

Recent European Case Law on Well-known Marks: («From Davidoff and INTEL with Camel and NASDAQ to Pago and Bellure»)

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- Does well-known mean „*famous*“ ?



- Does well-known mean „*notorious*“ ?



- Does well-known mean „*having a reputation*“ ?



No clear and general definition of „well-known trademark“ in the EU! (and there isn't any corresponding register)

European Community:

Enhanced (i.e. specially strong) protection for trademarks
with a reputation:

Art. 8 (5) Community Trademark Regulation:

(...), upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trademark applied for shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark **has a reputation in the Community** and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would **take unfair advantage** of, or **be detrimental** to, the **distinctive character or the repute** of the earlier trade mark.

This special protection for trademarks with a reputation applies:

- in opposition proceedings against a CTM (application)
 - in invalidity proceedings against a CTM (registration)
 - in CTM infringement proceedings against a trademark
- and also
- in the national trademark laws of the EU Member States

Three conditions must be fulfilled:

1. The first mark must have a reputation.
2. The second mark must be identical or similar (a „link“).
3. The use of the second mark must be likely to
 - take unfair advantage of (=exploit)
 - or
 - be detrimental to (=damage)the distinctive character or the repute of the first mark.

Note:

- There must be a „link“ between the two marks, but a likelihood of confusion is not required.
- The claim requires a global appreciation of the case, taking into account, e.g.
 - Similarity of marks
 - Nature of goods/services
 - Similarity of goods/services
 - Strength of the reputation
 - Distinctiveness of the earlier mark

When does a trademark have «a reputation»?

When the trademark is known by a significant part of the public concerned by the products or services covered by the trademark.

Therefore,

the relevant public depends on the relevant products / services. It can be the public at large or a more specialized public.

Case No. 1

Davidoff / Gofkid (DURFFEE) (ECJ 9.1.2003 – C-292/00)

Marks: 



Goods: Cigars, perfume,
glasses, leather goods

Silver wares, ashtrays, jewellery, watches

Case No. 2

Intel / CPM (Intelmark) ECJ 27 (November 2000 – C-252/07)



Intel Corporation

Cl. 9 Microchips etc.
Huge reputation



CPM Limited

Cl. 35 Telemarketing services
UK TM appl. 1997
(INTEGRATED TELEPHONE
MARKETING)

Intel claimed:

INTEL has a reputation and the use of INTELMARK would take unfair advantage of, or be detrimental to, its distinctive character or repute.

Questions asked by UK Court of Appeal to European Court of Justice:

Is there

- a) a link between the two trademarks?
- b) a case of taking unfair advantage or being detrimental to the distinctive character?

When

- aa) the earlier mark has a huge reputation for specific goods/services; and
- bb) those goods/services are dissimilar to those of the later mark; and
- cc) the earlier mark is unique; and
- dd) the earlier mark is brought to mind by the consumer when he encounters the later mark?

ECJ:

- Yes, consumers are likely to make a „link“ between INTEL and INTELMARK.
- However, global appreciation is required:
- Use of the later mark is detrimental to the distinctive character of INTEL if there's evidence that the economic behavior of the average consumer of the INTEL goods changes as a result of the use of INTELMARK.

Conclusion:

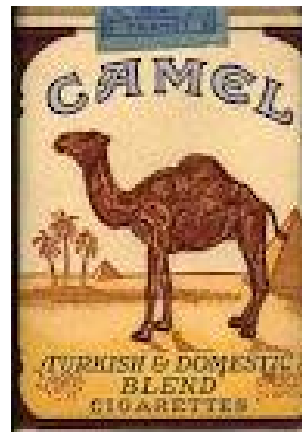
Since Intel had not produced such evidence, the Court concluded that INTELMARK has not caused detriment to distinctive character of INTEL.

Case No. 3

Japan Tobacco / Torrefaccao Camela (30.1.2008 / T-128/06 and 30.4.2009 –

C-136/08)

Trademarks:



Goods:

Tobacco, Cigarettes

Coffee

General Court and confirmed by ECJ on appeal:

Camel & device

- has a reputation
- but not a strong distinctive character
- Camelo & device doesn't exploit the distinctive character
- and it's unlikely that use of CAMELO & Device for coffee would damage repute of CAMEL.
- => Action / Opposition dismissed.

Case No. 4

Amen Corner SA / Comercio Electrónico Ogal (17.12.2010 / T-192/09)

Trademarks:



Goods:

Clothing, sport goods,
sport events
(golf tournament)

Class 9 (Class headings)

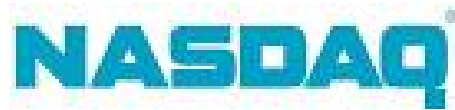
The court:

- SEVE TROPHY has a reputation.
- There is a link between the two marks.
- SEVE TROPHY (of Severiano Ballesteros) has a reputation for golf tournaments, but not for electronics or computer games.
- Lack of convincing evidence of damage to reputation.
- => Action / Opposition dismissed.

Case No. 5

Nasdaq Stock Market Inc. / Antarctica Srl (12.3.2009 – C-320/07)

Trademarks:



Goods:

Class 36: Financial Services,
stock index, listing of
securities

Class 9, 12, 25, 28:
sportswear, helmets for sports,
mountainbikes, skis

The court:

- NASDAQ is very distinctive and has a strong reputation.
- The marks are identical. There's a link!
- NASDAQ: image of modernity, of hightech.
- Antarctica seeked to exploit this reputation by using TM Nasdaq (Logo).
- => Action / Opposition upheld.

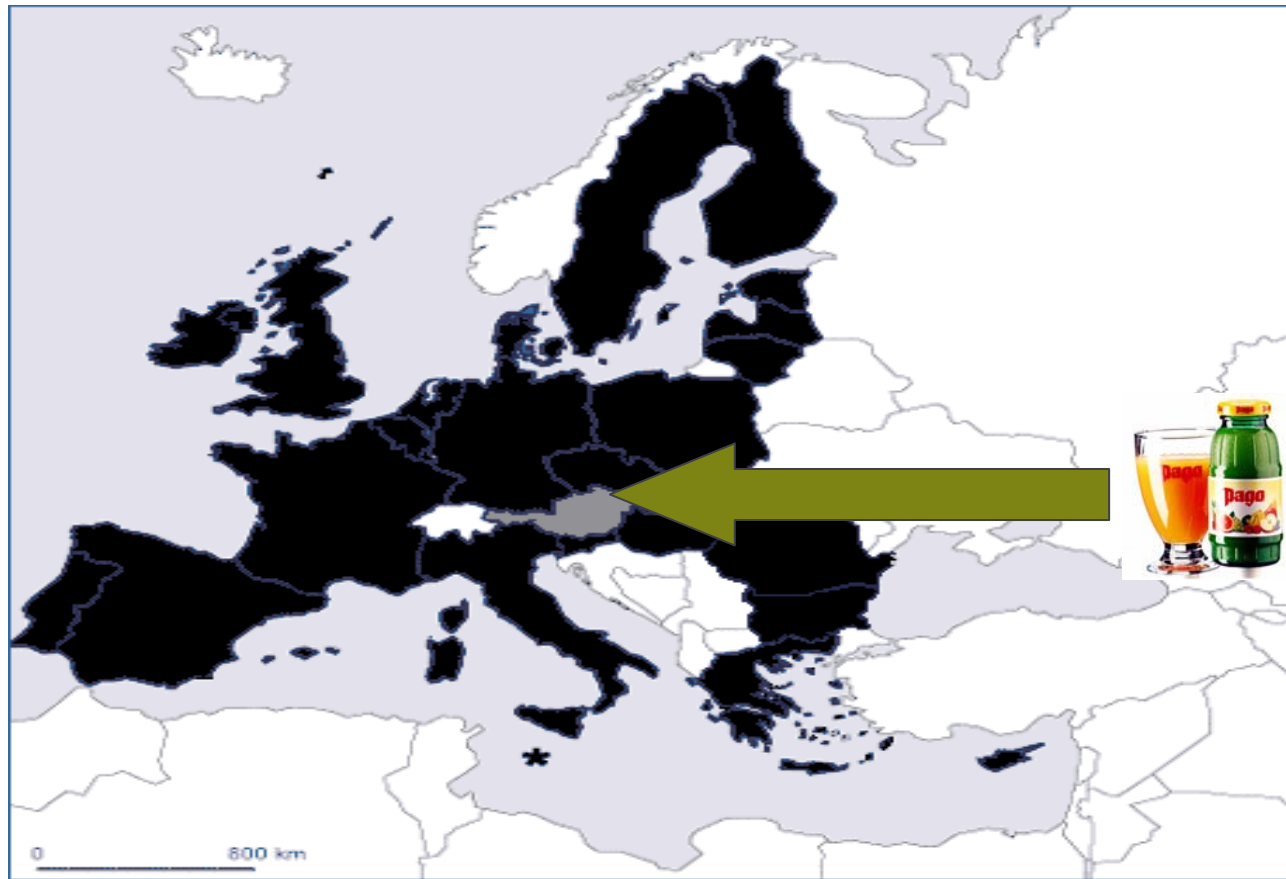
Case No. 6

ECJ, Decision of 6 October 2009, C-301/07 – Pago / TirolMilch

Key issue:

Is a Community Trade Mark protected in the whole Community as a “trade mark with a reputation” if it has a “reputation” only in one Member State?





The Court:

The territory of one State (here Austria) is considered a substantial part of the European Community.

Therefore, the reputation of the CTM is protected in the whole Community; the injunction against the later mark can be issued for the whole Community.

Open issue: What if a trademark only has a reputation in, say, Malta?

Case No. 7

L'Oréal vs. Bellure (18.06.2009 – C-487/07) (Systematic but subtle imitation of successful perfumes)



Background:

- L'Oréal sued Bellure in UK
- L'Oréal: Bellure infringed trademark rights by selling “smell-alike” perfumes under similar trademarks and in similar packaging, thereby exploiting the reputation of the first trademark (e.g. TRESOR)
- UK Court of Appeal referred the case to ECJ for preliminary ruling.

Trésor & La Valeur

BAKER & MCKENZIE



Miracle & Pink Wonder

BAKER & MCKENZIE



Problems of the case

- The Bellure trademarks were not confusingly similar.
- The Bellure trademarks did not exploit the reputation of the L'Oréal trademarks (e.g. TRESOR)
- The Bellure trademarks did not damage the distinctiveness of the L'Oréal trademarks.

Could L'Oréal still claim protection for its trademarks with a reputation?

ECJ's conclusion

- Bellure has infringed L'Oréal's rights!
- Bellure is taking unfair advantage, because it seeks:
“to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.”

=> Landmark decision!

Thank you for your attention!

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