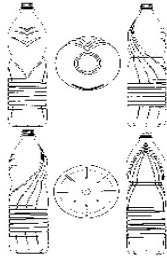

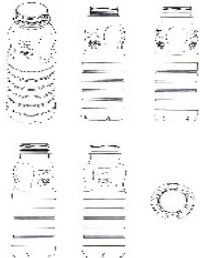
⁸⁰ See Guidelines of the Office, Part C, Section 2, Chapter 1, Annex

⁸¹ C-273/00, Sieckmann, 12/12/2002, ECLI:EU:C:2002:748

⁸² European Intellectual Property Network (EUIPN), *Common Communication, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021, p. 8

⁸³ *Ibidem*, p. 7





⁸⁴ *Ibidem*, p. 7

Trade marks registered before 2010			
			
EUTM no. 003169448	EUTM no. 003177391	EUTM no. 006486005	EUTM no. 000922179
			
EUTM no. 002910925	EUTM no. 002006781	EUTM no. 005228267	EUTM no. 003049251

In résumé, the relevant consumer, whose perception is of high importance to determine the distinctiveness of the earlier mark in opposition proceedings is presumed not likely to clearly identify the commercial origin of non-traditional marks. Yet, this *in abstracto* approach does not take into account his real and evolving perception.

II. A strict assessment in view of the public interest

As recalled in *Libertèl*, “the possibility of registering a trade mark may be limited for reasons relating to the public interest”.⁸⁵ In this regard, products or packaging are not distinctive *per se* and shall not be granted an *ad vitam eternam* right that could distort the competition in the market. Shapes must “depart significantly from the norms of the sector” and cannot be “guided by the nature of the product”⁸⁶. In *Hauck*, the Court of Justice stated that all shapes “that are inherent to the generic function or functions of such goods, must in principle also be denied registration”⁸⁷. The “in principle” is here the main problem. Most of three-dimensional marks which shape is inherently not distinctive where granted a protection on a sole figurative or verbal element affixed on the products. They face much difficulty to oppose other trade marks. The below two examples illustrate it. The trade marks were found not confusing because the shape was not distinctive. Account was only taken of the difference of LIDL⁸⁸ on the bottle and on the letter “f”⁸⁹ on the tea bag.

Earlier shape TM	Contested shape TM	Earlier shape TM	Contested shape TM
			
German TM no. 30 344 963	EUTM no. no. 3 553 732	EUTM no. 4 078 945	EUTM no. 5 469 069

⁸⁵ *Ibidem*, *Libertèl*, § 50

⁸⁶ Article 7(1)(e), EUTMR No 2017/1001

⁸⁷ C-205/13, *Hauck GmbH & Co KG v Stokke A/S and others*, 18/09/2014, EU:C:2014:2233, § 25

⁸⁸ Decision on opposition, B 973 257, *Lidl Stiftung & Co. KG v Société des eaux minérales de Saint Amand*, 08/01/2008

⁸⁹ Case R 2492/2010-2, *Tea Forté, Inc v Dr. Dünner AG*, 14/02/2012

The false prohibition of concept. In most of the decisions involving complex shape marks, where the shape of the earlier mark is considered to be not distinctive, and the trade mark as a whole to have a minimum degree of distinctiveness, the Opposition Division holds that the purpose of trade mark law is not to grant monopolies on concept: *e.g.*, to remove the label of a bottle of wine and affix directly on the bottle the word element “ROJO”.⁹⁰ For instance, in an unsuccessful opposition between a bottle with a blade of grass in it against a bottle of the blade of grass, the Court stated that “trademarks cannot protect concepts or ideas, only the concrete expression of such”⁹¹. In the present case, the shape of the bottle was considered to be not distinctive. By stating that the trade mark law does not grant protection on concepts or on shapes marks that are lowly distinctive, it is a roundabout way of stating that these trade mark are actually not distinctive at all.⁹² Doing so, they actually let other non-distinctive trade marks exist. Trade mark loses its essence since numerous similar, if not almost identical, shape marks can coexist on the market.

The discrepancy between the – above all *former* – easiness⁹³ to get a low or non-distinctive trade mark and the difficulty to success in opposition proceedings tackles the way these trade marks were registered. Again, the practice of the Office has become much stricter since a few years as regards the registration. Yet, many trade marks subsist in the register while they have no value.

In this regard, many weak distinctive trade marks face difficulties to improve their lot: *i.e.*, to prove their genuine use to oppose other trade marks or enjoy an enhanced distinctive character.

⁹⁰ See above, Part I, Chapter 1, I, B, Decision on opposition, B 2 951 625, ROJO/ROUGE, 27/09/2018

⁹¹ Case T-796/16, CEDC International sp. z. o. o. v EUIPO – Underberg AG, 23/09/2020, JUDGMENT OF THE GENERAL COURT (Ninth Chamber)

⁹² C-196/11, 04/05/2012, F1-Live, EU:C:2012:314. The earlier trade mark is presumed to have at least a minimum degree of inherent distinctiveness. Therefore, the European jurisdictions cannot states officially that a trade mark is not distinctive.






Section 2. Non-traditional trade marks do not have a sufficient inherent distinctive character to be used as registered

Given their low distinctive character, non-traditional trade marks face difficulties to exist by themselves. Non-traditional marks are often used in combination with other elements or trade marks (1). Sometimes, they are themselves not used as they are represented in the register: they suffer alterations in terms of shape or colours (2). The problem is that in the course of an opposition upon Article 8(1)(b), the proprietor of the contested trade mark can request the proof of genuine use of the earlier trade mark upon Article 47. This evidence is difficult to submit as the representation of the trade mark shall normally be consistent with the use made of it. By extension, the proprietor of the trade mark faces many difficulties to prove its trade mark has acquired an enhanced distinctive character through use.

I. The unacceptable use of a non-traditional trade mark within a composite sign

Non-traditional marks are often used in combination with other elements or trade marks, within a composite sign. In that regard, the bottles registered as trade marks represented in the above section which do not contain any verbal element, were all registered, although the examiner certainly knew that they would not be used as is, but that they would contain a label once used in the course of trade. Moreover, one could argue that they are lowly distinctive or not distinctive at all, as the difference in shapes are not very striking and rather common for bottles.

Nevertheless, the General Court has recently ruled that such use is not a genuine use of the trade mark. In the case below, the proprietor of a trade mark representing a bottle with a blade of grass submitted pictures of its product i.e., the same bottle together with labelling.

Earlier 3D mark	Contested 3D mark	Proofs of use of the earlier trade mark
 <p>French TM no. 95588457</p>	 <p>CTM no. 33266</p>	 <p>(a)</p>  <p>(a bis)</p>  <p>(b)</p>

The Court considered that the trade mark is “a commonly shaped bottle with a [straight] line on the body of it which runs diagonally from the left side of the bottle, starting just below the neck, to the bottom edge of the base”.⁹⁴ In that regard, the Court ruled according to the assessment of the Board of Appeal stating that, in the first two proofs submitted by the proprietor (a; a *bis*), the bottles bear a “striking non-transparent ‘zubr wka bison vodka’ label” which covers a large part of them and which hides the back of the bottle and the straight line represented in the register.⁹⁵ This assessment is debateable as the line behind the label is clearly visible from the bottom of the bottle and the upper part of the label. Due to the inherent nature of this three-dimensional trade mark, the average consumer can look at the bottle from different views – which reverses the argument of the Board of Appeal.

⁹⁴ Ibidem, para. 115

⁹⁵ Ibidem, para. 16 and 150

II. The unacceptable use of non-traditional marks in a different way than the one in which they were registered

Article 18 EUTMR states that the use of the trade mark in a different way than the one as registered constitutes a genuine use within the European Union insofar as the differences do not alter the distinctive character of the trade mark. In view of marketing and promotion necessities, the General Court stated that the signs as registered and as used do not have to be strictly identical but “broadly equivalent”.⁹⁶ Concretely and as mentioned in the Guidelines of the Office⁹⁷, in order to determine whether the use of the trade mark in a different way shall be authorised, the difference must be in negligible elements. Additions, omissions and other alterations as regards the colours, among others, of word and figurative marks are accepted by the General Court.⁹⁸ Nevertheless, the practice of the European Union Office and Courts seems much stricter as regards non-traditional marks, and in particular simple shape marks, colours or patterns. It is very difficult to prove genuine use or enhanced distinctiveness if the trade mark is not used in the exact same way as registered. To demonstrate so, we will focus on the unacceptable changes of certain elements which do not alter the distinctive character of the trade mark (A) and on the unacceptable alterations of colours (B).

A. Unacceptable alterations of certain elements which do not alter the distinctive character

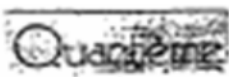



As regards, composite marks, that is to know, trades marks containing word and figurative elements, “changes to certain figurative elements do not normally affect the distinctive character of the marks”. To that extent, the following trade marks were able to prove the genuine use of their trade mark.⁹⁹

⁹⁶ T-194/03, Bainbridge, 23/02/2006, EU:T:2006:65, § 50

⁹⁷ Guidelines of the Office, Part C Opposition, Section 6 Proof of use, 2.7 “Use of the mark in forms different from that registered”

⁹⁸ See for instance T-29/04, Cristal Castellblanch, 08/12/2005, EU:T:2005:438; 30/11/2009, T-353/07, Coloris, 30/11/2009, EU:T:2009:475 ; 10/06/2010, T-482/08, Atlas Transport, 10/06/2010, EU:T:2010:229 and 4 T-135/04, Online Bus, 04/11/2005, EU:T:2005:419)



⁹⁹ Guidelines of the Office, Part C Opposition, Section 6 Proof of use, 2.7.3.3

Registered Form	Actual Use	Case no.
		12/01/2006, T-147/03, Quantum, EU:T:2006:10; dismissed 15/03/2007, C-171/06 P, Quantum, EU:C:2007:171
		18/11/2015, T-361/13, VIGOR / VIGAR, EU:T:2015:859

As for simple trade marks, it seems much more difficult to prove genuine use or enhanced distinctiveness acquired through use as a simple alteration may change the overall impression made by the trade mark on the relevant consumer.

Following an invalidating action¹⁰⁰, Adidas intended to prove its trade mark had acquired distinctiveness through use claiming that this trade mark was in reality a pattern – claim that was rejected by the Court. The trade mark was accompanied by the description “the mark consists of three parallel equidistant stripes of identical width, applied on the product in any direction”. As deemed to be used on shoes, pants and other clothes, the trade mark could not be used in the exact same way as it was registered in terms of length and colours.

¹⁰⁰ T-307/17, AG c. EUIPO v Shoe Branding Europe BVBA, 19 /06/ 2019, ECLI:EU:T:2019:427

Registered Form	Actual Use
 <p data-bbox="212 533 488 566">EUTM no. 12442166</p>	 <p data-bbox="1161 533 1198 555">101</p>

The length of the figurative trade mark as registered was considered as is. Account was not taken of the fact that the trade mark could be longer or shorter according to the clothes or shoes on which it would be used. As the three stripes are always depicted with the same space (see the above-actual use depictions of the trade mark), the length of the trade mark shall not be important.

Indeed, the acceptable alterations from the above-mentioned case law show strongest differences with the trade marks as registered, than the ones of Adidas. For instance, as for VIGAR, the figurative elements are totally different. The letters are not depicted in the same typography and are not in upper-case letters either.

Likewise, as regards the above-mentioned case of the bottle with the diagonal line it, the Court considered that in the evidence (b), the line is not straight but slightly curved. This assessment is certainly questionable insofar as, again, the alterations of a sign that do not alter its distinctive character are normally accepted.¹⁰² In this case, it is doubtful that the fact that the line is straight or slightly curved would alter the distinctive character of the trade mark. This is due to its inherent low distinctiveness. To quote the General Court, whether “the scope of protection of the earlier mark as defined by its graphic representation proves to be narrow, [...] its distinctive character is easily altered, all the more so because it is a three-dimensional mark”.¹⁰³







¹⁰¹ https://www.adidas.es/banador-corto-colorblock-3-bandas/GM2243.html?pr=still_interested&slot=3
https://www.adidas.es/camiseta-adicolor-classics-oversize/H37796.html?pr=still_interested&slot=1

¹⁰² See following section “2. The unacceptable use of non-traditional marks in a different way than the one in which they were registered”

¹⁰³ T-796/16, para. 156 in reference to T-317/14, *Forme d’un fourneau*, 24/09/2015, non published, EU:T:2015:689, para. 37

B. Unacceptable alterations of colours

The practice of the Office is to consider the distinctive character of the trade mark is not altered whether “the word/figurative elements coincide and are the main distinctive elements; the contrast of shades is respected; the colour or combination of colours does not have distinctive character itself; the colour is not one of the main contributors to the overall distinctiveness of the sign” (see below Case Law from the Guidelines)¹⁰⁴.

Registered Form	Actual Use	Case no.
		24/05/2012, T-152/11, Mad, EU:T:2012:263
		23/06/2011, R 1479/2010-2, VOLKS-LASUR (fig.) / LASUR et al.
		29/04/2010, R 877/2009-1, Kaiku Bifi actiVium (fig.) / Bi-Fi (fig.)

Nevertheless, it is almost impossible to apply for a colour, shape or position mark in black and white, use it in a different way and still hope to prove later the genuine use or its enhanced distinctiveness on the trade mark. As regards Adidas, the three white stripes on a black background were judged too divergent from the registered three black stripes on a white background. Therefore, the General Court stated that the inherent low distinctive character of the latter was altered by these modifications and that “once a trademark is registered, the

¹⁰⁴ Guidelines of the Office, Part C Opposition, Section 6 Proof of use, 2.7.3.3 Other alterations

proprietor is not entitled to a broader protection than that afforded by that graphic representation”.¹⁰⁵

Such a decision clearly shows how complex is the question of the law of permissible alterations, how important the applicant's attention must be at the time of registration for simple figurative marks and how important it is to manage the use of the mark, i.e. to use it as much as possible in the same way as it was registered (same colours, same shape, same length)¹⁰⁶. The reasoning must be extended to simple shapes or simple sound marks. Albeit the Guidelines of the Office states that as for shape marks “the addition of a word/figurative element to such a mark does not generally alter the distinctive character of the sign”, the recent case about a shape mark representing a bottle with a blade of grass in it, shows the contrary¹⁰⁷. It also shows that before proving it, how difficult it to use its trade mark as registered considering their specificity and the various goods on which they are used. On the contrary, “word marks are considered used as registered regardless of typeface, use of upper/lower case or colour. It would not be correct to analyse this type of use from the perspective of whether distinctive character is altered”.¹⁰⁸ The same appears in the United States where it was stated that even if the trade mark was registered in standard typeface, it would then be possible to be used under different colours, shape or size.¹⁰⁹

Lastly, it is noteworthy to mention that to prove enhanced distinctive character, a threshold of recognition within the European Union must be assessed¹¹⁰. The evidence must relate to the relevant geographical area and to the relevant goods and services.¹¹¹ Account should be taken of several criteria and notably, the inherent characteristics of the trade mark as a whole as well as its potential descriptive components in relation to the goods and services at stake. It should also be considered “the market share held by the mark; how intensive, geographically

¹⁰⁵ Adidas case, *Ibidem*, § 30 (see also T 101/15 and T 102/15, Red Bull v EUIPO — Optimum Mark (Combination of the colours blue and silver), 30/11/2017, EU:T:2017:852, § 71)

¹⁰⁶ See the observations of KOCH, A., “The General Court of EU confirms the invalidity of Adidas three-stripes trademark”, *Dennemeyer IP Blog*, 09/07/2019; LUBBOCK, M., “adidas decision: General Court reiterates importance of evidence in trademark disputes”, *brownreudnick.com*, 09/17/2019; MURRAY, G., Adidas loses its stripes, *The Chartered Institute of Trade Mark Attorneys (CITMA)*, 20/06/2019

¹⁰⁷ T-796/16, CEDC International sp. z. o. o. v EUIPO – Underberg AG, 23/09/2020, ECLI:EU:T:2020:439

¹⁰⁸ Guidelines of the Office, Part C Opposition, Section 6 Proof of use, 2.7 “Use of the mark in forms different from that registered”, 2.7.3.3. “Other alterations”

¹⁰⁹ See for instance White Rock Distilleries Inc., 92 USPQ2d 1282, 1284 (TTAB 2009) + RSI Sys., LLC, 88 USPQ2d 1445, 1448 (TTAB 2008); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); Pollio Dairy Prods. Corp., 8 USPQ2d 2012, 2015

¹¹⁰ Guidelines of the Office, Part C, Section 2, Chapter 5, 2.3

¹¹¹ *Idem*

widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking”.¹¹² Last but not least, the General Court outlines the “importance of statements from chambers of commerce and industry or other trade and professional associations”.¹¹³ Whether it be word or figurative trade marks, proof of enhanced distinctive character through use is reputed quite difficult since the above-mentioned criteria must all be fulfilled, and particularly, as the European Union is composed of 27 States where tens of languages are spoken. Again, the exercise is even more difficult for non-traditional marks due to their inherent low distinctive character. Also, it should be paid high attention to the last paragraph of the section related to the examination of enhanced distinctiveness of the Guidelines. It states that “it must be recalled that although a mark as a whole may have acquired enhanced distinctiveness, there may be descriptive elements that will have less than normal or no distinctiveness. For example, the enhanced distinctiveness of the mark ‘Coca Cola’ as a whole does not alter the fact that the element ‘Cola’ remains entirely descriptive for certain products.”¹¹⁴ If we come back to the shape mark composed of simple bottle and bearing a logo on it, does it mean that enhanced distinctiveness will only be recognised by the judge for the logo but not for the shape of the bottle? More broadly, does this provision can ever apply to such a bottle? We doubt so.

Again, the scope of protection of word marks is widely stronger than the protection granted to non-traditional marks. Under the current practice, it seems more interesting to keep registering word marks which covers the entire alterations of the word element than complex shape marks that mainly protect the word part of it and which will have to be used in the exact same way.

¹¹² C-342/97, Lloyd Schuhfabrik Meyer, 22/06/1999, ECLI:EU:C:1999:323, § 23

¹¹³ *Idem*

¹¹⁴ Guidelines of the Office, Part C Opposition, Section 2, Chapter 5, 2.3

In Part I, we demonstrated the limits of the current *in abstracto* assessment of the likelihood of confusion involving non-traditional marks. In the framework of the following Part II, we will therefore suggest a more pragmatic approach based on an *in concreto* assessment of the likelihood of confusion.

Part II – Proposals for an *in concreto* assessment of the likelihood of confusion involving non-traditional marks

In this second part, we will try to give Caesar what is Caesar's. We will propose a different methodology more grounded in reality, offering suggestions to ensure the protection granted through registration to non-traditional marks complies with the use made of it, first requirement to be successful in opposition proceedings. In other words, we will try to reconcile the registration with the enforcement, by taking account of the use.

We will therefore propose a more pragmatic assessment for a better scope of protection (Chapter 1), taking into the fact that this methodology will have to be implemented in the optimum to be efficient (Chapter 2).

Chapter 1. A more pragmatic assessment for a better scope of protection

First, the problem should be addressed at its source. Granting a protection to a trade mark that has very little distinctiveness is useless since its scope is very limited. Nevertheless, if the demonstration of acquired distinctiveness through use was a required factor at the moment of registration, the distinctiveness of those trade marks would *de facto* be at least average. Their scope of protection would be sufficient to be able to be enforced.

Furthermore, the *in abstracto* approach to assess the likelihood of confusion, adopted by the European jurisdiction, is disconnected from the reality of these non-traditional marks which use is likely to differ a lot from the trade marks as registered. Moreover, under article 8(1)(b), no account is taken of the market's realities. The global assessment is made on *in abstracto* sweeping assessments to determine whether the relevant consumer is likely to be confused. Nevertheless, the trade marks can be closely similar but not be confusing at all.

Hence, we would praise in favour of a methodology based on use (Section 1), taking into account the market's conditions (Section 2).

Section 1. A methodology based on use

The registration of non-traditional trade marks should be conditional upon acquired distinctiveness through use (I). Also, the comparison of the trade marks should rely on *in concreto* criteria (II).

I. A methodology based on acquired distinctiveness through use

Within the framework of European Union trade mark law, albeit a sign does not comply with the provisions of Article 7(1)(b), (c) or (d) EUTMR, it can be registered under Article 7(3) EUTMR since it “has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it”. In other terms, acquired distinctiveness through use can be invoked whether the sign is *ab initio* devoid of distinctiveness in relation to the goods and services for which registration is sought, if thanks to the use that was made of it, the relevant public is now able to differentiate the goods and services that it covers, from the ones of other undertakings. If it is encouraged by the office when applying for non-traditional marks, it is not mandatory¹¹⁵. Thus, many non-traditional marks that should not have been registered because of a too low distinctive character are totally useless for its proprietor. Considering the evolving perception of the relevant consumer and its weaker ability to identify a non-traditional sign as originating from a particular undertaking, the fact that it was confronted to it may resolve this problem.

On the contrary, the concept of use does not encompass the same standards than in the United States where the first is more important than the second. Use means a “bona fide use of a mark in the ordinary course of trade and [is] not made merely to reserve a right in a mark”¹¹⁶. It “must

¹¹⁵ Judgment of the Court (Fourth Chamber), Case C-578/17, *Oy Hartwall Ab*, 27/03/2019. The Court stated that “Articles 2 and 3(1)(b) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the classification as a ‘colour mark’ or ‘figurative mark’ given to a sign by the applicant on registration is a relevant factor among others for the purpose of establishing whether that sign can constitute a trade mark within the meaning of Article 2 of the directive and, if so, whether it is distinctive within the meaning of Article 3(1)(b) of that directive, but does not release the competent trade mark authority from its obligation to carry out a global assessment of distinctive character by reference to the actual situation of the mark considered, which means that that authority cannot refuse registration of a sign as a mark on the sole ground that that sign has not acquired distinctive character through use in relation to the goods or services claimed.”

¹¹⁶ TMEP §901.01, amended by the Trademark Law Revision Act of 1988 (TLRA), Public Law 100-667, 102 Stat. 3935

be in connection with a real, commercial sale and delivery or free distribution of goods or services to arms' length customers in the U.S.”¹¹⁷ From the very beginning of the registration, use constitutes a legal standing. The USPTO gives the applicants two possibilities, to apply to the Principal register – which gives them an absolute protection – or the Supplementary register – which is endorsed to a lower protection and some further requirements.¹¹⁸ They can apply to the former whether they have proved the sign had acquired distinctiveness through use or, “secondary meaning”. It means that “through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer”.¹¹⁹ Accordingly, three means of proof may be taken into account. The applicant must submit substantial evidence that he has exclusively and continuously used its trade mark for the past five years¹²⁰. It may also be counted on prior registrations in the Principal register of the same trade mark for similar goods or services as the one for which registration is sought.¹²¹ Lastly, other types of evidence can be submitted including “verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public”.¹²² After the examination of the distinctive character of the trade mark which relies on similar grounds as the absolute grounds at the EUIPO, the trade mark is presumed to be valid and enjoys an optimised protection. It is recognised by the Office and in the market as a trade mark.

Therefore, the examiner or the judge can assess the likelihood of confusion on the basis of concrete elements from the use of the trade mark in the course of trade instead of sweeping assessments. To that extent, adopting an *in concreto* approach and notably making acquired distinctiveness through use mandatory for applicants of non-traditional trade marks would be a way to allow for consistency as regards decisions before the European jurisdictions. Lastly, it

¹¹⁷ DICONZA, N. C., “United States: USPTO: Proving Use Of A Trademark In The United States Patent And Trademark Office”, *Mondaq*, 01/04/2016

¹¹⁸ We will not detail them in the course of this paper.

¹¹⁹ Nims, *Unfair Competition and Trademarks* at §37 (1947) in TMEP, §1212

¹²⁰ 37 C.F.R. §2.41(a)(2)

¹²¹ 37 C.F.R. §2.41(a)(1)

¹²² 37 C.F.R. §2.41(a)(3)

would also be a way to avoid or, at least, reduce the appropriation of monopolies on shapes or colours by trade mark law.¹²³

II. A methodology based on *in concreto* criteria to compare the signs

When comparing the signs, an *in concreto* approach would consist in taking into account the use of the trade mark as regards the goods and services at stake (A). The perception of the relevant consumer of the trade mark as used in the course of trade should also prevail over the representation of the trade mark as registered (B).

A. The consideration of use of the trade mark as regards the goods and services at stake

In the United States, the similarity or dissimilarity of the goods is assessed as regards the description made by the applicant in the registration or in connection with a prior mark which is in use¹²⁴.

On the one hand, the description made by the applicant is from high importance as to define precisely the scope which will be granted by the trade mark. This description is mandatory so as to avoid any sweeping assessment on whether the mark would be used in this or that way¹²⁵. On the other hand, the similarity between the goods is assessed in view of the goods which bears the trade mark in the course of trade. Such a description of the relation between the trade mark and the goods falling under the protection should be mandatory before the European Union Intellectual Property Office so as to avoid sweeping assessment on which goods and services the trade mark is going to be affixed. It is even more the case since the EUIPO does not limit the length of the list of goods and services at the moment of registration. James Bond's theme movie was for instance registered for an extensive number of goods. It is reasonable to think the trade mark will not be used for half of them. For *CD ROMs*, it is clear that the sound can be recorded and played. As for *lip care*, albeit it seems less evident, we can imagine that an

¹²³ RAMSEY, L. P., "Inherently Valuable Expression", in CALBOLI, I., SENFTLEBEN, M., *The protection of Non-Traditional Trademarks, Critical Perspective*, Oxford University Press, 1st Edition, 2018, p. 353

¹²⁴ *Idem*

¹²⁵ *Idem*

electronic system affixed on a lip-gloss makes the play of the sound possible. However, regarding *depilatory preparations* or *sponges*, such a use is totally unconceivable.¹²⁶

The consideration of the use of the trade mark at the moment of the registration has actually been taken into account for the registration of colours for bus services. In a recent case, the Court of Justice stated that it was not relevant to statute on whether the sign departs significantly from the norms of the sector. The distinctive character of a trade mark exclusively composed of colours depicted in a particular way, and which “is intended to be affixed exclusively and systematically in a specific manner to a large part of the goods used for the provision of that service, must be assessed by considering the relevant public’s perception of the affixing of that sign to those goods.”¹²⁷



¹²⁶ EUTM no. 018168977, filed on 19/12/2019 and registered on 06/10/2021

¹²⁷ C-456/19, Aktiebolaget stg tatrafik, 08/10/2020, EU:C:2020:813, § 44

B. The prevalence of the perception of the relevant consumer of the trade mark as used in the course of trade over the representation of the trade mark as registered

Unprecise registration is one of the main causes of limited scope of protection at the moment of enforcement¹²⁸ and notably at the moment to prove genuine use. It is time to reconnect the scope of protection of these trade marks across registration and enforcement.¹²⁹ Within the territory of the European Union, it is a well-established case law that the representation is what determine the extent of the protection of trade marks. It prevails over the type and the description. Nevertheless, the representation is not always reliable (1) and the description is totally useless (2).

1. The relative liability of the representation

First, and as above-mentioned, when looking at the representation of a simple figurative sign as such, most of the time, the image, photograph or drawing does not help to determine whether it is a figurative mark, a pattern or position mark. It could fit in more than one category. In that case, and because the Office cannot *ex officio* change the category of the trade mark, the inherent distinctiveness of the sign is assessed according to the sign as represented, and in the light of the criteria of the type of trade mark as indicated in the application. To that extent, to avoid the functionality-test for instance¹³⁰, or because they are not aware of the differences between types of marks, applicants tend to apply for figurative marks instead of other types of trade marks. Many EU non-traditional marks are registered as figurative marks while they are in reality colours, patterns, shapes or position marks. The above-detailed Adidas¹³¹ and further-detailed Vuitton¹³² cases are striking examples of wrong categorization. The three strips of the former were not a figurative mark but definitely a pattern, as well as the chequerboard pattern.

¹²⁸ HANDLER, M., “What Should Constitute Infringement of a Non-Traditional Mark? The Role of “Trademark Use”.” in CALBOLI, I., SENFTLEBEN, M., *The protection of Non-Traditional Trademarks, Critical Perspective*, Oxford University Press, 1st Edition, 2018, p. 198

¹²⁹ *Ibidem* GANJEE, Dev S., “Paying the price of admission”, p. 88

¹³⁰ GANJEE, Dev S., “Paying the price of admission”, in CALBOLI, I., SENFTLEBEN, M., *The protection of Non-Traditional Trademarks, Critical Perspective*, Oxford University Press, 1st Edition, 2018, pp. 63-64, in relation to Case C- 163/ 16, Christian Louboutin SAS v. Van Haren Schoenen BV, 22/06/2017, confirmed (Feb. 6, 2018), ECLI:EU:C:2018:423; *Opinion*: ECLI:EU:C:2018:64, ECLI:EU:C:2017:495

¹³¹ T-307/17, AG c. EUIPO v Shoe Branding Europe BVBA, 19 /06/ 2019, ECLI:EU:T:2019:427

¹³² T-105/19, Louis Vuitton Malletier v EUIPO – Norbert Wisniewski, 10/06/2020, ECLI:EU:T:2020:258

Nevertheless, this leads to two difficulties in the case of conflicts. On the one hand, the judge is able to redetermine the type of trade mark according to its own assessment. Therefore, the degree of inherent distinctiveness of the trade mark is not the same at all than the one granted through registration. On the other hand, if the examiner does not do so, the trade mark faces much difficulty to enforce a pattern trade mark or a position trade mark since the judge considers that a simple figurative sign is not sufficiently distinctive to enforce a pattern or shape mark. Doing so would lead to the granting of a concept to a trade mark.

Due to the difficulty to represent a shape mark with a drawing¹³³ in the register, and if placed in the wrong category, the trade mark as represented can be interpreted in many different ways. This *in abstracto* approach is based on misleading interpretations by the judge.

2. *The useless character of the description of the representation*

The description of the trade mark as represented in the register is not taken into account in the framework of conflicts between most non-traditional marks which makes sense since the relevant consumer is not deemed to see it when looking at the trade marks. Hence, it is therefore totally useless and should not be an option (a). On the contrary, and until the recent legal reform, it was an obligation to file a Scientifically standard colour codes when applying for a colour trade mark. It is arguably a nonsense since it does not give any indication to the consumer what the colour is at stake (b).

¹³³ T-796/16, CEDC International sp. z. o. o. v EUIPO – Underberg AG, 23/09/2020, ECLI:EU:T:2020:439

a. The disregarded description of the sign as represented

As non-traditional trade marks can be represented in any way – graphically or not, and as they can be of many types, they face more difficulty to be represented in a way which is “clear, precise, self-contained, easily accessible, intelligible, durable and objective”¹³⁴.

To that extent, the EUIPO give the applicants the option – but it is not mandatory – to add a description to their trade marks under certain circumstances¹³⁵. The description is supposed to help the examiner understand what the scope of protection of the trade mark is, accordingly to the representation. On the contrary, such a description cannot be added to word trade marks as they are self-sufficient. Nevertheless, the description is most of the time disregarded in the framework of conflicts between non-traditional trade marks. Indeed, if the description is not perfectly describing the trade mark as represented, the representation always prevails.¹³⁶

The decision of the Court dated from September 20th, 2020 is a striking example of the prevalence of representation over description regarding three-dimensional marks.¹³⁷ The earlier trade mark was accompanied by the description “a bottle as represented above inside which a blade of grass is placed almost diagonally in the body of the bottle”¹³⁸. As for the contested trade mark, it was accompanied by the description “the object of the trademark is a greeny-brown blade of grass in a bottle; the length of the blade of grass is approximately three-quarters the height of the bottle”¹³⁹. The Court considered that the straight-line as represented in the register did not look like at all to a blade of grass. Accordingly, the description is from no importance, as the sign as represented is what defines the extent of the protection.

Therefore, genuine use of the earlier right upon article 47(2) could not be demonstrated as both the description and the use of the trade mark differed from the sign as registered.

¹³⁴ C-273/00, Sieckmann, 12/12/2002, ECLI:EU:C:2002:748. See also EUTMR No 2017/1001, Article 4(b) accordingly to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), itself replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1))

¹³⁵ See Guidelines of the Office, Part B Examination, Section 2, 9.2

¹³⁶ European Intellectual Property Network (EUIPN), *Common Communication, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021, p.3

¹³⁷ T- 796/16, CEDC International sp. z. o. o. v EUIPO – Underberg AG, 23/09/2020, JUDGMENT OF THE GENERAL COURT (Ninth Chamber) (EU:T:2020:439) – See Part I, Chapter 2, Section 1, II

¹³⁸ *Ibidem*

¹³⁹ *Ibidem*

Nevertheless, it is obvious that the conflicting signs are almost identical since the bottles are identical and since they share a line in it – which, in the contested sign either, is not really identifiable.

One could argue that the proprietor of the contested trade mark will also face much difficulty to oppose the use or registration of a third trade mark as the bottle lacks any distinctive character. If we follow the assessment of the Court as regards the earlier trade mark, the blade of the grass is barely recognisable. It could be a vanilla pod or a lemongrass stick, which is quite common in the course of trade. A simple search on Google let us discover numerous bottles of Ron containing vanilla pods, bottles of spirits containing all types of herbs and wild grass e.g., rosemary and thyme. To that extent, the addition of a blade of grass in a bottle is a simple concept – like for the earlier trade mark – and should not be granted registration either. Therefore, how can the examiner have accepted the registration of the trade mark without considering in the first place whether the description was in accordance to the representation? The proprietor spent money and time to register and enforce its trade mark for nothing. If what is represented counts is the only thing that matters, and not the description made by the applicant as to define the trade mark, the question is asked whether the description has an interest as it brings nothing more to the trade mark registration.

In any case, the description is never given to the relevant public, which perception of the trade mark only relies on the trade mark as used in the course of trade. Therefore, the interest of the description in accordance with the function of guarantee the identity of the origin of goods and services is finally quite relative. In that regard, the issue of colour marks' Pantone code is quite relevant.

b. The relative importance of the indication of the Pantone colour code

When registering single colour trade marks or combination of colours before the EUIPO, the description of the colour is required according to Pantone, RAL, RGB, Hex or CMYK generally recognised codes.¹⁴⁰ The applicant is free to add a supplementary verbal description of its colours which must be in accordance to the colour trade mark as registered. Nevertheless, are these codes useful whether to prove genuine use? Are they relevant whether to determine if there is a likelihood of confusion between two colour trade marks? While comparing two figurative trade marks containing coloured figurative elements, such a description based on colour codes is not mandatory. The same should apply to colour trade marks.

First and foremost, as stated by the Court in *Libertel*¹⁴¹, depending on the good on which it is affixed, the colour is deemed to change from a material to another. Furthermore, there are several hundreds of identifiable colours by the specialists. Trade marks are not patents and should therefore not be analysed under scientifically objective terms. As the relevant public is the average consumer, deemed to be reasonably well-informed and well-circumspect, he does not have the acknowledgement of a person skilled in the art¹⁴² and will, at any moment distinguish one from another.

It is unreasonable to think that the latter will be confused between a Pantone 138 C and a Pantone 7564 C (see below).

¹⁴⁰ Guidelines of the Offices, Part B Examination, Section 2, 9.2 Colour marks

¹⁴¹ Case C-104/01, *Libertel Groep BV v Benelux-Merkenbureau* ('Libertel'), 2003, ECR I- 3793

¹⁴² According to the EPO Guidelines for Examination, Part G, Chapter VI, 3 "Person skilled in the art", the 'person skilled in the art' "is presumed to be a skilled practitioner in the relevant field of technology who is possessed of average knowledge and ability and is aware of what was common general knowledge in the art at the relevant date (see T 4/98, T 143/94 and T 426/88). The skilled person is also presumed to have had access to everything in the "state of the art", in particular the documents cited in the search report, and to have been in possession of the means and capacity for routine work and experimentation which are normal for the field of technology in question".



In this regard, McCarthy wrote rightly that “anyone who has gone shopping in a paint store and been unable to distinguish between fine variations of shades will appreciate the attitude of a judge or juror asked to find that “yellow red” does not infringe “bluish red”.¹⁴³

On the contrary in the United States, the “USPTO does not endorse or recommend any one commercial color identification system”.¹⁴⁴ The “description of the mark must be clear and specific, use ordinary language, and identify the mark as consisting of the particular color as applied to the goods or services”.¹⁴⁵ Whether the trade marks is a combination of shades, the same principles applies.¹⁴⁶

¹⁴³MCCARTHY, J. Thomas, *McCarthy on Trademarks and Unfair Competition*, § 7:45:70, Color infringement – Scope of rights in a color mark and “shade confusion”, 4th ed., 2015

¹⁴⁴ TMEP § 807.07(a)(ii)

¹⁴⁵ TMEP § 1202.05(e)

¹⁴⁶ *Idem*

Section 2. A methodology taking into account the market's conditions

When the other criteria let some uncertainty to determine whether there is a likelihood of confusion, the European jurisdictions should conduct their global assessment on the basis of concrete relevant factors.

In the United States, the Ninth Circuit Court of Appeals' assessment is conducted to an eight-step-test¹⁴⁷. Apart from traditional factors similar to the one considered under article 8(1)(b), the evidence of actual confusion, the marketing channels used, the proximity between the goods (as used), the defendant's intent in selecting the mark and the likelihood of expansion of the product lines are also taken into account¹⁴⁸.

By 1973, the former Court of Custom and Patent Appeals¹⁴⁹ developed a thirteen-step-test, today called the DuPont factors¹⁵⁰, and used by the Federal Court in opposition proceedings. This test is one of the keys of this *in concreto* approach. Apart from the criteria mentioned above, the consideration of “the number and nature of similar marks in use on similar goods” (sixth factor), “the nature and extent of any actual confusion” (seventh factor) or “the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion” (eight factor) are extremely useful to determine whether a likelihood of confusion currently exists or is very likely to exist.

In particular, account is taken of the dishonest intention behind the application of the trade mark to ensure the trade mark is not infringed. On the basis of acquired distinctiveness through use, we can therefore endorse that the trade mark is recognised by a substantial part of the relevant public as originated from a particular undertaking. Therefore, it gives an essential indicator that the trade mark may be known by the applicant.

In the European Union, such a dishonest intention, also called bad faith, can only be invoked on absolute ground, in the framework of an invalidity action upon Article 59(1)(b).

¹⁴⁷ MF, Inc v Sleekcraft Boats, 599 F.2d 341 (C.A.9) 1979

¹⁴⁸ <https://sites.google.com/site/trademarkwiki/Home/trademark-infringement>

¹⁴⁹ The Court of Custom and Patent Appeal existed from 1909 to 1982

¹⁵⁰ In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973)

Chapter 2. A methodology which will have to be implemented in the optimum

This methodology will only be effective under certain conditions that we can resume in two words: flexibility and technology.

Indeed, the current practice is too strict as regards the substantiation of proof and forgets that trade mark law shall not be the law of the strongest. Indeed, very few companies can meet the criteria of acquired distinctiveness through use since the costs and the time required to gather all the evidence are huge.

Besides, so far the technology is not optimised to monitor non-traditional marks. Therefore, many companies fail to enforce their rights on the simple basis of their lack of awareness of these applications or registered trade marks.

Discuss these two issues and will be the purpose of our last Chapter, *i.e.*, a methodology which will have to take into account small companies and individual entrepreneurs (Section 1) and a methodology which will have to show improvements in technology (Section 2).

Section 1. A methodology which will have to take into account small companies and individual entrepreneurs

The standards of substantiation are really high. A strict threshold must be respected as regards “the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations”.¹⁵¹ Therefore, it can be very difficult for many to prove acquired distinctiveness. As L. Ramsey wrote, “requiring companies to prove acquired distinctiveness through use of non-traditional marks will favour larger companies over start-ups and individual sellers, and make it easier for famous brands to maintain their strong position in the market.”¹⁵² Indeed, showing acquired distinctiveness through use has a cost. It requires time to gather all the evidence and money to fulfil all the criteria imposed by the judge.

The extent of use. According to the Guidelines, turnover and advertising expenses are “one of the most readily available forms of evidence”.¹⁵³ To that extent, only large companies are able to provide such evidence of massive use in a substantial part of the territory.

The Louis Vuitton saga case law as regards its famous checkerboard pattern constitutes one striking illustrations of the even stronger difficulty for non-traditional marks to show acquired distinctiveness through use. *We will here precise that the proof of acquired distinctiveness through use was requested in the framework of an invalidity action. Nevertheless, it applies to our case as the standard of proof and the relevant time, i.e., the date of the application, are the same in invalidity and in registration proceedings.*

In June 2020, Louis Vuitton finally won the invalidity battle about the figurative European portion of the International trade mark no. 986207 registered in 2008 for various leather goods in Class 18 (see below). The main ground of the application for invalidity was the lack of

¹⁵¹Case C-342/97, Lloyd Schuhfabrik Meyer, 22/06/1999, ECLI:EU:C:1999:323, §23

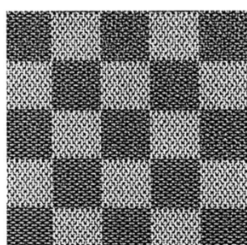
¹⁵² RAMSEY, L. P., “Inherently Valuable Expression”, in CALBOLI, I., SENFTLEBEN, M., *The protection of Non-Traditional Trademarks, Critical Perspective*, Oxford University Press, 1st Edition, 2018, pp. 353-354

¹⁵³ Guidelines of the Office, Part B, Section 4, 8

distinctive character of the trade mark so that it should not have been registered in the European Union in the first place. The applicant claimed that a chequerboard was a “simple, basic and commonplace pattern” as regards goods in Class 18, which was confirmed by the Board of Appeal.



This is also what had already been assessed in former decisions dated from 21 April 2015, *Representation of a grey chequerboard pattern*¹⁵⁴, *Representation of a brown and beige chequerboard pattern*¹⁵⁵. The trade marks at stake are depicting below.



EUTM no. 6587851 filed on 04/01/2008 (fig.) *EUTM no. 370445 filed on 18/09/1996 (fig.)*

In its judgement from June 2020¹⁵⁶, again, the Court took up the above claims and relied on the criteria for three-dimensional marks, that is to know, the trade mark has to depart significantly

¹⁵⁴ T-360/12, not published, EU:T:2015:214

¹⁵⁵ T T 359/12, 2005, EU:T:2015:215

¹⁵⁶ Case T-105/19, Louis Vuitton Malletier v EUIPO – Norbert Wisniewski, ECLI:EU:T:2020:258, Judgment Of The General Court (Tenth Chamber), 10/06/2020

from the norms of the sector so as to be able to guarantee the identity of the commercial origin of the goods and services.¹⁵⁷

Vuitton contested the assessment of the evidence submitted made by the Board to prove its trade mark has acquired distinctiveness through use. Among others, Vuitton submitted brochures, advertisements, catalogues identifying the company as the top-selling of bags and travel bags in Western Europe from 2008 to 2014. As for the geographical extent of the use of the trade mark, Vuitton brought to the attention of the Board that its shops were situated in large cities, in airports and other touristic places. Its online presence through social networks and its high position on Google was also part of the proofs submitted. Lastly, the firm stated its trade mark were subject to counterfeiting and product piracy. Nevertheless, the Board considered it could not constitute an admissible evidence since not only the pattern but the whole goods were reproduced.

The Court of Justice upheld Louis Vuitton's claims and finally cancelled the decision of the Board of Appeal considering the evidence submitted as relevant. It was not a foregone conclusion, and it is not for most of the trade mark proprietors, which may not have that much time and money to deal with it. It is to be noted that if Vuitton had been required to prove acquired distinctiveness through use before being granted a supposed *ad vitam eternam* right, all these proceedings would have been avoided.

The geographical extent of use. In particular, in the European Union it is even more difficult considering the number of languages and countries. Comparing to other heterogeneous markets such as the United States, the European jurisdictions are more likely to reject “most, if not all, pure shapes, colours and the like by operating geographic reach as a threshold filter”.¹⁵⁸ For instance, the recognition of the shape of the Kit Kat chocolate bars by the relevant public in ten out of fourteen countries was not sufficient.¹⁵⁹

Alternatively, large companies can engage the services of trade mark agents and legal advisers to advise them on the importance of collecting - and knowing how to do so using useful tools such as the Wayback machine - years and years of evidence of their accounts, *i.e.* their

¹⁵⁷ *Ibidem*

¹⁵⁸ PORANGABA, L. H., “Acquired distinctiveness in the European Union: when non-traditional marks meet a (fragmented) single market”, *Trademark Reporter*, 109(3), 2019, pp. 619-670.

¹⁵⁹ Joined Cases C-84/17 P, C-85/17 P and C-95/17 P, *Société des Produits Nestlé S.A. v. Mondelez UK Holdings & Services Ltd* and EUIPO, 25/07/2018, EU:C:2018:596. The case is still pending.

investments, turnover, sales, advertising campaigns, photographs of their products representing the mark. They are also responsible for selecting the relevant evidence provided by the company and justifying to the examiner how it meets the criteria for extensive use of the mark. Therefore, some improvements and adaptations need to be made in order to include all trade mark proprietors in this reform.

However, in order for the practice of the European courts to become more flexible, they should already recognise that a trade mark can be something other than a word or a figurative element.

Section 2. A methodology which we will have to count on improvement in technology

The abandonment of the graphical representation brings more complexity in terms of trade marks monitoring¹⁶⁰. In this regard, the issue tackled is the ability to identify whether a prior multimedia, motion or sound trade marks is already registered. Applicants need it to avoid an opposition later. Trade marks proprietors need it so as to ensure their right is not infringed. When applicants or trade marks proprietors conduct monitoring searches in the EUIPO's or national free databases such as eSearch, or fee-based ones *e.g.*, Fovea, Compumark or Corsearch, these non-traditional trade marks are not always taken into account. With regard to current technology, words and figurative trade marks are easily identifiable thanks to the improvements of artificial intelligence. Fingerprinting and picture recognition are used by all the above-mentioned databases. Nevertheless, no efficient technology is able to recognise a figurative element in a multimedia or motion sign under a mp4 file. Likewise, no technology can identify the imitation of a word in a sound mark containing words. No technology can recognise the similarity of two sounds filed under a mp3 format.

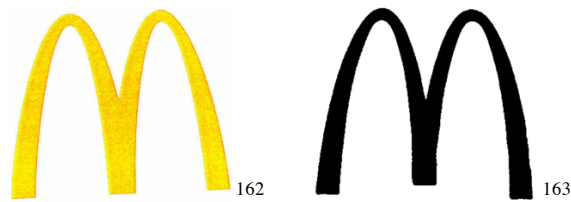
As an example, a motion mark was registered in March 2021 for *meat, fish, compotes, chilly dairy desserts, drinks made from dairy products, stewed, processed and dried fruits, dairy whipped topping* among others in Class 29, *advertising* and other services in Class 35 and *services for providing food and drinks* in Class 43. The sign is a video consisting of a green M which turns into a heart before going back to its initial form (see below screenshots taken from the video representing the trade mark in the register).



It is clear that the sign is composed of the identical M of famous McDonald's trade mark (see below) registered for identical and similar products and services in Class 29, 35 and 42.

¹⁶⁰ BUCHILLOT, S., THRIERR, O., "(R)évolution(s): le nouveau droit des Marques", *Propriété Industrielle*, n°4, *Lexis Nexis*, Avril 2020 p. 2

¹⁶¹ Screenshots of the motion EUTM n° 018429600 filed on 16/03/2021 and registered on 03/07/2021



Notwithstanding, McDonald did not oppose the registration of the M, which is certainly surprising insofar as it would win on the grounds of Article 8(1)(b) and 8(5). Indeed, as explained in the first part of this essay¹⁶⁴, the words and figurative elements prevail on the movement while comparing a multimedia or motion trade mark containing words or figurative elements to another word or figurative trade mark. A simple link in the mind of the consumer would be found, and even a likelihood of confusion. Furthermore, we would hardly trust the fact that the well-known company does not duly monitor his intellectual property rights on a regular basis. In the present case, the green M was not referenced in the database system because of the flaws inherent to it. Indeed, the applicant requested a search report to the EUIPO which did not identify McDonald's trade mark.¹⁶⁵ This serious lack of technology tools can also explain the low percentage of case law related to non-traditional marks. Their proprietors are simply not aware of the existence of other confusing rights in the market.

It is to be noted that olfactory signs and taste cannot be registered in compliance with Article 4 EUTMR "as the subject matter of protection cannot be determined with clarity and precision with generally available technology".¹⁶⁶ Insofar as the same technology deficiency applies to motion, multimedia and sound trade marks, one could argue that the European Union Office and the national ones were not ready to abandon the requirement of graphic representation. Nevertheless, the legislator ruled in favour of this evolution, and it is regrettable.

Therefore, it is urgent to think about new technology tools to help the current and future proprietors of non-traditional marks to enforce their rights in the best way.

¹⁶² Figurative EUTM n°000058461 filed on 01/04/1996 and registered on 02/02/1999

¹⁶³ Figurative EUTM n° 000062570 filed on 25/03/1996 and registered on 15/07/1999

¹⁶⁴ See Part I, Chapter 1, Section 1, I

¹⁶⁵ See on eSearch the request no. 018429600 from GIORGIO TRANI

¹⁶⁶ Guidelines of the Office, Part B Examination ; Section 4 Absolute grounds for refusal, Chapter 2, 2.9 « Other marks »

Conclusion

The aim of this paper was to evaluate the scope of protection of non-traditional marks in opposition proceedings upon article 8(1)(b), in the light of the current *in abstracto* approach of the assessment of the likelihood of confusion.

Within that framework we identified the criteria of the five-step-current-methodology which have the most impact on the ability to enforce non-traditional marks. We thus focused our analysis on the comparison of the signs and on the determination of the degree of distinctiveness of those trade marks.

We observed that the methodology to compare the signs is the same than the one used for word and figurative marks *i.e.*, the three-step – visual, aural and conceptual – comparison. Nevertheless, we shed light on its limits since it does not take into account the specificities of these unconventional marks.

The analyse made also enabled us to tackle the way these trade marks are registered and the discrepancy between the right supposedly granted and the scope of protection actually granted.

We then underlined the lack of recognition of the distinctive character of non-traditional marks, which again tackles the earlier days of their existence. The European jurisdictions adopt a strict assessment of their inherent distinctiveness, based on their supposing inability to be considered as such by the relevant public. We also shed light on the consideration made by the judges of the public interest at the moment to enforce.

Then, we put forward the difficulties for non-traditional trade marks to benefit from the provision related to enhanced distinctiveness, which shows the lack of importance attached to use. We could therefore conclude that this *in abstracto* approach was totally disconnected with market's conditions of these non-traditional marks, and that they benefited from a very low scope of protection under the current practice.

In the light of the *in concreto* practice adopted by the Court of the United States, we then attempted to give a new approach to assess the likelihood of confusion.

In that regard, we realised the necessity to revisit the methodology with a view to granting a better scope of protection to these trade marks.

We thus gave some proposals of a methodology based on acquired distinctiveness through use at the moment of registration.

We then highlighted the importance to reconcile use and non-traditional marks by comparing the signs on the basis of *in concreto* criteria. In particular, we underlined the importance of the consideration of the relation between non-traditional trade marks and the goods on which it was affixed or services under which it was used. Likewise, we emphasised the importance of the perception of the relevant consumer of such a use. Afterwards, we suggested to take into account the market's conditions in the global assessment of the likelihood of confusion. In particular, we highlighted the relevance of the consideration of the dishonest intention of the applicant in opposition proceedings.

We finally realised that this methodology could only be efficient under two conditions. First, the European jurisdictions must recognise the ability of non-traditional trade marks to be perceived by the relevant public as such, and by analogy, they shall give more flexibility in terms of standard of proof of acquired distinctiveness. If not, non-traditional marks will be the tool of the biggest at the expense of small companies and individual entrepreneurs. Furthermore, improvements in technology and new tools to monitor trade marks are required to anticipate further conflicts.

Bibliography

Literature

Books

- CALBOLI, I., SENFTLEBEN, M. R. F., *The Protection of Non-traditional Trademarks: Critical Perspectives*, Ed. Oxford Press university, 1st Edition, 2018
- DICONZA, N. C., “United States: USPTO: Proving Use Of A Trademark In The United States Patent And Trademark Office”, *Mondaq*, 01/04/2016
- PHILIPS, J., *Trade Marks at the Limit*, Ed. Edward Elgar Publishing Limited, 2006
- MCCARTHY, J. Thomas, *McCarthy on Trademarks and Unfair Competition*

Articles

- KOCH, A., “The General Court of EU confirms the invalidity of Adidas three-stripes trademark”, *Dennemeyer IP Blog*, 09/07/2019
- LUBBOCK, M., “adidas decision: General Court reiterates importance of evidence in trademark disputes”, *brownreudnick.com*, 09/17/2019
- MURRAY, G., Adidas loses its stripes, *The Chartered Institute of Trade Mark Attorneys (CITMA)*, 20/06/2019

Papers

- BUCHILLOT, S., THRIERR, O., “(R)évolution(s): le nouveau droit des Marques”, *Propriété Industrielle*, n°4, *Lexis Nexis*, Avril 2020 p. 2
- MISHRA, N., “Registration of Non-Traditional Trademarks”, *Journal of Intellectual Property Rights*, Vol 13, January 2008, pp. 43-50
- PORANGABA, L. H., “Acquired distinctiveness in the European Union: when non-traditional marks meet a (fragmented) single market”, *Trademark Reporter*, 109(3), 2019, pp. 619-670

- RIBEIRO DA CUNHA, I., RANDAKEVICIUTE-ALPMAN, J., *New types of marks available after the European Union Trade Mark Reform An Analysis in the light of the U.S. Trade mark law*, 10 (2020) JIPITEC 375

Guidelines, Decisions of the Director of the Office and Common Communication

European Union

- Decision No EX-20-9 of the Executive Director of the Office of 03/11/2020 on communication by electronic means
- European Intellectual Property Network (EUIPN), *Common Communication, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021
- European Intellectual Property Network (EUIPN), *Common Practice, New types of trade marks: Examination of formal requirements and relative grounds*, April 2021
- Guidelines of the Office

United States

- Trademark Manual of Examining Procedure (TMEP)

Case Law

France

- OPP 05-0902, Couleur rose Pantone 212c / Magenta, 03/10/2005

European Union

Opposition Division

- B 2 951 625, ROJO/ROUGE, 27/09/2018

- B 3070138, COLORMIX / COLOMIX 2:1 Standard Klarlack Kratzfest 2:1 Standard Стандартный 2k Clearcoat As Бесцветный Лак As Transparente Ag 1 Inhalt Liter Helios(3d), 12/05/2020
- B 3078328, RENAISSANCE / Biotissima RENNESENCE Professional Anti-Aging Care instant action (3D: cosmetic boxes), 18/12/2019
- B 973 257, Lidl Stiftung & Co. KG v Société des eaux minérales de Saint Amand, 08/01/2008

Board of Appeal

- R 409/2009-1, 04/02/2010
- R 994/2009-4, 15/07/2010
- R 0755/2009-4, 20/10/2010
- R 2492/2010-2, Tea Forté, Inc v Dr. Dünner AG, 14/02/2012
- R 1529/2006-1, FLASCHE (3D-MARKE) / FLASCHE (3D-MARKE), 16/07/2009
- R 1996/2020-5, THE SOUND OF THE THEME OF THE JAMES BOND MOVIE (sound mark), 12/03/2021

Court of Justice

- C-10/89, HAG II, 1990, ECR I-3711
- C-39/97, Canon, 29/09/1998, EU:C:1998:442
- C-63/97, BMW, 1999, ECR I-905
- C-84/17 P, C-85/17 P and C-95/17 P, Société des Produits Nestlé S.A. v. Mondelez UK Holdings & Services Ltd and EUIPO, 25/07/2018, EU:C:2018:596
- C-104/01, Libertel Groep BV v Benelux-Merkenbureau ('Libertel'), 2003, ECR I- 3793
- C- 163/ 16, Christian Louboutin SAS v. Van Haren Schoenen BV, 22/06/2017, confirmed (Feb. 6, 2018), ECLI:EU:C:2018:64
- C-196/11, 04/05/2012, F1-Live, EU:C:2012:314
- C-205/13, Hauck GmbH & Co KG v Stokke A/S and others, 18/09/2014, EU:C:2014:2233
- C-251/95, Sabèl, 11/11/1997, EU:C:1997:528

- C-273/00, Sieckmann, 12/12/2002, ECLI:EU:C:2002:748
- C-291/00, LT Diffusion, 2003, ECR I-2799
- C-342/97, Lloyd Schuhfabrik Meyer, 22/06/1999, ECLI:EU:C:1999:323
- C-456/19, Aktiebolaget stg tatrafikken, 08/10/2020, EU:C:2020:813

General Court

- T-29/04, Cristal Castellblanch, 08/12/2005, EU:T:2005:438
- T-101/15 and T-102/15, *Red Bull v EUIPO – Optimum Mark (Combination of the colours blue and silver)*, 30/11/2017, EU:T:2017:852
- T-105/19, Louis Vuitton Malletier v EUIPO – Norbert Wisniewski, 10/06/2020, ECLI:EU:T:2020:258
- T-135/04, Online Bus, 04/11/2005, EU:T:2005:419
- T-137/08, BCS v OHIM – DEERE, 28/10/2009, ECLI:EU:T:2009:417
- T-153/03, Peau de vache, 13/06/2006, EU:T:2006:157
- T-307/17, AG c. EUIPO v Shoe Branding Europe BVBA, 19 /06/ 2019, ECLI:EU:T:2019:427
- T-312/03, Selenium-Ace, 14/07/2005, EU:T:2005:289
- T-317/14, Forme d’un fourneau, 24/09/2015, non published, EU:T:2015:689
- T-353/07, Coloris, 30/11/2009, EU:T:2009:475
- T-359/12, 2005, EU:T:2015:215
- T-360/12, 2015, EU:T:2015:214
- T-424/10, Dosenbach-Ochsner AG Schuhe und Sport v OHIM, ECLI:EU:T:2012:58
- T-482/08, Atlas Transport, 10/06/2010, EU:T:2010:229
- T-552/10, 25/10/2012, 07/02/2012, EU:T:2012:576
- T-581/13, Royal County of Berkshire POLO CLUB (fig.) / BEVERLEY HILLS POLO CLUB et al., 26/03/2015, EU:T:2015:192
- T-796/16, CEDC International sp. z. o. o. v EUIPO – Underberg AG, 23/09/2020, ECLI:EU:T:2020:439,
- T-194/03, Bainbridge, 23/02/2006, EU:T:2006:65

United States

- In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973)
- MF, Inc v Sleekcraft Boats, 599 F.2d 341 (C.A.9) 1979
- White Rock Distilleries Inc., 92 USPQ2d 1282, 1284 (TTAB 2009)
- RSI Sys., LLC, 88 USPQ2d 1445, 1448 (TTAB 2008)
- In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991)
- Pollio Dairy Prods. Corp., 8 USPQ2d 2012, 2015

Legislative Sources

- Code of Federal Regulations (CFR)
- Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark [2017] OJ L154/1
- Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015
- Council Regulation (EC) No 207/2009 on the Community trade mark
- Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark
- Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)
- Singapore Treaty on the Law of Trademarks, 27 March 2006
<https://wipolex.wipo.int/en/text/290013>
- Resolution by the Diplomatic Conference Supplementary to the Singapore Treaty on the Law of Trademarks, para 3, 27 March 2006
<https://wipolex.wipo.int/en/text/290013>

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