

**Master program in intellectual property law**  
**Module 2A European trade mark law**

**Individual essay**

Each participant in Module 2A European trade mark law shall write an individual essay. The essay constitutes 50 percent of the course examination. The established topics are distributed below.

The topics are described in general terms. Your first task is therefore to confine the topic to a precise, relevant and interesting issue. The essay should be concise and focused on the particular problem. As a general rule, the essay should focus on traditional trade marks, such as word marks, figurative marks and composition marks, i.e. combinations of words and of words and figurative elements. The essay may take the form of an article for a law journal and to get the highest credit it should in principle be of such quality that it can be published (which has actually happened).

The essay shall not exceed 7000 word, including footnotes, not including the front page, the bibliography, or the tables of contents, abbreviations and cases. You shall be careful when referring to sources and you are expected to use other materials than those referred to during the course. In other words you are expected to make research on your own by using the library, electronic databases and other Internet resources to find further information regarding your topic.

We are not in favour of any particular font or format, but we request that the same standard is used throughout the entire essay. Moreover, as to citations and arguments, full information about the references and support used should be consistently provided for e.g. in footnotes or endnotes. A list of cases, books, articles, etc. should be listed in a bibliography and similar indexes.

Your essays are to be handed in electronically to *Henning.Albertsson@juridicum.su.se* no later than Thursday 29 April 2010 09.00. The essay will be discussed at the examination seminar the 6 May 2010.

Your essays will be examined by Claes Granmar and Per Jonas Nordell.

Good luck!

## Authors and topics

### Alexei Martinez

A basic condition for obtaining trade mark rights is that the mark has distinctive character or distinctiveness. What is distinctive character and how is it acquired under the EU trade mark statutes in the light of rulings by the EU Courts and relevant doctrine? What makes a mark more distinctive than another? Where are the boundaries of distinctiveness? (However, you do not have to address the relationship between distinctive character and geographical indications of origin. cf. the topic below).

### Mariana Ogaz Diaz

Certain questions arise with respect to the relation between trade marks and geographical indications. What are the reasons behind these hindrances for obtaining and maintaining trade mark rights? How are these interrelations treated in decisions by the EU Courts and in the legal doctrine?

### Justyna Kozak

The rights conferred by technical trade marks are based on the principles of priority and first to file. However, these principles are not without exceptions. A particular ground for refusing registration and, if registered, for invalidation of the trade mark rights is bad faith on the part of the applicant at the time when the application was filed. However, the concept of bad faith is surrounded by many uncertainties i.e. as to market effects of making the rights conditioned on the state of mind of someone. Investigate the meaning of bad faith and its role in the trade mark system.

### Asaya Kardileeva

The national trade mark in the EU Member States confers a right on the proprietor to prevent others from using in the course of trade any sign where there exists a likelihood of confusion on the part of the public, which includes a likelihood of association between the sign and the trade mark. What is meant really by likelihood of confusion? What principles should apply to assess whether such similarity is at hand? Clarify in more detail the relation with likelihood of association.

### Camille Genevois

The extended protection for reputed trade marks broadens the perspective beyond assessments of identity or similarity to repress unfair trade involving signs. Explain the technical meaning of “reputation” and the scope of protection against use of signs which without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

### Nina Barzey

In case of “double identity” the junior sign is often considered automatically giving rise to likelihood of confusion on the part of the public. However, it is evident in many cases on double identity involving use of the proprietor’s trade mark that it does not cause any consumer confusion at all. Instead, the Court of Justice has recognised a protection for other functions than the “essential function” to designate a commercial origin of the goods sold by the third party. In particular the advertising function appears as an independent basis for trade mark protection. Clarify the meaning of the advertising function and the relation between this protection and the extended protection for reputed trade marks (i.e. under Article 5(1)(a) and 5(2) of the trade mark directive).

### Karin Maria Gros Pedersen

The approximation of national trade mark laws in Europe shall according to Article 5(5) of the trade mark directive “not affect provisions in any Member State relating to the protection against the use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.” In other words, the scope of approximation of the laws is confined to use of signs for the purposes of distinguishing goods or services on the marketplace. However, the Court of Justice has repeatedly held that the trade mark directive applies even if signs are used for other purposes, such as geographical indications, trade names, or as mere parts of the products). Does Article 5(5) apply at all today, and what is the relevance of whether the trade mark is used “as a trade mark” or not under Article 5(1-4) of the trade mark directive?

### Narine Avagyan

Third party’s use of the proprietor’s trade mark in the course of trade may escape the scope of trade mark law. A case in point is referential use of the trade mark which is necessary i.e. for informing the public about the intended purpose of goods or services such as reparations, spare parts, or second hand sale. How far does this exception extend and what principles define the boundaries to trade mark infringement? (However, you do not have to address the relationship between trade mark protection and the principles of comparative advertising (cf. the topic below).

### Jamie Quane

Whereas trade mark law defines the rights to prevent other traders from using signs in the course of trade, the national rules approximated by directive 2006/114/EC are based on the idea that use of another trader’s trade mark e.g. in comparative advertising promotes trade and competition. In cases concerning use of signs in advertising these rules regarding fair trade overlap with the scope of trade mark protection as they appear as the other side of the same coin. The rules on fair trade may also expand the scope of actionable use of signs. Explain the interrelation between trade mark protection and the rules on comparative and misleading advertising.

### Eleonora Skaffari

The trade mark proprietor is entitled to extend the trade mark rights for production purposes. Analyse the particular legal issues that may arise with respect to such horizontal trade mark licenses. Moreover, two proprietors of identical or similar trade marks may agree not to use their marks in the geographical territory where the other proprietor uses its mark. Analyse the particular legal issues that may arise with respect to such delimitation agreements within the EU.

### Ying Dai

If the trade mark proprietor omits to invoke the rights to prevent a third party from using an actionable sign in the course of trade, that sign may become a trade mark which coexists with the earlier mark. When have the rights for the proprietor to prevent use of such a junior mark expired? In other words, what are the conditions for coexistence of the senior and junior trade marks? Moreover, the proprietor may only invoke the trade mark rights against a trader not having his *consent* to use the mark in the course of trade. Could the mere omission to invoke the rights constitute a consent which overtrumps the proprietor’s rights to prevent use of the junior mark?

Nasrin Iranfar

The trade mark rights are exhausted when the goods bearing the trade mark has been duly put into circulation on the market within the EU by the proprietors or with consent of the proprietor. However, the proprietor of a national trade mark rights in Europe retains a possibility to invoke the rights against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form covered by the registration in which the trade mark may be used, the scope of the goods or services for which the licence is granted, the territory in which the trade mark may be affixed, or the quality of the goods manufactured or of the services provided by the licensee. What is the relation between the principle of exhaustion and the residual right to prevent a licensee from selling the branded goods (under Articles 7 and 8 of the trade mark directive)?