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**TRADEMARKS
AND UNFAIR COMPETITION**

QUARTERLY BULLETIN

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INTRODUCTION

It is my pleasure to welcome you to this latest bulletin from the field of trademarks, unfair competition and — in this issue — personal data.

We present the most interesting rulings in these areas issued by European, French and Polish courts. This time around, we discuss such issues as an amendment of the Industrial Property Law introducing a new procedural model for granting protection to trademarks, as well as a planned EU regulation on personal data protection whose purpose is to provide natural persons with greater control over their data and to bring personal data protection provisions in line with technological developments.

Our regular team of writers has been joined by our colleagues from France, Claude Armingaud and Audrey Decima, who discuss such problems as an attempt to register the trademark “Pray for Paris” and a 3D pen.

We hope this issue will keep you up to date on the most important news from this rapidly changing field of law. As always, I encourage you to share your opinions and reflections with us, and to address any questions you may have to our authors.

Oskar Tułodziecki



LEGISLATION

EU: REFORM OF THE EUROPEAN TRADE MARK SYSTEM

Michał Ziółkowski

After many months of work on a reform of trademark law within the EU, drafts of a regulation and directive were put to a vote during the second reading at a plenary session of the European Parliament on December 15, 2015, and were approved.

The official publication of the Directive in the European Community Official Journal took place on December 23, and of the Regulation on December 24. Regulation No. 2015/2424 entered into force on March 23, 2016 (90 days after the date of publication). Directive No. 2015/2436 entered into force on January 12, 2016, (20 days after publication), while its provisions should be implemented in domestic legal systems within three years.

Regulation No. 2015/2424 changes the existing system of official payments for submissions and extensions of protection. Moreover, it also introduces certain changes of terminology.

The Office for the Harmonization of the Internal Market (OHIM) changes its name to the European Union Intellectual Property Office (EUIPO), while the Community Trade Mark (CTM) will become the European Union Trade Mark (EUTM).

The requirement of the graphic presentability of a trademark resulting from the definition thereof has been replaced in both the Regulation and the Directive by a requirement that the presentation of a mark be clear, precise, concise, easily accessible, comprehensible, lasting, and objective. A trademark is to be presented in the



register in a manner which allows the competent authorities and users to exactly, unambiguously, determine the object of the protection granted to the proprietor of the trademark. This clarification of the criterion of the presentability of a mark, while seeking to be more liberal, may in practice lead to further blocking of registrations of marks which are perceived as unconventional, such as, for example, fragrance marks.

Apart from the reworking of the definition of graphic presentability, one of the most important changes in the Directive is a requirement that domestic patent offices consider matters connected with the registration of expired trademarks

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solely by assessing the absolute prerequisites for protection, resigning from any assessment of relative prerequisites, that is, those which concern the existence of earlier similar or identical trademarks belonging to other entities, and which could constitute a barrier to the registration of the mark in question. The provisions of the Polish Industrial Property Law have recently been amended in this scope.

EU: NEW EU REGULATION ON PERSONAL DATA PROTECTION IN TWO YEARS

Dorota Koseła

In mid-December, negotiations concluded on a draft General Data Protection Regulation, hereinafter: the “GDPR”. Its provisions will come into force in a uniform wording throughout the European Union in mid-2018.

The objective of the new regulation is to give natural persons more control over their data, and to adjust personal data protection provisions to technological developments. Data subjects will gain more control through such measures as that their consent to personal data

processing will no longer be able to be implied, but will have to be expressed directly. It will also be easier to transfer personal data between various service providers. At the request of a data subject, an administrator will be obliged to provide processed data on that person in a form which is easily legible. The GDPR also introduces a “right to be forgotten”. This right can be exercised by a natural person when that person withdraws his or her consent or if another basis on which the administrator processes the personal data of that



person loses validity. Separate provisions concern the obligation to obtain the consent of parents to the processing of the personal data of their children. The GDPR also introduces an obligation to employ measures aimed at protecting personal data even at the stage of designing goods or services. This is known as privacy by design.

Despite its restrictiveness, the GDPR will facilitate the processing of personal data by administrators. This will occur because provisions will be uniform throughout the European Union, and complying with them will be less expensive. Further, businesses active in more than one EU country will be subject to a single, main personal data protection regulator.

For businesses, the GDPR means it will be necessary for them to promptly report any infringements within the area of personal data processing. It is advisable for personal data administrators to review the documentation they maintain on personal data and adapt it to the new provisions. It is also worthy considering appointing an Information Security Administrator, even if this is not mandatory on the basis of the GDPR. In particular, such an obligation will

exist in the case of regular processing of large amounts of personal data by an administrator or an entity acting on its instructions. Irregularities may lead to the imposition of severe penalties. Failing to comply with the obligation to report an infringement may result in a penalty of up to 10 million euros or 2 per cent of global turnover in the previous year, whichever is higher. Such a submission should be made promptly to the regulator and to the natural persons the data concern. An administrator is also obliged to maintain a registry of infringements in which it describes each infringement and the measures taken to prevent adverse consequences thereof.

Noncompliance with the new provisions concerning personal data processing may result in a sanction of as much as 20 million euros or 4 per cent of turnover in the previous year. Such a penalty may be imposed, for example, in a case where personal data are processed without a legal basis.

In addition, apart from the GDPR, a directive on data protection will come into force in the police and justice system in criminal cases. It will be aimed at effectively protecting the data of victims, witnesses, and those suspected of having committed a crime.

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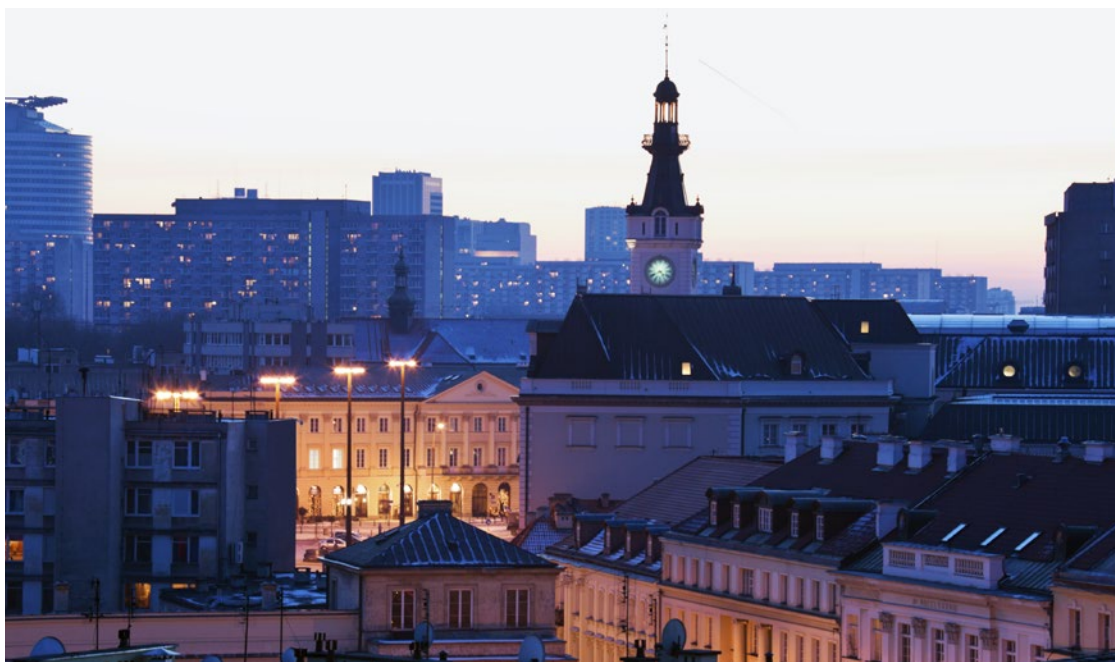
PL: AMENDED INDUSTRIAL PROPERTY LAW

Michał Ziółkowski

Entry into force of the amended Industrial Property Law.

On September 11, 2015, after considering Senate amendments, the Polish Parliament amended the Industrial Property Law, signed by the President on October 5, 2015. The amended act entered into force on April 15, 2016. The amendment does not introduce any fundamental changes concerning the basis on which protection rights to a trademark can be refused. The division is maintained between absolute grounds, which will be assessed *ex officio* (Article 129¹ Intellectual Property Law), and relative grounds, which can provide a basis for an objection (Article 132¹ IPL).

The most significant change is the introduction of a new model for proceedings for granting protection rights to trademarks. The system of assessment has been abolished, and a system of objections introduced (as currently functions in the EUIPO in Alicante in respect of EU marks). Only absolute obstacles registration will be assessed *ex officio*, and within three months following publication of an announcement, a holder of earlier rights will be able to submit an objection (not, as previously, within six months following a legally binding decision on granting a protection right). The PPO



will be obliged to prepare a notification for those submitting new trademarks on the existence of identical or similar trademarks which could provide grounds for an objection leading to a refusal to grant a protection right over the new mark. This change to a system of objections will mean that protection rights to trademarks will, in principle, be granted much faster than in the past.

In the amended IPL, the possibility of submitting a motion for annulment has been eliminated in cases where, previously, another objection was submitted on the same legal basis and the same earlier laws, and that objection

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was finally dismissed. The amendment also introduces important changes concerning the issue of legal interest, lifting the obligation to prove this in the case where a motion is submitted for ascertaining that the protection right to a trademark has expired. The obligation to demonstrate a legal interest is also abolished in proceedings on the annulment of a trademark if the motion is based on absolute prerequisites.

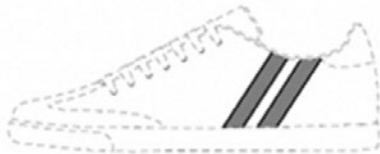
A photograph of a lecture hall or classroom. The foreground is filled with rows of purple upholstered chairs with chrome legs. The chairs are arranged in a slightly staggered pattern, receding into the background. The floor is covered with a light-colored, patterned carpet. The lighting is even, and the overall atmosphere is professional and academic.

CASE LAW

EU: RULING OF THE ECJ PREVENTING THE REGISTRATION OF A TRADEMARK IN THE FORM OF TWO PARALLEL, SLANTING STRIPES ON THE SIDE OF SPORTS SHOES

Aleksandra Stachera

In 2009, the company Shoe Branding Europe BVBA applied to the OHIM for the registration of the following trademark:



The company Adidas AG opposed the application with one of its own registered trademarks:



The OHIM did not find in favor of Adidas AG's objection. In 2014, Adidas AG filed a complaint against that OHIM decision before the EU General Court, moving for its annulment. On May 21, 2015, in case T-145/14, the General Court ruled in favor of Adidas' complaint. It found that the marks in dispute share common

elements; parallel diagonal stripes of the same width placed the same distance apart from each other on a contrasting background. Shoe Branding Europe BVBA appealed against that ruling to the EU Court of Justice. In a decision of February 17, 2016, case ref. No. C-396/15P, the ECJ upheld the ruling of the General Court.

First, the ECJ showed that the slight differences between the marks compared, such as differences in the lengths of the stripes which result from their sloping at different angles, could not have any effect on the general impression made concerning the similarity of the marks. Further, those differences are not sufficient to hold that there is a lack of similarity between the marks in dispute.

Here the ECJ pointed out that sports shoes are goods in widespread use and the relevant target group consists of average consumers who are sufficiently well-informed, attentive and cautious. Their level of attention should be considered average. An average consumer perceives a trademark as

a whole, and does not analyze its individual details.

Therefore, the very presence of stripes on the outside of a shoe will be easily perceived by a consumer, and deemed as an element of similarity between the marks in dispute. The presence of small differences in the positioning and slope of the stripes is perceived only on closer consideration of the marks.

Moreover, the ECJ noticed that the Board of Appeal had previously found that Adidas AG marks consisting of three parallel stripes of the same size and width in a color contrasting with the base color of the shoe are renowned marks. The more distinctive an earlier trademark, the more likelihood there is

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of consumers being misled. Therefore, marks which possess a high degree of distinctiveness (primary or secondary) enjoy wider protection than marks which are less distinctive. The distinctive nature of an earlier trademark, and in particular its renown, must be taken into consideration when evaluating whether there exists a likelihood of consumers being misled (see, *inter alia*: ruling of April 17, 2008, *Ferrero Deutschland v. OHIM*, C-108/07 P).

EU: USE OF A TRADEMARK ON REPLACEMENT PARTS FOR CARS – DECISION OF THE EUROPEAN COURT OF JUSTICE IN CASE C-500/14 FORD MOTOR COMPANY V. WHEELTRIMS SRL

Piotr Wenski

In a decision of October 6, 2015 in case C-500/14, the European Court of Justice ruled on whether a trademark can be used without the consent of the proprietor by producers of replacement

parts for cars, based on what is known as the “repair clause” provided in Article 110 of Regulation 6/2002 on Community designs. The matter was initiated by a pretrial question from an Italian court

conducting proceedings in the case *Ford Motor Company v. Wheeltrims srl*.

The company Ford Motor Company is a renowned manufacturer of passenger cars, replacement parts and accessories for those cars. In connection with its activities, it has registered a series of trademarks which it places on the products it offers. The company Wheeltrims srl is a supplier of replacement parts for cars of various brands. It sells such products as wheel covers bearing the trademarks of various auto manufacturers, without being authorized to do so.

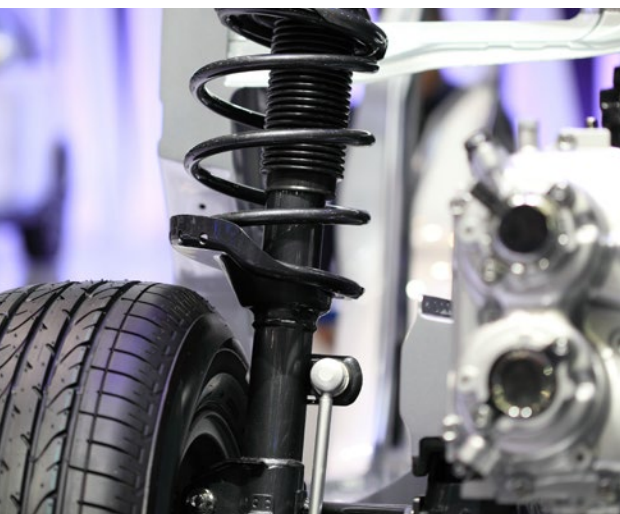
For this reason, Wheeltrims srl was called before an Italian court by Ford Motor Company, which sought a prohibition of Wheeltrims srl continuing to produce wheel covers bearing the Ford trademark, a prohibition of the impermissible use of that mark, and the remedy of harm caused to the Ford Motor Company.

In its defense, Wheeltrims srl maintained that its use of the Ford trademark is of

a descriptive nature only, and is justified by the “repair clause” provided in Article 110 of Regulation 6/2002 on Community designs. The defendant company showed in particular that its placing the Ford trademark on wheel caps was not for the purpose of indicating the derivation of that part of a product (the wheel cover), but only acted to identify the manufacturer in respect of the product in all of its complexity (i.e., the whole car on which the cover is installed). In Wheeltrims’ opinion, therefore, placing the Ford trademark on the wheel covers offers only acts to “create on replacement parts aesthetic and descriptive features present on the original parts”.

The domestic court had doubts as to the relationship between the provisions of EU trademark law and those concerning Community designs, and so it addressed a pretrial question to the European Court of Justice, seeking in particular a determination of whether the “repair clause” provided in Article 110 of Regulation 6/2002 on Community designs allows for a trademark to be placed on certain products without the consent of the proprietor.

The Court of Justice found that the answer to that question raises no doubts whatsoever, and applied the procedure provided in Article 99 of the rules of procedure before the Court, pursuant to which, if the answer to a pretrial question raises no reasonable doubts, then, upon a motion by a judge rapporteur and after having heard the opinion of an Advocate General, the Court may, at any time,



issue a ruling in the form of a decision with justification.

In the decision in this case, the Court of Justice stated that the provisions of Regulation 6/2002 on Community designs can in no way limit the application of the provisions concerning trademarks. Directive 2008/95 and Regulation 207/2009 achieve the full harmonization of provisions concerning protection rights to trademarks, and in that way determine the rights enjoyed by a proprietor of a trademark. In the view

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of the Court of Justice, these provisions must be interpreted as not allowing a manufacturer to affix to its products (such as wheel covers) a sign identical to a trademark registered by a producer for motor vehicle, without obtaining the latter's consent.

EU: A DECISION MUST BE DULY JUSTIFIED – RULING OF THE EU GENERAL COURT IN THE CASE OF THE WORD TRADEMARK “WINNETOU”

Dorota Koseła

In a ruling of March 18, 2016 (case ref. No. T-501/13) in the case of a complaint by Karl-May-Verlag GmbH (the “Plaintiff”), the Court annulled a decision by the OHIM First Board of Appeal within the scope in which that decision ruled in favor of a motion to invalidate a trademark.

In that decision, issued on July 9, 2013, the OHIM partially annulled the right to the disputed word trademark “WINNETOU”, in all classes except for “printer's type” and “printing blocks”. The application for a declaration of invalidity was submitted by Constantin Film Produktion GmbH, appearing before the Court as an intervener. In considering

the case, the Board of Appeal pointed out that the word “WINNETOU” is not related to any of the languages of the European Union. In the opinion of the Board, an analysis should first be made in respect of German-speaking consumers. For these, the word “WINNETOU” evokes a noble, fictional Native American who is a good chieftain. The OHIM referred

to a ruling by the German Federal Court of Justice that the word is descriptive in Germany in relation to printing materials, film production, and book and magazine publishing.

The Plaintiff filed an appeal with the Court, seeking the annulment of that decision. It charged that the OHIM decision breached the principle of the autonomy and independence of a Community trademark and the system of Community trademarks by relying on German case law. The Court agreed with that argument of the Plaintiff. While it found that the OHIM Board of Appeal was right to take account of rulings by German courts on the designation “WINNETOU”, such previous rulings cannot be binding on the Board of Appeal, even if they refer to the same designation.

The Court also raised ex officio that there had been an infringement of the obligation to justify a decision. Pursuant to Article 75 sentence 1 of Council Regulation (EC) No. 207/2009 of February 26, 2009 on the Community trade mark, OHIM decisions must contain a description of the reasoning on which they are based. Such a justification should be provided especially in the case of a refusal to register a designation as a Community trademark. In the opinion of the Court, the Board of Appeal did not make any detailed analysis in order to determine that the designation “WINNETOU” – apart from its specific meaning referring to a fictional character – is perceived by the relevant target group as referring to the



concepts “Native American” or “Native American chieftain”. The contested decision did not contain any evaluation or conclusions as to how the designation would be perceived in respect of the general concepts “Native American” and “Native American chieftain”. The contested decision is insufficiently justified as to how the designation “WINNETOU”, apart from its specific meaning referring to a fictional character, is perceived in respect of the concepts “Native American” or “Native American chieftain”. The Court also found that there was no proper indication of how the Board of Appeal reached the conclusion that the contested trademark is descriptive in that a consumer will assume that the designation “WINNETOU” only describes a fact, that it concerns a film or book about “WINNETOU”, or some other goods of that type.

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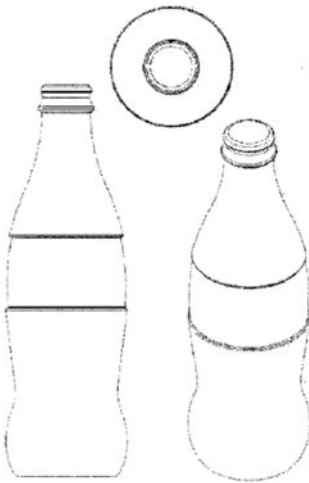
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EU: RULING OF THE EU GENERAL COURT REFUSING TO REGISTER A COMMUNITY TRADEMARK IN THE FORM OF A “CONTOURED BOTTLE WITHOUT FLUTES”

Aleksandra Stachera

On February 24, 2016, the EU General Court dismissed a complaint by the Coca-Cola Company against a decision by the OHIM refusing to register a Community trademark in the form of a “contoured bottle without flutes”.



The General Court found that a particular feature of the mark submitted is its curved silhouette. That feature, however, constitutes only a variant of the form of packaging of goods, but does not permit an average consumer to distinguish those goods from those of other businesses.

Furthermore, goods bearing that mark are goods of daily use, addressed towards all consumers. Therefore, the level of attention paid by the relevant target group should be deemed as average.

Nor did the EU General Court agree with the arguments of the plaintiff, which claimed that the trademark submitted had obtained distinctiveness as part of a contoured bottle with flutes. In the opinion of the plaintiff, this is proved, inter alia, by the fact that the trademark submitted has been used by third parties in various forms of cultural expression. Since the works of various artists refer to the Coca-Cola bottle, the mark submitted is distinctive. In this scope the Court referred to earlier rulings, according to which a mark's acquiring distinctiveness through use requires that at least a significant part of the relevant target group of consumers identifies given goods or services as deriving from a specific business thanks to that mark. However, the circumstances in which the condition for acquiring distinctiveness through use

may be deemed fulfilled cannot be identified solely on the basis of general and abstract data (see: Bottega Veneta International/OHIM T-409/10). The EU General Court therefore found that the assessment made in this case did not provide sufficient proof that the trademark submitted had acquired distinctiveness through use throughout the European Union for a significant part of the relevant target group.

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For these reasons, the EU General Court dismissed the Coca-Cola Company's complaint against the OHIM's decision not to register a Community trademark in the form of a "contoured bottle without flutes".

EU: UNSUCCESSFUL ATTEMPT TO REGISTER A MARK IN THE FORM OF THE OUTLINE OF THE CREST OF A SPORTS CLUB – RULING OF THE EU GENERAL COURT IN THE CASE FÚTBOL CLUB BARCELONA V. OHIM

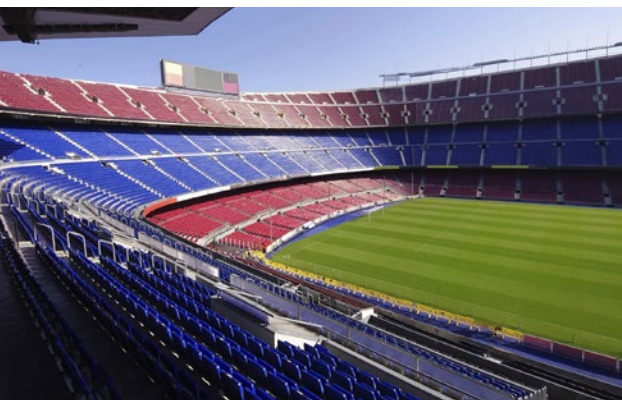
Piotr Wenski

In a ruling of December 10, 2015 in case No. T-615/14, the EU General Court upheld a decision by the OHIM First Board of Appeal dismissing a complaint against a refusal to register

a graphic trademark in the form of the outline of the crest of the sports club Fútbol Club Barcelona.



On April 24, 2013, Fútbol Club Barcelona submitted a graphic Community trademark showing the outline of its



club crest to the OHIM. The application was made for goods and services from classes 16, 25, and 41 of the Nice Classification (including photographic and paper materials, magazines, clothing, footwear, and sporting and cultural events). In a decision of October 15, 2013, the OHIM expert rejected the application for registration due to the existence of an absolute grounds for a refusal to register. The mark submitted lacks distinctiveness. That decision was later upheld by the OHIM First Board of Appeal. It was shown that the mark submitted contains no element which could attract a consumer's attention, thereby acting as an indicator of the origin of the goods or services concerned. The Board of Appeal found that the mark submitted did not differ significantly from other basic forms in general use in various sectors of the market for purely decorative purposes, which do not function as trademarks. It was also found that Fútbol Club Barcelona had not adequately demonstrated that the mark submitted had acquired secondary distinctiveness. The relevant target group of consumers was said to be the average consumer, who is informed at an average level and is sufficiently attentive and circumspect.

In its complaint to the Court, Fútbol Club Barcelona argued, firstly, that the mark submitted has primary distinctiveness. In the plaintiff's opinion, the OHIM Board of Appeal's contrary view was factually groundless. The plaintiff argued that the appearance of the mark submitted is unique, and as such is easily remembered by the average consumer and evokes

an association with the Fútbol Club Barcelona club. In its second claim, the plaintiff argued that the mark submitted had acquired secondary distinctiveness through use in trademarks registered for the benefit of the plaintiff and as an element of other marks.

In its ruling, the EU General Court found no errors in how the OHIM had considered the case, and refused to register the mark. First, the Court pointed out that the mark submitted for registration does not contain any element at all capable of attracting consumers' attention. In effect, that mark will be perceived by consumers as a simple shape which does not enable them to distinguish the products and services of the plaintiff from those of other businesses. The Court also shared the view of the OHIM Board of appeal that the differences between the outline of the crest of the plaintiff and the outlines of the crests of other clubs are perceptible to the average consumer only when a direct comparison between them is made. None of the specific features of the mark submitted, however, will remain in the memory of such a consumer, and this amounts to a lack of distinctiveness.

In reference to the second claim raised by Fútbol Club Barcelona in which the disputed mark had acquired distinctiveness through use (secondary distinctiveness), the Court also disagreed with the opinion of the plaintiff. It held that Fútbol Club Barcelona had not presented adequate arguments in support of its assertion that the mark

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submitted is perceived by the relevant target group as indicating the original of the goods and services specified in the application. Further, in respect of the plaintiff's arguments concerning the use of the mark submitted together with other trademarks registered for its benefit, the General Court also agreed with the position taken by the OHIM. The Court

found that the mark submitted is not sufficiently different from the other marks with which it is used to hold that it had thereby acquired distinctiveness. In the view of the Court, it is also not reasonable to argue that the mark submitted had acquired distinctiveness through use as an element of other marks. The plaintiff had not shown that the outline of the crest plays a significant or dominant role in the perception of those signs, while only in such a situation would it be possible to acknowledge that it had secondary distinctiveness.

All of the above circumstances led to a refusal to register the mark.

EU: REAPING BENEFITS FROM THE DISTINCTIVENESS OR RENOWN OF THE EARLIER TRADEMARK “SPA WISDOM” V. “SPA” – RULING OF THE EU GENERAL COURT

Ewelina Madej

On February 22, 2010, the company The Body Shop International applied for the registration of the word mark “SPA WISDOM” as a Community trademark for goods from class 3 of the Nice Classification, in particular for cosmetic products.

That registration was opposed by the company Spa Monopole. The objection lodged by the latter company was based on a series of earlier trademarks

containing the word “spa” registered in the Benelux countries. In particular, it was based on the word trademark “SPA” registered under number 389 230

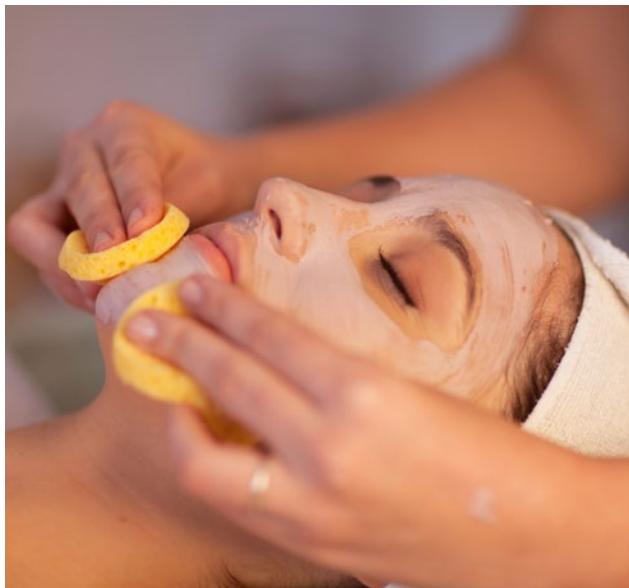
for goods from class 32 of the Nice Classification, including in particular mineral waters and carbonated waters.

The OHIM found in favor of the objection by Spa Monopole and refused to register the mark “SPA WISDOM”. The OHIM concluded that there existed a risk that the use of that mark could lead to undue benefits being reaped from the distinctiveness or renown of the earlier mark “SPA”. The Body Shop International appealed against that decision, but its complaint was rejected by the OHIM in January 2014. The matter came to the Court.

The Court found that the word “spa” may be a generic (descriptive) term for places offering hydrotherapy, such as baths and saunas, but not for cosmetic products. It also held that the trademark “SPA” is used in the Benelux countries and had acquired a high degree of renown in relation to the goods it covered.

The Court found that there is an average amount of similarity between the designations. Further, it also held that the target group to which products bearing the disputed marks are addressed (consumers in the Benelux countries) could reach the conclusion that some connection exists between the marks. This is suggested by certain similarities between the goods the designations refer to, and by the familiarity (renown) of the earlier word trademark “SPA”.

The Court drew attention to the circumstances that the mark “SPA” and



the message it conveys refer to health, beauty, cleanliness, and a wealth of minerals. These attributes also apply to cosmetic products, whose purpose is to protect, care for, and maintain healthy skin. In light of the above, in the Court’s opinion there is a risk that the use of the mark “SPA WISDOM” could lead to undue benefits being reaped from the distinctiveness and renown of the trademark “SPA” and the image it evokes. Consequently, it would be easier to market products covered by the application for registration of the disputed mark due to an association with the earlier mark. For this reason, the Court ruled that the designation “SPA WISDOM” cannot be registered as a Community trademark.

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EU: USE OF A TRADEMARK IN AN ADVERTISEMENT WITHOUT THE CONSENT OF THE PROPRIETOR – RULING OF THE EUROPEAN COURT OF JUSTICE IN CASE C-179/15 DAIMLER AG V. EGYÜD GARAGE GÉPJÁRMŰJAVÍTÓ ÉS ÉRTÉKESÍTŐ KFT

Piotr Wenski

On March 3, 2016, case No. C-179/15, the European Court of Justice ruled on the scope of entitlements of the proprietor of a trademark to forbid third parties from using that mark in advertising.

The ruling was issued in connection with a pretrial question from a court in Budapest conducting proceedings begun as a result of a claim by Daimler

AG (a manufacturer of passenger cars and the proprietor of the Mercedes-Benz brand) lodged against Együd Garage Gépjárműjavító és Értékesítő Kft, a company which services Mercedes brand vehicles. Up to March 31, 2012, the two companies were tied by an agreement for the provision of post-sales services, on the basis of which Együd Garage serviced Mercedes cars. The company was also entitled under



the agreement to use the descriptor “authorized Mercedes-Benz service point” and to use the following word-graphic trademark:

„Mercedes-Benz”

In order to promote its business, Együd Garage Gépjárműjavító és Értékesítő Kft commissioned external suppliers to prepare advertisements using the Mercedes-Benz trademark and the phrase “authorized service point”. On some internet advertising sites, such advertisements appeared without the knowledge or consent of Együd Garage Gépjárműjavító és Értékesítő Kft.

Following the termination of the agreement with Daimler AG, Együd Garage Gépjárműjavító és Értékesítő Kft took steps aimed at removing all instances of the use of the disputed trademark which could lead consumers to believe that a contractual relationship still existed between and Daimler AG. In particular, Együd Garage Gépjárműjavító és Értékesítő Kft requested that entities provided advertising services for its benefit change the content of those advertisements so that it was no longer portrayed as an authorized Mercedes-Benz service point. It also approached companies running a number of other internet services on which advertisements connecting Együd Garage Gépjárműjavító és Értékesítő Kft with the Mercedes-Benz brand had appeared without's Együd Garage Gépjárműjavító és Értékesítő Kft consent, demanding the removal of such advertisements.

Despite the measures taken by Együd Garage Gépjárműjavító és Értékesítő Kft, advertisements portraying the company as an authorized Mercedes-Benz dealer and using the disputed trademark continued to be accessible on the internet. Daimler AG, therefore, brought a claim to the Hungarian court, seeking a ruling that Együd Garage Gépjárműjavító és Értékesítő Kft was using the disputed trademark without the consent of the proprietor, and ordering Együd Garage Gépjárműjavító és Értékesítő Kft to remove the contested advertisements, to cease further infringements, and to publish an appropriate correction in domestic and local newspapers. The Hungarian court decided to suspend the proceedings and address a pre-trial question to the European Court of Justice, requesting a determination of whether the proprietor of a trademark has the right to forbid a third party from using that mark in advertising also in a situation where the advertisement was not placed on the internet by that third party and where the third party had sought the removal of the advertisement.

The ECJ, making an interpretation of Article 5 par. 1 a) and b) of Directive 2008/95/EC, answered the question in the negative. In respect of the advertisements commissioned by Együd Garage Gépjárműjavító és Értékesítő Kft and not removed from the internet despite that company's request to do so, the ECJ stated that Együd Garage Gépjárműjavító és Értékesítő Kft cannot be held liable for the actions of other independent commercial entities.

According to the Court, the facts of the case show that there was no use at the entire Mercedes-Benz trademark by Együd Garage Gépjárműjavító és Értékesítő Kft. The Court referred to an interpretation of “using”, showing that its essence consists in “active behaviour and direct or indirect control of the act constituting the use”. In the Court’s view, there was no such situation in the case at hand. The Court also interpreted the appropriateness of Article 5 par. 1 of Directive 2008/95, and stated that only a third party who directly or indirectly controls of the act constituting the use is able to comply with the prohibition as

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defined in that provision and to stop that use. In the Court’s opinion, the notion that any potential economic benefits to Együd Garage Gépjárműjavító és Értékesítő Kft from the continued presence of the disputed advertisements on the internet provide a basis for that entity’s liability cannot be reconciled with the purpose of Article 5 par. 1 of Directive 2008/95.

PL: PROTECTION OF GEOGRAPHICAL INDICATIONS OF SPIRITS – RULING OF THE ECJ OF JANUARY 21, 2016

Marlena Wach

The company Viiniverla Oy, incorporated under Finnish law, (“Viiniverla”) has been producing and selling cider spirits under the name “Verlados” since 2001. On November 23, 2012, as a result of a complaint of an infringement of the French geographical indication “Calvados”, the European Commission approached the Finnish authorities with a request for clarification on the use of the name “Verlados”.

In response, the Finnish authorities showed that the drink “Verlados” is a local product whose name derives directly from the place in which it is produced, namely, the village Verla and the Verla winery. The Finnish authorities also stated that the names “Calvados”

and “Verlados” have only the last syllable in common. The Commission sent a motion for additional information to the Finnish authorities in which the Commission stated that, on the basis of Article 16 letter b) of Regulation of the European Parliament and of the

Council No. 110/2008 of January 15, 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks (“Regulation 110/2008”), the name “Verlados” is inadmissible, and notified Finland of its intention to initiate proceedings in the matter of an infringement if the Finnish authorities did not agree with that interpretation. In the Commission’s opinion, the ending “ados” of the name “Verlados” is sufficient to be an evocation of the name “Calvados” in the meaning of ECJ case law.

As a result, Sosiaali- ja terveystieteiden lupa- ja valvontavirasto (the Office of Control and Supervision of Social and Health Care, the “Office”) issued, on the basis of Article 43 par. 1 of the Finnish Alcohol Act, a decision prohibiting Viiniverla from selling spirits under the name “Verlados”, effective as from February 1, 2014.

Viiniverla applied to the Commercial Court with a complaint, seeking the annulment of the decision of the Office of November 18, 2013 prohibiting the company from selling spirits under the name “Verlados” as from February 1, 2014. Viiniverla argued before the court that the use of the name “Verlados” has no hallmarks of improper use, imitation, or evocation with the product “Calvados”, and therefore does not breach EU law on geographical indications. On January 21, 2016, the European Court of Justice issued a ruling in the case (ref. No. C-75/15). A motion for the issuance of a preliminary ruling was filed by the Market Court in Finland. The motion concerned an interpretation of Article 16 letter b)

of Regulation 110/2008. The ECJ ruled that Article 16 letter b) of Regulation 110/2008 must be interpreted that in order to determine whether there has been an “evocation” in the meaning of that provision, the domestic court must address the manner of perception of an average, properly informed and sufficiently attentive and circumspect consumer, where this is to be understood as describing a European consumer, and not only a consumer of the member state in which the product which may refer to a protected geographical designation is produced.

Further, Article 16 letter b) must be interpreted such that, in order to evaluate whether the name “Verlados” constitutes an “evocation” in the meaning of that provision of the protected geographical indication “Calvados” for similar products, the court must take account of the phonetic and visual similarities between the two names, as well as of elements which could possibly suggest that such a similarity is not a mere coincidence. It must therefore be determined whether, in a situation where an average, properly informed and sufficiently attentive, circumspect European consumer encounters that product name, that consumer will make a mental association with the protected geographical indication.

The product “Verlados” was initially called “Verla”, and the suffix “dos” was added only recently, following a significant increase in exports of Calvados to Finland in the years

1990–2001. Furthermore, as the French government has shown, the syllable “dos” has no specific meaning in the Finnish language. In such circumstances, the verification of which



falls within the remit of the Finnish court may constitute conditions for holding that the similarity in question is not the result of coincidence. Article 16 letter b) of Regulation 110/2008 should be interpreted such that the use of a name which is deemed an “evocation” – in the meaning of that provision – of a geographical indication as specified in Schedule III to that Regulation cannot be admitted to trade, even where there is no likelihood whatsoever of consumers being misled.

Summarizing the ruling, it must be emphasized that, pursuant to Article 15 par. 1 of Regulation 110/2008, a “geographical indication” points to the origin of spirit drinks within the territory of a country, region or place in the case where the quality, renown or other property of the spirit drink is fundamentally ascribed to that geographical territory.

Article 16 letter b) of Regulation 110/2008 protects geographical indications against “evocation”, even if the actual place of origin of the product is indicated or if the geographical indication is translated, or if there are accompanying descriptors such as “similar” “type”, “style”, “produced”, “flavor”, etc.

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EU: LIKELIHOOD OF CONSUMERS BEING MISLED – “ELMA” V. “ELMEX” – RULING OF THE EU GENERAL COURT

Ewelina Madej

On December 7, 2015, the company Enosi Mastichoparagagon Chiou (“Enosi”) filed an application for the registration of an international trademark within the territory of the European Union. Registration was sought for the word designation “ELMA” for goods of class 5 of the Nice Classification, i.e., for chewing gum designated for medical and dental purposes containing mastic from Chios, for dental mastic and dental materials containing mastic from Chios, and for oral cavity products designated for medical, dental, and hygienic purposes containing mastic from Chios.

An objection to that registration was filed on August 10, 2007, by the company Gaba International Holding GmbH (“Gaba”), on the basis of an earlier Community trademark, “ELMEX”, registered on July 22, 1999, under number CTM 000703546. That mark was registered for class 3 (cosmetic products and preparations, products and preparations for oral and dental care), class 5 (pharmaceutical and hygienic products and preparations, products and preparations for oral and dental care) and class 21 (toothbrushes). The objection was approved, leading the company Enosi to file an appeal, which was also finally dismissed. In this case it was held

that, in relation to the disputed marks, there exists a likelihood of consumers being misled. Both the designations themselves and the goods they relate to were compared. As a result of that comparison, the OHIM Fourth Board of Appeal concluded that the goods are very similar to each other, whereas the designations themselves feature an average level of visual and phonetic similarity. They could not be compared on the semantic level because neither designation has any meaning.

The EU General Court ruled on the dispute similarly. It found, first of all, that the high degree of similarity between the goods concerned results in a likelihood of consumers being misled. Further, as a result of comparing the designations, the Court reached the conclusion that, in the case of relatively short designations, the central syllable is as important as the initial or final syllables. It must be considered that an average consumer rarely has an opportunity to make a direct comparison between different trademarks, and must rely on the imperfect image of those marks which he or she retains in his mind. Further, when assessing the visual similarity between two word marks, what is important is the presence in each of them of specific

letters appearing in the same order. In the case at hand, the designation “ELMA” contains four letters, and the designation “ELMEX” five. Each begins with the same three letters, “e”, “l” and “m”. Their final letters differ: “a” as opposed to “e” and “x”. This difference, however, is insufficient. An analysis of the phonetic layer showed that the designations are similar (the syllables “el” and “ma” and the syllables “el” and “mex”). The fact that the first syllable in each designation is the same (“el”) increases the phonetic similarity between them. As to the semantic level of the designations, it was shown

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that the word “elma” is an uncommon girl’s name and the name of small towns in the United States, while the word “elmex” is devoid of any meaning whatsoever in any of the languages of the European Union. The EU General Court found, therefore, that it was not possible to evaluate the designations on the semantic level.

PL: SHELF FEES – RESOLUTION OF THE POLISH SUPREME COURT OF NOVEMBER 18, 2015

Marlena Wach

The claimant, D. S.A. in liquidation, demanded that C. sp. z o.o. return the amount of PLN 1,694,526.93 unduly collected during a period of cooperation as a discount on turnover, and the amount of PLN 103,879.46 for advertising services not performed.

The parties had concluded an agreement on long-term business cooperation pertaining to the sale of interior fit-out elements produced by the claimant. That agreement provided a cash bonus for the defendant (called a discount after the agreement was amended) calculated from net sales achieved during the agreed settlement period.

In a ruling of June 4, 2014, the Regional Court awarded from the defendant, for the benefit of the receiver of the bankruptcy estate of D. S.A. in liquidation, the amount of PLN 867,562.39, and dismissed the remainder of the claim. Only the discount from the second half of 2010 was deemed by the Court as justifiable,

equivalent to economic benefits reaped by the claimant during that period. Both sides to the dispute appealed against the ruling of the Regional Court. In considering the appeals, the Court of Appeal raised doubts concerning the legal nature of the post-sales discount provided in the agreement, and addressed the following legal question to the Supreme Court for consideration: Does a post-sales discount paid to a buyer by a seller when a certain amount of sales determined by the parties is achieved constitute a fee other than a commercial margin as foreseen in Article 15 par. 1 pt. 4 of the Act on Combating Unfair Competition of April 16, 1993, (the “ACUP”)?

On November 18, 2015,, the Supreme Court issued a resolution (case file No. III CZP 73/15), in which it stated that, in commercial relations between a buyer running a chain of stores and a supplier, in an agreement it is possible to include a monetary bonus which depends on the amount of turnover as a post-sales discount which does not constitute a fee as foreseen in Article 15 par. 1 pt. 4 ACUC. That provision states that it is an act of unfair competition to hinder the access of other businesses to the market, including by collecting fees other than a commercial margin for accepting goods for sale. That provision is an elaboration of Article 3 par. 2 ACUC, in which examples are provided of a number of acts of unfair competition, including hindering access to the market, and of Article 3 par. 1, which defines an act of unfair competition as an act contrary to

the law or good custom, if it threatens or infringes the interests of another business or a customer.

The implementation of Article 15 par. 1 pt. 4 ACUC to the legal system was made for the purpose of improving the competitiveness of small and medium-sized businesses by eliminating the practice of commercial chains collecting “shelf fees”, that is, fees collected from suppliers in exchange for the change of establishing or continuing commercial cooperation with a given chain. What is essential when applying that provision is to interpret the scope of the concept it contains of “fees other than a commercial margin for accepting goods for sale”. A margin, which is an element of price, is not a “fee for accepting goods for sale”. Since the purpose of Article 15 par. 1 pt. 4 ACUC was to eliminate situations in which the conclusion of a supply or sale agreement was dependent on an additional monetary consideration paid by a supplier/seller, fees which result in a price reduction are not covered by that provision. The sales agreement and the conditions thereof remain, therefore, beyond the scope of Article 15 par. 1 pt. 4 ACUC. That provision prohibits chains from collecting monetary amounts from supplier/sellers which are not actually justified by the performance of the buyer, other than those whose performance directly results from the sales/supply agreement, or in a situation where the conclusion of the agreement itself is the equivalent of a monetary consideration by the supplier/seller.

Accepting these discounts (and similar items) is, in principle, beyond the catalogue of fees covered by Article 15 par. 1 pt. 4 ACUC and does not mean that they are excluded from the control of the courts on the grounds of that provision. In case of law and literature, the view has been expressed that it is permissible for a court to assess whether a margin established does not hide an unjustifiable “shelf fee”, and therefore, whether a discount is not something other than a commercial margin. This may occur if the amount of the margin differs significantly, to the detriment of the supplier, from margins collected from other similar agreements concerning similar goods, if those margins are not reasonably uniform, if the parties do not establish conditions in which a buyer has the right to a price reduction, or if they do not establish the amount of the price reduction, leaving it to the

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unilateral discretion of the buyer. Such circumstances may indicate that the discount was a sham. Determining the existence of such camouflaged fees would result in the discount being read as an impermissible fee in the meaning of the above provision. Therefore, there is no doubt that, in the event of a dispute over the nature of a fee other than a margin, each case must be analyzed individually, and the final conclusion reached will depend equally on the content of the agreement and the manner in which it was performed – that is, on the facts of the case.



FR: SWATCH (WIPO NO. 506 123) / ICE WATCH (WIPO NO. 1 029 087) – SECOND TIME COMES THE CHARM?

Claude Armingaud, Audrey Decima

On October 6 2015, the Commercial Division of the French Supreme Court (“Cour de Cassation”) confirmed the refusal of Paris Court of Appeal to register the “Ice Watch” trade mark. This decision follows the 2008 co-existence agreement concluded between the respective owners of the “Swatch” trademark and the “Ice Watch” business.

Divergences upon the interpretation of this agreement led Swatch to oppose the designation of both the French and European territories in the January 7, 2010 application of the international trade mark “Ice Watch” before the French and Community trademark offices (respectively, the “INPI” and the “OHIM”)

On February 13, 2013, INPI Director rejected the opposition relating to the French territory. A week later, the OHIM welcomed the opposition for the European territory on the ground of Article 8.1.b of the Community Trademark Regulation and the likelihood of confusion by phonetic association of both signs and the strong distinctiveness of the earlier “Swatch” trademark.

The French decision was subsequently appealed and led to the cancellation of the INPI Director’s decision, on the ground of similarities from the overall impression given by comparison of the signs.

The Court of Appeal estimated that graphic elements of “Ice Watch” were subsidiary and did not allow a sufficient distinction between the signs, potentially resulting in confusion on the part of relevant consumers, notably given the reputation of the earlier trademark. The Court estimated that the applied trademark would therefore benefit from the notoriety of the earlier trademark.

The French Supreme Court confirmed this position, highlighting the dominance of the verbal components of the word and figurative signs “Ice Watch” and the analysis based on the overall impression created by both signs. In the meantime, the parties entered into a new co-existence agreement, which may as well end the legal developments... until the next divergence of interpretation of this agreement. Only time will tell!

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FR: TRADEMARK REFUSAL ON THE GROUND OF POLITICS

Claude Armingaud, Audrey Decima

Following the November '15 events in Paris, the French Trademark Office ("INPI") received and subsequently rejected numerous attempts of registration of the signs "Pray For Paris" and "Je Suis Paris" ("I am Paris").

The refusals were justified on the ground that *"these signs consisted in terms which may not be monopolized by an economic actor due to their use and perception by the collectivity"*.

This position differed from the one expressed after the January 7, 2015 attacks against Charlie Hebdo, where the attempts to register *"Je Suis Charlie"* (*"I Am Charlie"*) had been refused on public order grounds.

Further to Articles L711-1 and L711-3 of the French Intellectual Property Code, a sign has to be distinctive, available and lawful to be registered. The INPI Director's decision dated November 20, 2015 retained the unlawfulness of the applied signs, considering their perception by the public.

From a European point of view, such refusal could also be admitted on the ground of Article 7.1.f of the Community Trademark Regulation.

However, if the French decision appears politically appropriate, its basis may be seen as legally weak. Indeed, the words themselves are not unlawful, while their relations to terrorist attacks, and the intent to market on such events, could be interpreted as an offense to public order.

The INPI based its interpretation on the very nature of the trademark, which is *"to distinguish goods and services"* without confusion as to their origins, as per Article L711-1 of the French Intellectual Property Code.

In the meantime, *"Pray For Paris"* and *"#PrayForParis"* have been respectively registered in the UK in 2013 (and consequently without pre-existing relation to the November '15 events) and applied for in Germany the day following the event.

It remains to be seen if a common European position emerges from the tragedy.



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FR: THE 3D PEN IS MIGHTIER

Claude Armingaud, Audrey Decima

The BIC company registered the shape of its renowned pens as a tri-dimensional Community trademark in 1997.

Further to customs seizure in Saint-Malo, France, BIC sought legal remedy against the alleged infringement, only to be naturally opposed by the defendant that the tri-dimensional trademark was invalid.

Indeed, Article 7.1 e) (iii) of the Community Trademark Regulation provides that a Community trademark may not “consist exclusively of [...] the shape which gives substantial value to the goods.”

Such provision aims at avoiding that a trademark, which may be renewed without limitation in time, takes over other IP rights which may be extinguished sooner.

In its November 19, 2015 decision, the Court of Paris (“Tribunal de Grands

Instance de Paris”) highlighted that “the value granted by the shape of a product is substantial when the esthetical value is likely to dictate the consumers’ choices, when the shape is the determining factor in the buying process, and thereby of the commercial value of the considered product.”

However, in BIC’s case, instead of the aesthetic of the product, the determining factor was considered to be the value for money ratio, the durability and writing comfort. Consequently, the trademark has been upheld.

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FR: “LE JOURNAL D’ANNE FRANK” COMMUNITY TRADEMARK – APPLICATION N°11.063.307 – CASE R2401.2014-4

Claude Armingaud, Audrey Decima

One year after the rejection of the application of the trademark “*Le journal d’Anne Frank*”, the Fourth Board of Appeal of OHIM cancelled this decision. On December 20 2013, the Anne Frank Fonds applied for the registration of the Community word mark. In August 2014, the application was rejected by the OHIM examiner, stating that the notoriety of the story characterized a lack of distinctiveness. One of the arguments was to distinguish this application from “*Harry Potter*” which had been registered as a trademark; it was reminded that the character whose name was registered was fictional.

The issues at stake were whether the real-life nature of the story and the name of its heroin affected the distinctive character of the applied trademark. To reject this statement, the Fourth Board highlighted that the notoriety of a story did not impact on its distinctiveness regarding its capacity to identify the origin of the expected goods or services. Moreover, the real-life nature of the story did not turn the brand descriptive, as the goods and services were not implicitly

related to the applied trademark.

Consequently, it could not be considered that “*Le journal d’Anne Frank*” fell into the generic French language useful for the competitors of the same market.

While, unlike French law, EU law does not recognize copyright as part of a prior right upon which an opposition to an application could be grounded, Article 52 of the Community Trade Mark Regulation nevertheless provides for the possibility to seek the cancelation of such trade mark further to its registration.

The saga goes on and the decision upon the final registration of the trademark “*Le journal d’Anne Frank*” is expected shortly.

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OTHER ISSUES

MOTION TRADEMARKS AS AN ELEMENT OF BRAND PROMOTION

Michał Ziółkowski

A motion mark may be an animation created using a computer program, or some other moving object which exists in the real world.

A moving logo

A motion mark may be an animation created using a computer program, or some other moving object which exists in the real world. In particular, such a mark may be in the form of a gesture made by a person using various parts of the body, especially the hand. Submitting a trademark application involves the same criteria of assessment as do other forms of trademarks, but motion marks remain a small fraction of the trademark applications made in the European Union.

A motion trademark should be distinctive, and should be possible to depict precisely in an application. The presentability of motion marks depends on being able to depict a series of movements by an appropriate arrangement of a sequence of images. It is also crucial to provide a sufficiently exact description of the mark, including the order and form of the movement occurring in the images. In a motion mark, it is precisely the motion and the succession of scenes which are the most important aspects which may be subject to protection. Care must also be taken, since motion marks cannot

appear in trade in “pure” form, but only as a combination of marks, for example, movement and sound (e.g., application CTM No. 003429909 showing clasping hands, used for some time by the company Nokia).

Despite their complexity, motion marks do not belong among those whose graphic presentability raises doubts in the majority of cases. The presentability of such marks is interpreted fairly liberally. A motion mark must be deemed perceptible by the sense of sight. It does exist, however, a certain doubt as to whether this type of trademark in every case meets the requirement of a uniform designation, for it may be the case that it is not possible to take in an animation by a single act of perception. When preparing a trademark application for a motion mark, it is necessary to ensure that the mark is suitably brief and coherent. A failure to meet the requirement of uniformity may be raised by the authority considering an application for registration of this type of mark

When a decision is taken on the protection of a motion mark, particularly one which presents a specific device or elements thereof in motion, an



application may be rejected by the authority if the mark is for the purpose of protecting the way the device works or its construction or function. A trademark is for the purpose of identifying the goods or services of a particular business and to distinguish them from those of other businesses. The perpetual monopoly resulting from the registration of a trademark should be not extended to technical solutions. Such features of goods, when they meet certain assumptions, may be the subject of limited patent protection.

Lambo doors

It is worth recalling the attempt to register the motion trademark “lambo doors” (application CTM No. 001400092). A sequence of movements showing the characteristic opening of the doors used in Lamborghini brand cars was not granted registration as a Community trademark by the OHIM. The submission of the mark consisted of a description of the way the doors open, together with four images showing a sequence of the motion of the doors. That mark did not achieve registration because of its lack

of distinctiveness and because it was not functional. The application was approved, however, in the USA, where this type of trademark presentation is treated more liberally.

Author’s opinion

Motion marks, which are non-conventional visual trademarks, depict the movement of objects, figures, or a combination thereof. Marks of this type may be presented as film, recordings or a moving logo, and may also be in the form of a designation composed of graphics and text combined in motion.

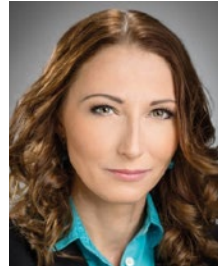
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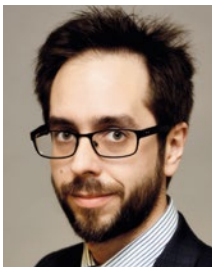
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