

# Trade Mark Law in Europe

Case Law of the Court of Justice  
of the European Union

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THIRD EDITION

ULRICH HILDEBRANDT



Wolters Kluwer

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## About the Author

Ulrich Hildebrandt studied music and law. He is a partner of the German law firm Lubberger Lehment. He has been active in the field of Trade Mark Law for several years. Additionally, he is assistant lecturer at the Heinrich-Heine-University Dusseldorf and the author of several books, especially the German standard reference work 'Marken und andere Kennzeichen' (Trade marks and other signs). He is a member of the Special Committee for Unfair Competition and Trade Mark Law of the German GRUR-Association, member of the Working Committee for Trade Mark Law at the Markenverband (German Trade mark Association), and correspondent for the Dutch journal *Berichten Industriële Eigendom*.

## Notes to the user

1. The material provisions of the **Directive** are reproduced with their original wording. Major changes to previous versions of the Directive are expressly marked. The author tries a prediction whether case law concerning the previous version may also be relevant for the actual version.
2. The **appendixes** 1, 2, and 3 enable the finding of the relevant provision of the actual Directive and the relevant case law.
3. An unofficial full text of the decisions of the European Court of Justice is available on the **Internet** at [curia.europa.eu](http://curia.europa.eu). Both numerical access to the case law and a search form are provided. In some instances, decisions may be found by using one of the search methods, but, not the other.
4. The **citation** goes by the schema 'file number, date of the decision – catchword, paragraph.' Since there are no official catchwords, reference is made to the designation found in the numerical list of case law on the Court's Internet page. These catchwords may differ from familiar catchword used by certain journals. Appendix 3 compiles the decisions sorted by catchword.
5. Wherever no official translation of a decision exists in the English language, a translation by the author is provided followed by a **footnote**. Sections that contain unavoidable variances from the original wording are identified.
6. **Quotations** in the case law sections are adopted from the wording of the decision.
7. **Bold type** inside the case law sections was supplied by the author for purposes of emphasis and clarity.
8. The **case law until February 2016** has been taken into account.
9. My special thanks go to Louisa McDonnell for the help with the English translation.

# Preface

The book you are holding in your hand (or reading from your screen) is a valuable tool for any trade mark professional.

The trade mark system as such is already somewhat complicated, but in a long string of decisions, starting around 1997, the Court of Justice of the European Union (CJEU) has made this even more complex, and sometimes even incomprehensible for those who have not studied the field in detail. Just as examples one can look at the interpretation that the CJEU gives to Trade mark Law concepts, how it tries to harmonize Trade Mark Law with other laws on fundamental rights or the legal construct of the 'function theory', which is essential to trade mark protection, but in no way is defined or delineated in the text of the Trade marks Directive or Community Trade mark Regulation. Many just as clear examples could be added, and I have still to meet a trade mark professional that has not been taken by surprise by a CJEU decision at some point. Each time we have to recalibrate, consider how the decision fits into the trade mark system (or how it could be fitted into it).

This is not an easy task, not for anybody. It requires an overview of the subject matter and knowledge of previous decisions. This is what Ulrich Hildebrandt has, and what he has done in this book.

It provides a thorough analysis of the CJEU case law on the basis of some key basic principles, followed by an overview of what the CJEU decision teach us, following the Trade marks Directive.

Those who read or study this book – even if it is just on a specific topic or article – will feel less lost in thick forest that European Trade mark Law has become, and may well find that open spot where things are clarified and answers can be found.

I, for one, always keep this book within reach.

*Amsterdam, 1 February 2016  
Prof. Dr Tobias Cohen Jehoram*

## List of Abbreviations

CJEU	Court of Justice of the European Union
CTMIR	Commission Regulation (EC) No. 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark
CTMR	Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark (OJ L 78, 24.3.2009, p. 1) [References to the Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ Nr. L 11 of 14 January 1994, p. 1) have been adopted]
EC	European Community / Treaty establishing the European Community (consolidated text)
ECR	European Court Reports
EEA	European Economic Area
EEC Treaty	Treaty establishing the European Community of 25 March 1957
et seq.	and the following
et seqq.	and the following
No.	Number
OHIM	Office for Harmonization in the Internal Market / European Union Intellectual Property Office
OJ	Official Journal of the European Community
OJ-OHIM	Official Journal of the Office for Harmonization in the Internal Market
p.	Page
para.	Paragraph

TMD	Directive (EU) 2015/2436 of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (OJ L 336, 23.12.2015, p. 1)
TMD2008	Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ L 299, 8.11.2008, p. 25) [References to the First Directive 89/104/EEC of the Council, of 21 December 1988, to Approximate the Laws of the Member States Relating to Trade Marks (OJ EC No L 40 of 11.2.1989, p. 1) have been adopted]
Treaty	Treaty establishing the European Community of 25 March 1957
TRIPs	Agreement on Trade Related Aspects on Intellectual Property Rights of April 15, 1994



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