

Hasselblatt (ed.)

Community Trade Mark Regulation

A Commentary

C.H.BECK · Hart · Nomos

Hasselblatt (ed.)
Community Trade Mark Regulation

Community Trade Mark Regulation (EC) No 207/2009

A Commentary

edited by
Gordian N. Hasselblatt

2015

C. H. BECK · Hart · Nomos

Published by

Verlag C. H. Beck oHG, Wilhelmstrase 9, 80801 München, Germany,
eMail: bestellung@beck.de

Co-published by

Hart Publishing, 16C Worcester Place, Oxford, OXI 2JW, United Kingdom,
online at: www.hartpub.co.uk

and

Nomos Verlagsgesellschaft mbH & Co. KG Wilhelmstrase 3–5, 76530 Baden-Baden, Germany,
eMail: nomos@nomos.de

Published in North America (US and Canada) by Hart Publishing,
c/o International Specialized Book Services, 930 NE 58th Avenue, Suite 300,
Portland, OR 97213-3786, USA, eMail: orders@isbs.com

ISBN 978-3-406-65587-6 (Beck)
ISBN 978-1-84946-362-1 (Hart Publishing)
ISBN 978-3-8487-1282-3 (Nomos)

© 2015 Verlag C. H. Beck oHG
Wilhelmstr. 9, 80801 München

Printed in Germany by
Kösel GmbH & Co. KG
Am Buchweg 1, 87452 Altusried-Krugzell

Typeset by
Reemers Publishing Services GmbH, Krefeld

All rights reserved. No part of this publication may be reproduced, stored in a retrieval system, or transmitted, in any form or by any means, without the prior permission of Verlag C. H. Beck, or as expressly permitted by law under the terms agreed with the appropriate reprographic rights organisation.

Enquiries concerning reproduction which may not be covered by the above should be addressed to
C. H. Beck at the address above.

Foreword

The Community Trade Mark (CTM) is now widely recognised as a very important tool helping entrepreneurs both large and small to gain full access to the European single market while protecting their IP rights.

When OHIM was founded two decades ago, few would have predicted the popularity that the CTM enjoys today. Right from the start demand exceeded expectations and as the Office and the CTM celebrate their 20th year, the statistics speak for themselves.

Total applications from CTMs now top 1.3 million, and the Office has in the region of 350,000 users in almost 200 countries. Demand has continued to grow even through the current financial crisis.

But, in spite of the success and economic importance of the CTM, to date there is only a small body of literature dealing with this EU-level right which is aimed at the needs of IP professionals.

Under the editorship of Professor Hasselblatt, the current book, and a companion volume on the Registered Community Design (RCD) set out to address this gap in the market by providing comprehensive pan-European commentaries in English, covering the entire text of the relevant legislation for Community trade marks and designs, 'provision by provision'.

The volume on the CTM has been prepared against a background of considerable change in Intellectual Property Rights in the EU as the European Commission, Council and Parliament finalise the details of the new Trade Mark Package, which seeks to modernise and further harmonise the Regulation and the Directive.

These changes also reflect the increasingly international nature of business and the high value put by industry on IP rights. While two-thirds of CTM applications come from within the EU, one-third of them are made by companies from elsewhere, eager to trade within the single market.

The value of IP rights was confirmed by a recent study on the economic contribution of IPR-intensive industry, carried out by OHIM through the European Observatory on Infringements of Intellectual Property Rights, in partnership with the European Patent Office, and with the help of a number of other authorities.

The study, which for trade mark data examined CTMs and International Registrations, shows that 39 % of total economic activity in the EU – that is € 4.7 trillion of GDP (\$6.3 trillion) – is provided directly by industries that use IP rights intensively.

Approximately 26 % of all employment in the EU directly depends on the IPR-intensive industries and another 9 % of jobs rely indirectly on these industries and they also account for 90 % of external trade.

The study shows a strong inter-dependence of IP rights, since they are often used in combination, but trade marks emerge as being the IP right that is most relied upon.

The CTM, and its companion design right, the RCD, along with the Unregistered Community Design, are part of a two-tier system of trade marks and design rights. Consequently, OHIM works in close partnership with National IP Offices to provide a choice of national or EU-wide rights to entrepreneurs, depending on their business needs. This relationship has been reinforced by the success of the European Trade Mark and Design Network, which is building shared IT tools to modernise the trade mark and design system, and working to converge practices.

Against this background, it is refreshing to see the increased interest in providing detailed analysis of the legislation underpinning these important IP rights.

Foreword

Professor Hasselblatt is a well-known and highly respected figure in the IP world. A partner in the Cologne office of CMS Hasche Sigle, he is also adjunct professor at both the McGeorge School of Law, Sacramento, as well as the Chicago-Kent College of Law, and he is a member of GRUR's expert committee for trade mark and unfair competition law.

In addition to authoring a number of commentaries personally, Professor Hasselblatt has assembled for both volumes an impressive list of co-authors including leading figures in European Intellectual Property law drawn from a wide spectrum of law firms, faculties and authorities.

The commentaries are written 'by practitioners for practitioners', and as such are a very welcome and useful addition to the canon of literature on IP, deserving a place on the bookshelf of any professional or student interested in the Community trade mark and design system.

I commend him and his fellow authors for the scale and ambition of the work and am particularly pleased to see that the intention is to update both volumes regularly to keep pace with changes in legislation and practice.

António Campinos
President, OHIM

Preface

The international market for books in the field of intellectual property is largely saturated. There is, however, a noticeable void in the area of pan-European commentaries in the English language on both the Community Trade Mark Regulation (CTMR) and the Community Design Regulation (CDR). In fact, the low density of the available English language literature is in striking contrast to the commercial importance of the Community trade mark and the Community design. The present Commentary and the parallel work on the CDR aim to make a contribution to filling this gap.

This Commentary has been written by ‘practitioners for practitioners’, with a focal point on the application, registration and enforcement practice regarding Community Trade Marks. The authors of this work come from all walks of life and are all true trade mark experts; the band of authors encompasses practising lawyers, legal scholars, judges and OHIM officials. Suffice to say that the Commentary reflects the personal views of the authors and should not be attributed to their respective law firms and clients or particular cases. In the case of OHIM agents and officials, the views and opinions expressed do not necessarily reflect those of the Office.

Instead of reflecting the legal conception of one or a few Member States, the Commentary endeavours to interpret the CTMR from a European perspective, focusing on the plethora of decisions rendered by OHIM, the GC and the CJ, supplemented by important decisions handed down by the Community Trade Mark Courts, namely where such decisions were rendered in ‘landmark cases’.

The format corresponds to that of a ‘traditional’ German commentary, dealing with the entire text of the CTMR on an article by article basis. As far as possible, the commentaries on the individual articles are for the most part structured identically so as to enhance the user-friendliness of the work. In addition, by way of cross references, the reader’s attention is called to systematics not only in the CTMR, but also to similarities or differences in terms of the CDR. Where appropriate, the authors explain the practical implications of the provisions contained in the CTMIR and the CTMFR.

The CTMR commentary under A. obviously constitutes the main part of the present work. However, the CTMR does not regulate all of the proprietor’s rights but limits itself to the right to injunctive relief and to the claim for reasonable compensation under Article 9 (3) CTMR. The Regulation remains silent about all other claims. Under Art. 101 CTMR, the courts are to apply their national law on all matters not covered by the CTMR. This holds true, amongst others, to many remedies in infringement actions. Therefore, in order to achieve the quite ambitious goal of a ‘unitary character’ throughout the EU, it is of paramount importance to establish and maintain uniform standards for the enforcement of the CTMR in all EU Member States. At the same time, it has to be ensured that, as far as it is possible, these standards will be uniformly applied by the courts. In this respect, the Enforcement Directive (2004/48/EC) has proven to be quite valuable, as it provides for a harmonized body of law. As it is crucial for the proprietors of CTM rights to be familiar with said legal framework, under B. this Commentary deals with those measures and remedies that are not regulated in the CTMR.

Furthermore, under C. the Commentary includes a section explaining the enforcement of intellectual property rights under the national laws in each of the 28 Member States. This entails the assertion of the proprietors’ IP rights out of court as well as in litigation in summary and main proceedings. All of these ‘country reports’ are written by experts from the respective EU jurisdiction and follow a uniform structure.

Preface

The Commentary is rounded off by supplementary rules, such as implementing regulations and examination guidelines under D., followed by a Table of Cases under E., reflecting the decisions cited throughout this Commentary.

Most recently, the Commission's reform plans have triggered lively discussions, which are also dealt with in this Commentary. Certainly it is safe to say that, all in all, the CTMR has stood the test of time. Even after some 20 years its foundations remain perfectly valid. Nonetheless, it appears to be time to adapt the current system to the technological, commercial and political developments that have taken place over the past 25 years. Therefore, the Commission rightfully deems it necessary to modernise the EU trade mark system by making it more effective, efficient and consistent. The Commission submitted far-reaching reform proposals on 27 March 2013, which are aimed at a well-targeted modernization rather than a major overhaul of the current regime. At the time of printing the present Commentary, it could not be foreseen when and to what extent the proposals for a revision of the CTMR and a recast of the TMDir – seen by the Commission as one package – were going to mature into legal force. Owing to its importance, the Commission's reform efforts are discussed in detail in the present Commentary under Art. 1 CTMR mn. 42–60; moreover, individual aspects of the 27 March 2013 reform proposals are examined in the comments on the provisions concerned.

The authors, the publisher and the editor would be very appreciative of readers' comments and suggestions. Please send any feedback and criticism to gordian.hasselblatt@cms-hs.com.

Gordian N. Hasselblatt
Cologne, February 2015

Summary of Contents

Foreword	V
Preface	VII
List of Authors	XV
List of Abbreviations	XIX
General Bibliography	XXIII

A. Commentary	1
---------------------	---

TITLE I GENERAL PROVISIONS

Article 1 Community trade mark	4
Article 2 Office	35
Article 3 Capacity to act	38

TITLE II THE LAW RELATING TO TRADE MARKS

SECTION 1 Definition of a Community trade mark and obtaining a Community trade mark ...	46
Article 4 Signs of which a Community trade mark may consist	46
Article 5 Persons who can be proprietors of Community trade marks	59
Article 6 Means whereby a Community trade mark is obtained	63
Article 7 Absolute grounds for refusal	69
Article 8 Relative grounds for refusal	198
SECTION 2 Effects of Community trade marks	295
Article 9 Rights conferred by a Community trade mark	295
Article 10 Reproduction of Community trade marks in dictionaries	378
Article 11 Prohibition on the use of a Community trade mark registered in the name of an agent or representative	379
Article 12 Limitation of the effects of a Community trade mark	380
Article 13 Exhaustion of the rights conferred by a Community trade mark	396
Article 14 Complementary application of national law relating to infringement	411
SECTION 3 Use of Community trade marks	412
Article 15 Use of Community trade marks	412
SECTION 4 Community trade marks as objects of property	438
Article 16 Dealing with Community trade marks as national trade marks	438
Article 17 Transfer	455
Article 18 Transfer of a trade mark registered in the name of an agent	470
Article 19 Rights in rem	477
Article 20 Levy of execution	481
Article 21 Insolvency proceedings	484
Article 22 Licensing	488
Article 23 Effects vis-à-vis third parties	505
Article 24 The application for a community trade mark as an object of property	513

TITLE III APPLICATION FOR COMMUNITY TRADE MARKS

SECTION 1 Filing of applications and the conditions which govern them	514
Article 25 Filing of applications	514
Article 26 Conditions with which applications must comply	519
Article 27 Date of Filing	528
Article 28 Classification	532

Summary of Contents

SECTION 2 Priority	551
Article 29 Right of priority	551
Article 30 Claiming priority	559
Article 31 Effect of priority right	561
Article 32 Equivalence of Community filing with national filing	561
SECTION 3 Exhibition priority	563
Article 33 Exhibition priority	563
SECTION 4 Claiming the seniority of a national trade mark	566
Article 34 Claiming the seniority of a national trade mark	566
Article 35 Claiming seniority after registration of the Community trade mark	575

TITLE IV REGISTRATION PROCEDURE

SECTION I Examination of applications	577
Article 36 Examination of the conditions of filing	577
Article 37 Examination as to absolute grounds for refusal	588
SECTION 2 Search	604
Article 38 Search	604
SECTION 3 Publication of the application	605
Article 39 Publication of the application	605
SECTION 4 Observations by third parties and opposition	606
Article 40 Observations by third parties	606
Article 41 Opposition	610
Article 42 Examination of opposition	630
SECTION 5 Withdrawal, restriction, amendment and division of the application	640
Article 43 Withdrawal, restriction and amendment of the application	640
Article 44 Division of the application	644
SECTION 6 Registration	651
Article 45 Registration	651

TITLE V DURATION, RENEWAL, ALTERATION AND DIVISION OF COMMUNITY TRADE MARKS

Article 46 Duration of Registration	654
Article 47 Renewal	654
Article 48 Alteration	661
Article 49 Division of the registration	662

TITLE VI SURRENDER, REVOCATION AND INVALIDITY

SECTION 1 Surrender	666
Article 50 Surrender	666
SECTION 2 Grounds for revocation	670
Article 51 Grounds for revocation	670
SECTION 3 Grounds for invalidity	681
Article 52 Absolute grounds for invalidity	681
Article 53 Relative grounds for invalidity	689
Article 54 Limitation in consequence of acquiescence	693
SECTION 4 Consequences of revocation and invalidity	696
Article 55 Consequences of revocation and invalidity	696

Summary of Contents

SECTION 5 Proceedings in the Office in relation to revocation or invalidity	698
Article 56 Application for revocation or for a declaration of invalidity	698
Article 57 Examination of the application	702

TITLE VII APPEALS

Article 58 Decisions subject to appeal	707
Article 59 Persons entitled to appeal and to be parties to appeal proceedings	709
Article 60 Time limit and form of appeal	713
Article 61 Revision of decisions in ex parte cases	718
Article 62 Revision of decisions in inter partes cases	720
Article 63 Examination of appeals	722
Article 64 Decisions in respect of appeals	727
Article 65 Actions before the Court of Justice	730

TITLE VIII COMMUNITY COLLECTIVE MARKS

Article 66 Community collective marks	770
Article 67 Regulations governing use of the mark	785
Article 68 Refusal of the application	787
Article 69 Observations by third parties	789
Article 70 Use of marks	789
Article 71 Amendment of the regulations governing use of the mark	790
Article 72 Persons who are entitled to bring an action for infringement	791
Article 73 Grounds for revocation	792
Article 74 Grounds for invalidity	794

TITLE IX PROCEDURE

SECTION 1 General provisions	795
Article 75 Statement of reasons on which decisions are based	795
Article 76 Examination of the facts by the Office of its own motion	804
Article 77 Oral proceedings	815
Article 78 Taking of evidence	819
Article 79 Notification	833
Article 80 Revocation of decisions	840
Article 81 Restitutio in integrum	845
Article 82 Continuation of proceedings	864
Article 83 Reference to general principles	869
Article 84 Termination of financial obligations	873
SECTION 2 Costs	876
Article 85 Costs	876
Article 86 Enforcement of decisions fixing the amount of costs	896
SECTION 3 Information which may be made available to the public and of the authorities of the Member States	899
Article 87 Register of Community trade marks	899
Article 88 Inspection of files	903
Article 89 Periodical publications	913
Article 90 Administrative cooperation	916
Article 91 Exchange of publications	918
SECTION 4 Representation	920
Article 92 General principles of representation	920
Article 93 Professional representatives	924

Summary of Contents

TITLE X JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO COMMUNITY TRADE MARKS

SECTION 1 Application of Regulation (EC) No 44/2011	929
Article 94 Application of Regulation (EC) No 44/2011	929
SECTION 2 Disputes concerning the infringement and validity of Community trade marks	935
Article 95 Community trade mark courts	935
Article 96 Jurisdiction over infringement and validity	942
Article 97 International jurisdiction	945
Article 98 Extent of jurisdiction	954
Article 99 Presumption of validity – Defence as to the merits	957
Article 100 Counterclaims	961
Article 101 Applicable law	973
Article 102 Sanctions	977
Article 103 Provisional and protective measures	983
Article 104 Specific rules on related actions	994
Article 105 Jurisdiction of Community trade mark courts of second instance – Further appeal	1000
SECTION 3 Other disputes concerning Community trade marks	1002
Article 106 Supplementary provisions on the jurisdiction of national courts other than Community trade mark courts	1002
Article 107 Obligation of the national court	1004
SECTION 4 Transitional provision	1006
Article 108 Transitional provision relating to the application of the Convention on Jurisdiction and Enforcement	1006

TITLE XI EFFECTS ON THE LAWS OF THE MEMBER STATES

SECTION 1 Civil actions on the basis of more than one trade mark	1007
Article 109 Simultaneous and successive civil actions on the basis of Community trade marks and national trade marks	1007
SECTION 2 Application of national laws for the purpose of prohibiting the use of Community trade marks	1011
Article 110 Prohibition of use of Community trade marks	1011
Article 111 Prior rights applicable to particular localities	1018
SECTION 3 Conversion into a national trade mark application	1020
Article 112 Request for the application of national procedure	1020
Article 113 Submission, publication and transmission of the request for conversion	1033
Article 114 Formal requirements for conversion	1039

TITLE XII THE OFFICE

SECTION 1 General provisions	1043
Article 115 Legal status	1043
Article 116 Staff	1044
Article 117 Privileges and immunities	1048
Article 118 Liability	1052
Article 119 Languages	1056
Article 120 Publication and entries in the Register	1075
Article 121	1080
Article 122 Control of legality	1081
Article 123 Access to documents	1083
SECTION 2 Management of the Office	1086
Article 124 Powers of the President	1086
Article 125 Appointment of senior officials	1088

Summary of Contents

SECTION 3 Administrative Board	1090
Article 126 Creation and powers	1090
Article 127 Composition	1092
Article 128 Chairmanship	1093
Article 129 Meetings	1094
SECTION 4 Implementation of procedures	1096
Article 130 Competence	1096
Article 131 Examiners	1098
Article 132 Opposition Divisions	1100
Article 133 Administration of Trade Marks and Legal Division	1102
Article 134 Cancellation Divisions	1105
Article 135 Boards of Appeal	1107
Article 136 Independence of the members of the Boards of Appeal	1112
Article 137 Exclusion and objection	1118
SECTION 5 Budget and financial control	1121
Article 138 Budget Committee	1121
Article 139 Budget	1124
Article 140 Preparation of the budget	1129
Article 141 Audit and control	1130
Article 142 Auditing of accounts	1132
Article 143 Financial provisions	1133
Article 144 Fees regulations	1134

TITLE XIII

INTERNATIONAL REGISTRATION OF MARKS

SECTION I General provisions	1144
Article 145 Application of provisions	1144
SECTION 2 International registration on the basis of applications for a Community trade mark and of Community trade marks	1154
Article 146 Filing of an international application	1154
Article 147 Form and contents of the international application	1159
Article 148 Recordal in the files and in the Register	1169
Article 149 Request for territorial extension subsequent to the international registration	1170
Article 150 International fees	1175
SECTION 3 International registrations designating the European Community	1177
Article 151 Effects of international registrations designating the European Community	1177
Article 152 Publication	1182
Article 153 Seniority	1185
Article 154 Examination as to absolute grounds for refusal	1188
Article 155 Search	1193
Article 156 Opposition	1194
Article 157 Replacement of a Community trade mark by an international registration	1200
Article 158 Invalidation of the effects of an international registration	1202
Article 159 Conversion of a designation of the European Community through an international registration into a national trade mark application or into a designation of Member States	1204
Article 160 Use of a mark subject of an international registration	1208
Article 161 Transformation	1209

TITLE XIV

FINAL PROVISIONS

Article 162 Community implementing provisions	1213
Article 163 Establishment of a committee and procedure for the adoption of implementing regulations	1217
Article 164 Compatibility with other Community legal provisions	1219
Article 165 Provisions relating to the enlargement of the Community	1224

Summary of Contents

Article 166	Repeal	1232
Article 167	Entry into force	1232
B.	Measures under Enforcement Directive 2004/48/EC	1235
C.	Litigation in EU Member States	1247
Austria	1247
Belgium	1255
Bulgaria	1263
Croatia	1270
Cyprus	1278
Czech Republic	1284
Denmark	1292
Estonia	1301
Finland	1306
France	1313
Germany	1322
Greece	1328
Hungary	1334
Ireland	1342
Italy	1349
Latvia	1359
Lithuania	1368
Luxembourg	1379
Malta	1386
The Netherlands	1392
Poland	1398
Portugal	1403
Romania	1407
Slovakia	1415
Slovenia	1423
Spain	1433
Sweden	1438
United Kingdom	1443
D.	Annexes	1451
Annex 1	DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL	1451
Annex 2	COMMISSION REGULATION (EC) No 2868/95	1461
Annex 3	COMMISSION REGULATION (EC) No 2869/95	1506
Annex 4	Directive 2004/48/EC of the European Parliament and of the council	1515
E.	Table of Cases	1527
Index	1571

List of Authors

<i>Vladimir Anohin</i> , Latvian and European Patent Attorney, Agency TRIA ROBIT, Riga	Latvia
<i>Emmanuel Baud</i> , Avocat à la Cour, Cabinet Jones Day, Paris	Artt. 11, 18 (together with Edouard Fortunet)
<i>Michel Béjot</i> , Docteur en Droit, Avocat à la Cour, Bernard Hertz Béjot, Paris	Art. 45; France
<i>Anne Bekema</i> , Advocaat, Houthoff Buruma, Amsterdam	Artt. 13, 110 and 111 (together with Wolter Wefers Bettink)
<i>Matthias Berger</i> , LL.M. (Golden Gate University, San Francisco), Rechtsanwalt, Fieldfisher, Hamburg	Art. 81
<i>Wolter Wefers Bettink</i> , Advocaat, Houthoff Buruma, Amsterdam	Artt. 13, 110 and 111 (together with Anne Bekema)
<i>Alexandra von Bismarck</i> , Prof., Dr., Rechtsanwältin, Fieldfisher, Hamburg, Professorin, German Graduate School of Management & Law, Heilbronn	Artt. 40–42 (together with Sven Jacobs)
<i>Héloïse Bock</i> , Avocat à la Cour, Arendt & Medernach, Luxembourg	Luxembourg
<i>Rudolf Böckenholt</i> , Dr., LL.M., Rechtsanwalt, BOEHMERT & BOEHMERT, Bremen	Artt. 75–80
<i>Thies Bösling</i> , Dr., LL.M. (San Diego), Rechtsanwalt, Harte-Bavendamm, Hamburg	Artt. 145–161
<i>Andrej Bukovnik</i> , Lawyer, PETOSEVIC, Ljubljana	Slovenia
<i>Louise Carey</i> , Solicitor and Trade Mark Attorney, Tomkins & Co., Dublin	Ireland
<i>Claus Barrett Christiansen</i> , LL.M. (Kings College London) Lawyer, Bech-Bruun, Copenhagen/Aarhus	Art. 109; Denmark
<i>Lee Curtis</i> , Trade Mark Attorney, HGF Limited, Manchester	Artt. 10; 14
<i>Magnus Dahlman</i> , LL.M. (University of Lund), Advokat, Setterwalls Advokatbyrå, Malmö	Sweden
<i>Frank Dittschar</i> , Dr., Rechtsanwalt, Kapellmann & Partner, Düsseldorf	Artt. 36, 37 (together with Andrea Lensing-Kramer)
<i>Julia Dönch</i> , M.A., Rechtsanwältin, BDO Legal, Hamburg	Germany
<i>Andreas Ebert-Weidenfeller</i> , Dr., Rechtsanwalt, Meissner Bolte & Partner, Bremen	Artt. 12; 112–114
<i>Egon Engin-Deniz</i> , Dr., Rechtsanwalt, CMS Reich-Rohrwig Hainz, Vienna	Artt. 82–84; Austria
<i>Edouard Fortunet</i> , Avocat à la Cour, Cabinet Jones Day, Paris	Artt. 11, 18 (together with Emmanuel Baud)
<i>Blas Alberto Gonzalez Navarro</i> , Abogado, Cuatrecasas, Gonçalves, Pereira, Madrid	Spain
<i>Simon Gray</i> , BBS, DipLS, MITMA, Trade Mark Attorney, Tomkins & Co., Dublin	Artt. 46–49
<i>Antje Gruneberg</i> , Dr., LL.M. (Dresden/London), Rechtsanwältin, CMS Hasche Sigle, Düsseldorf	Artt. 29–35 (together with Thomas Manderla)
<i>Steffen Hagen</i> , Advocaat, VanEps Kunneman VanDoorne, Oranjestad	Artt. 38, 39
<i>Alexis Hallemans</i> , LL.M. Eur. (Saarbrücken), LL.M. (Brussels), Advocaat, CMS DeBacker, Antwerp	Artt. 163–166

List of Authors

<i>Gordian N. Hasselblatt</i> , Prof., Dr., LL.M. (McGeorge School of Law, Sacramento), Rechtsanwalt, Professor of Law University of the Pacific, Professor of Law Chicago-Kent College of Law, CMS Hasche Sigle, Cologne	Artt. 1; 3; 6, 7
<i>Michal Havlík</i> , Dr., Advokat, Associated Law Offices VŠETEČKA ZELENÝ ŠVORČÍK KALENSKÝ and Partners, Praha	Czech Republic
<i>Tom Heremans</i> , LL.M. (UCLA), Advocaat, CMS DeBacker, Brussels	Artt. 50, 51; 162; 167; Belgium
<i>Sven Jacobs</i> , Rechtsanwalt, Norton Rose Fulbright, Frankfurt	Artt. 40–42 (together with Alexandra von Bismarck)
<i>Andrea Jaeger-Lenz</i> , Dr., Rechtsanwältin, Harte Bavendamm, Hamburg	Art. 8 (1)–(4)
<i>Philipp von Kapff</i> , DESS (Lyon), Member of the Boards of Appeal, OHIM, Alicante	Artt. 138–144
<i>Urmas Kauler</i> , Lawyer, Patendibüro TURVAJA, Tallinn	Estonia
<i>David Kipping</i> , Dr., LL.M. (Cologne/Paris), Maître en droit (Université Paris I – Panthéon-Sorbonne), Rechtsanwalt, CMS Hasche Sigle, Cologne	Artt. 25–28
<i>Mariusz Kondrat</i> , Ph.D., Rzecznik Patentowy, Adwokat, KONDRAT & Partners, Warsaw	Poland
<i>Peter Kružliak</i> , Mgr., Advokát, BRICHTA & PARTNERS, Bratislava	Slovakia
<i>Áron László</i> , Dr., Ügyvéd, Oppenheim Ügyvédi Iroda, Budapest	Hungary
<i>Andrea Lensing-Kramer</i> , Dr., Rechtsanwältin, Freshfields Bruckhaus Deringer, Düsseldorf	Artt. 36, 37 (together with Frank Dittschar)
<i>Manuel Lopes Rocha</i> , Lawyer, PLMJ, Lisbon	Portugal
<i>Inga Lukauskienė</i> , Advokatė, METIDA Law Firm of Reda Zaboliene, Vilnius	Art. 44, Lithuania (together with Reda Žaboliene)
<i>Thomas Manderla</i> , Dr., CMS Hasche Sigle, Düsseldorf	Artt. 29–35 (together with Antje Gruneberg)
<i>Ruxandra Manea</i> , Legal Assistant in 5 th Board of Appeal, OHIM, Alicante	Artt. 2; 124–135
<i>Mary-Rose McGuire</i> , Prof., Dr., M. Jur. (Göttingen) University of Mannheim, Mannheim	Artt. 16, 17; 19–24
<i>Carsten Menebröcker</i> , Dr., LL.M. (NYU, New York), Rechtsanwalt, CMS Hasche Sigle, Cologne	Artt. 94–99; Artt. 100–103 (together with Sabine Stier)
<i>Max W. Mosing</i> , Mag., Dr., LL.M. (Vienna), LL.M. (Strathclyde), Rechtsanwalt, GEISTWERT Rechtsanwälte, Vienna	Artt. 85, 86
<i>Iliana Muhibian</i> , Trade Mark and Design Attorney, J. Varbanov & Partners, Sofia	Bulgaria (together with Julian Varbanov)
<i>Axel Nordemann</i> , Prof., Dr., Rechtsanwalt, Honorary Professor at the University of Konstanz, Boehmert & Boehmert, Berlin	Artt. 15; 66–74
<i>Kim Parviainen</i> , LL.M. (Helsinki), Lawyer, Castrén Snellman Attorneys Ltd, Helsinki	Artt. 58–64; Finland
<i>Tanja Rajic</i> , LL.M. (The John Marshall Law School, Chicago, IL), Lawyer, PETOSEVIC, Zagreb	Croatia
<i>Luigi A. Sansone</i> , Dr., LL.B. (Hons.), LL.D., Advocate, SALOMONE SANSONE, Valletta	Malta (together with Francesca Warrington)
<i>Grigoris Sarlidis</i> , LL.M. (King’s College London, London), L.P.C. (The College of Law, London), Advocate, Pamboridis, Nicosia	Cyprus
<i>Gregor Schneider</i> , Litigator, OHIM, Alicante	Artt. 4; 136, 137
<i>Tom Scourfield</i> , Solicitor Advocate, CMS Cameron McKenna, London	Artt. 92, 93; United Kingdom

List of Authors

- Ewa Skrzydło-Tefelska*, Dr. (hab.), University Maria Curie-Skłodowska, Lublin, radca prawny (legal advisor) Sołtysiński Kawecki & Szlęzak, Warsaw
Art. 8 (5); Art. 9 (together with Mateusz Żuk)
- Dirk Smielick*, Dr., Rechtsanwalt, CMS Hasche Sigle, Cologne
Art. 5
- Dimitris Spiliotis*, Lawyer, Bahas Gramatidis & Partners, Athens
Greece
- Gabriela Staber*, Dr., LL.M. (King's College, London), LL.M. (Suffolk University, Boston), Rechtsanwältin, Attorney at law (MA, NY), CMS Reich-Rohrwig Hainz, Vienna
Artt. 87–91
- Sabine Stamm*, LL.B., Rechtsanwältin, Odenthal
Artt. 115–123
- Sabine Stier*, Rechtsanwältin, CMS Hasche Sigle, Cologne
Artt. 100–103 (together with Carsten Menebröcker); Artt. 104–108
- Tankred Thiem*, Rechtsanwalt & Avvocato, LGV Avvocati, Milan
Italy
- Valeska Töbelmann*, LL.M. (Dresden/Exeter), Rechtsanwältin, CMS Hasche Sigle, Cologne
Art. 65; Enf. Dir.
- Julian Varbanov*, Lawyer, J. Varbanov & Partners, Sofia
Bulgaria (together with Iliana Muhibian)
- Raluca Vasilescu*, Trade Mark Attorney, Cabinet M. Oproiu, Bucharest
Art. 43; Romania
- Gregor Vos*, LL.M. (Amsterdam/London), Advocaat, Klos Morel Vos & Reeskamp, Amsterdam
Artt. 52–57; The Netherlands
- Francesca Warrington*, Dr., LL.B., LL.D., Advocate, SALOMONE SANSONE, Valletta
Malta (together with Luigi A. Sansone)
- Reda Žaboliienė*, Advokatė, METIDA Law Firm of Reda Zaboliene, Vilnius
Art. 44, Lithuania (together with Inga Lukauskienė)
- Mateusz Żuk*, Prawnik, Sołtysiński Kawecki & Szlęzak, Warsaw
Art. 9 (together with Ewa Skrzydło-Tefelska)

List of Abbreviations

acc.	according to
ACRR	(Polish) Act on Copyright and Related Rights
AIPPO	International Association for the Protection of Intellectual Property
All E.R.	All England Reporter
AnwBl	Anwaltsblatt (German law journal)
approx.	approximately
BGB	Bürgerliches Gesetzbuch (German Civil Code)
BGH	Bundesgerichtshof (German Federal Court of Justice)
BoA	Board of Appeal
BT	Bundestag (German Federal Parliament)
C&D	cease and desist
CD	Community Design
CDFR	Community Design Fees Regulation
CDIR	Community Design Implementation Regulation
CDPA (UK)	Copyright, Designs and Patents Act
CDR	Community Design Regulation (EC) 6/2002 of 12 December 2001 on Community Designs
cf.	confer (consult; see)
Ch D	Chancery Division (UK)
ch.	chapter(s)
CJ	Court of Justice
CJEU	Court of Justice of the European Union
cl.	clause
COM	Proposed legislation and other Commission communications to the Council and/or the other institutions, and their preparatory papers. Commission documents for the other institutions
Com.	Commission
Common Regulations	Common Regulations under the 1999 Act, the 1960 Act and the 1934 Act of the Hague Agreement
CTM	Community Trademark
CTMDir	Community Trade Mark Directive
CTMFR	Community Trade Mark Fees Regulation
CTMIR	Community Trade Mark Implementing Regulation
CTMR	Community Trade Mark Regulation
DDir	Design Directive
Dec.	Decision
Dir.	Directive
diss.op.	dissenting opinion
Drs	Drucksache (printed matter of the German Parliament)
Duke LJ	Duke Law Journal
E.C.D.R.	European Copyright and Design Reports
e. g.	exempli gratia (for example)
EnforcementDir	Directive on the enforcement of intellectual property rights
E.I.P.R.	European Intellectual Property Review
E.T.M.R.	European Trade Mark Report
ECHR	European Convention on Human Rights
ECR	Report of cases before the European Court of Justice and the General Court
EEA	European Economic Area/European Economic Agreement
EIPR	European Intellectual Property Review
ELJ	European Law Journal
EPC	European Patent Convention of 1973
EPLA	European Patent Litigation Agreement
EPO	European Patent Office
EuR	Europarecht (German law journal)
EuZW	Europäische Zeitschrift für Wirtschaftsrecht (German law journal)

Abbreviations

EWCA	Court of Appeal for England and Wales
ExaminationGuidelines	Guideline for the Examination of Community Designs by OHIM
Fed.	Federal
fn.	footnote
FS	Festschrift (liber amicorum)
FSR	Fleet Street Reports: Cases on Intellectual Property Law (UK)
GC	General Court
GCA	German Copyright Act
GDA	German Design Act
Geneva Act	Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs
GRUR	Gewerblicher Rechtsschutz und Urheberrecht (German law journal)
GRUR Int.	Gewerblicher Rechtsschutz und Urheberrecht – Internationaler Teil (German law journal)
GRUR Prax	Gewerblicher Rechtsschutz und Urheberrecht, Praxis im Immaterialgüter- und Wettbewerbsrecht (German law journal)
GRUR-RR	Gewerblicher Rechtsschutz und Urheberrecht – Rechtsprechungsteil (German law journal)
i. e.	id est
ibid.	in the same place
ICA	Italian Copyright Act
id.	idem, the same
IEHC	High Court of Ireland decisions
IIC	International Review of Intellectual Property and Competition Law
INID	Internationally agreed Numbers for the Identification of Data
INTA	International Trademark Association
Invalidity Guideline	Guideline for the Proceedings Relating to a Declaration of Invalidity of a Registered Community Design by OHIM
IP	Intellectual Property
IPC	(Italian) Industrial Property Code
IPL	(Polish) Industrial Property Law Act
IPLR	Intellectual Property Law Reports
IPR	Intellectual Property Rights
IR	International Registration
J	Judge
lit.	letter; littera
LOC	Locarno Classification
loc. cit.	in the place cited
Madrid Agreement	Madrid Agreement Concerning the International Registration of Marks of 14 April 1891
MarkenG	Markengesetz (German Act on the Protection of Marks and Other Designations)
Mitt.	Mitteilungen der deutschen Patentanwälte (German law journal)
mn./mns.	margin number/margin numbers
MPI	Max-Planck-Institut
Nice Agreement	Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957
nyp	not yet published
NZI	Neue Zeitschrift für Insolvenzrecht (German law journal)
OAPI	African Intellectual Property Organisation
Öbl	Österreichische Blätter für gewerblichen Rechtsschutz (Austrian law journal)
OECD	Organisation for Economic Cooperation and Development
Office	Office for Harmonization in the Internal Market
OGH	Oberster Gerichtshof (Supreme Court of Austria)
OHIM	Office for Harmonization in the Internal Market
OJ	Official Journal
para./paras.	paragraph(s)
Paris Convention	Paris Convention for the Protection of Industrial Property of 20 March 1883
PatG	Patentgesetz (German Patent Act)
PCT	Patent Cooperation Treaty

Abbreviations

PI	preliminary injunction
Protocol	Protocol Relating to the Madrid Agreement of 27 June 1989
pub.	publication
R	rule (WIPO)
RBC	Revised Berne Convention
Rc.	recital
RCD	Registered Community Design
Reg.	Regulation
RenewalGuidelines	Registered Community Design Renewal Guidelines by OHIM
Rope	Rules of Procedure
RPC	Reports of Patents, Designs and Trade Mark Cases
RTM	Registered Trade Mark
RTMA	Registered Trade Mark Attorney
s.	see
SCT	The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications
SEA	Single European Act
Sec.	section
SME	Small and medium sized enterprise
Stat.	Statute(s)
Swiss IPRG	Bundesgesetz über das Internationale Privatrecht (Swiss law on conflicts of law)
TEC	Treaty of the European Community
TEU	Treaty on European Union
TFEU	Treaty on the Function of the European Union
TM	Trademark
TMR	Trademark Report
TMDir	Directive (EC) 2008/95 of 22 October 2008 to approximate the law of the Member States relating to Trade Marks
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
TRT	Trademark Registration Treaty
U.S.	United States Reports
U.S.C.	US Supreme Court cases
UCD	Unregistered Community Design
UDRP	Uniform Domain-Name Dispute-Resolution Policy
UKHL	UK House of Lords
UKSC	UK Supreme Court (decided cases)
UNCITRAL	United Nations Commission on International Trade Law
USPTO	U.S. Patent and Trademark Office
v	versus
VAT	Value Added Tax
WIPO	World Intellectual Property Organization
WM	Wertpapier-Mitteilungen (German law journal)
WRP	Wettbewerb in Recht und Praxis (German law journal)
WTO	World Trade Organisation
Yb	Yearbook
ZfRV	Zeitschrift für Europarecht, Int. Privatrecht & Rechtsvergleichung (German law journal)
ZGE	Zeitschrift für Geistiges Eigentum (German law journal)
ZUM	Zeitschrift für Urheber- und Medienrecht (German law journal)
ZUR	Zeitschrift für Umweltrecht (German law journal)

General Bibliography

- Marco Alcalá/Luis Alberto*, Las Causas de la denegación de registro de la marca comunitaria, Valencia 2001;
- Ruth Annand/Helen Norman*, Blackstone's Guide to the Community Trade Mark, London 1998;
- Jürgen Basedow/Josef Drexl/Annette Kur/Axel Metzger*, Intellectual Property in the Conflict of Laws, Tübingen 2005;
- Friedrich K. Beier/Gerhard Schricker/Matthias Eck*, Neue Wege zum Schutz der Formgebung, Cologne 1993;
- Achim Bender*, Europäisches Markenrecht, Cologne/Berlin/Munich 2008;
- Franco Benussi*, Il marchio comunitario, Milano 1996;
- Daniel R. Bereskin*, International Trade Mark Dilution, Toronto 2014;
- Georg Hendrik Christiaan Bodenhausen*, Pariser Verbandsübereinkunft zum Schutz des gewerblichen Eigentums, Cologne/Berlin/Bonn 1971;
- Magaret Briffa/Lee Gage*, Design Law, London 2004;
- Ulrich Brückmann/Philipp Günther/Helmut Beyerlein*, Kommentar zum Geschmacksmustergesetz, Frankfurt am Main 2007;
- Alexander Bulling/Angelika Langöhrig/Tillmann Hellwig*, Geschmacksmuster, 3. ed., Cologne 2011;
- Ursula Bumiller*, Durchsetzung der Gemeinschaftsmarke in der Europäischen Union, Munich 1997;
- Jan Busche/Peter-Tobias Stoll/Andreas Wiebe*, TRIPs – Internationales und europäisches Recht des geistigen Eigentums, 2. ed., Cologne 2012;
- Wolfgang Büscher/Stefan Dittmer/Peter Schiwy*, Gewerblicher Rechtsschutz, Urheberrecht, Medienrecht, Cologne 2011;
- Dennis Campbell/Susan Cotter*, International Intellectual Property Law, New York 1996;
- Alberto Casado Cerviño*, Comentarios a los reglamentos sobre la marca comunitaria, 2. ed., Madrid 2000;
- Alberto Casado Cerviño*, El sistema comunitario de marcas: normas, jurisprudencia y práctica, Valladolid 2000;
- Tobias Cohen Jehoram/Constant van Nispen*, European Trademark Law, Alphen aan den Rijn 2010;
- Denis Cohen*, Le droit des dessins et modèles, 3. ed., Paris 2014;
- William Rodolph Cornish*, Intellectual Property: Omnipresent, Distracting, Irrelevant?, Oxford 2006;
- William Rodolph Cornish/David Llewelyn/Tanya Aplin*, Intellectual Property: Patents, Copyrights, Trademarks & Allied Rights, London 2014;
- Paul Craig/Gráinne De Búrca*, EU Law, 5. ed., Oxford 2011;
- Salvo Dell'Arte*, I marchi d'impresa nella Comunità europea, Forlì 2005;
- Josef Drexl/Annette Kur*, Intellectual Property and Private International Law, Oxford 2005;
- Andreas Ebert-Weidenfeller*, Marque communautaire, London 2000;
- Martin Ebner*, Markenschutz im internationalen Privat- und Zivilprozessrecht, Cologne 2004;
- Helmut Eichmann/Annette Kur*, Designrecht, Baden-Baden 2009;
- Helmut Eichmann/Roland Vogel von Falckenstein*, Geschmacksmustergesetz, 4. ed., Munich 2010;
- Günther Eisenführ/Detlef Schennen*, Gemeinschaftsmarkenverordnung, 4. ed., Cologne 2014;
- Friedrich Ekey/Diethelm Klippel/Achim Bender*, Markenrecht, vol. 1, 2. ed., Heidelberg 2009;
- Willi Erdmann/Sabine Rojahn/Olaf Sosnitzer*, Handbuch des Fachanwalts Gewerblicher Rechtsschutz, 2. ed., Cologne 2011;
- European Max Planck Group*, Conflict of Laws in Intellectual Property, Oxford 2013;
- James J. Fawcett/Paul Torremans*, Intellectual Property and Private International Law, Oxford 2011;
- Carlos Fernández-Nóvoa*, El sistema comunitario de Marcas, Montecorvo 1995;
- Carlos Fernández-Nóvoa*, Fundamentos de derecho de marcas, Madrid 1984;
- Karl-Heinz Fezer*, Markenrecht, 4. ed., Munich 2009;
- Karl-Heinz Fezer*, Lauterkeitsrecht: UWG, vol. 1, 2, 2. ed., Munich 2010;

General Bibliography

- Mario Franzosi, *European Community Trade Mark, Commentary to the European Community Regulation*, Den Haag/London/Boston 1997;
- Mario Franzosi, *European Design Protection*, Den Haag 1996;
- Eric Gastinel, *La marque communautaire*, Paris 2000;
- Eric Gastinel, *Legal aspects of the Community trade mark*, Den Haag/London/Boston 2001;
- Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis*, 4. ed., London 2012;
- Charles Gielen/Verena von Bomhard, *Concise European Trade Mark and Design Law*, Alphen aan den Rijn 2011;
- François Greffe/Pierre Greffe, *Traité des dessins et modèles*, 8. ed., Paris 2008;
- Franz Hacker, *Markenrecht*, 3. ed., Cologne 2013;
- Henning Hartwig, *Designschutz in Europa/Design Protection in Europe*, vol. 1, Cologne 2007, vol. 2, 2008, vol. 3, 2009, vol. 4, 2012;
- Gordian N. Hasselblatt, *Münchener Anwaltshandbuch Gewerblicher Rechtsschutz*, 4. ed., Munich 2012;
- Frauke Henning-Bodewig/Annette Kur, *Marke und Verbraucher. Funktionen der Marke in der Marktwirtschaft*, vol. 1, Weinheim 1988, vol. 2, 1989;
- Ulrich Hildebrandt, *Harmonised Trade Mark Law in Europe, Case-Law of the European Court of Justice*, 2. ed., Cologne/Berlin/Munich 2008;
- Reinhard Ingerl, *Die Gemeinschaftsmarke*, Stuttgart/Munich/Hannover/Berlin/Weimar/Dresden 1996;
- Reinhard Ingerl/Christian Rohnke, *Markengesetz*, 3. ed., Munich 2010;
- Francisco José/Alonso Espinosa, *El nuevo Derecho de Marcas*, Granada 2002;
- Toshiyuki Kono, *Intellectual Property and Private International Law: Comparative Perspectives*, Oxford 2012;
- Helmut Köhler/Joachim Bornkamm, *Gesetz gegen den unlauteren Wettbewerb*, 32. ed., Munich 2014;
- Guido Kucsko/Christian Schumacher, *marken.schutz*, Vienna 2013;
- Guido Kucsko, *Geistiges Eigentum*, Vienna 2003;
- Annette Kur/Thomas Dreier, *European Intellectual Property Law*, Cheltenham, Northampton, 2013;
- Paul Lange, *Marken- und Kennzeichenrecht*, 2. ed., Munich 2012;
- Stefan Leible/Ansgar Ohly, *Intellectual Property and Private International Law*, Tübingen 2009;
- Matthias Leistner/Estelle Derclaye, *Intellectual property overlaps: A European perspective*, Oxford 2011;
- Manuel Lobato García-Mijan, *La Marca Comunitaria. Aspectos procesales y de Derecho Internacional Privado del Reglamento sobre la marca comunitarian*, Bologna 1997;
- Spyros M Maniatis/Dimitris Botis, *Trade Marks in Europe: A Practical Jurisprudence*, 2. ed., London 2010;
- Paul Mathély, *Le nouveau droit français des marques*, Paris 1994;
- Hector MacQueen/Charlotte Waelde, *Contemporary Intellectual Property Law and Policy*, 2. ed., Oxford 2008;
- James Mellor/David Llewelyn/Thomas Moody-Stuart/David Keeling/Iona Berkeley, *Kerly's law of Trade Marks and Trade Names*, 11. ed., London 2011;
- Amanda Michaels/Andrew Norris, *A practical Guide to Trade Mark Law*, 5. ed., Oxford 2014;
- Christopher Morcom/Ashley Roughton/Simon Malynicz, *The Modern Law of Trade Marks*, 3. ed., London 2008;
- Jan Bernd Nordemann/Axel Nordemann/Anke Nordemann-Schiffel, *Wettbewerbsrecht Markenrecht*, 11. ed., Baden-Baden 2012;
- Ansgar Ohly/Theo Bodewig/Thomas Dreier/Horst-Peter Götting/Maximilian Haedicke/Michael Lehmann, *Perpektiven des Geistigen Eigentums und des Wettbewerbsrechts*, Munich 2005;
- Jeremy Phillips, *Trade Mark Law*, Oxford 2002;
- Jeremy Phillips/Ilanah Simon, *European Trade Mark Reports*, London 2013;
- André Pohlmann, *Verfahrensrecht der Gemeinschaftsmarke*, Munich 2012;
- Oliver Ruhl, *Gemeinschaftsgeschmacksmuster*, 2. ed., Cologne 2010;
- Elke Schaper, *Durchsetzung der Gemeinschaftsmarke*, Cologne 2006;
- Gerhard Schricker/Eva-Marina Bastian/Roland Knaak, *Gemeinschaftsmarke und Recht der EU-Mitgliedstaaten*, Munich 2006;
- Roger Staub/Allesandro L. Celli, *Designrecht*, Zürich 2003;

General Bibliography

- Maximiliane Stöckel*, Handbuch Marken- und Designrecht, Berlin 2013;
- David Stone*, European Union Design Law, Oxford 2012;
- Paul Ströbele/Franz Hacker*, Markengesetz, 11. ed., Cologne 2015;
- Robert M. Stutz*, Individualität, Originalität oder Eigenart? Schutzvoraussetzungen des Design, Bern 2002;
- David Tatham/William Richards*, ECTA Guide to E.U. Trade Mark Legislation, London 1998;
- Louise Thorning/Solvår Winnie Finnanger*, Trademark Protection in the European Union with a Scandinavian View, Copenhagen 2010;
- Guy Tritton*, Intellectual Property In Europe, 4. ed., London 2014;
- Paul van der Kooij*, The Community Trade Mark Regulation- An Article by Article Guide, London 2000;
- Alexander von Mühlendahl/Dietrich Ohlgart/Verena von Bomhard*, Die Gemeinschaftsmarke, Munich 1998;
- Detlef von Schultz*, Kommentar zum Markenrecht, 3. ed., Frankfurt am Main 2012.

