

provisions of second sentence of Article 15(1) of TRIPs whose literal import necessitates a conclusion that the shapes described under Article 7(1) (e) of the CTMR may be registered just upon meeting the distinctiveness test. The problematic aspect of those exceptions is that registration is not warranted even where the shapes referred to in Article 7(1) (e) of the CTMR acquire a secondary meaning. However, “[according] to the position adopted by the European Union, there is no conflict between this regulation [the CTMR] and the obligations under TRIPs, because shapes falling under the reservation clause cannot be regarded as “signs” in the meaning of the definition laid down in the first sentence of Article 15(1)”.<sup>386</sup>

It follows that the above position as adopted by the EU can only be justified under the public interests rather than the basic function of trademark; for “consumers are capable of recognizing the distinctive character of a product’s shape”, to the extent that they may even be confused as to the origin of two identically shaped products which bear different word marks.<sup>387</sup>

## *II. Relative grounds for refusal*

Six types of relative grounds for refusal to register a CTM may be identified pursuant to Article 8(2) – (5) of the CTMR. These are: (1)earlier trademark registrations or applications, (2)earlier trademark registrations or applications with reputation, (3)earlier well-known marks, (4)agents’ mark, (5)earlier unregistered trademarks, and (6)earlier signs used in the course of trade, except for signs with only local significance.<sup>388</sup>

According to Article 8(1) of the CTMR, relative grounds for trade mark refusal may be invoked by third parties to oppose registration of a CTM registration.<sup>389</sup> Since the relative grounds for trademark refusal define the scope of a trademark monopoly, they are thus discussed in section E below in the context of CTM infringement.

386 KUR, A., “TRIPs and Trademark Law”, in: BEIER, F., & SCHRICKER, G. (eds.), “From GATT to TRIPs – The Agreement on Trade-Related Aspects of Intellectual Property Rights” 100 IIC Studies Vol. 18 (VCH, Weinheim 1996).

387 PHILIPS, J., “Trade Mark Law: a Practical Anatomy” 143 (Oxford University Press, Oxford 2003).

388 *Cf.* also Rule 15(2) (b) of the CTMIR.

389 For the extensive discussion on opposition procedure and grounds for opposition *cf.* PAGENBERG, J., “Das Widerspruchsverfahren der Gemeinschaftsmarke – Neue Strategien im Markenrecht”, 1998 GRUR 288.

## *E. CTM infringement*

Article 9 of the CTMR stipulates some circumstances under which CTM infringements may be presumed or proved. On the other hand, Article 8 of the CTMR strengthens the rights granted under Article 9 of the CTMR by allowing the right holder to prohibit registration of a sign the use of which would, but for registration, infringe his earlier rights. In order to determine whether a CTM has been, or is likely to be, infringed, various factors such as whether the use of a CTM by a third party falls within the scope of the exclusive rights that a CTM bestows upon the proprietor and the limitation posed against these rights have to be considered.

### *I. Scope of CTM protection*

#### 1. Article 9 of the CTMR

The scope of a CTM protection is systematically described under Article 9(1) (a), (b) and (c) of the CTMR.

According to Article 9(1) (a) of the CTMR, the CTM proprietor is entitled to interdict the use, in trade, by third parties, of any sign, which is identical to his trademark, where such use is in relation to goods or services, which are identical with those for which the proprietor's CTM was registered. A sign may be regarded as identical with a registered CTM if "it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer".<sup>390</sup> To put it simply, infringement under the paragraph will require the plaintiff to prove double identity, i.e. identity of the sign and the CTM as well as identity of goods or services marketed under the sign and the CTM. For a CTM proprietor to be able to prohibit the use of another sign within the ambit of Article 9(1) (a) of the CTMR, such a sign and the proprietor's mark must correspond in all aspects. If there is any difference between them, then the action must be decided under Article 9(1) (b). However, where an infringer reproduces in his sign a part of a registered CTM, he cannot be held liable under the double identity doctrine of infringement, notwithstanding

390 ECJ, 20 March 2003, Case C-291/00 *LTJ Diffusion SA v Sadas Vertbaudet SA* [2003] ECR I-02799, para. 54.