

Guidance on answering the discussion questions in the book

Para 15.24

The section refers to identical marks, and identical goods and services. What does ‘identical’ mean in this context?

Remember that this test is strict, as befits the strength of this ground of infringement. A sign is identical to a registered mark where 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’ (*LTJ Diffusion v SADAS*, Case C-291/00).

Para 15.37

Can you discern a clear overall policy direction from the Court of Justice’s decisions in *Bellure*, *Google France* and *Interflora*? How do you think the case law should develop from here?

Looked at in the round, these three decisions present a confusing picture. On the one hand, *Bellure* represents an expansive policy approach, radically broadening the scope of infringement under the double identity rules. *Google France* and *Interflora* continue in that vein insofar as they seem to lower the threshold for demonstrating an adverse effect on the origin function. However, at the same time both *Google France* and *Interflora* seem to curtail

the circumstances in which the advertising or investment functions may be harmed. It seems fair to conclude that the messages from the Court of Justice on the new ‘extended functions’ are mixed – perhaps the Court is quietly back-tracking from *Bellure*?

Para 15.50

As well as aural and visual considerations, can you think of any other senses that might be used in assessing similarities between marks? Consider the debate in Chapter 14 as to whether taste and smell marks can be registered. Are there any implications for the assessment of similarity between marks arising from the removal of the requirement for graphic representation by the 2015 EU trade mark reform package?

If non-conventional marks such as smells or tastes do ever come to be validly registered, this may well require a re-think of the Court of Justice’s approach to assessing the similarity of marks. At the moment, the Court of Justice’s approach focusses on the aural, visual and conceptual similarities between marks – there is, however, no place for assessing marks such as smells or tastes in aural or visual terms.

Para 15.80

In what other circumstances can you envisage the test of ‘due cause’ being used in the interests of fair competition? Do you think that the concept of ‘due cause’ is a satisfactory way of placing boundaries on the scope of the trade mark monopoly?

As noted in Chapter 15, in the lead-up to the adoption of the 2015 reform package, attempts to widen the scope of defences explicitly to cover infringements such as parodic use of trade marks did not succeed. ‘Due cause’ could be a filter for removing from infringement socially important uses of marks – for example, in criticism and review, parody or other artistic contexts. This would, however, only be an option in relation to claims for infringement of marks with a reputation – as noted in Chapter 15, there is no ‘due cause’ saving in relation to double identity or confusion-based infringement.