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Annual Review of European Trademark Law

2025 in Review

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I. INTRODUCTION

A. About This Review

This thirteenth *Annual Review of European Trademark Law* contains highlights of European trademark cases in 2025 in the European Union ("EU") (at both the EU and national levels), the United Kingdom ("UK"), and other European jurisdictions. This Review therefore is both the thirteenth edition of the EU Annual Review, and the fifth edition of the European Annual Review.[*]

Matters relating to the unitary right of the EU Trade Mark ("EUTM") are governed by Regulation (EU) 2017/1001 of June 14, 2017—referred to in this Review as the "2017 EUTM Regulation." Harmonized laws in respect of national trademarks within EU Member States became, as of January 15, 2019, determined by Directive (EU) 2015/2436 of December 16, 2015, referred to in this Review as the "2015 TM Directive." An introduction to the role of the primary EU legislation (applicable at the time) is contained in the introduction to *Annual Review of EU Trademark Law: 2013 in Review*,[**] which also details the particular roles played by the EU General Court ("GC") and the Court of Justice of the European Union ("CJEU").

As previously, this European Review continues to look beyond the EU system to track comparable developments for the wider brand community. This Review continues to report on cases in the UK post-Brexit, as well as cases from Norway (members of the European Economic Area ("EEA") but not the EU), Switzerland, and Türkiye, all of which, to varying degrees, contain a trademark system modelled on, or at least analogous to, the EU system.

Once again, this 2025 Review arranges cases into groups by common subject matter. As such, it covers the familiar issues of "absolute" trademark issues, including validity, distinctiveness, descriptiveness, and "relative" grounds, including similarity and confusion and the continuing relevance of bad faith, which remains a highly relevant topic in Europe. This Review also explores recurring topics such as trademark use, infringement, exhaustion, and other defenses and limitations, and some notable cases illustrating changes or significant analysis of new practice and procedure.

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[*] Tom Scourfield, *Annual Review of European Trademark Law: 2025 in Review*, 116 Trademark Rep. 353 (2026). The principal author and contributor to this Review is grateful to a number of colleagues at CMS for their assistance, but in particular Omri Shirion, Nancy Lee, Daniel Amery, Emily Spain, Jessica Hall, and Ana-Maria Curavale.

[**] Guy Heath, *Annual Review of EU Trademark Law: 2013 in Review*, 104 Trademark Rep. 445 (2014).

With so many cases, overall trends and conclusions are typically a question of patterns identified during the process of editing, which of itself is a distillation of each country contributor's view as to the most relevant topics and cases to cover. Readers are encouraged to be aware of three particular developments in 2025.

The first is the perennial issue of distinctiveness and, in particular, absolute grounds exclusions for non-traditional or semi-descriptive marks. Chapter II contains the usual analysis of a range of marks, including pictorial (*Mercedes-Benz Group AG v. EUIPO*), color (*OMV AG v.* EUIPO and several national decisions in Germany), and shape marks (*Spin Master Toys UK Ltd. v. EUIPO*). There have also been interesting considerations of the interpretation and validity of "position" marks with both the General Court of the CJEU (*VistaJet Ltd. v. EUIPO*) and the UK Court of Appeal analyzing such marks (*Thom Browne Inc. & Thom Browne UK Ltd. v. adidas AG*). There was also a lot of analysis of geographical marks, in particular ICELAND (*Iceland Foods Ltd. v. EUIPO*) and Dubai chocolate (a national decision in Germany).

The second notable development is the interaction between EUTM courts in EU Member States and the EUIPO where there is a validity challenge to the underlying mark. Chapter VIII contains details of a case before the First Chamber of the Supreme Court of Spain,[1] which addressed a procedural issue of considerable practical relevance in the field of European Union trademark law, being the scope and mandatory nature of the suspension of infringement proceedings where the validity of the trademark relied upon has been challenged before the EUIPO, pursuant to Article 132 of the 2017 EUTM Regulation. Given the importance of the Alicante court in Spain for granting pan-EU injunctive relief, all practitioners and brand owners should be aware of the increased likelihood of EUTM courts staying infringement proceedings in favor of the jurisdiction of the EUIPO.

Finally, the increasing use and importance of AI in all areas of law and commerce in 2025 will be familiar to all readers. In a first for AI cases in this Review, the UK case of *Getty Images (US) Inc. & Ors. v. Stability AI Ltd.* included analysis of trademark infringement arising from the use of generative AI. The judgment established that an AI model provider can also be responsible for AI-generated outputs (rather than only the end user) and that trademark use can arise where the average consumer attributes a commercial connection between the provider and the third party's marks created by the generative AI output. No doubt there will be many more cases where AI is a feature or contributor to the fact pattern in future editions of this Review.

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[1] Judgment No. 92/2025 of January 14, 2025 (Cassation Appeal 3915/2020, Bodegas Vega Sicilia S.A. v. Bodegas Sanviver S.L.).

B. Legislative Change and Terminology

As in previous editions of this Review, each Part contains, in an introductory section, extracts of the most relevant provisions of the Regulation and Directive. Extracts given at the beginning of each part in this year's Review are taken from the 2017 EUTM Regulation and the 2015 TM Directive only. Some cases may also refer the predecessor legislation in the 2008 TM Directive and the 2009 EUTM Regulation.

Non-EU territories typically identify the relevant legislative provisions in the case commentary where required but these are not set out separately.

C. Organization of Material in this Review

As usual, the 2025 case reviews are arranged by theme, with CJEU decisions appearing at the beginning, followed by the most significant national decisions (according to the authors and contributors in that jurisdiction). Non-EU cases are set out after selected decisions from the national courts of EU Member States. Each theme is contextualized with introductory comments and recurring EU statutory provisions to provide the legal context of the commentary. Each case note is introduced by an indication of whether the ruling is that of the CJEU, GC, or national court, with an indication of the status and seniority of the relevant court concerned.

II. ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION, AND FOR CANCELLATION

A. Introductory Comments

Absolute grounds relate to the inherent characteristics of the trademark in question, such as its form (clarity, precision, and scope) and the extent to which it can perform what EU law refers to as "the essential function" of trademarks—to identify the exclusive origin of the goods or services for which registration is sought without the possibility of confusion. Grounds for refusal of registration on the basis of absolute grounds typically also form the basis for a later claim to invalidation, so cases in this section usually deal with the analysis of both pre- and post-registration issues. The law in other European states is typically closely modelled on the EU legislation, and many of the same issues will apply.

Absolute grounds are considered under both Article 4 and Article 7 of the 2017 EUTM Regulation, since the considerations of Article 4 of the 2017 EUTM Regulation are incorporated by Article 7(1)(a) of the 2017 EUTM Regulation. The absolute grounds for refusal or invalidity are all now solely contained in Article 4 of the 2015 TM

Directive although Article 4(1)(a), by implication at least, incorporates Article 3 of that Directive.

The starting point for any consideration of registrability (or validity) is therefore whether the "sign" in question is something "of which a trademark may consist" within the bounds of EU law under Article 4 of the 2017 EUTM Regulation or Article 3 of the 2015 TM Directive. If it is not, a valid registration is impossible.

Absolute grounds are harmonized as between EUTMs and national trademarks in EU Member States. The absolute grounds for refusal relating to EUTMs are set out in Article 7(1) of the 2017 EUTM Regulation. The absolute grounds for refusal that must be applied by the national trademark authorities of EU Member States are set out in Article 4(1) of the 2015 TM Directive.

The first four absolute grounds for refusal of registration are, in general terms, (a) that the mark is not a sign capable of protection; (b) that the mark is not distinctive; (c) that the mark is descriptive; and (d) that the mark is generic. The last three of these grounds can, in principle, be overcome by evidence that the trademark has acquired distinctiveness through the use made of it prior to the relevant date. The first cannot.

Article 7(1) of the 2017 EUTM Regulation and Article 4(1) of the 2015 TM Directive go on to provide certain specific absolute grounds for refusal relating to shape marks, marks that would be contrary to public policy, marks that would be deceptive, marks that raise issues under Article 6ter of the Paris Convention, and marks that contain certain geographical indications or designations of origin protected in the EU. Article 7(1) of the 2017 EUTM Regulation expressly provides for absolute grounds of refusal by reference to traditional terms for wine, traditional specialties guaranteed ("TSGs"), and plant variety rights. Similar provisions are contained in the 2015 TM Directive, where the absolute grounds for refusal are contained in Article 4(1)(i) to 4(1)(l) of the 2015 TM Directive.

Absolute grounds cases offer the opportunity for courts and tribunals to consider one of the fundamental questions of trademark law—what can (and should) constitute a valid mark, capable of distinguishing origin? An analysis of the most topical cases in 2025 identifies three of the most common themes. The first relates to geographical indications and whether country or place names can be monopolized as trademarks. The German courts grappled with whether "Dubai Chocolate" denoted a geographical origin or merely a recipe, while the General Court invalidated the ICELAND word and figurative marks for food, beverages, and retail services on grounds of descriptiveness. The second theme relates to the registrability and clarity requirements for non-traditional marks that continued to be contentious, with the General Court refusing a position mark consisting of a red stripe on a VistaJet aircraft and also invalidating the Rubik's Cube shape marks for the technical

function of a shape mark, while the UK Court of Appeal considered whether written descriptions of figurative and position marks could extend beyond their pictorial representations. Thirdly, color marks continue to attract particular scrutiny, with the General Court upholding refusal of a blue-green combination for service stations and the German courts issuing a series of decisions examining the evidentiary requirements for acquired distinctiveness, including the effect of concurrent marketing campaigns on survey reliability and the necessity of identifying colors by recognized classification codes.

B. Legal Texts

Part (b) of Article 4 of the 2017 EUTM Regulation was a new addition, replacing the requirement in Article 4 of the "old" EUTM Regulation that the sign should be "capable of being represented graphically." Also new to Article 4 were the express references to colors and sounds, although this change was not intended to alter the substance of the law. The possibility of registering EUTMs without a graphical representation (e.g., by providing a sound file for a sound mark) first became a possibility on October 1, 2017 (similar modifications were made in the 2015 TM Directive, where the relevant provisions appear in Articles 3 and 4(1)(a)).

Article 4 of the 2017 EUTM Regulation

An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

(a) distinguishing the goods or services of one undertaking from those of other undertakings; and

(b) being represented on the Register of European Union trade marks ("the Register"), in a manner which enables the competent authorities and the public to determine the clear and precise subject-matter of the protection afforded to its proprietor.

Article 7 of the 2017 EUTM Regulation

Absolute grounds for refusal

1. The following shall not be registered:
   (a) signs which do not conform to the requirements of Article 4;
   (b) trade marks which are devoid of any distinctive character;
   (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate

the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

(e) signs which consist exclusively of:

(i) the shape, or another characteristic, which results from the nature of the goods themselves;

(ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;

(iv) the shape, or another characteristic, which gives substantial value to the goods;

(f) trade marks which are contrary to public policy or to accepted principles of morality;

(g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service;

(Note: paragraphs (h) to (m) omitted.)

2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Union.

3. Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.

Article 3 of the 2015 TM Directive

Signs of which a trademark may consist

A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

a) distinguishing the goods or services of one undertaking from those of other undertakings; and

b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

Article 4 of the 2015 TM Directive

Absolute grounds for refusal or invalidity

1. The following shall not be registered or, if registered, shall be liable to be declared invalid:
   (a) signs which cannot constitute a trade mark;
   (b) trade marks which are devoid of any distinctive character;
   (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;
   (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
   (e) signs which consist exclusively of:
      (i) the shape, or another characteristic, which results from the nature of the goods themselves;
      (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;
      (iii) the shape, or another characteristic, which gives substantial value to the goods;
   (f) trade marks which are contrary to public policy or to accepted principles of morality;
   (g) trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service;
   (h) trade marks which have not been authorised by the competent authorities and are to be refused or invalidated pursuant to Article 6ter of the Paris Convention;
   (i) trade marks which are excluded from registration pursuant to Union legislation or the national law of the Member State concerned, or to international agreements to which the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications;
   (j) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine;

(k) trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional specialities guaranteed;

(l) trade marks which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation or the national law of the Member State concerned, or international agreements to which the Union or the Member State concerned is party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species.

2. A trade mark shall be liable to be declared invalid where the application for registration of the trade mark was made in bad faith by the applicant. Any Member State may also provide that such a trade mark is not to be registered.

3. Any Member State may provide that a trade mark is not to be registered or, if registered, is liable to be declared invalid where and to the extent that:

(a) the use of that trade mark may be prohibited pursuant to provisions of law other than trade mark law of the Member State concerned or of the Union;

(b) the trade mark includes a sign of high symbolic value, in particular a religious symbol;

(c) the trade mark includes badges, emblems and escutcheons other than those covered by Article 6ter of the Paris Convention and which are of public interest, unless the consent of the competent authority to their registration has been given in conformity with the law of the Member State.

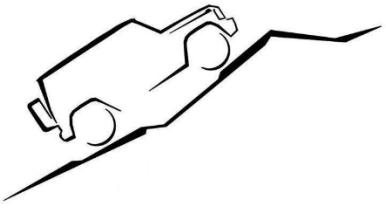
4. A trade mark shall not be refused registration in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration, following the use which has been made of it, it has acquired a distinctive character. A trade mark shall not be declared invalid for the same reasons if, before the date of application for a declaration of invalidity, following the use which has been made of it, it has acquired a distinctive character.

5. Any Member State may provide that paragraph 4 is also to apply where the distinctive character was acquired after the date of application for registration but before the date of registration.

C. Cases

1. EU—GC—Can a sketch of an off-road vehicle be inherently distinctive for vehicles and their parts?

In *Mercedes-Benz Group AG v. EUIPO*,[2] the General Court considered an appeal from a decision of the Fifth Board of Appeal, which refused registration of a figurative EU trademark showing an off-road vehicle climbing a slope, with respect to, among others, "motor vehicles and parts thereof" in Class 12:



The refusal was based on the absolute ground of lack of distinctive character under Article 7(1)(b) of the 2017 EUTM Regulation. The applicant, Mercedes-Benz AG, brought an action before the Court advancing a single plea alleging infringement of Article 7(1)(b) of the 2017 EUTM Regulation. It argued that even the slightest distinctive character in a mark, however weak, should preclude the non-distinctiveness objection. Further, the applicant claimed that the Board failed to consider all possible significant uses of the mark. Finally, Mercedes-Benz argued that recognition of distinctive character does not require any particular originality, creativity, or novelty of the applied-for mark.

The Court first considered the test under Article 7(1)(b) of the 2017 EUTM Regulation and stressed that a mark must enable the relevant public to identify commercial origin. A low threshold of distinctiveness is enough, but the assessment is made by reference to the goods and to public perception. The Board had identified the relevant public as EU consumers who show a higher level of attention when buying costly goods such as vehicles. The Court accepted that finding.

The Court agreed with the Board that the sign is a common depiction of an off-road vehicle. The graphic shows a boxy vehicle with large tyres and an external rear spare tire climbing a slope. Those are typical features and a typical situation for such vehicles. The image communicates an objective, promotional message that the goods relate to off-road vehicles and their parts. The Court found that the applied-for mark did not contain any element capable of being remembered by the consumer as a reference to the applicant.

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[2] Case T-400/24 (GC, March 19, 2025).

As a result, it was incapable of distinguishing the relevant goods from those offered by other undertakings. On that basis, the mark did not meet the distinctiveness threshold under Article 7(1)(b) of the 2017 EUTM Regulation.

Interestingly, recalling *Hästens Sängar v. EUIPO*,[3] the Court stressed that the closer a sign comes to the usual appearance of the goods, the more likely it is to be non-distinctive under Article 7(1)(b). Only a sign that departs significantly from the norms or customs of the sector can indicate origin. Although developed for three-dimensional marks, the Court pointed out that this principle applies by analogy to figurative signs that are two-dimensional depictions of the goods. Applied here, the sketch-like execution did not create such a significant departure. If anything, the Court stressed, its simplicity made the device blend into customary depictions rather than stand out from them.

The applicant's argument that the Board failed to consider all significant uses of the sign also failed. The Court stated that the contested decision assessed consumer perception in realistic trade contexts, including advertising. The Court pointed out that the applicant did not identify any other significant ways of use in the sector that, if considered, would alter the outcome. In the absence of such specifics, the applicant failed to show an error in applying Article 7(1)(b) of the 2017 EUTM Regulation by the Board of Appeal. In the light of the above, the Court dismissed the action.

2. EU—GC—Is a combination of two colors sufficiently distinctive?

In *OMV AG v. EUIPO*,[4] the General Court considered an EU designation of an international registration consisting of a combination of colors, identified as gentian blue (RAL 5010) and yellow green (RAL 6018), filed by the applicant, OMV AG:

The application covered, among others, goods and services in Classes 1, 4, 35, and 37, including "chemical additives to motor fuel and hydrogen; fuels, lubricants and electrical energy; retail and wholesale services relating to fuels, lubricants and vehicle products and construction, maintenance, refuelling and recharging services for energy and service-station infrastructure." The EUIPO refused

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[3] Case T-658/18 (GC, December 3, 2019).

[4] Case T-38/24 (GC, June 11, 2025).

the application in part, for the above goods and services, as lacking distinctive character under Article 7(1)(b) of the 2017 EUTM Regulation, and the Board dismissed the applicant's appeal.

On appeal, the applicant advanced three pleas, supported by interveners from the amicus groups of MARQUES and INTA: insufficient reasoning, infringement of Article 7(1)(b) of the 2017 EUTM Regulation, and breach of the principles of legal certainty, equal treatment, and sound administration.

The Court first addressed the duty to state reasons and rejected the applicant's complaint. It held the Board had explained why the mark lacked distinctiveness and had addressed the systematic arrangement of the two colors and their specific tones. It also noted that the Board had identified the legal framework applicable to color combinations, and had explained the associations that blue and green may convey in the automotive sector. The Court noted that the Board considered OMV's market studies but found them irrelevant to inherent distinctiveness. It also accepted the Board's practical observations about how the arrangement would be perceived by drivers approaching filling stations at speed and in varying conditions, and found that the Board's explanation on these points was adequate.

Turning to inherent distinctiveness, the Court recalled that while Article 7(1)(b) of the 2017 EUTM Regulation does not differentiate by sign type, the relevant public's perception of a color or color combination *per se* is not the same as for word or figurative signs, and that there is a general interest in not unduly restricting the availability of colors.

Recalling *Heidelberger Bauchemie*,[5] *Demp v. EUIPO*,[6] and *Enercon v. OHIM*,[7] the Court confirmed that a systematic arrangement associating colors in a predetermined and uniform way is not, of itself, sufficient to confer distinctive character. Rather, such a sign must contain elements capable of distinguishing it from other color combinations and of attracting the consumer's attention so that it functions as an indicator of origin for the specified goods and services. Against that standard, the Court upheld the Board's finding that blue and green, in various tones and layouts, are common in the service-station market for which the mark would be used. The specific OMV scheme, even in its stated arrangement, would be seen as decorative rather than as a badge of origin. The Court added that the applicant's surveys, carried out after the relevant filing and designation dates, could not establish inherent distinctiveness at the time of filing.

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5 Case C-49/02 (CJEU, June 24, 2004).

6 Case T-595/17 (GC, September 27, 2018).

7 Case T-655/13 (GC, January 28, 2015).

The Court also rejected the applicant's criticism of the Board's discussion of color connotations. It held that considering the ideas evoked by green and blue, including environmental or ecological themes, was part of assessing how the relevant public perceives the sign and whether it conveys information about commercial origin. INTA's suggestion that such analysis is relevant only to descriptiveness under Article 7(1)(c) of the 2017 EUTM Regulation was dismissed. The reasoning went to origin-indicating capacity, which is central to Article 7(1)(b) of the 2017 EUTM Regulation.

Finally, the Court dismissed the plea based on legal certainty, equal treatment, and sound administration. It reiterated that EUIPO's Guidelines are not binding and that the legality of a decision is assessed against the 2017 EUTM Regulation as interpreted by the EU Courts. It stressed that the Board had relied on pertinent case law, well-known facts, specific examples from the market, an Internet search, and even the applicant's own expert material. There was, therefore, no breach of the invoked principles. In the light of the above, the General Court dismissed the action.

3. EU—GC—Can a country name function as a trademark for everyday goods and retail services, or is it descriptive of their geographical origin?

In the joined cases of *Iceland Foods Ltd. v. EUIPO*,[8] the General Court considered two parallel appeals from decisions of the EUIPO Grand Board of Appeal upholding applications for declarations of invalidity of the word mark ICELAND and the corresponding figurative mark:

Both marks were registered in 2014 by the applicant, Iceland Foods Ltd., a British supermarket chain, and covered a broad range of goods and services in Classes 7, 11, 16, 29 to 32, and 35, including everyday consumer products, such as foodstuffs and retail thereof. The registrations were challenged by the Icelandic Trademark Holding ehf (in case of the figurative mark), and by Íslandsstofa (Promote Iceland), The Icelandic Ministry for Foreign Affairs and SA—Business Iceland (in case of word mark). The applications for declarations of invalidity were based, among others, on the ground

[8] Cases T-105/23 and T-106/23 (GC, July 16, 2025).

of descriptiveness under Article 59(1)(a) in conjunction with Article 7(1)(c) of the 2017 EUTM Regulation.

In 2019, the EUIPO Cancellation Division declared the contested EU trademarks invalid for all the goods and services; decisions subsequently confirmed by the EUIPO Grand Board of Appeal. The Grand Board found that the marks were perceived by the relevant public (being the English-speaking general public of the European Union) as indicating that the goods and services covered originated from Iceland. Regarding the figurative mark, the Grand Board added that this perception was not altered by the figurative elements of the contested mark, given their decorative nature. These cases are also notable as the first-ever oral hearing of the EUIPO Grand Board open to the public. The hearing was also streamed online, with nearly a thousand attendees joining the live transmission of the hearing in September 2022.

In its appeal to the General Court, the applicant, supported by an amicus intervention from INTA, alleged infringement of Article 7(1)(c) and Article 7(1)(b) of the 2017 EUTM Regulation, which deal with, respectively, a sign's descriptiveness and non-distinctiveness. In giving judgment, the Court first set out the legal framework on absolute grounds for invalidity. It recalled that under Article 59(1)(a) of the 2017 EUTM Regulation a registered EU trademark must be declared invalid if it was registered contrary to Article 7 of the 2017 EUTM Regulation. Article 7(1)(c) of the 2017 EUTM Regulation excludes signs that may serve to designate, in trade, the geographical origin or characteristics of goods or services. Article 7(2) of the 2017 EUTM Regulation confirms that the restriction applies even if the ground obtains only in part of the European Union. The Court reiterated the public-interest aim of keeping geographical names free. Recalling *Bundesverband Souvenir—Geschenke—Ehrenpreise v. EUIPO*,[9] the Court stated that refusal is warranted where, at the relevant filing date, the name designates a place associated in the minds of the relevant public with the goods or services, or where such an association can reasonably be expected to arise. The Court also noted the presumption of validity in invalidity proceedings and confirmed that the burden of proof lies on the invalidity applicants.

Turning to the substance, the Court addressed the application of Article 7(1)(c) of the 2017 EUTM Regulation to foods and beverages. It held that for Classes 29 to 32, the link between the sign ICELAND and geographical origin was immediate and specific. Indications of origin are customary, and for some goods mandatory, in the food and beverage sector. The evidence showed that, at the relevant dates, Iceland produced and exported a wide range of products of plant and animal origin, including fish and

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[9] Case C-488/16 P (CJEU, September 6, 2018).

seafood, beef, mutton and pork, dairy products, fruits, vegetables, and herbs. It was reasonable to expect production or processing of other goods, such as edible oils and fats, and that even goods not grown in Iceland, like coffee or tea, could be processed there and adapted to local taste. The Court emphasized that consumers could legitimately perceive goods marketed under ICELAND marks as originating from that country or as having characteristics linked to that origin. Arguments that food exports formed only a small share of Iceland's total exports did not displace this descriptive link. The same analysis applied to beers, waters, and non-alcoholic beverages in Class 32, given the evidence of production and the sector's practices.

The Court then examined non-food goods and printed matter in the word-mark case. It upheld the Grand Board's finding that for Classes 7 and 11, which include refrigerators, freezers, and household appliances, the sign ICELAND could designate geographical origin and qualities associated with that origin, in particular sustainability and eco-friendliness. The evidence supported a perception of Iceland as a country with strong renewable energy credentials and an industrial base capable of manufacturing such goods, or capable of doing so in the foreseeable future. For Class 16, which includes printed matter, periodical publications, and stationery, the sign could describe the subject matter of the goods or their ecological messaging linked to Iceland, irrespective of the place of manufacture. In each case, the Court confirmed that the descriptive character arose in the minds of the relevant public at the relevant date.

Finally, the Court assessed retail and related services in Class 35. It held that ICELAND could be understood as describing the place from which retail services are provided, or as conveying information about the geographical origin or qualities of the goods sold in connection with those services. This descriptive understanding was reinforced by sector practice and by consumer expectations in retail of food and household products. The Court therefore confirmed the Grand Board's application of Article 7(1)(c) of the 2017 EUTM Regulation to Class 35.

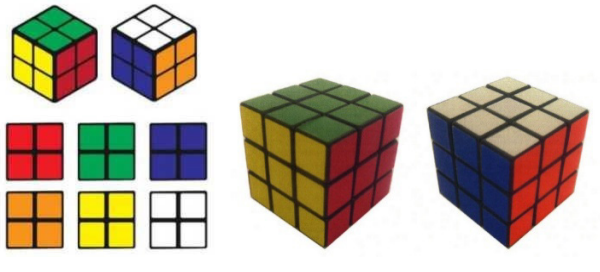
The Court also addressed the figurative elements in the figurative-mark case. It agreed that the colored rectangular background and the standard white typography did not alter the descriptive message of the word element. Such background colors are common in advertising and packaging and would be perceived as decorative. The figurative elements highlighted the word "ICELAND" rather than changing its meaning. The Court therefore held that the sign remained descriptive under Article 7(1)(c) of the 2017 EUTM Regulation.

The Court rejected the applicant's and INTA's arguments. The Court clarified that there is no per se prohibition on registering

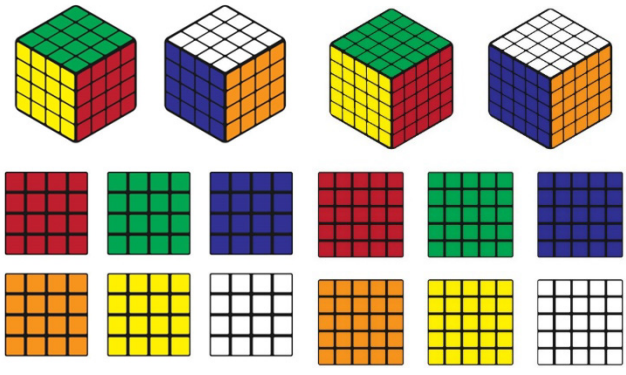
country names; however, registration must be refused under Article 7(1)(c) of the 2017 EUTM Regulation where the sign is descriptive for the relevant goods or services at the relevant date, or is reasonably expected to become so. It also dismissed reliance on Article 14(b) of the 2017 EUTM Regulation. That provision limits the effects of a trademark by preserving third-party descriptive use; it does not protect the public-interest objective underpinning Article 7(1)(c) of the 2017 EUTM Regulation, which must be applied at the registration or invalidity stage. The Court also upheld the Grand Board's treatment of evidence. It considered the economic, environmental, and export data relied upon by the interveners as apt to establish the descriptive link. It held that consumer surveys adduced out of time or post-dating the relevant filing dates were rightly found inadmissible or irrelevant to inherent descriptiveness. Finally, the Court noted that only one absolute ground of refusal needs to apply. Given that Article 7(1)(c) of the 2017 EUTM Regulation sufficed, the Court did not need to examine Article 7(1)(b) of the 2017 EUTM Regulation. In the light of the above, the Court dismissed both actions and upheld the Grand Board's decisions declaring the ICELAND word and figurative marks invalid under Article 59(1)(a), read with Article 7(1)(c), of the 2017 EUTM Regulation.

4. EU—GC—Is a 3D trademark consisting of a Rubik's Cube shape capable of having distinctive character, or does it consist exclusively of the shape necessary to obtain a technical result?

In *Spin Master Toys UK Ltd. v. EUIPO*,[10] the General Court reviewed four parallel actions against decisions of the EUIPO First Board of Appeal upholding applications for declarations of invalidity of the following three-dimensional EU trademark registrations owned by the applicant, Spin Master Toys UK Ltd., and covering, among others, "toys, games, playthings and three-dimensional puzzles" in Class 28:



[10] Cases T-1170/23, T-1171/23, T-1172/23, and T-1173/23 (GC, July 9, 2025).



In the contested decisions, the Board had found that each of the marks consisted exclusively of the shape of goods necessary to obtain a technical result, within the sense of Article 7(1)(e)(ii) of the 2009 EUTM Regulation (now replaced by the 2017 EUTM Regulation) in relation to the relevant goods in Class 28. It had held that the essential characteristics of each sign were functional and that the marks therefore fell within the absolute ground.

The applicant then brought four actions before the Court. On appeal, the Court first set out the legal framework, recalling that the public interest underlying Article 7(1)(e)(ii) is to keep technical solutions and the functional characteristics of products free for all. A sign cannot be registered if, in its essential characteristics, it consists exclusively of the shape of goods that is technically causal and sufficient for the intended result. The availability of alternative shapes is irrelevant. Minor arbitrary features do not save a sign if all essential characteristics are functional. Aesthetic appeal does not preclude the bar. In recalling these principles, the Court cited well-established case law, including *Lego Juris v. OHIM*,[11] *Gömböc*,[12] and the Court of Justice's earlier judgment concerning black-and-white Rubik's Cube.[13]

The Court then confirmed the technical result common to all four marks. The goods are three-dimensional color puzzles solved by rotating rows of smaller cubes around three axes to produce six uniformly colored faces. According to the Court, the Board had correctly identified three essential characteristics across the variants: the cube shape, the grid structure separating equal, movable units on each face, and the differentiation of those units by six basic colors, creating a contrasting effect that allows the user to distinguish faces and squares. The Court rejected the applicant's contention that a "specific arrangement" of the six colors was an

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11 Case C-48/09 P (CJEU, September 14, 2010).

12 Case C-237/19 (CJEU, April 23, 2023).

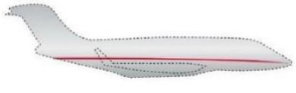
13 Case C-30/15 P (CJEU, November 10, 2016).

essential characteristic. No such arrangement was clearly and unambiguously shown in the representations or descriptions.

The Court held that the color differentiation of the squares performed the technical function of enabling the user to distinguish each face and each unit on that face to complete the puzzle by aligning colors. Such color differentiation was, therefore, inherent in and inseparable from the shape. The fact that other surface designs (letters, symbols, patterns) could achieve the same effect was found immaterial. The Court also dismissed the applicant's argument that the bright colors were chosen for aesthetic "excitement." In light of the above, the Court dismissed all four actions and upheld the Board of Appeal's decisions declaring the contested shape marks invalid for the Class 28 goods.

5. EU—GC—Can a red stripe on a silver aircraft fuselage be registered as a position mark for private aviation services?

In *VistaJet Ltd. v. EUIPO*,[14] the General Court considered an appeal from a decision of the EUIPO First Board of Appeal refusing an EU trademark application for a position mark consisting of a horizontal red stripe on a silver aircraft fuselage:



The application, filed by VistaJet Ltd., covered services in Class 39, including "air transport by means of private aircraft, private aircraft charter services and private aircraft flight planning services." The EUIPO refused registration for lack of distinctive character under Article 7(1)(b) of the 2017 EUTM Regulation, and the Board dismissed the applicant's appeal. VistaJet brought a single plea before the General Court, alleging infringement of Article 7(1)(b) of the 2017 EUTM Regulation.

On appeal, the Court first addressed the legal framework for position marks. It noted that neither the 2017 EUTM Regulation nor the Delegated Regulation refers to position marks as a specific category, but that this is irrelevant to registrability given the non-exhaustive list of sign types pursuant to Article 4 of the 2017 EUTM Regulation. The Court then stated that position marks share characteristics with figurative and three-dimensional marks, since they relate to the application of elements to a product surface. The Court confirmed that case law developed for three-dimensional marks consisting of the appearance of the product also applies to

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[14] Case T-195/24 (GC, February 5, 2025).

position marks that are indissociable from the appearance of the goods or services concerned. Accordingly, a position mark must depart significantly from the norms and customs of the sector to be perceived as an indicator of origin.

The Court identified the relevant public as members of the general public, specifically the ultra-wealthy, who display a high level of attention when selecting private aviation services due to factors such as safety, punctuality, and cost. However, the Court recalled that a higher level of attention does not lower the threshold of distinctiveness required under Article 7(1)(b) of the 2017 EUTM Regulation. The overall impression must still enable identification of commercial origin.

Turning to the substance, the Court agreed with the Board that the mark would not be perceived by the relevant public as distinctive. A line is a basic geometrical figure that is not, in itself, capable of conveying a memorable message. The red color is highly visible and striking, but is commonly used for decorative purposes and is, therefore, in itself devoid of inherent distinctiveness. The silver fuselage does not stand out from the colors customary in the aviation sector. Taken together, the Court found that the elements amount to a simple, banal decorative device.

The Court also rejected the applicant's argument that the Board had failed to examine the mark as a whole. It found that the Board assessed each element, including the line, the color red, and the silver fuselage, and expressly concluded that their combination served a decorative rather than origin-indicating purpose. The Court confirmed that the overall impression, including the affixing of the sign to the goods to which the services relate, was duly considered.

Finally, the Court dismissed the applicant's reliance on prior EUIPO decisions registering similar marks. Recalling *Agencja Wydawnicza Technopol v. OHIM*,[15] it reiterated that EUIPO must take account of previous decisions and apply the principles of equal treatment and sound administration. However, legality is assessed against the 2017 EUTM Regulation as interpreted by the EU courts, not by reference to earlier administrative practice. The examination must be stringent and full in each individual case. The Court stated that the Board was entitled to find the ground for refusal applicable, and the applicant could not rely on allegedly unlawful acts committed for the benefit of others. In the light of the above, the Court dismissed the action.

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[15] Case C-51/10 P (CJEU, March 10, 2011).

6. Austria—Austrian Supreme Court—How strict are the requirements for the registration of color trademarks in Austria?

In this case,[16] the Austrian Supreme Court ("OGH") had to deal with an application for the registration of the color trademark depicted below, which was applied for the following goods and services in Classes 1 (chemical preparations as fuel additives for improving combustion, inter alia), 4 (fuels, inter alia), 35 (retail services relating to food and beverages, inter alia), 37 (repair and maintenance of vehicles, inter alia), 39 (transport services, inter alia), 40 (energy generation, inter alia), 42 (software development, inter alia), 43 (provision of food and drink, inter alia), and 44 (operation of public showers, washrooms [personal hygiene] and toilets).

The applicant is a multinational Austrian oil, gas, and chemicals group engaged, inter alia, in exploration, production, refining, and marketing, and operating a large number of petrol stations across Europe.

First-instance decisions established that:

(a) 39% of the relevant public are familiar with the sign in connection with oil and gas companies;

(b) 74% per cent of the relevant public associate the sign with one specific undertaking when they see it in connection with petrol stations; and

(c) 59% of the relevant public attribute the sign to the group to which the applicant belongs, 2% to a competing group and 3% to other undertakings.

The applicant lodged an extraordinary appeal after the Patent Office rejected the original application on the grounds of lack of distinctiveness pursuant to Section 4(1)(3) of the Austrian Trademark Protection Act ("MSchG") and the Court of Appeal upheld this decision.

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[16] Austrian Supreme Court (July 22, 2025), 4Ob109/25w.

According to Section 4(1)(3) MSchG, signs that are excluded from registration are those that have no distinctive character. According to Section 4(2) MSchG, registration would still be possible despite the lack of distinctive character if the sign has acquired distinctive character in the domestic market within the relevant circles of trade and commerce prior to the application as a result of its use.

In the court's opinion, the color combination "blue-green" was not inherently distinctive. The applicant also failed to prove that the sign had acquired distinctiveness through use (secondary meaning): it had not demonstrated that a sufficiently high proportion of the relevant public would associate the sign with a specific undertaking when it is viewed completely in isolation and not in connection with petrol stations. An association rate of 59% was considered too low in light of the particular need to keep colors and color combinations free for general use.

With regard to the question of the *original distinctiveness* of the sign, the OGH held that both the Legal Department of the Patent Office and the appellate court had correctly found that such distinctiveness was lacking, and that this assessment could not be altered by case law cited by the applicant.

With regard to the question of *acquired distinctiveness*, the Austrian Supreme Court emphasized that colors generally have a low inherent capacity to distinguish. Although colors may evoke associations or emotions, they are by their nature scarcely capable of conveying clear and unequivocal information. This is particularly true because colors are widely used in the marketing of goods and services for their attractive effect and usually without any specific semantic content. As a result, there is generally a strong public interest in keeping colors and color combinations free for use.

The Court further observed that consumers typically distinguish only between a limited number of colors, since they rarely have the opportunity to compare goods or services featuring different shades directly. Consequently, even a small number of registrations of abstract color marks for specific goods or services could significantly restrict the range of colors available to competitors.

A color or a color combination may nevertheless acquire distinctiveness through use in relation to the goods and services for which it is registered, provided that at least a significant part of the relevant public recognizes the sign as indicating commercial origin. This is primarily assessed on the basis of the degree of distinctiveness, meaning the proportion of the relevant public that perceives the sign, in connection with certain goods or services, as an indication of a particular undertaking. The rate of attribution becomes relevant only where the degree of distinctiveness does not lead to a clear result.

The Court made clear that there is no fixed threshold above which acquired distinctiveness must be presumed. Instead, a case by case assessment is required. The lower the inherent capacity of a sign to distinguish and the greater the need to keep it free for general use, the higher the evidentiary requirements for proving acquired distinctiveness, in particular with regard to the degree of distinctiveness.

Applying these principles, the Austrian Supreme Court agreed with the appellate court that the sign consisting of the colors blue and green has only a low capacity to distinguish. Both colors, whether considered individually or in the specific combination applied for, are commonly used in the marketing of goods and services, including those at issue. In light of the strong public interest in keeping these positively connoted colors available for general use, the appellate court's conclusion that the sign had not acquired distinctiveness through use was consistent with established case law and did not constitute a manifest error of assessment.

7. Germany—Court of Appeal of Cologne—Geographical indication—Does "Dubai Chocolate" denote a geographical origin or merely a type of or recipe for chocolate?

In a recent decision, the Court of Appeal of Cologne ruled on the distinctiveness of "Dubai Chocolate" (chocolate typically filled with pistachio cream and shredded pastry, *Kadayif*) resolving diverging court decisions at first instance.

The origins of Dubai chocolate are unclear. Many attribute the success to a Dubai-based influencer, Sarah Hamouda, who claimed to have created "Dubai Chocolate" in 2021. Others attribute the success to a food influencer on TikTok, Maria Vehera, who posted videos of herself eating Dubai chocolate in December 2023, which received more than 98 million views. By fall of 2024, consumers in Germany were swept up in the chocolate's popularity and in several cities queued for hours to buy a bar of "Dubai chocolate."

As might be expected, a range of products were soon on offer, including some genuinely produced in Dubai that were offered by German importers; other manufacturers, retailers, and discount chains all marketed similar products under names such as "Dubai Chocolate," or "A Touch of Dubai," even though many were produced in Tu̇rkiye or elsewhere. The central legal question was thus whether products could be described as "Dubai Chocolate" (or similar) if they are not actually produced in Dubai or have no genuine link to the geographical location.

In 2024, the German Patent Trademark Office rejected two trademark applications for "Dubai Schokolade" for confectionery

goods in Class 30 on the basis of a lack of distinctiveness and a descriptive nature. As such, trademark protection for "Dubai Chocolate" was not possible.

Unlike designations such as "Champagne," there is currently no protected geographical indication for "Dubai Chocolate." That left open the question as to whether "Dubai Chocolate" was a geographical indication or a generic indication of the type or recipe of chocolate. Under Section 127 of the German Trademark Act, a geographical indication may not be used in a misleading manner that deceives consumers as to the true origin of the product, so if "Dubai Chocolate" merely denoted origin, its use would be restricted to products genuinely connected to Dubai. However, if it denoted a generic recipe, then its use might be permissible regardless of source location.

Recent German court decisions had come to differing interpretations. One chamber of the District Court of Cologne[17] (like the District Court of Bochum[18] in an earlier decision) had ruled in favor or a geographic indication and held that selling chocolate produced in Türkiye labelled "Dubai Chocolate" was misleading. The average consumer would assume a production origin in Dubai, and thus the labelling constitutes a deceptive indication of origin. However, only a day later another chamber of the District Court of Cologne[19] (like the District Court of Frankfurt/Main[20] in an earlier decision) held that "Dubai" has evolved into a generic term for a particular recipe or flavor rather than a true geographical origin, and therefore did not mislead consumers.

In June 2025, the Court of Appeal of Cologne then decided[21] on an appeal in the case of "Dubai handmade chocolate," finding that "Dubai" must be understood as a geographical indication in this context.

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17 Dec. of February 25, 2025, Case No. 33 O 513/24.

18 Dec. of January 20, 2025, Case No. 17 O 5/25.

19 Dec. of February 26, 2025, Case No. 84 O 11/25.

20 Dec. of January 21, 2025, Case No. 2-06 O 18/25.

21 Dec. of June 27, 2025, Case No. 6 U 52/25.

It held that the designation "Dubai-Handmade Chocolate" fulfilled the requirements for a direct indication of origin: The relevant public understand it as an indication of origin and do not perceive it merely as a reference to the recipe—chocolate with pistachios and kadayif (angel hair)—or as a purely fanciful designation. The court could make its own findings on the perception of the relevant public because the offer is aimed at the general consumer, so no expert evidence was required.

The court held that designations, which directly refer to a specific origin, are generally to be regarded as designations of origin provided they are not merely indications of quality detached from their (local) origin or purely fanciful designations.

The court took into account that the "hype" surrounding "Dubai Chocolate" first originated in Dubai (and the invention of the recipe by Ms. Sarah Hamouda) but that it then gained worldwide fame and, for the purposes of this dispute, significant Germany-wide recognition through TikTok videos by two influencers who each tried this chocolate in Dubai and enthusiastically reported on it to their "followers." The particularly high prices charged for the chocolate products, especially in the early days, and the initially limited availability of the chocolate products in Germany suggest that consumers understood the designation from the outset as an indication of origin and not merely a description of the composition of ingredients. Only for the luxury and exclusivity associated with Dubai were consumers willing to pay so much and wait in line for hours, which also led to the chocolate being resold online at considerable markup due to its scarcity. The perception of consumers was not only influenced by their appreciation for a recipe with pistachios (and commensurate cost) but also the origin from the emirate or city of Dubai, which promises a special "exclusive moment of enjoyment."

The understanding of the designation "Dubai Handmade Chocolate" as an indication of origin was also supported by the design of the product packaging: The pictorial representation of, among other things, the striking and widely recognized silhouettes of the Burj al-Arab and Burj Khalifa conveyed at least one association with Dubai to the relevant public even when viewed in isolation. This appearance of Dubai origin in Dubai was reinforced by the fact that the front of the packaging is exclusively in English and hence imported.

From this basis, a subsequent change in meaning to the effect that the designation "Dubai Chocolate" or "Dubai Schokolade" would now be understood only as a generic term could not be established. That risk would arise only if the section of the relevant public who sees the indication as a geographical reference had become negligible. Measured against this, despite intensive media coverage and a large number of "free-riding" products, it could not be assumed as merely a generic term. Despite frequent use as a recipe and as a general term in the media, the mark remained primarily one of geographical indication.

8. Poland—Is the foreign-language term "perlage" descriptive for mineral water?

In Case II GSK 2433/21 *PERLAGE*,[22] the Polish Supreme Administrative Court considered an appeal from the judgment of the District Administrative Court upholding the Polish Patent Office's ("PPO") refusal to register PERLAGE for "mineral waters" in Class 32.

The Polish Patent Office had found the sign devoid of sufficient distinctiveness on the basis that it directly described a method of carbonation and, in any event, had not acquired distinctiveness through use. In the contested decision, the District Administrative Court accepted that approach, concluding that PERLAGE immediately conveyed to consumers a production method and therefore could not function as an indicator of origin for the goods claimed.

On appeal, the Supreme Administrative Court overturned the contested decision and the PPO's refusal. The Supreme Administrative Court began by restating the standards for descriptiveness under the Polish Industrial Property Law ("IPL"). A sign is descriptive only if, for the relevant public, it conveys a current, concrete, and direct indication of characteristics of the goods, and the assessment must be conducted *ad casum* with reference to the nature of the goods and the perception of their consumers. The Court framed the decisive question as whether an

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[22] Case II GSK 2433/21 (Supreme Administrative Court, May 6, 2025).

average Polish consumer of table waters would, without reflection, perceive PERLAGE as designating a characteristic of the product rather than as a badge of commercial origin. That question had to be answered from the viewpoint of Polish-language consumers applying their ordinary marketplace understanding.

The Court emphasized that "perlage" is a French word that does not occur in Polish and is not commonly known even among Poles with some knowledge of French. By contrast, the marketplace uses Polish descriptors such as "gazowana," "lekko gazowana," and "średnio gazowana" to refer to carbonation levels in water. The Court explained that a foreign-language term can be descriptive in a national system only if a significant part of the relevant local public will actually recognize it, in ordinary usage, as denoting a product characteristic. That threshold was not met here. The Court distinguished EU-level case law on unitary marks, where descriptiveness in any one Member State language can suffice, noting that a Polish national application must be assessed from the perspective of Polish-language consumers.

Applying those principles, the Court rejected the administrative premise that PERLAGE would, for the Polish public, directly and concretely describe a production method for mineral water. The materials cited in support of descriptiveness did not show that the French term was used or understood by Polish consumers as an informational indication; everyday Polish usage pointed the other way. Given the breadth of the relevant consumer group for mineral waters and the absence of the term from Polish-language dictionaries, PERLAGE would be perceived as fanciful. Because the sign was inherently distinctive for the goods claimed, there was no need to examine whether it had acquired distinctiveness through use.

The Court also identified procedural shortcomings in both the PPO's and first-instance Court's reasoning, including selective reliance on materials that did not establish Polish-market usage and an internal inconsistency in assuming both low French-language knowledge among Polish consumers and, nevertheless, their immediate understanding of a French technical term. Accordingly the Supreme Administrative Court annulled the District Administrative Court's judgment and the Polish Patent Office refusal.

9. Germany—Federal Court of Justice / Federal Patent Court—What is the scope of protection and required level of distinctiveness for color trademarks?

In three decisions in 2025, the Federal Court of Justice and the Federal Patent Court ruled on the scope of protection of color marks.

Use of survey during marketing campaign

In the first decision,[23] the Federal Court of Justice considered the proper use of a survey to prove acquired distinctiveness of a color mark in circumstances where the trademark owner had conducted a marketing campaign when the survey had been running.

In 2008, a publishing company filed a trademark application for the following color as a German color trademark for "legal journals" in Class 16:

The German Patent and Trade Mark Office registered the trademark in 2009 as a trademark with acquired distinctiveness without a survey having been submitted. On 2015, the cancellation applicant filed an application with the German PTO for cancellation of the trademark on the grounds, among other things, that the requirements for acquired distinctiveness had not been met. The German PTO rejected the application for cancellation.

The Federal Patent Court dismissed the appeal against this decision: the absence of a survey during the registration process does not mean cancellation is inevitable. It is not a question of whether the registration as a trademark was based on an administrative error, but whether the absolute ground for refusal existed at the relevant time and whether this issue was overcome by acquired distinctiveness or not. The question of distinctive character might also have been resolved by "indirect" indications such as turnover, market share, intensity, geographical distribution, and duration of use of the trademark. Such matters can be identifiable to justify the assumption of acquired distinctiveness even without a market survey.

Upon further appeal, the Federal Court of Justice overturned the decision and referred the matter back to the Federal Patent Court. The Federal Court of Justice clarified that it had abandoned its previous case law, according to which the party requesting cancellation bore the burden of proving that the trademark had *not* acquired distinctiveness. The Federal Patent Court was to re-examine whether the trademark had acquired distinctiveness and, if necessary, obtain further evidence.

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[23] Federal Court of Justice, dec. of April, 24, 2025, Case No. I ZB 50/24—NJW-ORANGE II.

Subsequently, the Federal Patent Court again rejected the applicant's appeal after obtaining an expert opinion (in effect, a market survey). The trademark owner had provided evidence of market penetration at the time of the decision based on an overall assessment of the circumstances that could be taken into account. These included the intensity, geographical spread, and duration of use, as well as the survey obtained in the reopened appeal proceedings.

The applicant again appealed this decision to the Federal Court of Justice, which once again upheld the applicant's appeal, remitting the matter once more to the Federal Patent Court. The Federal Court of Justice held that the Federal Patent Court violated the applicant's constitutionally guaranteed right to a fair hearing in a manner relevant to the decision by failing to give sufficient consideration to the applicant's submission regarding an advertising campaign by the trademark owner. The court conceded that the Federal Patent Court did take into account that the trademark owner had carried out an advertising campaign entitled "Law is orange," in which the color in question was highlighted, and that this campaign had taken place in part during the market survey conducted by the court expert. However, the Federal Patent Court had not taken into account the fact that this was a campaign by the trademark owner, on which the applicant had been able to comment only to a limited extent based on its own perception, and that the trademark owner had not commented on the nature, scope, and duration of its campaign. Therefore, the trademark owner had a duty to demonstrate that the campaign had not influenced the results of the court expert opinion. The Federal Court of Justice pointed out that it was possible that the Federal Patent Court would have come to the conclusion that proof of acquired distinctiveness of the color had not been demonstrated. This is because the advertising campaign in question was carried out, among other places, in one of the leading legal databases and on the LinkedIn social media network, which, according to the findings of the Federal Patent Court, is extensively used by lawyers and students. This decision demonstrates that a marketing campaign conducted at the same time as a public awareness survey can influence and invalidate the survey results.

Identification of a color by a color code

In the second decision,[24] the Federal Patent Court considered the identification of a color by means of color code. In 2006, the trademark owner had filed a trademark application for the following

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[24] Federal Patent Court, dec. of June 4, 2025, Case No. 29 W (pat) 25/17—Farbmarke ROT (color mark RED).

color as a German color trademark for a "loose-leaf edition of laws" in Class 16 on the basis of acquired distinctiveness:

The German Patent and Trade Mark Office had rejected the application on the grounds of lack of distinctiveness because, in particular, the entire spectrum of red tones was claimed. The applicant argued that the color did not correspond to any of the common color codes on the basis that the color claimed had been individually mixed for them, so no RAL or Pantone number could be specified. The German PTO rejected the application. The applicant appealed the decision and stated in the appeal proceedings that the color should be defined as follows: "Color: Pantone Red 032 C."

The Federal Patent Court overturned the rejection decisions of the German PTO. Although the trademark lacked any distinctive character, this absolute ground for refusal had been overcome by decades of uninterrupted use for loose-leaf editions of legal texts throughout Germany. As such the German PTO registered the color but the registry entry does not contain the Pantone specification, nor any other reference according to a recognized color classification system, nor a color description.

In 2015, the cancellation applicant applied for the cancellation of the trademark. The German PTO rejected the cancellation request. The cancellation applicant appealed the decision. In response to a comment by the Federal Patent Court that the pattern underlying the registration was not identical to "Pantone Red 032 C," the trademark owner settled on the color "Holland Red" according to No. 030 5060 from the RAL design color system. Following the preliminary opinion of the Federal Patent Court that this RAL color code also did not correspond to the design, the trademark owner specified the color with a specific CIELab color code in the oral hearing 2025, which had been determined by an external institute on the basis of the cover foil of the loose-leaf collection and in a subsequent brief, it communicated a different CIELab color code based on its own color paper sample.

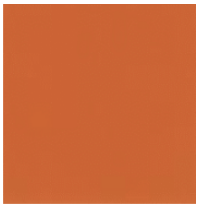
The Federal Patent Court overturned the contested decision of the German PTO and ordered the cancellation of the color trademark. The registered color trademark "red" was not eligible for trademark protection because its subject matter is not clearly and unambiguously defined. This absolute grounds for refusal of protection cannot be overcome by acquired distinctiveness. The

physical color sample deposited may change over time and is therefore not sufficient for certainty. The designation "red" refers to a color spectrum and is therefore also not sufficiently specific. The subsequent designation of an internationally recognized color code that has not already been registered, as in this case, is still possible in cancellation proceedings if the color sample has not changed. However, the trademark owner had not succeeded in doing so until the oral hearing on the appeal and also in a subsequent written submission. This is because the Pantone and RAL color codes specified in the course of the cancellation and appeal proceedings were not identical to the color sample. The same applied to the CIELab code, which had been determined not on the basis of the color sample, but on the basis of the cover foil of the loose-leaf collection. The second CIELab code communicated was not covered by the written submission because it had been determined on the basis of, among other things, the trademark owner's paper sample. The decision shows that even a custom-mixed color must be determinable if it shall be registered as a color trademark.

Probative value of surveys and counter surveys

In the third decision,[25] the Federal Patent Court ruled on the probative value of a survey when it was significantly called into question by a counter-survey.

The applicant had filed a trademark application for the following color as a German color trademark for "Retail services in the field of construction and DIY products" in Class 35:



The German Patent and Trade Mark Office had registered the mark in 2015 on the basis of acquired distinctiveness.

Upon cancellation requests by two competitors of the trademark owner, the German PTO did not recognize the survey due to methodological deficiencies and decided to cancel the trademark. The trademark owner appealed the decision and submitted a new survey that showed a public awareness of 49.6%. One of the cancellation applicant submitted a counter-survey that showed an awareness of only 30%. The trademark owner applied for an expert opinion on the background of the divergence of the results of the two

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[25] Federal Patent Court, dec. of June 5, 2025, Case No. 29 W (pat) 24/18—Farbmarke ORANGE (color mark ORANGE).

survey. However, the expert only found that both surveys were unobjectionable and that the difference of approximately 20% was inexplicable.

The Federal Patent Court examined in detail the methodological errors in the original survey and stated that the degree of distinctiveness remaining after deducting the necessary reductions due to these deficiencies was insufficient for demonstrating acquired distinctiveness.

The trademark owner's further survey was also insufficient for demonstrating acquired distinctiveness at the time of the decision. Although this survey avoided the shortcomings of the first survey and also showed distinctiveness of just under 50% in the relevant market of the general population, the considerable deviations from the cancellation applicant's survey, which was also methodologically correct, could not be determined. Since the relevant case law determines that the trademark owner bears the burden of proof, there was no reason to gather further evidence by obtaining a court-appointed official survey. It was incumbent upon the trademark owner to prove that his trademark has acquired distinctiveness through use and if the owner had not done so, the mark was invalid.

10. Austria—Austrian Supreme Court—When should a mark be refused registration on grounds of descriptiveness?

In this decision,[26] the OGH had to address the question of whether a word-and-device mark applied for in respect of numerous meat products in Class 29, including, inter alia, meat, meat extracts, preserved meat, salted meat products (cured meat), freeze-dried meat, meat and meat products, and packaged meat (see image below), is excluded from registration on the grounds of its descriptive character pursuant to Section 4(1)(4) MSchG.

[26] Austrian Supreme Court, November 25, 2025, 4Ob129/25m.

The appellate court had previously upheld a decision of the Legal Department of the Patent Office by which the application for registration had been refused under Section 4(1)(4) MSchG.

At the outset, the OGH reiterated that purely descriptive signs are not capable of identifying goods or services as originating from a particular undertaking, since they cannot fulfill the essential function of a trademark as an indicator of commercial origin. According to settled case law, a sign is to be regarded as descriptive where the indication contained in the word relating to the manufacture, characteristics, or intended purpose of the goods can be readily understood by the relevant public without any particular intellectual effort.

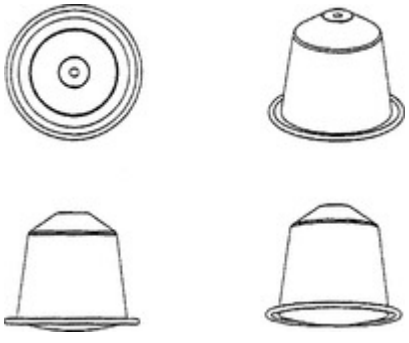
On that basis, the OGH confirmed the assessment of the lower instances that the mark applied for consisted exclusively of descriptive elements. The word elements "Kalbin," "Gourmet," and "aus Österreich" are part of everyday language and are recorded in dictionaries. "Kalbin" denotes a young female cattle, while "Gourmet" refers both to a connoisseur and, particularly in the food sector, to a certain quality or suitability for connoisseurs. These meanings would be immediately perceived by an average, reasonably well-informed consumer, even if the specific word sequence is not commonly used. The combination of the terms merely amounts to a juxtaposition of descriptive indications and does not display any perceptible additional meaning going beyond the sum of its individual components.

The OGH further held that the graphic design of the word-and-device mark was likewise incapable of altering the overall descriptive impression. The typefaces and colors used are common and merely emphasize the reference to Austria. The stylized depiction of a cow is discreetly positioned in the background and serves solely to visually underline the term "Kalbin," without possessing any independent distinctive character. Finally, the OGH clarified that earlier trademark registrations as well as previous decisions of the Austrian Supreme Court or the Court of Justice of

the European Union do not have any precedential effect, since each sign must be assessed individually on the basis of the specific circumstances of the case. The appeal was accordingly dismissed.

11. Belgium—Brussels Court of Appeal—Was a coffee capsule trademark exclusively composed of a shape necessary to obtain a technical result and hence invalid?

In 2001, Nestlé registered an international three-dimensional mark designating, among other territories, the Benelux, consisting of the shape of the Nespresso capsule, for goods in Class 30 (including coffee):



In 2013, the Mondelez International group launched, in several European countries, capsules compatible with machines of the Nespresso system. That same year, the Dutch company Mondelez Nederland and the French company Kraft Foods France Intellectual Property (both part of the Mondelez International group) summoned Nestlé before the Brussels Business Court, seeking to challenge Nestlé's trademark insofar as it covers the Benelux. At first instance, the lower court invalidated the mark and rejected Nestlé's defense that the Benelux part of its international mark is not exclusively composed of a shape that is necessary to obtain a technical result. Nestlé filed an appeal.

The Brussels Court of Appeal[27] first identified four essential characteristics of the trademark: the double truncated cone forming the body, the circular shape on the flat surface, the circular rim, and the fold running along the edge of the rim.

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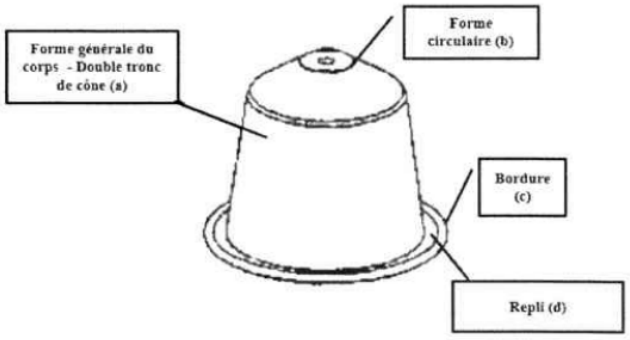
[27] Brussels Court of Appeal, July 3, 2025, Ing.-Cons., 2025/3, p. 541-576.



In a second step, relying on Nestlé's patents, expert reports, and foreign decisions, the Brussels Court of Appeal found that each of these features pursues a technical function. By way of example, these elements provide greater resistance to crushing and facilitate removal after use, offer increased stability in the upper part of the capsule, and protect the user against the risk of injury when handling the capsule.

The Court therefore concluded that the three-dimensional shape at issue exclusively consists of a shape necessary to obtain a technical result within the meaning of Article 2(1)(2) of the Benelux Convention on Intellectual Property. Nestlé's appeal was therefore dismissed, and the Court ordered the cancellation of the Benelux part of the international registration.

12. Portugal—Portuguese PTO (INPI)—Is it possible to register trademarks consisting exclusively of generic signs or indications?

The applicant had filed applications to register BABA DE RINOCERONTE and BABA DE DINOSSAURO as Portuguese national trademarks with respect to "Prepared desserts [confectionery]; Prepared desserts (pastry); Dessert mousses [confectionery]; Pastry and confectionery; Chocolate; Ice cream, sorbets and other edible ice products," in Class 30.

The applications were provisionally refused by the Portuguese PTO ("INPI"), on the following grounds:

a) the signs did not have sufficient distinctive effectiveness.

b) the signs were composed of expressions that did not give them distinctive character, since they were limited to indicating the type of products that were intended to be marked.

c) the terms "BABA DE RINOCERONTE" and "BABA DE DINOSSAURO" were simply used to describe a type of

dessert, as could be verified through searches on the "Google" search engine.

d) such terms lack any distinctive character to identify the intended products, since the consumer would not be able to differentiate the marked products from other similar products on the market and to trace their origin (directly or indirectly), to a specific business source.

e) in the absence of other verbal and/or figurative elements that could confer distinctiveness upon them, the trademarks would be incapable of individual and exclusive identification of the applicant and should remain available for use by other traders to characterize similar products.

The applicant appealed, claiming the marks had acquired a distinctive character under Article 231, No. 2, of the Portuguese Industrial Property Code (the "CPI").[28] The trademarks BABA DE RINOCERONTE and BABA DE DINOSSAURO had been used by the applicant over the past few years and had acquired distinctive capacity or character as a result of their use as names for desserts inspired by the decoration of the applicant's restaurants JNcQUOI Asia and JNcQUOI Avenida in Lisbon.

In seeking to discharge the burden of proof in showing distinctiveness, the applicant submitted several documents and published interviews and various posts on the Internet and social media demonstrating that both BABA DE RINOCERONTE and BABA DE DINOSSAURO have become true phenomena on social media, notably on Instagram, Facebook, and TikTok and that such use was always as a reference to desserts in the applicant's restaurants and made before the respective trademark applications.

On November 21, 2025, the INPI issued its decisions, granting the trademarks. INPI acknowledged that the sign sets BABA DE RINOCERONTE and BABA DE DINOSSAURO, due to the general recognition they have received, always associated with the restaurants JNcQUOI (also a registered trademark of the applicant), met the necessary distinctive condition to identify the products requested in Class 30.

13. UK—Court of Appeal—Can a written description of a figurative mark result in invalidity for lack of clarity and precision?

In *Babek International Ltd. v. Iceland Foods Ltd.*,[29] the Court of Appeal considered whether a figurative trademark consisting of a pictorial logo accompanied by a brief written description satisfied

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[28] Equivalent to Article 4(4) of the 2015 TM Directive.

[29] [2025] EWCA Civ 134.

the requirements for registrability, namely that it comprised "a sign" and that it was represented with sufficient clarity and precision, under the (pre-2015) UK/EU trademark rules.

The appeal arose from the counterclaim by the defendant ("Iceland") for invalidity of Babek's UK trademark registration, filed in 2009 for goods and services in Classes 29 and 42. The application form identified the type of mark as "figurative," attached a color image of an oval device with the word "BABEK" rendered in a raised effect (as depicted below), and included the written description "Gold Oval with Embossed BABEK writing," with colors indicated as "Gold, black."

The Intellectual Property Enterprise Court ("IPEC") considered the validity of the mark at a summary judgment hearing, rejecting Iceland's invalidity challenge. Iceland appealed to the Court of Appeal.

The Court approached registrability under the Trade Marks Act 1994, which requires three independent and cumulative conditions to be satisfied:

(i) The mark must be "a sign";

(ii) The mark must be capable of graphical representation, applying the *Sieckmann*[30] criteria, namely that it is clear, precise, self-contained, easily accessible, intelligible, durable and objective; and

(iii) The mark must have the capacity to distinguish the goods or services of one undertaking from those of others.

The Court emphasized the independent and cumulative nature of the first two conditions and the need to resist conflating them with distinctiveness. Iceland's first argument was that the mark was not a "sign" because the image, together with the written description, embraced *multiple* possible signs (citing *Dyson*[31]; *Spear v. Zynga*[32]). It also argued that the mark failed the *Sieckmann* criteria due to the ambiguity between the pictorial reproduction and

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30 Sieckmann v. Deutsches Patent- und Markenamt, Case C-273/00 (ECJ, December 12, 2002).

31 Dyson Ltd. v. Registrar of Trade Marks, [2007] ECR I-687, Case C-321/03 (ECJ, January 25, 2007).

32 JW Spear & Son Ltd. v. Zynga Inc., [2013] EWCA Civ 1175.

the written description, including the use of non-specific color words (i.e., "gold, black", rather than specific Pantone references) and the term "embossed" (which, Iceland argued, indicated a claim to a three-dimensional sign). Finally, Iceland argued that the first-instance judge, HHJ Hacon, had given precedence to the applicant's categorization of the mark as "figurative," wrongly favoring this over the mark's pictorial representation and written description.

The Court of Appeal accepted that the judge had applied a legally erroneous "capacity to distinguish" test, thereby conflating the anterior questions of "sign" and "graphic representation" with distinctiveness. It therefore considered the case afresh, although ultimately reaching the same conclusion on validity.

First, on interpretation, the Court held that the categorization (as a "figurative mark") required the pictorial image and the written description be read together, with neither taking precedence. The categorization is a useful starting point but cannot cure inconsistency. On a fair reading, however, there was no inconsistency here. The pictorial representation depicted a single-colored logo; the written description concisely described that image and nothing more. The word "embossed" would be understood by the reasonable reader as referring to a visual relief or shadowing effect in a two-dimensional device, rather than as asserting a three-dimensional mark presented in two dimensions.

Secondly, the Court rejected the argument that the use of "gold, black" (without Pantone references) rendered the representation unclear or resulted in multiple possible signs. The words in the written description identified in a straightforward way the principal colors visible in the image. Consequently, the reasonable reader would understand the description as merely summarizing the image (including shadowing approximating black) rather than expanding the claim beyond it. This was not a color-per-se claim or a "colours in every conceivable form" case (*Heidelberger*[33]); nor did the description introduce alternatives or variability of the kind condemned in *Spear v. Zynga*.

Thirdly, the Court clarified that this mark comprised a single sign, namely the sign as depicted in the image read with the description. It expressly disagreed with the suggestion that the claimed sign extended to "minor variations in hue." Nothing in the documents indicated that the reproduction was merely exemplary or that the claim embraced a range of hues; the registration therefore did not suffer from the multiplicity defect identified in *Dyson* and *Spear v. Zynga*.

Accordingly, the Court dismissed the appeal. Although it found that the judge had relied on the wrong test, it held that, properly analyzed, the mark satisfied the "sign" condition and the *Sieckmann*

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[33] [2004] ECR I-6129 (ECJ, June 24, 2004).

graphic-representation requirement. The Court emphasized that the three registrability conditions are independent and cumulative and that they should not be conflated. It also cautioned against reliance on "state of the register" comparators and confirmed that where an image and a brief description are provided, they must be read together to identify one specific sign with clarity and precision.

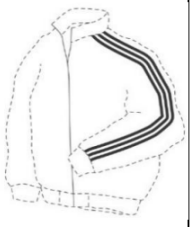
14. UK—Court of Appeal—Can a written description of a position mark cover variations not shown visually in the mark?

In *Thom Browne Inc. & Thom Browne UK Ltd. v. adidas AG*,[34] the UK's Court of Appeal ("COA") considered whether six UK "three-stripe" position marks satisfied the threshold registrability conditions, namely that each registration identified a single sign and that the sign was represented with the clarity and precision required by trademark law.

Background

The appeal arose from High Court proceedings in which Thom Browne challenged 16 adidas registrations for three-stripe configurations applied to apparel. The attacks relied on lack of registrability, distinctiveness, and non-use. The High Court upheld registrability challenges against eight marks (while rejecting the distinctiveness attacks and largely rejecting non-use). On appeal, adidas contested invalidity of only six of the marks—each comprising three parallel, equally spaced stripes positioned on sleeves, trouser legs, or the side of upper garments. All six marks combined a pictorial representation with an optional written description. Two examples of the marks are depicted below (the "Marks").

[34] [2025] EWCA Civ 1340.

00002327095		The mark consists of three parallel equally spaced stripes applied to an upper garment, as illustrated below, the stripes running along one third or more of the sleeve of the garment.	Sports wear; T-shirts (including long sleeved, short sleeved and cropped); football shirts; rugby shirts; polo shirts; leotards sweat shirts; hooded tops; drill tops; jerseys; rain jackets; insulated jackets; hooded jackets; wind breakers; crop jackets; track suit tops; bodysuits; satin shirts; all the aforementioned being sleeved, upper garments.
00903517661		The mark consists of three parallel equally spaced stripes applied to a trouser or short, the stripes running along one third or more of the length of the side of the trouser or short.	Sports wear; Three quarter length pants; running tights; fleece pants; lycra shorts; running shorts and hot pants; track suit bottoms; swimming trunks and swimsuit bottoms; all the aforementioned goods being in the nature of trousers or shorts.

Each entry comprised an image and a textual formula: "the mark consists of three parallel equally spaced stripes applied to [the sleeve/trouser side/garment side], the stripes running along one third or more of the length of the [relevant part]." The illustrations typically showed three stripes running along substantially the length of the relevant garment panel (e.g., along a sleeve), on a contrasting background, with equal width, spacing, and length. The descriptions, however, were non-limiting and expressly contemplated stripes extending "one third *or more*," without fixing start/finish points, orientation on the panel, or the precise length. Adidas argued these were single signs allowing limited, permissible variation, whereas Thom Browne argued the descriptions embraced multiple signs and were unclear.

In invalidating the Marks at first instance, the High Court held that each one failed to satisfy the definition of "a sign" (each being a multiplicity of signs) and also that they were incapable of graphical representation on the register. Adidas appealed this decision.

The appeal

The parties agreed the Marks were "position marks" and that the dispute related to registrability on the face of the entries, that is, whether, read as a whole, the combination of images and words identified a single sign and did so with the requisite clarity and precision. It was common ground that the image and the wording had to be read together.

The Court considered registrability under the Trade Marks Act 1994, which requires three independent and cumulative conditions to be satisfied:

(i) The mark must be "a sign";

(ii) The mark must be capable of graphical representation, applying the *Sieckmann*[35] criteria, namely that it is clear, precise, self-contained, easily accessible, intelligible, durable, and objective; and

(iii) The mark must have the capacity to distinguish the goods or services of one undertaking from those of others (this condition was not relevant to the appeal).

The Court noted that position marks draw distinctiveness not only from the visual element (here, three stripes of equal width and spacing on a contrasting ground) but at least in part also from their specific placement on the goods such that if positioning is left open, the registration requirements "may well not be met."

Adidas appealed on four grounds:

(i) That the judge had incorrectly interpreted *Dyson*[36] as laying down a rule that any description permitting variants not shown in the image was fatal.

(ii) That the judge was wrong to conclude that the description of the first mark depicted above could be interpreted to extend the stripes to the sleeve's underside. Adidas argued that this error infected the judge's reasoning regarding all six marks, although the same comments were not made with respect to the other marks.

(iii) That the judge contradicted herself by accepting that the words "one third or more" were clear, yet finding their effect unclear.

(iv) That the judge had fixated on visual differences between variations encompassed by the written descriptions and failed to consider whether the public would "see the same mark" (the "origin message").

Regarding the first ground, the COA rejected adidas' reasoning and found that the trial judge had correctly treated the availability of unpictured variants as a relevant, though not conclusive, factor. The real question was whether the registrations covered a multiplicity of signs or a single sign with tightly delimited variation. On that evaluative question, the judge made no error of law. This ground therefore failed.

The COA also disagreed with adidas on the second ground. It found that, properly read, the wording "running along one third or

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35 Case C-273/00 (ECJ, December 12, 2002).

36 Case C-321/03 (ECJ, January 25, 2007).

more of the length of the sleeve" encompassed variability in start/finish points, length, and, at least to some extent, lateral placement. In any event, the judge's core reasoning concerned the breadth signaled by "one third or more" combined with the non-limiting image, not underside positioning. The essential point remained that the registrations captured many visually different manifestations.

The COA also held, in relation to the third ground, that the High Court's reasoning was sound. Words can be clear in their meaning but nonetheless create uncertainty as to a sign's boundaries when juxtaposed with a single, non-limiting depiction. The COA stressed that ambiguity about the subject matter confers an unfair competitive advantage for the trademark owner (by enabling them to pivot between materially different depictions of the mark depending on the target) and fails the *Sieckmann* standard. The third ground of appeal was also, therefore, rejected.

Finally, regarding the fourth ground, the COA held that the judge had properly addressed the origin message and rejected the premise that the average consumer would perceive a single sign across the breadth of contemplated variants. In addition, it held that evidence of use could not cure a definitional defect in a mark; whether something is a registrable sign is logically anterior to distinctiveness or use. Nor did it assist adidas that, in other registrations not under appeal, it had used narrower, image-matched descriptions that the High Court had upheld. The contrast underscored that the breadth chosen here was a drafting choice that carried registrability consequences. The final ground was also rejected. The appeal was therefore dismissed in its entirety.

III. CONFLICT WITH EARLIER RIGHTS—RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION

A. Introductory Comments

This Part III relates to claims that a trademark should be refused registration (or for post-registration, invalidity), on the basis of its conflict with an "earlier right." The earlier right is typically an earlier registered trademark, but may also include challenges based on earlier unregistered rights.

In relation to conflict with earlier registered trademarks or trademark applications, there are three grounds for refusal (or post-registration invalidity under Article 60 of the 2017 EUTM Regulation):

(1) where the mark applied for is identical to the earlier mark, and the goods/services for which the applicant seeks registration are identical to those for which the earlier mark

is protected. Often known as "double-identity" cases, the relevant rules are contained in Article 8(1)(a) of the 2017 EUTM Regulation and Article 5(1)(a) of the 2015 TM Directive;

(2) where the mark applied for is identical or similar to the earlier mark and the goods/services for which the applicant seeks registration are identical or similar to those for which the earlier mark is protected, resulting in a likelihood of confusion. This provision typically accounts for much of the case law. The relevant provisions are set out in Article 8(1)(b) of the 2017 EUTM Regulation and Article 5(1)(b) of the 2015 TM Directive; and

(3) where the use of the mark applied for would offend one or more of the EU law principles of what are generally known as tarnishment, dilution, and unfair advantage (although not precisely the language used in the legislation)—see Article 8(5) of the 2017 EUTM Regulation and Article 5(3)(a) of the 2015 TM Directive.

The rules on tarnishment, dilution, and unfair advantage apply only in situations in which the earlier mark has a reputation in the EU, or in the relevant EU Member State (or national European territory). Claims of this type do not depend on any similarity of goods/services and may be brought irrespective of whether or not the contested application covers goods or services identical or similar to those for which the earlier mark is protected or in which it has acquired its reputation. Some similarity between the marks is still a requirement in order to create a link between the two in the mind of the relevant consumer, although not such that it would likely result in confusion. The basis for any such claim is that the use of the junior mark would take unfair advantage of, or be detrimental to, the distinctive character (dilution) or the reputation (tarnishment) of the senior mark.

The relevant rules relating to EU trademarks are found in Article 8(5) of the 2017 EUTM Regulation and the corresponding rules relating to applications before the national trademark authorities of EU Member States are at Article 5(3)(a) of the 2015 TM Directive (see below).

There is a wide range of possibilities for challenges to trademark applications (or, by way of cancellation action, to registered marks) based on other types of earlier rights. These include claims based on unregistered trademarks, copyright, and protected geographical indications. Relevant provisions are found in Articles 8(4) and 8(6) of the 2017 EUTM Regulation and in Article 60 of the 2017 EUTM Regulation, and Articles 5(3)(b) and (c) and 5(4) of the 2015 TM Directive. The provision for the owner of a designation of origin or a

geographical indication to prevent the registration of a subsequent trademark were new additions in the 2015 TM Directive.

Conflicts between marks always provide plenty of available case law for this section of the Review. In *Schweppes International,* the General Court considered whether conceptual identity in different languages (here Russian and English) could lead to confusion, finding that descriptive conceptual overlap between mark and sign cannot outweigh clear visual and phonetic differences. The impact of reversing identical word elements was also considered, with the German Federal Patent Court in blend beauty/beautyblender confirming that "anagrammatic rotation" of components does not eliminate confusion where consumers cannot reliably recall precise word order. For marks with a reputation, the Spanish Supreme Court in *Diesel v. Ohbuyshoes* (ODISEL) clarified that enhanced protection for reputed marks is not displaced by identical goods, while confirming that such protection does not automatically result in infringement and requires a fact-specific assessment of the consumer's mental linkage between mark and sign. Whether trademark reputation can bridge dissimilar goods was also tested in several jurisdictions: the Spanish Provincial Court of Madrid upheld invalidity of a TITLEIST mark for alcoholic beverages, while the Athens Administrative Court of Appeals reached the opposite conclusion in dismissing PEPSICO's challenge to a pharmaceutical mark containing PEPSI.

B. Legal Texts

Article 8 of the 2017 EUTM Regulation

1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:
   (a) if it is identical with the earlier trade mark and the goods and services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;
   (b) if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.
2. For the purposes of paragraph 1, "earlier trade mark" means:
   (a) trade marks of the following kinds with a date of application for registration which is earlier than the

date of application for registration of the EU trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

(i) EU trade marks;

(ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Office for Intellectual Property;

(iii) trade marks registered under international arrangements which have effect in a Member State;

(iv) trade marks registered under international arrangements which have effect in the Union;

(b) applications for the trade marks referred to in point (a), subject to their registration;

(c) trade marks which, on the date of application for registration of the EU trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the EU trade mark, are well known in a Member State, in the sense in which the words "well known" are used in Article 6bis of the Paris Convention.

3. [Omitted]

4. Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the [EU] legislation or the law of the Member State governing that sign:

(a) rights to that sign were acquired prior to the date of application for registration of the EU trade mark, or the date of the priority claimed for the application for registration of the EU trade mark;

(b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

5. Upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to, or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in [the Union] or, in the case of an earlier

national trade mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

6. [Omitted]

Article 60 of the 2017 EUTM Regulation

1. An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:
   (a) where there is an earlier trade mark as referred to in Article 8(2) and the conditions set out in paragraph 1 or paragraph 5 of that Article are fulfilled;
   (b) [Omitted];
   (c) where there is an earlier right as referred to in Article 8(4) and the conditions set out in that paragraph are fulfilled.
   (d) [Omitted]
2. An EU trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right under [EU] legislation or national law governing its protection, and in particular:
   (a) a right to a name;
   (b) a right of personal portrayal;
   (c) a copyright;
   (d) an industrial property right.

(Note: Articles 60(3) to 60(5) have been omitted.)

Article 5 of the 2015 TM Directive

Relative grounds for refusal or invalidity

1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid where:
   (a) it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;

(b) because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

2. 'Earlier trade marks' within the meaning of paragraph 1 means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

(i) EU trade marks;

(ii) trade marks registered in the Member State concerned or, in the case of Belgium, Luxembourg or the Netherlands, at the Benelux Office for Intellectual Property;

(iii) trade marks registered under international arrangements which have effect in the Member State concerned;

(b) EU trade marks which validly claim seniority, in accordance with Regulation (EC) No 207/2009, of a trade mark referred to in points (a)(ii) and (iii), even when the latter trade mark has been surrendered or allowed to lapse;

(c) applications for the trade marks referred to in points (a) and (b), subject to their registration;

(d) trade marks which, on the date of application for registration of the trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the trade mark, are well known in the Member State concerned, in the sense in which the words 'well-known' are used in Article 6bis of the Paris Convention.

2. Furthermore, a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where:

(a) it is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State in respect of which registration is applied for or in which the trade mark is registered or, in the case of

an EU trade mark, has a reputation in the Union and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

(b) an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's authorization, unless the agent or representative justifies his action;

(c) and to the extent that, pursuant to Union legislation or the law of the Member State concerned providing for protection of designations of origin and geographical indications:

(i) an application for a designation of origin or a geographical indication had already been submitted in accordance with Union legislation or the law of the Member State concerned prior to the date of application for registration of the trade mark or the date of the priority claimed for the application, subject to its subsequent registration;

(ii) that designation of origin or geographical indication confers on the person authorized under the relevant law to exercise the rights arising therefrom the right to prohibit the use of a subsequent trade mark.

3. Any Member State may provide that a trade mark is not to be registered or, if registered, is liable to be declared invalid where, and to the extent that:

(a) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark, and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;

(b) the use of the trade mark may be prohibited by virtue of an earlier right, other than the rights referred to in paragraph 2 and point (a) of this paragraph, and in particular:

(i) a right to a name;

(ii) a right of personal portrayal;

(iii) a copyright;

(iv) an industrial property right;

(c) the trade mark is liable to be confused with an earlier trade mark protected abroad, provided that, at the date of the application, the applicant was acting in bad faith.

4. The Member States shall ensure that in appropriate circumstances there is no obligation to refuse registration or to declare a trade mark invalid where the proprietor of the earlier trade mark or other earlier right consents to the registration of the later trade mark.

5. Any Member State may provide that, by way of derogation from paragraphs 1 to 5, the grounds for refusal of registration or invalidity in force in that Member State prior to the date of the entry into force of the provisions necessary to comply with Directive 89/104/EEC are to apply to trade marks for which an application has been made prior to that date.

C. Cases

1. EU—GC—Does conceptual identity in different languages automatically lead to a likelihood of confusion?

In joined cases *Schweppes International Ltd. v. EUIPO—May OOO*,[37] the General Court reviewed four appeals from the EUIPO First Board of Appeal upholding applications for declarations of invalidity of the following EU trademark registrations owned by the applicant, Schweppes International Ltd., and covering, among others, "flavoured tea-based beverages" and "non-alcoholic tea flavoured beverages" in Classes 30 and 32:

The intervener, May OOO, filed an application for declaration of invalidity of the above marks based, inter alia, on its earlier international word mark МАЙСКИЙ ЧАЙ ("may tea" in Russian), designating Czech Republic, Germany, France, Latvia, Poland, and Slovakia for "tea" in Class 30. The grounds relied on in support of

[37] Cases T-1066/23 to T-1069/23 (GC, February 26, 2025).

the invalidity application were based upon a likelihood of confusion under Article 60(1)(a) in conjunction with Article 8(1)(b) the 2017 EUTM Regulation.

The Cancellation Division dismissed the applications for declaration of invalidity, decisions later overturned by the EUIPO Board of Appeal, who found a likelihood of confusion for a part of the Latvian public that understands both Russian and English. Schweppes appealed the Board's decision to the General Court.

The Court annulled the Board's decisions. The Court first confirmed the Board's unchallenged findings on the identity and similarity of goods and the trademarks' distinctiveness. Turning to the similarity assessment, the Court upheld the Board's conclusion that the signs were not visually similar overall. The word elements differed in alphabet, length, and orthography, and the contested marks include figurative components absent from the earlier word mark. Phonetically, similarity was very low, if any, because the English pronunciation of MAY TEA and the Russian pronunciation of МАЙСКИЙ ЧАЙ differ in syllable structure and phonemes. Conceptually, the Court accepted that, for the Latvian public with at least a basic knowledge of both English and Russian at the relevant dates, MAY TEA and МАЙСКИЙ ЧАЙ convey the same literal meaning—"May tea"—and that this association arises without complex translation.

The Court found that the Board erred in its global assessment of the likelihood of confusion. First, the marks in comparison displayed significant visual differences. For everyday food products, purchasing is primarily based on visual aspects because such goods are usually sold in self-service stores and consumers rely on the image of the mark on the product. Second, the marks displayed, overall, a very low degree of phonetic similarity, if any. Third, although the marks were conceptually identical for the bilingual Latvian public, that identity rested on elements, such as TEA/чай, which were, for that public, descriptive of the goods.

The interdependence principle does not allow weak conceptual overlap based on non-distinctive elements to outweigh clear visual and phonetic differences where the goods are identical or similar. The Board therefore misapplied Article 8(1)(b) of the 2017 EUTM Regulation in finding a likelihood of confusion for the bilingual Latvian public. Given that error, the Court did not need to rule on the applicant's additional complaint that the Board failed to show that the bilingual subset was non-negligible. In the light of the above, the Court annulled the First Board of Appeal's decisions.

2. Austria—Austrian Supreme Court—What is the likelihood of confusion between identical word marks applied to goods and services that appear dissimilar?

In this decision,[38] the OGH was required to assess the likelihood of confusion between two identical word marks pursuant to Section 29a(1) in conjunction with Section 30(1)(2) MSchG (Article 43(2) in conjunction with Article 5 (1a and 1b) of the 2015 TM Directive).

The applicant had lodged an opposition against the registration of the Austrian word mark CAPSAGAMMA for goods in Class 3 (soaps, perfumery goods, essential oils, non-medicated cosmetics, non-medicated hair lotions, non-medicated dentifrices, and preparations for body and beauty care), and Class 5 (dietary supplements for humans and animals).

The opposition was based on the applicant's earlier international word mark of the same wording, which had originally been registered for various goods in Class 5. However, following revocation proceedings initiated by the opposing party, the earlier mark CAPSAGAMMA had been partially revoked for non-use and remained protected only for "cream for pain relief" in Class 5.

In the opposition proceedings subsequently continued by the applicant, the Patent Office upheld the opposition in part and cancelled the registration of the contested mark for all goods in Class 3, but denied the existence of a likelihood of confusion with regard to the goods claimed in Class 5, namely "dietary supplements for humans and animals." It reasoned that dietary supplements, as food products, differ from pain-relieving creams, as medicinal products, in their nature, method of use, and effect, as well as in their regulatory framework, and that they neither compete with nor complement one another.

The appellate court did not share this view and also cancelled the registration for the goods in Class 5, finding that there was a sufficient degree of similarity between the goods. From the consumer's perspective, both product categories serve the purpose of affecting health and well-being, are available in pharmacies, and may be used in combination.

The OGH upheld this assessment and dismissed the opposing party's extraordinary appeal. It reaffirmed its settled case law according to which the likelihood of confusion must be assessed globally, taking into account all the circumstances of the individual case and the interdependence between the relevant factors. Where the marks are identical, a particularly clear distance between the goods is required in order to rule out a likelihood of confusion.

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[38] Austrian Supreme Court, November 25, 2025, 4 Ob 118/25v.

In the present case, the OGH emphasized that the terms "cream for pain relief" in Class 5 and "dietary supplements for humans and animals" in Class 5 are broadly defined and may also encompass non-prescription products that, from the perspective of the average consumer, can be purchased together and used in a complementary manner. Although dietary supplements may not legally be attributed properties of preventing, treating, or curing diseases, their consumption nevertheless aims at positively influencing the body and may therefore, from the consumer's point of view, be meaningfully combined with topically applied creams. In view of the identity of the marks and the plausible complementary relationship between the goods, the appellate court's assumption of a likelihood of confusion was a decision it was entitled to reach.

Finally, the OGH also rejected the opposing party's argument that the applicant lacked the necessary pharmaceutical authorization in Austria. For the purposes of assessing the likelihood of confusion, only the position on the trademark register is decisive. Moreover, the current absence of authorization does not in itself exclude the possibility of future market presence and, consequently, a likelihood of confusion. The extraordinary appeal on a point of law was therefore dismissed as inadmissible.

3. Spain—Supreme Court—Does enhanced protection for reputed trademarks apply automatically where the earlier mark has a reputation and the signs and goods are similar?

The Supreme Court of Spain[39] issued a decision of particular significance in trademark law, as it clarifies the scope of enhanced protection for trademarks with a reputation and its interaction with the assessment of likelihood of confusion, both in infringement and invalidity actions, in cases involving identical or similar goods.

The dispute arose between Diesel S.p.A., proprietor of the word mark DIESEL for goods in Class 25. and Ohbuyshoes, S.L., owner of the Spanish figurative mark  , also registered for goods in that class. Diesel brought actions for trademark invalidity and infringement, alleging a likelihood of confusion and, in addition, unfair advantage taken of the reputation of its mark and detriment to its distinctive character, arising from the use of the sign ODISEL and the corresponding domain name. Both the Commercial Court[40] and the Provincial Court of Barcelona[41] dismissed the action in its entirety.

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[39] Judgment 4213/2025 of September 30, 2025 (First Chamber), Diesel S.P.A. v. Ohbuyshoes S.L.

[40] Judgment of Commercial Court No. 9 of Barcelona (August 11, 2020).

[41] Judgment 899/2021 of May 11, 202 (Case 317/2021).

On appeal, the Supreme Court first dismissed the alleged procedural infringements, holding that the appellate court had not made a material error by considering it unnecessary to examine the alleged unfair advantage only once the likelihood of confusion had been excluded, without prejudice to the possibility that such a legal approach might be erroneous and therefore open to review on the merits. The Chamber reiterated that disagreement with the legal reasoning adopted by the lower court does not amount to a failure to rule.

Turning to the substance of the dispute, the Supreme Court undertook a systematic analysis of the relationship between the assessment of likelihood of confusion and the protection afforded to trademarks with a reputation following the reform of the Spanish Trademark Law by Royal Decree–Law 23/2018 (as part of the implementation of the 2015 TM Directive). The Court emphasized that the revised statutory framework has moved beyond the traditional distinction between "well-known" and "renowned" trademarks, so that enhanced protection now applies to any trademark that "enjoys a reputation in Spain," in line with the criteria developed in the case law of the CJEU.

On that basis, the Court expressly corrected the approach adopted by the Provincial Court, which had held that, where the marks at issue cover identical or similar goods, the assessment of likelihood of confusion is sufficient and there is no need to examine whether unfair advantage has been taken of the reputation of the earlier mark. The Supreme Court stated unequivocally that the protection conferred by Articles 8 and 34(2)(c) of the Trademark Law on trademarks with a reputation does not disappear in cases involving identical or similar goods and is fully applicable where, notwithstanding the absence of a likelihood of confusion, the use of the later sign may give rise to an unfair advantage or cause detriment to the distinctive character or reputation of the earlier mark. In this regard, the Court expressly relied on the case law of the CJEU, in particular the Davidoff judgment, rejecting any interpretation that would result in reduced protection for reputed trademarks in cases involving identical goods.

Having clarified the correct legal framework, the Supreme Court nonetheless proceeded to examine whether, in the specific circumstances of the case, such unfair advantage had, in fact, been established. Following an overall assessment of the relevant factors, it concluded that there was no sufficient mental link or evocative association between the signs capable of supporting a finding that the appeal or prestige of the DIESEL mark was being transferred to the goods marketed under the ODISEL sign. The Court attached decisive weight to the significant visual, phonetic, and conceptual differences between the signs, emphasizing the highly distinctive and dominant nature of the figurative elements of the ODISEL

mark, as well as the different conceptual impressions conveyed: whereas DIESEL immediately evokes the name of a fuel with a clear meaning for the average consumer, ODISEL appears as a fanciful term associated with travel and the maritime sphere.

The Court further noted that the context of use did not support a finding of unfair advantage, since Ohbuyshoes' products were aimed at a different market segment, characterized by lower prices and a positioning far removed from the premium and transgressive image associated with the DIESEL brand. In the absence of the requisite mental link, the Court therefore excluded both unfair advantage and detriment by dilution or impairment of the distinctive character of the earlier mark.

Finally, regarding the likelihood of confusion, the Supreme Court confirmed that the assessment carried out by the Provincial Court was consistent with established case law, recalling that the identity of goods does not render differences between the signs irrelevant and that the global assessment of likelihood of confusion may allow conceptual and visual differences to neutralize phonetic similarities. Accordingly, the Court dismissed Diesel's appeals in their entirety and confirmed the validity of the ODISEL mark and the lawfulness of its use.

The judgment reaffirmed that the enhanced protection afforded to trademarks with a reputation is not displaced by the existence of identical or similar goods and confirms that such protection does not operate automatically, but always requires a careful and fact-specific assessment of the existence of a mental link and of the actual context in which the contested sign is used.

4. Germany—Federal Patent Court—Does reversing identical components eliminate confusion between trademarks?

In a decision of January 30, 2025,[42] regarding the trademarks BLEND BEAUTY and BEAUTYBLENDER, the Federal Patent Court had to consider whether reversing identical components ("blend beauty" vs. "beautyblender") would eliminate confusion between two marks.

In December 2019, the applicant applied for registration of the word/device mark shown below for goods and services in Classes 3, 41, and 44 (including cosmetics, beauty care training and consultancy):

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[42] Federal Patent Court, Case No. 30 W (pat) 519/22—BLEND BEAUTY / BEAUTYBLENDER.

blend beauty.

your online make-up artist

The opponent filed an opposition based on its earlier internationally registered word/device mark (shown below) protected for "cosmetics and make-up" (Class 3).

In 2022, the German Patent and Trade Mark Office rejected the opposition, holding that despite the similarity of goods and services there was no likelihood of confusion because both words "beauty" and "blender" were descriptive and the overall mark had only below-average distinctiveness. On appeal, the Federal Patent Court overturned the Office's decision and ordered the cancellation of the later mark "blend beauty" based upon the opposition of the earlier mark "beautyblender."

As to similarity between goods and services, the court found identity between the cosmetics of the opposing trademark and the goods covered by the younger trademark and above average similarity between consulting and training services in beauty care. Due to the fundamental differences between the provision of services and the manufacture or distribution of goods and services are generally not automatically considered similar. An indication of similarity between goods and services may exist if the goods are not only offered independently but are also typically used in the provision of services, as with the relationship between (cosmetic) products and services in the field of body and beauty care. In this area, consumers are accustomed to manufacturers of skin care and decorative cosmetics offering their products in spas, salons, cosmetic institutes, etc.

The court assessed the distinctiveness of the earlier mark to be below-average but not weak: Whereas "beauty" is descriptive, "blender," is not an established technical term in the cosmetics industry and remains vague; thus, the mark as a whole was sufficiently distinctive and original.

The key question was therefore whether a change in word order could *still* result in similarity despite a limited degree of

distinctiveness of the earlier mark. In this respect the court found that the inversion of the trademark components ("anagrammatic rotation") does not eliminate the likelihood of confusion, as consumers often cannot recall the precise word order from memory.

However, confusion arising from syllable rotation must be applied with caution and in particular would not be applicable where:

(a) the overall impression of both words is completely different;

(b) the rearrangement results in a different, easily comprehensible overall term; or

(c) combinations of elements with weak distinctive character are compared, and it is only the order of those elements that makes the mark distinctive.

On the facts, none of these considerations applied. The additional ending "-er" in "blender" is phonetically insignificant so that the marks show an average similarity. Considering the identity or close similarity of the goods and the phonetic closeness of the marks, the court held that there exists a direct likelihood of confusion.

As such, even marks containing descriptive elements can retain distinctive character if their overall composition is sufficiently original and the reversal of identical components could create confusion, particularly where the marks also sound similar and cover identical goods.

5. Spain—Provincial Court of Madrid—Can trademark reputation extend to clearly dissimilar goods?

This case provides an illustrative example of how Spanish courts apply the enhanced protection regime for trademarks with a reputation, in a case involving the globally well-known brand TITLEIST.

The dispute arose from the decision of the Spanish Patent and Trademark Office ("SPTO") to grant the Spanish trademark TITLEIST for goods in Class 33 (alcoholic beverages) to a Spanish winery, notwithstanding the opposition filed by Acushnet Company, the long-standing proprietor of the TITLEIST trademark for golf-related products. While the SPTO expressly acknowledged both the identity of the signs and the well-known character of the earlier TITLEIST mark in the golf sector, it considered that the significant distance between the respective goods (sports equipment on the one hand and alcoholic beverages on the other) prevented the relevant public from establishing a link between the signs.

The Provincial Court[43] overturned that assessment and upheld Acushnet's appeal. Starting from the complete identity of the sign and the reputation of the earlier trademark within a specialized sector of the public (not among the general public), the Chamber focused its analysis on whether there was a real risk of unfair advantage being taken of the reputation of the earlier mark. In this respect, it was decisive that the marketing and promotion of alcoholic beverages in golf-related environments was effectively established in the market, and one that had in fact been used by the applicant for the contested trademark itself.

On that basis, the Court concluded that the use of the TITLEIST sign for wines and alcoholic beverages could enable the proprietor of the later trademark to benefit from the power of attraction, prestige and reputation associated with the reputed mark, without making a comparable effort of its own. This, in the Court's view, constituted an unfair advantage. The judgment further recalled that, in line with the case law of the CJEU, it is sufficient to establish the existence of a serious and non-hypothetical risk of unfair advantage, without any requirement to prove that such advantage has already materialized.

6. Poland—Is a one-letter difference sufficient to avoid confusion for a mark registered for identical goods?

In Case *II GSK 1035/22 GERDIN*,[44] the Supreme Administrative Court considered an appeal from the judgment of the District Administrative Court in Warsaw upholding the Polish Patent Office's ("PPO") decision to dismiss an opposition to the word mark GERDIN for goods in Class 5, including "medicines, medicinal products and pharmaceutical preparations."

The opposition was based on a portfolio of earlier VERDIN and VERDIN-formative signs covering Class 5, comprising word and figurative registrations such as VERDIN, VERDIN EXTRA, VERDIN FIX, VERDIN COMPLEXX and VERDIN ENZYMIXX, as well as VERDINA FIX. The PPO initially allowed the opposition in February 2021, finding identity or close similarity of the goods and similarity of the signs, but in August 2021 reversed its initial assessment and rejected the opposition in full. In the contested decision, the District Administrative Court endorsed that outcome, placing decisive weight on the difference in the initial letter of the conflicting marks, and the proposition that average consumers pay particular attention to the beginnings of short signs. The opponent challenged the judgment before the Supreme Administrative Court.

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43 Judgment 27/2024 of January 25, 2024 (Section 32 of the Madrid Provincial Court).

44 Case II GSK 1035/22 (Supreme Administrative Court, December 16, 2025).

On appeal, the Supreme Administrative Court first recalled that examining likelihood of confusion requires a global assessment that balances the similarity of the goods with the similarity of the signs and their effect on the origin function. The Court emphasized the principle of interdependence, according to which identity or a high degree of proximity between the goods intensifies the significance of even modest similarity between the signs. It further underlined that the analysis must focus on the dominant and distinctive components of the marks as perceived by the relevant public, and that the proven market recognition of the earlier marks is a material factor that increases the likelihood of confusion.

Applying those principles, the Court held that the PPO and first-instance reasoning gave disproportionate weight to non-distinctive, descriptive add-ons in the earlier signs, such as "extra," "fix," "complexx," and "enzymixx." The Court stressed that those elements do not alter the perception of the fanciful cores GERDIN and VERDIN, which are the dominant elements in the comparison. Even acknowledging the differing initial letter, the signs share five of six letters and present notable proximity in both visual and phonetic dimensions, such that consumers may perceive the later sign as a variant of, or economically linked to, the earlier family. In circumstances where the goods are identical, even a limited degree of similarity can suffice to meet the statutory threshold for a likelihood of confusion. The court also observed that the PPO and District Administrative Court failed properly to account for the enhanced recognition of the earlier VERDIN marks.

The Court referred the case back to the PPO, pointing out that it must reassess the case by giving primacy to the distinctive cores of the signs, taking due account of the identity of the goods, applying the interdependence principle, and factoring in the established recognition of the earlier VERDIN registrations in its global assessment of confusion. In consequence, the Supreme Administrative Court annulled the judgment of the District Administrative Court and the contested Patent Office decision and remitted the case for reconsideration.

7. Germany—Federal Court of Justice—Can there be a likelihood of confusion if the conflicting works belong to different work categories?

In a decision[45] on the likelihood of confusion between the title of a TV series and a book, the Federal Court of Justice had to decide whether there could be a likelihood of confusion if the conflicting works belong to different work categories.

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[45] Federal Court of Justice, dec. of May 7, 2025, Case No. I ZR 143/24—Nie wieder keine Ahnung.

The plaintiff, a public broadcasting corporation, produced a television series titled *Nie wieder keine Ahnung* (*Never Again No Idea*), focusing on subjects such as painting and architecture. The title had been protected since 2009. The broadcaster also published a companion book and online educational materials under that title.

The defendant, a book publisher, released a non-fiction book in 2021 bearing the same title, covering basic knowledge in politics, economics, and culture. The book was written by hosts of a children's news program broadcast on a public TV channel and was also available as an e-book and audiobook.

The broadcaster claimed this constituted a likelihood of confusion and thereby a violation of its title protection rights under Sections 5(1), (3), and 15 of the German Trademark Act. The Regional Court of Stuttgart ruled in favor of the broadcaster, while the Court of Appeal of Stuttgart overturned the decision, finding no likelihood of confusion. The plaintiff appealed to the Federal Court of Justice.

The Federal Court of Justice dismissed the plaintiff's appeal. The judgment of the Court of Appeal of Stuttgart was upheld. In its decision, the court confirmed the basic rules of title protection, in particular when there is a likelihood of confusion between work titles, especially across different types of works and under what conditions a broader protection for well-known titles applies.

Work titles typically serve only to distinguish one work from another and do not indicate the work's commercial origin. Therefore, the title protection covers direct confusion only where the public mistakes one work for another.

The Federal Court of Justice dismissed the plaintiff's appeal on the following grounds:

a) No direct likelihood of confusion (confusion about identity of work)

The TV series and the book belong to different categories of works, so the public would not mistake the defendant's book for an episode of the plaintiff's television series. Unlike the earlier case, *Winnetous Rückkehr* ("Winnetou's Return"), where a *novel* and film were considered closely related because movies are often based on novels, no such "work proximity" exists here where the book is a non-fiction knowledge book.

b) No likelihood of confusion in a broader sense (confusion about commercial origin)

Protection regarding the commercial origin of a work is possible only if, as a result of the similarity of titles, the public assumes economic or organizational connections between the undertakings behind the book and the film, and thus a deception as to origin can occur. This can be affirmed in the case of sufficiently well-known titles of periodically published printed matter or television series

and a factual connection between the works involved. Here, the broadcaster failed to prove sufficient recognition of the title: Audience data showing that several million people had briefly watched the show did not demonstrate actual title awareness. Website views also did not establish that users remembered the title. Thus, the necessary degree of public awareness was not met.

c) No indirect (series-related) likelihood of confusion

Indirect confusion may occur if similar works share a common title component (a "series mark"). This was not the case here.

This ruling clarifies and narrows the scope of title protection under German trademark law:

Protection for work titles generally extends only to preventing direct confusion between identical or similar works. If the works differ in nature—such as a television series and a book—there is no infringement unless the title has achieved substantial recognition and serves as an indicator of commercial origin. Mere identity of titles is not sufficient when the works belong to different categories.

8. Greece—Athens Administrative Court of Appeals—Was there a sufficient link between carbonated drinks and pharmaceutical preparations?

In its decision,[46] the Athens Administrative Court of Appeals ruled on appeal in trademark invalidity proceedings on the basis of dilution/unfair advantage brought by PEPSICO against a Greek trademark registered for pharmaceutical goods.

The Greek pharmaceutical company Intermed filed a Greek trademark application for the figurative trademark  with the word elements "by Intermed PepsiSODA" for goods in Class 5, namely dietetic products for digestive disorders. The mark was registered, and PEPSICO subsequently filed an invalidity action based on its earlier famous PEPSI trademarks, for carbonated soft drinks in Class 32 (and goods in classes other than Class 5) relying on their protection as reputed trademarks against dissimilar goods.

At first instance, the Greek Trademark Office ("TMO") rejected the invalidity action. It held that there was no link or likelihood of dilution or unfair advantage, given that the goods at issue were dissimilar (soft drinks v. pharmaceuticals/medical preparations), were distributed through different channels to different circles of consumers, while the goods designated by the contested marks were used for the treatment of digestive problems. The TMO further found that the contested trademark consisted of four words, that the wording "by Intermed" appeared prominently on top of the mark and that "Intermed" was the trade name of the holder, separately indicating the origin of the goods, while the words "PEPSI SODA"

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[46] No. 1561/2025.

were not prominent. In addition, the TMO stated that the PEPSI marks did not include the word "SODA." In conclusion, the TMO found that due to the overall impression, from a visual and phonetic point of view, the contested trademark was sufficiently different from the PEPSI marks.

PepsiCo appealed against that decision before the Administrative Court of First Instance. The first-instance court upheld the appeal and cancelled the mark, finding that PEPSI marks are "commonly known" at an international level for non-alcoholic carbonated beverages. The first-instance court confirmed that the marks are similar, given that the dominant element in the contested mark is the word element "PEPSI." Regarding the goods, the Court held that, even though the goods are in different classes, the goods under the contested mark are advertised and promoted as an effervescent drinkable preparation, as follows also from the logo of the contested mark, which shows two effervescent tablets, while the product as such is an instant effervescent drink aimed at aiding digestion. Furthermore, the goods under the contested mark are not necessarily sold in pharmacies given that they are over-the counter goods. On that basis, it concluded that there was a link and a likelihood of unfair advantage and dilution of the earlier marks.

Upon further appeal, the Athens Administrative Court of Appeals dismissed the cancellation action and reversed the first-instance court ruling. The Court of Appeals found that no link can be established between the contested mark and the earlier PEPSI marks, in view of their overall impression. The goods under the contested mark are pharmaceutical preparations for digestion problems while the goods under the earlier marks are totally different (carbonated beverages and non-alcoholic beverages), the contested goods are sold in different outlets (pharmacies) by specialists (pharmacists), and the relevant consumers exhibit a high level of attention when purchasing them, while consumers' mother tongue is Greek; therefore the mental link that is created to them by the word "PEPSI" is not with the earlier trademark of PEPSICO but with the Greek word "πεψη" (pepsi) written in Latin letters, which denotes the purpose of the goods and constitutes, as a composite, an international medical term (for example "dyspepsia" means difficulties with digestion).

9. Switzerland—Swiss Federal Administrative Court—Did the first name of a famous artist contain sufficient distinctive character to block a later applicant?

In the FRIDA KAHLO / FRIDA case,[47] the Swiss Federal Administrative Court ("FAC") considered the interpretation of Article 3(1)(c) of the Swiss Trademark Protection Act ("TmPA"), specifically addressing whether the registration of the trademark FRIDA by a third party could give rise to a likelihood of confusion with the earlier mark FRIDA KAHLO. The provision prohibits the registration of a trademark if it is similar to an earlier trademark and intended for identical or similar goods, thereby creating a risk of confusion.

The dispute involved the Frida Kahlo Corporation, holder of the earlier trademark FRIDA KAHLO, and Fridababy LLC, a U.S. company based in Miami specializing in innovative baby and parenting products. Fridababy's portfolio includes care and hygiene items as well as brushes. Both trademarks were registered for goods in Class 21, in particular brushes and related products.

The opponent argued that the younger mark FRIDA adopted the distinctive element of the earlier mark FRIDA KAHLO, and that the omission of KAHLO did not eliminate the risk of confusion. It also claimed a danger of indirect confusion, namely that consumers might perceive FRIDA as part of a series of marks derived from FRIDA KAHLO, and thus assume a common commercial origin. The respondent countered that KAHLO was the dominant element of the earlier trademark and that the signs differed significantly in meaning. Moreover, the respondent argued that the earlier mark lacked increased distinctiveness for brushes.

The FAC first established that the goods covered by the trademarks were identical or similar. With regard to similarity of the signs, it acknowledged that FRIDA is fully contained in FRIDA KAHLO, which creates a certain visual and phonetic resemblance. However, the trademarks differ in meaning: FRIDA KAHLO is perceived as the full name of a famous artist, whereas FRIDA appears merely as a first name. In assessing distinctiveness, the court concluded that the earlier mark had no increased distinctiveness for brushes. Although the name Frida Kahlo is globally recognized, this recognition relates to the person rather than the relevant product category. Enhanced distinctiveness would have required particular recognition in the market segment concerned, which was not demonstrated.

The court then turned to the broader policy question of how first and last names function in trademarks. It recalled that while

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[47] B-3401/2024.

surnames often carry greater weight in composite marks, this is not an absolute rule. First names can also serve as indicators of origin, particularly when they are rare, original, or have acquired distinctiveness through use. Common first names, by contrast, are generally weak identifiers, as consumers perceive them primarily as personal names rather than as source indicators. In multi-word marks, both elements must be considered in assessing the overall impression: sometimes the surname dominates, sometimes the first name, depending on the distinctiveness of each element and the expectations of the relevant public.

Applying these principles, the FAC emphasized that in the trademark FRIDA KAHLO, the surname "Kahlo" constitutes the decisive element. As the surname of a world-renowned artist, it defines the individual character of the mark and is the element that consumers most readily associate with the famous painter. The first name "Frida," by contrast, is relatively common and lacks strong distinctiveness. The omission of KAHLO in the younger trademark FRIDA, therefore, fundamentally changed the perception of the sign: instead of pointing to the famous painter, it is understood simply as a given name.

The court held that the arguments concerning indirect confusion were not convincing. While it had been claimed that the contested trademark might be perceived as a variant or part of a series derived from the earlier mark, no evidence of an established and publicly recognized series of marks containing "FRIDA" was provided. The mere fact of multiple registrations with a common element could not establish a series. In the absence of substantiated proof, the distinctiveness of the earlier trademark could not be considered enhanced, and the contested sign was not regarded as a modification of the opponent's trademark.

Accordingly, the risk of indirect confusion was dismissed.

The FAC therefore denied the existence of a likelihood of confusion despite identical goods and partial similarity of the signs. The decisive factors were the absence of enhanced distinctiveness of the earlier mark for brushes and the dominance of the element "KAHLO." The mark FRIDA was thus allowed to remain on the register.

IV. BAD FAITH

A. Introductory Comments

The validity of an EUTM may be challenged on the basis that the application and/or resultant registration was made in bad faith. An invalidity action may be brought under Article 59(1)(b) of the 2017 EUTM Regulation.

The bad faith provisions in the 2015 TM Directive significantly adjusted the position from the 2008 TM Directive. Under the 2008

TM Directive, each EU Member State could choose to incorporate into its law either a broader bad faith provision under Article 3(2)(d), a narrower one under Article 4(4)(g), or *neither*.

The 2015 TM Directive expanded the mandatory grounds, providing that Member States must provide for bad faith as a mandatory (post-registration) *invalidity* ground going forward, as well as being a basis on which Member States may *optionally* provide that bad faith should be an opposition ground during the application phase. The relevant provisions of the 2015 TM Directive are Articles 4(2) and 5(4)(c).

The issue of bad faith remains high profile in European trademark law. Perhaps most notably in 2025, in *CeramTec v. Coorstek* the CJEU extended the concept still further, holding that the invalidity grounds based on technical shape exclusions and bad faith, although autonomous, are not mutually exclusive. As such, an applicant's belief at the time of filing that a mark represented a patented technical solution may establish evidence of bad faith following patent expiry, even where though post-filing discoveries demonstrated that it was not, in fact, a technical solution. The decision has practical significance across color and shape filings at the "patent cliff" for medical devices and pharmaceuticals. Beyond this, national courts in France and Spain considered procedural bad faith and strategic filings: the French INPI (National Institute of Industrial Property) declared a revocation action inadmissible as an abuse of rights where an IP firm filed it to circumvent ongoing infringement proceedings, while in a separate decision it cancelled a trademark filed to defeat an anticipated revocation action or consolidate prior rights during negotiations. In Spain, the Provincial Court of Barcelona distinguished clearly between revocation for non-use and bad faith at refiling, holding that failure to make genuine use does not automatically imply that a later application was filed without intention to use or to block third parties.

B. Legal Texts

Article 59(1)(b) of the 2017 EUTM Regulation

1. An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

   . . .

   (b) where the applicant was acting in bad faith when he filed the application for the trade mark.

Article 4(2) of the 2015 TM Directive

1. A trade mark shall be liable to be declared invalid where the application for registration of the trade mark was made in bad faith by the applicant. Any Member State may also provide that such a trade mark is not to be registered.

Article 5(4)(c) of the 2015 TM Directive

1. Any Member State may provide that a trade mark is not to be registered or, if registered, is liable to be declared invalid where, and to the extent that:

. . .

(c) the trade mark is liable to be confused with an earlier trade mark protected abroad, provided that, at the date of the application, the applicant was acting in bad faith.

C. Cases

1. EU—CJEU—Can bad faith be established when an EUTM is used to protect a technical solution previously protected by an expired patent?

In *CeramTec v. Coorstek*,[48] the CJEU considered the relationship between the absolute grounds for invalidity contrary to Article 7(1)(e)(ii) of the 2009 EUTM Regulation (shape necessary to obtain a technical result) and Article 52 (bad faith) and clarified the criteria and the relevant point in time for assessing bad faith in a reference from the Cour de cassation (France).

Background

The dispute arose between CeramTec GmbH, a German undertaking specializing in technical ceramic components for orthopaedic implants, and Coorstek Bioceramics LLC, a U.S. manufacturer of advanced technical ceramics for medical devices. CeramTec had held a European patent relating to composite ceramic material until its expiry on August 5, 2011. On August 23, 2011, it filed three EUTM applications: a color mark for pink Pantone 677C, a figurative mark depicting a pink ceramic ball, and a three-dimensional mark claiming the same pink.

CeramTec's figurative mark and three-dimensional mark are set out below:

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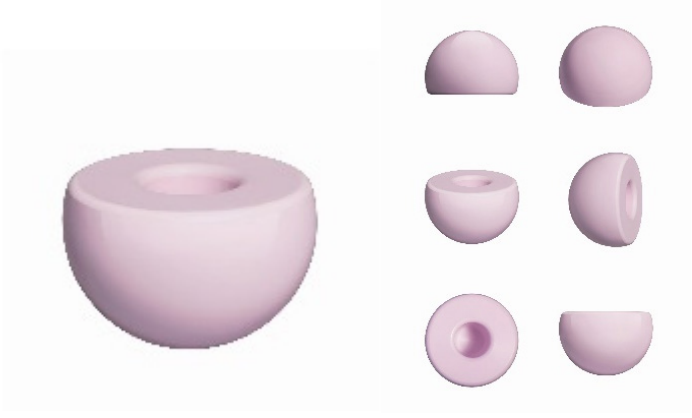
[48] Case C-17/24, EU:C:2025:455.



The figurative mark **The three-dimensional mark**

The marks covered "Ceramic parts for implants for osteosynthesis, articular surface replacement, bone spacer blocks; Hip joint balls, hip joint sockets and parts for knee joints; All of the aforesaid goods for sale to manufacturers of implants" in Class 10.

On December 13, 2013, CeramTec brought infringement and parasitic competition claims in France; Coorstek counterclaimed for invalidity of the three marks. The Paris Court of Appeal cancelled the registrations for bad faith, finding that, at filing, CeramTec believed the pink coloration—linked to the presence of chromium oxide (which it believed to have a technical effect)—expressed the technical solution previously protected by its patent and sought to extend that monopoly through trademark protection. CeramTec appealed, contending that this reasoning impermissibly collapsed Articles 7(1)(e)(ii) and 52(1)(b) and that later-discovered facts indicated no technical effect from chromium oxide. The Cour de cassation referred questions to the CJEU for a preliminary ruling on the autonomy and interaction of these grounds, whether an applicant's view at the time of filing that the sign conveys a technical solution can evidence bad faith post-patent, and whether post-filing circumstances may be considered in assessing bad faith.

The reference asked, in substance:

1. whether invalidity under Articles 52(1)(a) (via Article 7) and 52(1)(b) (bad faith) are autonomous or mutually exclusive;
2. whether bad faith may be substantiated, where an application follows patent expiry, by the applicant's opinion that the sign expresses, fully or partially, the patented technical solution, irrespective of Article 7(1)(e)(ii); and
3. whether post-filing circumstances may be used to assess bad faith.

The CJEU's decision

The Court held, first, that the invalidity grounds based on Article 52(1)(a) and Article 52(1)(b) are autonomous but not mutually exclusive (i.e., they may both apply to the same mark). The CJEU emphasized that the grounds in Article 52(1)(a) and (b) pursue different objectives (the technical shape exclusion preventing the granting of monopolies in technical solutions and bad faith addressing the applicant's conduct) and may coexist in a single case without one displacing the other, based on a literal reading of Article 52 and on the wider context of the 2009 EUTM Regulation. That thereby preserves the distinct role of the technical-shape exclusion while enabling scrutiny of the applicant's conduct through bad faith where warranted by the facts.

Regarding the second question, where registration is sought following expiry of a patent, bad faith may be substantiated, inter alia, by the applicant's opinion that the sign is suitable to express the patented technical solution, regardless of whether the sign "consists exclusively" of a shape necessary to obtain a technical result within Article 7(1)(e)(ii). The relevant assessment may consider the nature, origin, and use of the sign since its creation, the scope of the expired patent, the commercial rationale for filing, and the chronology of events characterizing the filing.

In relation to the third question, bad faith cannot be assessed on the basis of circumstances arising after the filing date; later developments cannot retroactively alter the applicant's state of mind at filing. The bad-faith inquiry must target the applicant's intention at the time of filing and may be informed by relevant and consistent indicia available then; post-filing discoveries—such as CeramTec's later-formed view that chromium oxide's pink coloration did not yield a technical effect—cannot be used to establish a posteriori an intention that did not exist at filing. Conversely, while post-filing events may serve as indicia of earlier intent in some settings, they cannot create a new state of mind ex post.

The decision has practical significance across color and shape filings at the "patent cliff." Proprietors cannot rely on the technical shape exclusion as a safe harbor from bad-faith scrutiny, nor can they defeat bad-faith allegations by invoking the later discovery of an absence of technical effect that they believed to exist at the time of filing. Evidence marshalled must speak to the applicant's contemporaneous commercial rationale and belief about the sign's role at filing, against the backdrop of factors now expressly identified by the Court. The ruling aligns with the Court's broader bad-faith framework that examines intention through "relevant and consistent indicia" and confines the inquiry to the filing date, as reflected in prior analyses of bad faith and timing in the EU jurisprudence and commentary.

2. EU—CJEU—Can a self-imposed deadline for taking enforcement action bar a subsequent validity challenge on the basis of bad faith?

In *Sánchez Romero Carvajal Jabugo v. Embutidos Monells*,[49] the CJEU considered whether a proprietor of an earlier mark who, in pre-action correspondence, fixed a time limit coinciding with the five-year statutory period of limitation for acquiescence under Article 9(1) of the 2008 TM Directive, could still bring a later invalidity action based on bad faith—even where the earlier proprietor already had knowledge of the facts needed to suspect bad faith at the time the correspondence was sent.

Background

The reference arose from the Juzgado de lo Mercantil No. 1 de Alicante in proceedings between Sánchez Romero Carvajal Jabugo S.A.U. ("Carvajal") and Embutidos Monells S.A. ("Monells"). Carvajal was the proprietor of EUTMs filed in 1999 and 2010 for goods in Class 29. The marks had a strong reputation in Spain. Carvajal's 1999 and 2010 Class 29 marks are set out below:

Monells applied for Spanish national trademarks in 2011 and 2012 for goods in Class 29, which were registered in 2012. Monnells' Class 29 marks are set out below:

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[49] Case C-322/24, EU:C:2025:556.

In 2016, Carvajal sent a cease-and-desist letter requiring Monells to withdraw its marks and to stop using the figurative mark 5Ms, indicating that invalidity actions could be brought before February 28, 2017 (for 5Ms), and March 18, 2017 (for 5Ps). No actions were filed in 2017.

It was not until 2021 that Carvajal brought an invalidity action before the Commercial Court in Alicante, alleging bad faith in Monells' filings. Monells relied on acquiescence under Article 61 of the 2017 EUTM Regulation and Article 9 of the 2015 TM Directive, arguing that Carvajal had tolerated the marks for years and that the self-imposed deadlines (in 2017) set out in the 2016 letter had long since expired (and could be relied on by Monells). Against that procedural and factual backdrop, the referring court asked two questions: in effect, whether a self-imposed deadline in a cease-and-desist letter binds the proprietor of the earlier mark, and whether an invalidity action based on bad faith is subject to the five-year limitation under Article 9 of the 2015 TM Directive.

Reference to the CJEU

The Spanish courts referred two questions to the CJEU:

1. Should the above legislation be read as preventing an earlier trademark owner from bringing an invalidity action after a self-imposed deadline in pre-action correspondence—on the basis that this creates an expectation on the part of the recipient? In addition, if that owner already knew of the facts indicating bad faith when sending its correspondence, is raising bad faith later contrary to principles of good faith?
2. If the answer to question 1 is yes, does successfully opposing similar EUTM applications count as taking steps within a reasonable period to remedy that situation?

The CJEU held that Article 9(1) of the 2008 TM Directive (which, although repealed and replaced by the 2015 TM Directive, applied as at the filing date of the application being challenged by Carvajal on bad faith grounds) must be interpreted as *not*

preventing the earlier proprietor from applying for a declaration of invalidity based on bad faith in the later filing, even in circumstances where the earlier proprietor already had all the information necessary to consider that the application had been made in bad faith at the time of the formal notice.

In its reasoning, the CJEU treated bad faith at filing as an absolute ground of invalidity distinct from, and not extinguished by, the limitation resulting from acquiescence. Article 9(1) limits actions to prohibit use of a later registered mark after five successive years of tolerated use. It does not, however, bar reliance on bad faith (an absolute ground for invalidity) which serves qualitatively different objectives linked to safeguarding the trademark system from registrations obtained contrary to honest practices. The Court therefore rejected the proposition that an extrajudicial letter synchronized with expiry of the acquiescence period could curtail subsequent reliance on bad faith merely because the earlier proprietor already possessed the underlying facts.

That approach aligns with prior CJEU analysis of acquiescence as a sanction for inactivity within the meaning of Article 9(1) (requiring pursuit of available remedies) but not as a shield for registrations rendered void ab initio by bad faith, it is also consistent with the Court's earlier emphasis that "acquiescence" concerns inaction to restrain use rather than the existence of absolute invalidity grounds as to the validity of the registration itself. In particular, in *HEITEC*,[50] the Court confirmed that a warning letter alone cannot interrupt or stop the five-year period; only the timely institution of administrative or judicial proceedings and the diligent completion of the procedural steps necessary for those proceedings to take effect will do so.

For practitioners, the decision confirms a clear demarcation: the five-year acquiescence bar under the 2008 TM Directive limits actions to prohibit use but does not foreclose invalidity actions grounded in bad faith, even where a pre-expiry warning letter specified a deadline and even if the facts supporting bad faith were already known. The judgment complements recent EU case law refining acquiescence and limitation mechanics, reinforcing the need to treat bad faith as a standalone absolute ground unaffected by procedural time bars aimed at tolerated use.

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50 C-466/20, EU:C:2022:400.

3. France—National Institute of Industrial Property (INPI)—Is a revocation action for non-use an abuse of procedure if filed in bad faith?

The decision[51] results from an action filed by an intellectual property firm ("IP firm") before the National Institute of Intellectual Property ("INPI") for the revocation for non-use of the French trademark registration GAZOUZ.

The action was filed as part of a larger dispute between the owner of the French registration GAZOUZ (the "TM holder") and two companies, Y and Z. As part of this dispute, the TM holder filed a counterclaim for infringement of the GAZOUZ trademark. Companies Y and Z were found liable at first instance, and an appeal was pending at the time the revocation action was filed.

Normally, in this context, the revocation claim would have been raised by Y and Z as a defensive measure as part of the ongoing infringement proceedings before the Court of Appeal. Instead, the action was filed before the INPI by an IP firm, which then, only a few days after filing the revocation action, became company Z's trademark representative. Further, companies Y and Z then sought a stay of provisional enforcement on the basis of the revocation action pending before the INPI.

Consequently, in defense, the TM holder argued that the revocation action was inadmissible on three grounds:

1. Lack of standing, the IP firm having no legitimate interest in bringing the action;
2. INPI's lack of jurisdiction on grounds of related proceedings, given the pending dispute before the Court of Appeal concerning the same trademark;
3. Bad faith on the part of the IP firm, which allegedly initiated the revocation action solely in order to circumvent the applicable rules of jurisdiction and to avoid the proceedings taking place before the Court of Appeal.

In its decision, the INPI first referred to Article L.716-5 I. 2° of the French Intellectual Property Code (IP Code), which grants it exclusive jurisdiction to handle "requests for revocation based on Articles L.714-5, L.714-6, L.715-5, and L.715-10," which includes revocation actions for non-use.

Paragraph II of this Article provides, however, that judicial courts have exclusive jurisdiction:

> 1° Where the requests referred to in points 1° and 2° of paragraph I are filed as a principal or counterclaim by the parties **in connection** with any other claim within the jurisdiction of the court, in particular in the context of an

[51] July 10, 2025, DC 24-0031.

> action brought under Articles L.716-4, L.716-4-6, L.716-4-7, and L.716-4-9, or in the context of an action for unfair competition.

In dismissing the argument of inadmissibility based on related proceedings, the INPI noted that the revocation proceedings brought before it did not involve the same parties as those in the judicial dispute. Indeed, the action pending before the Court of Appeal was between the TM holder and the companies Y and Z, whereas the revocation action was between the TM holder and the IP firm. Consequently, it considered that the necessary connection between the ongoing proceedings, within the meaning of Article L.716-5 II 1° of the IP Code, could not be established.

Regarding the claims of inadmissibility for lack of standing and bad faith, however, the INPI stated:

> It should be noted that, although legal standing is not required for revocation actions brought before the Institute pursuant to Article L.716-3 of the French Intellectual Property Code, the concept of abuse of rights or abusive procedure is independent of the rules concerning the person entitled to file a revocation action.
>
> The right to bring a revocation action may degenerate into an abuse if it actually constitutes a fault on the part of the applicant, by exceeding the limits of the rights conferred, either by diverting them from their intended purpose or with the aim of causing harm to others (see, in particular, CJEU, 14 December 2000, C-110/99 Emsland Stärke GmbH, para. 56; CJEU, 22 November 2017, C-251/16 E C, paras. 31–32; CJEU, 28 July 2016, C-423/15 K).

To support its conclusion that the IP firm abused its right to bring the action, therefore rendering it inadmissible, the INPI noted the following:

- based on the chronology of events, the filing of the revocation action could not be coincidental:
  - Filed: 8 February 2024
  - Registered: 9 February 2024
  - Published in BOPI: 15 March 2024
  - Mentioned in prior proceedings: appeal conclusions of 13 February 2024 and summons of 15 February 2024, when the revocation action was not yet public.
- the IP firm that filed the revocation action became the trademark representative of several marks owned by company Z as of 28 February 2024, only 20 days after filing the revocation action, thereby demonstrating a clear connection between the IP firm and company Z.

According to the INPI, all the factual elements submitted indicate that the IP firm, acting in its own name in the revocation action, attempted to circumvent the rules governing the INPI's jurisdiction and to obtain the revocation of the contested trademark before the INPI, whereas the action should have been filed before the Court of Appeal within the framework of the pre-existing judicial dispute. Consequently, the revocation action was declared inadmissible on the grounds of abuse of rights.

4. Spain—Provincial Court of Barcelona—Does non-use of a trademark imply bad faith at the time of refiling?

The Provincial Court of Barcelona[52] issued a decision of particular relevance in the field of revocation for non-use and invalidity for bad faith, considering the interplay between the concept of genuine use of a trademark and of the requirements for establishing bad faith at the time of filing.

The dispute arose between M2Linx Design, S.L., as claimant, and Implementing Technologies, S.L., proprietor of several Spanish trademarks incorporating the sign OSSA, including a historic mark registered in 1956 for engines and vehicles, as well as two later marks registered in 2018 (OSSA and OSSA SINCE 1940) covering motorcycles. The action combined a claim for revocation for non-use of the earlier mark with a claim for invalidity on grounds of bad faith in respect of the later registrations. The Barcelona Commercial Court No. 6[53] dismissed the action in its entirety, finding that genuine use had been established and ruling out bad faith.

On appeal, the Appeal Court partially set aside the judgment and declared the revocation for non-use of the Spanish trademark OSSA registered in 1956, following an exhaustive assessment of the evidence in accordance with the CJEU case law on genuine use. The Court identified the relevant period as the five years preceding the filing of the action (2017–2022) and expressly rejected a number of arguments frequently relied upon in this type of litigation.

First, the Court held that the mere existence of license agreements, even exclusive ones, does not in itself constitute genuine use where such agreements do not translate into an actual presence of the trademark on the market. Second, it ruled out preparatory acts, business plans, negotiations with investors, or failed manufacturing activities outside Spanish territory as constituting genuine use. The Court stressed that use must be external, real, and verifiable, attaching particular weight to

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[52] Judgment 587/2025 of April 23, 2025, Section 15 (Case 148/2024, M2Linx Design S.L. v. Implementing Technologies S.L.).

[53] Judgment of September 6, 2023 (Case 820/2022).

objective documentary evidence, such as invoices, delivery notes, advertising campaigns, or sales data that had more significant weight than witness testimony or generic certifications.

The Court also rejected the argument that the suspension of procedural deadlines during the COVID-19 period or sector-specific commercial difficulties could justify the absence of use, recalling that justifiable reasons must be beyond the trademark proprietor's control and cannot form part of the normal commercial risk of the business. In this respect, the judgment expressly aligns itself with the case law of both the Supreme Court and the CJEU, reaffirming a demanding standard of proof for establishing genuine use.

By contrast, the Court dismissed the claim for invalidity based on bad faith in relation to the trademarks registered in 2018. Although it declared the earlier mark revoked for non-use, it held that this circumstance did not automatically imply that the later applications had been filed without an intention to use or with the aim of blocking third parties. Relying on the CJEU's case law (notably *Lindt*[54] and *Monopoly*[55]), the Court recalled that bad faith requires more than the absence of use or mere awareness of third-party rights; it must be shown that the applicant intended to undermine the interests of others or to obtain an exclusive right for purposes unrelated to the functions of a trademark. In the present case, the existence of licensing and cooperation agreements contemporaneous with the filing, although insufficient to demonstrate actual use, was considered sufficient to demonstrate that there was an intention to use at the time of application.

From a practical perspective, the judgment is particularly valuable for the clarity with which it distinguishes between these two grounds. Failure to make genuine use of a trademark, leading to revocation, is not equivalent to acting in bad faith at the time of refiling the mark. The decision therefore reinforces a restrictive approach to findings of bad faith while simultaneously confirming a highly demanding standard for proving genuine use, making it a useful reference point for trademark litigation in Spain.

5. France—National Institute of Industrial Property (INPI)—Was a trademark registered for the sole purpose of defeating an action for revocation invalid on the grounds of bad faith?

The company operating the well-known Parisian department store Le Bon Marché (hereinafter the "claimant") developed a furniture and interior design workshop called "POMONE" in the

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[54] Judgment of November 6, 2009, Case C-529/07, LINDT GOLDHASE.

[55] Judgment of April 21, 2021, Case T-663/19, MONOPOLY.

1920s. The workshop was highly successful, and its reputation endured even after its activities ceased in the 1950s.

In 2023, the claimant wanted to relaunch the "POMONE" workshop. It was contacted in June 2023, however, by a third party (hereinafter, the "TM owner") that had registered two French trademarks for POMONE in 2017. The TM owner asserted his prior rights but also offered to sell them to the claimant.

On July 21, 2023, as part of the negotiations, the claimant asked the TM owner to provide evidence of use of the 2017 POMONE trademarks. On August 2, 2023, without responding to the claimant's request, the TM owner registered a new French trademark POMONE for goods almost identical to those registered in 2017. On December 27, 2023, the claimant filed a request for cancellation of the 2023 registration for POMONE on the grounds of bad faith.

In its decision,[56] the National Institute of Industrial Property ("INPI") emphasized that bad faith must be assessed as of the filing date of the contested registration, taking into account all the relevant circumstances surrounding the application. In particular, it held that bad faith presupposes, first, that the owner of the contested registration was aware, as of the filing date, of the prior use of the sign at issue and, secondly, that the application was made with the intention of preventing third parties from using a sign necessary to their business activity.

With regard to awareness of the prior use of the sign POMONE, the INPI observed that, as of the filing date of August 2, 2023, the owner already owned two POMONE trademarks filed in 2017.

It further noted that, in June and July 2023, he had contacted the claimant by email to assert his alleged rights in the POMONE signs and to propose an assignment. In those exchanges, he stated that he was familiar with the history of the POMONE workshop, founded in the 1920s, and that he had diligently traced and gathered archives relating to that workshop, which he also offered to sell to the claimant.

These emails, sent prior to the filing of the contested registration, demonstrated that the TM owner was fully aware of the claimant's prior use of the sign POMONE prior to the 2023 filing.

With regard to the TM owner's intention, the INPI observed that the contested registration POMONE was filed on August 2, 2023, less than three weeks after the claimant had requested proof of genuine use of the 2017 POMONE trademarks.

The INPI considered that this timeline led to the conclusion that the TM owner filed the contested trademark POMONE in 2023 with the intention of avoiding the cancellation of his earlier trademarks

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[56] March 27, 2025, NL 23-0276.

or, at the very least, of consolidating his prior rights in the context of negotiations with the claimant.

It considered that the TM owner could not dispute that the risk of cancellation of his 2017 trademarks, registered for more than five years, was likely to affect their value during negotiations with the claimant. The INPI therefore concluded that the application for the trademark POMONE filed on August 2, 2023, was made in bad faith and therefore cancelled it entirely.

V. USE OF A TRADEMARK

A. Introductory Comments

The following Part V includes cases with a common theme where the central questions to be considered relate to "use of a trademark." Questions of use of a trademark arise in a wide variety of ways in European trademark law, including *how* a mark is used (such as the manner, form, genuine nature, and intention of use), *when* (duration of use) and *where* (territory of use) in relation to *what* goods and services (as against a mark's specification), as well as *how* such use is perceived by the average consumer and the consequences arising from such perception.

Neither the 2015 TM Directive nor the 2017 EUTM Regulation require that a trademark should be in use *before* the mark may be registered. There is also no requirement for an applicant to indicate the particular use it will, or intends to, make of the mark applied for. The applicant may not even to know precisely what such use might be, since the applicant has a period of five years to commence the actual use, provided such use is consistent with the essential function of a trademark. Similarly, there is no formal requirement that the trademark owner should prove ongoing (or indeed any) use of the trademark upon the administrative act of renewal of the registration, or at any other periodic interval. Nevertheless, the EUTM regime and comparable national jurisdictions operate on a "use it or lose it" principle. An EUTM becomes vulnerable to attack on grounds of non-use once it has been registered for five years. A similar rule applies in relation to trademarks registered with national EUTM authorities. This concept of use also applies in other (non-EU) European territories.

As noted in Part II of this Review, trademarks that may initially lack distinctiveness, that are descriptive or that might be considered generic can, in principle, be overcome by persuasive evidence that the trademark has acquired distinctiveness among the relevant class of consumers through the use made of it (Article 7(3) of the 2017 EUTM Regulation and Articles 4(4) and 4(5) of the 2015 TM Directive).

Aside from acquired distinctive character, the question of whether or not a mark is in use at any given time most commonly

arises in two contexts. The first is where the registration of the mark is made the subject of a revocation attack on the specific grounds of non-use, which may happen on a stand-alone basis or as a counterclaim in infringement proceedings. The second is where the trademark in question is the basis of an "earlier right" used to challenge a third party's trademark application or registration. In this situation, the third party may require, if the challenger's mark is at least five years old, that "proof of use" be provided. To the extent that such proof is not then provided, the earlier right is disregarded for the purposes of the challenge. In all respects this is to ensure that only a valid (and used) prior right may be invoked against a third party.

The main provisions concerning the revocation of an EUTM on the ground of non-use are found in Articles 18 and 58(1) of the 2017 EUTM Regulation. The parallel provisions in relation to the trademark registrations on the registers of EU Member States are set out in Articles 16 and 19 of the 2015 TM Directive.

The main provisions relating to "proof of use" in connection with challenges to third-party marks are set out in Articles 47, 64(2), and 127(3) of the 2017 EUTM Regulation and Articles 17, 44, and 46 of the 2015 TM Directive.

The question as to "where" and "how" a mark might be used remains ever important, given the territorial nature of trademark registrations and online use requires a particular balancing of factors. In *Japan Tobacco v. Guangdong Camel Clothing*, the Spanish Provincial Court of Alicante undertook a detailed review of when e-commerce websites target the EU market, holding that actual sales to EU consumers, express shipping terms covering Member States, and promotional discount codes distributed through local media outweighed the use of English or U.S. dollar pricing. In Switzerland, the Federal Administrative Court confirmed in *Canna (fig.) / Cannavitas* that mere Internet accessibility is insufficient—genuine use requires a concrete link to the Swiss market through targeted marketing or actual transactions.

Whether a mark has been used at all is also a question that requires close analysis. In *ROMPIDEE*, the Swiss courts clarified the narrow scope of Switzerland's simplified cancellation procedure, holding that only non-use may be examined and that broader allegations of abusive filing or ownership disputes must be pursued in civil nullity proceedings. Questions of how use interacts with third parties also arose: in *Ferrari (TESTAROSSA)*, the General Court held that secondhand sales and spare parts use by authorized dealers, with implied consent, can constitute genuine use by the proprietor, and in *PMJC SAS v. [W] [X]*, the CJEU ruled that a designer-name mark may be revoked for deceptiveness where the proprietor's use leads consumers to believe the designer remains involved in the design. In Greece, the Athens Administrative Court

of Appeals in *PEPSICO v. BY UNI-PHARMA PEPSI SODA* rejected the argument that pending invalidity proceedings constitute a proper reason for non-use, emphasizing that such circumstances do not objectively prevent use. Finally, in the UK, *Getty Images v. Stability AI* saw the High Court hold that the provider of a generative AI model can be liable for trademark infringement where AI-generated outputs bear third-party watermarks—a historic ruling with implications for the intersection of AI development and trademark rights.

B. Legal Texts

Article 7 of the 2017 EUTM Regulation

Absolute grounds for refusal

1. The following shall not be registered:
   (a) . . .
   (b) trade marks which are devoid of any distinctive character;
   (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;
   (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
   (e) . . .
2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Union.
3. Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it. *(Emphasis added.)*

Article 4 of the 2015 TM Directive

Absolute grounds for refusal or invalidity

1. The following shall not be registered . . . :
   (a) . . .

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

. . .

4. A trade mark shall not be refused registration in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration, following the use which has been made of it, it has acquired a distinctive character. A trade mark shall not be declared invalid for the same reasons if, before the date of application for a declaration of invalidity, following the use which has been made of it, it has acquired a distinctive character. *(Emphasis added.)*

5. Any Member State may provide that paragraph 4 is also to apply where the distinctive character was acquired after the date of application for registration but before the date of registration.

Article 16 of the 2015 TM Directive

1. If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during a continuous five-year period, the trade mark shall be subject to the limits and sanctions provided for in Article 17, Article 19(1), Article 44(1) and (2), and Article 46(3) and (4), unless there are proper reasons for non-use.

2. Where a Member State provides for opposition proceedings following registration, the five-year period referred to in paragraph 1 shall be calculated from the date when the mark can no longer be opposed or, in the event that an opposition has been lodged, from the date when a decision terminating the opposition proceedings became final or the opposition was withdrawn.

3. With regard to trade marks registered under international arrangements and having effect in the Member State, the five-year period referred to in paragraph 1 shall be calculated from the date when the mark can no longer be rejected or opposed. Where an opposition has been lodged or when an objection on absolute or relative grounds has been notified, the period shall be calculated from the date when a decision terminating the opposition proceedings or a ruling on absolute or relative grounds for refusal became final or the opposition was withdrawn.
4. The date of commencement of the five-year period, as referred to in paragraphs 1 and 2, shall be entered in the register.
5. The following shall also constitute use within the meaning of paragraph 1:
   (a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor;
   (b) affixing of the trade mark to goods or to the packaging thereof in the Member State concerned solely for export purposes.
6. Use of the trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

Article 17 of the 2015 TM Directive

The proprietor of a trade mark shall be entitled to prohibit the use of a sign only to the extent that the proprietor's rights are not liable to be revoked pursuant to Article 19 at the time the infringement action is brought. If the defendant so requests, the proprietor of the trade mark shall furnish proof that, during the five-year period preceding the date of bringing the action, the trade mark has been put to genuine use as provided in Article 16 in connection with the goods or services in respect of which it is registered and which are cited as justification for the action, or that there are proper reasons for non-use, provided that the registration procedure of the trade mark has at the date of bringing the action been completed for not less than five years.

Article 19 of the 2015 TM Directive

1. A trade mark shall be liable to revocation if, within a continuous five-year period, it has not been put to genuine use in the Member State in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.
2. No person may claim that the proprietor's rights in a trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, genuine use of the trade mark has been started or resumed.
3. The commencement or resumption of use within the three-month period preceding the filing of the application for revocation which began at the earliest on expiry of the continuous five-year period of non-use shall be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.

Article 44 of the 2015 TM Directive

1. In opposition proceedings pursuant to Article 43, where at the filing date or date of priority of the later trade mark, the five-year period within which the earlier trade mark must have been put to genuine use as provided for in Article 16 had expired, at the request of the applicant, the proprietor of the earlier trade mark who has given notice of opposition shall furnish proof that the earlier trade mark has been put to genuine use as provided for in Article 16 during the five-year period preceding the filing date or date of priority of the later trade mark, or that proper reasons for non-use existed. In the absence of proof to this effect, the opposition shall be rejected.
2. If the earlier trade mark has been used in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the opposition as provided for in paragraph 1, be deemed to be registered in respect of that part of the goods or services only.
3. Paragraphs 1 and 2 of this Article shall also apply where the earlier trade mark is an EU trade mark. In such a case, the genuine use of the EU trade mark shall be determined in accordance with Article 15 of Regulation (EC) No 207/2009.

Article 46 of the 2015 TM Directive

1. In proceedings for a declaration of invalidity based on a registered trade mark with an earlier filing date or priority date, if the proprietor of the later trade mark so requests, the proprietor of the earlier trade mark shall furnish proof that, during the five-year period preceding the date of the application for a declaration of invalidity, the earlier trade mark has been put to genuine use, as provided for in Article 16, in connection with the goods or services in respect of which it is registered and which are cited as justification for the application, or that there are proper reasons for non-use, provided that the registration process of the earlier trade mark has at the date of the application for a declaration of invalidity been completed for not less than five years.
2. Where, at the filing date or date of priority of the later trade mark, the five-year period within which the earlier trade mark was to have been put to genuine use, as provided for in Article 16, had expired, the proprietor of the earlier trade mark shall, in addition to the proof required under paragraph 1 of this Article, furnish proof that the trade mark was put to genuine use during the five-year period preceding the filing date of priority, or that proper reasons for non-use existed.
3. In the absence of the proof referred to in paragraphs 1 and 2, an application for a declaration of invalidity on the basis of an earlier trade mark shall be rejected.
4. If the earlier trade mark has been used in accordance with Article 16 in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect of that part of the goods or services only.
5. Paragraphs 1 to 4 of this Article shall also apply where the earlier trade mark is an EU trade mark. In such a case, genuine use of the EU trade mark shall be determined in accordance with Article 15 of Regulation (EC) No 207/2009.

Article 18 of the 2017 EUTM Regulation

1. If within a period of five years following registration, the proprietor has not put the EU trade mark to genuine use in the [European Union] in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of

five years, the EU trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

The following shall also constitute use within the meaning of the first sub-paragraph:

(a) use of the EU trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trademark in the form as used is also registered in the name of the proprietor.

(b) affixing of the EU trade mark to goods or to the packaging thereof in the EU solely for export purposes.

2. Use of the EU trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

Note: The wording "regardless of whether or not the trademark in the form as used is also registered in the name of the proprietor" is new and reflects case law under the old 2009 EUTM Regulation.

Article 47 of the 2017 EUTM Regulation

1. If the applicant so requests, the proprietor of an earlier EU trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the EU trade mark application, the earlier EU trade mark has been put to genuine use in the Union in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier EU trade mark has at the date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier EU trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

2. Paragraph 2 shall apply to earlier national trademarks . . . by substituting use in the Member State in which the earlier national trademark is protected for use in the [Union].

Article 64(2) of the 2017 EUTM Regulation

1. If the proprietor of the EU trade mark so requests, the proprietor of an earlier EU trade mark, being a party to the invalidity proceedings, shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier EU trade mark has been put to genuine use in the Union in connection with the goods or services in respect of which it is registered and which the proprietor of that earlier trade mark cites as justification for his application, or that there are proper reasons for non-use, provided that the earlier EU trade mark has at that date been registered for not less than five years. If, at the date on which the EU trade mark application was filed or at the priority date of the EU trade mark application, the earlier EU trade mark had been registered for not less than five years, the proprietor of the earlier EU trade mark shall furnish proof that, in addition, the conditions set out in Article 47(2) were satisfied at that date. In the absence of proof to this effect, the application for a declaration of invalidity shall be rejected. If the earlier EU trade mark has been used only in relation to part of the goods or services for which it is registered, it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect of that part of the goods or services only.

Article 58 of the 2017 EUTM Regulation

1. The rights of the proprietor of the EU trade mark shall be declared to be revoked on application to the [EUIPO] or on the basis of a counterclaim in infringement proceedings:
   A) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Union in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; however, no person may claim that the proprietor's rights in an EU trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application or counterclaim, genuine use of the trade mark has been started or resumed; the commencement or resumption of use within a period of three months preceding the filing of the application or counterclaim which began at the earliest on expiry of the continuous period of five

> years of non-use shall, however, be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application or counterclaim may be filed.

Article 127(3) of the 2017 EUTM Regulation

> 1. In the actions referred to in points (a) and (c) of Article 124, a plea relating to revocation of the EU trade mark submitted otherwise than by way of a counterclaim shall be admissible where the defendant claims that the EU trade mark could be revoked for lack of genuine use at the time the infringement action was brought.

C. Cases

1. EU—CJEU—Are trademarks consisting of designer names liable for revocation on deception grounds by indicating the designer was involved in the supply of the goods where that is no longer the case?

In *PMJC SAS v. [W] [X] and Others*,[57] the CJEU ruled on a preliminary reference concerning Article 12(2)(b) of the 2018 TM Directive and Article 20(b) of the 2015 TM Directive. The central question was whether these provisions preclude revocation of a trademark consisting of a fashion designer's name where the proprietor uses it to mislead consumers into believing the designer remains involved in designing the goods.

Background

The dispute involved PMJC SAS ("PMJC"), the assignee of two French word marks comprising a fashion designer's name (the "Marks"). Following insolvency proceedings, PMJC acquired the designer's eponymous fashion company, including the Marks. The designer continued to work with PMJC until December 31, 2015.

Following the termination of this arrangement, PMJC brought an action against the designer in June 2018 for trademark infringement through a new company named "[X] Créative." The designer counterclaimed for revocation of the Marks, alleging that PMJC had used them deceptively to suggest the designer remained the author of the designs to which the Marks were affixed.

The *cour d'appel de Paris* (Court of Appeal, Paris) partially revoked PMJC's rights, finding the Marks had become deceptive when affixed to goods presented as original designs by the designer. PMJC appealed to the *Cour de cassation* (Court of Cassation,

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[57] Case C-168/24, December 18, 2025.

France), which referred a question to the CJEU asking, in essence: whether Article 12(2)(b) of the 2008 TM Directive and Article 20(b) of the 2015 TM Directive must be interpreted as precluding the revocation of a trademark consisting of a designer's surname where that mark is used post-assignment in a manner that leads the public to believe the designer remains involved in the design of goods, when that is no longer the case.

PMJC relied heavily on the CJEU's earlier judgment in *Emanuel*,[58] arguing that decision established that a trademark corresponding to a designer's name could not be revoked merely because the designer was no longer involved in the design of the goods.

Findings of the CJEU

The CJEU first confirmed that Article 12(2)(b) of the 2008 TM Directive and Article 20(b) of the 2015 TM Directive must be interpreted together, as their terms are essentially identical. The Court noted that a mark may be revoked if, as a result of the use made of it by its proprietor, it becomes "liable to mislead the public, particularly as to the nature, quality or geographical origin" of the goods.

The CJEU emphasized that the word "particularly" means the list of characteristics to which deception might relate is not exhaustive. Accordingly, "the creative origin of a product may, depending on the circumstances, constitute a characteristic of that product giving rise to certain expectations in the public." Therefore, such origin falls within the scope of what may "mislead" the public for the purposes of the revocation provisions.

However, the Court clarified that the mere fact a trademark consisting of a designer's name is used by an undertaking no longer connected with that designer is of itself insufficient to justify revocation, echoing the reasoning in *Emanuel*. The average consumer is conscious that not all goods bearing a trademark corresponding to a designer's name have necessarily been created by that designer. Consequently, revocation requires proof of "actual deceit or a sufficiently serious risk that the public will be deceived," assessed based on the circumstances of the case. Significantly, the CJEU held that the presence on goods of decorations pertaining to the specific creative universe of a designer and infringing that designer's copyright (as was alleged here) "may constitute such a relevant circumstance, in so far as it increases the risk that the public may mistakenly perceive the creative origins of the goods."

The CJEU ruled that Article 12(2)(b) of the 2008 TM Directive and Article 20(b) of the 2015 TM Directive must be interpreted as:

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[58] Elizabeth Florence Emanuel v. Continental Shelf 128 Ltd., Case C-259/04 (CJEU, March 30, 2006).

i) permitting the revocation of a trademark consisting of the surname of a fashion designer on the ground that; ii) having regard to all the relevant circumstances, it is used by the proprietor of the trademark, or with his or her consent; iii) in such a way as to lead the average consumer to believe, mistakenly, that that designer was involved in the design of the goods bearing that mark.

This judgment provides important clarification on the scope of revocation for deceptiveness under EU trademark law. While the decision does not overturn *Emanuel*, it makes clear that the principle established in that case, that a designer's departure alone does not render a name mark deceptive, is not absolute. Where a proprietor's use creates a sufficiently serious risk that the average consumer will be deceived as to the creative origin of goods, the mark may be revoked.

2. EU—GC—Can secondhand sales and spare parts use by authorized dealers amount to genuine use?

In *Ferrari SpA v. EUIPO*,[59] the General Court considered an application for non-use revocation of an international registration designating the European Union for the word mark TESTAROSSA owned by Ferrari SpA and covering, among others, "automobiles" and parts and accessories in Class 12.

In September 2015, the intervener, Mr. Kurt Hesse, applied to revoke the effects of the international registration pursuant to Article 58(1)(a) of the 2017 EUTM Regulation, in respect of all the Class 12 goods, on the ground that the mark had not been put to genuine use within a continuous period of five years. The Cancellation Division granted the application for revocation for all goods covered by the designation, save for *automobiles* in Class 12.

Both Mr. Hesse and Ferrari appealed the Cancellation Division decision. In the contested decision, the Fifth Board of Appeal upheld the intervener's appeal and dismissed Ferrari's appeal, revoking protection for TESTAROSSA in the European Union for all Class 12 goods. Ferrari appealed the decision to the General Court.

The General Court annulled the Board of Appeal's decision. First, the Court addressed use for automobiles within the relevant period. It noted that it was common ground that no new TESTAROSSA cars were produced then and that secondhand cars were sold by third parties. The Court held that the Board erred in disregarding secondhand sales by authorized dealers. Use by dealers and distributors authorized by Ferrari, on usual sector terms, established implied consent and thus counted as use by the proprietor. The Court recalled that use by a third party with the proprietor's consent is deemed to be use by the proprietor under

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[59] Case T-1103/23 (GC, July 2, 2025).

Article 18(2) of the 2017 EUTM Regulation, and that exhaustion does not preclude the proprietor's own use for goods already placed on the market. The Court also found that Ferrari's authenticity-certification service was directly connected with those sales. Invoices for certificates, bearing TESTAROSSA alongside the FERRARI mark, showed use capable of indicating origin. The Court stressed that joint use with another mark did not negate that.

Second, the Court examined use for parts and accessories. Procedurally, the Board rejected evidence filed for the first time on appeal as inadmissible in Ferrari's appeal, yet examined the same material on the merits in the intervener's appeal, without reasoned use of its discretion under Article 95(2) of the 2017 EUTM Regulation and contrary to the duty to state reasons under Article 94(1) of the 2017 EUTM Regulation. Substantively, the Court found that the record showed use of TESTAROSSA by authorized dealers for genuine spare parts and accessories. The Board's view that the sign merely described compatibility did not address the evidence. The Court held that Ferrari had shown implied consent to the use of TESTAROSSA for parts and accessories by authorized dealers and that such use could indicate origin.

Third, the Court considered whether use for parts and accessories could support use for automobiles. It reiterated that use, by or with the consent of the proprietor, for replacement parts forming an integral part of the goods, may constitute genuine use not only for those parts but also for the goods themselves, unless the goods form an independent subcategory. The Court found that the Board did not perform the required subcategory analysis. The Board focused disproportionately on economic value and on a general assertion that car manufacturers do not produce all parts. In turn, the analysis should have focused on the purpose, intended use, and perception of the goods in the market. On that basis, the Court found that use for integral replacement parts may count toward use for automobiles. In the light of all the above, the Court annulled the Board's decision.

3. Spain—Provincial Court of Alicante (EUTM Tribunal)—When is an e-commerce website considered to target the EU market?

The Alicante Provincial Court[60] (acting as a European Union Trademark Tribunal), ruled on the appeal lodged by Japan Tobacco Inc. against the decision of Commercial Court No. 4 of Alicante,[61] which had dismissed its infringement action concerning the CAMEL

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60 Judgment 130/2025 of September 15, 2025 (Japan Tobacco INC v. Guangdong Camel Clothing Ltd. and Camel International Invest Enterprise Ltd.).

61 Judgment of July 31, 2024.

trademarks on the ground that the activity carried out by the defendants through the website camelstore.com was not directed at the European Union market.

The dispute arose between Japan Tobacco, proprietor of multiple European Union and Spanish trademarks for CAMEL, widely associated with the tobacco sector, and several Chinese companies operating an e-commerce business offering clothing, footwear, and accessories under word and figurative signs identical or nearly identical to CAMEL, including the characteristic camel silhouette. The court of first instance had dismissed the infringement claim, holding that the mere accessibility of the website from within the European Union was insufficient to establish use of the sign in the course of trade in the Union, and placing particular emphasis on factors such as the use of the English language, the ".com" top-level domain and the absence of express references to European consumers.

The Provincial Court overturned that conclusion in full and undertook a particularly detailed review of CJEU case law on trademark infringement via the Internet. Relying on the *AMS Neve*[62] and *Berky*[63] judgments, the Court recalled that, while mere accessibility of a website is not sufficient, the decisive criterion is whether the offers for sale are directed at consumers located within the territory in which the trademark is protected, a matter that must be assessed globally, including on the basis of a set of non-exhaustive indicia.

Applying that guidance to the facts of the case, the Court was satisfied that the activity carried out through camelstore.com was indeed directed at the European Union market. In reaching that conclusion, it attached particular weight to evidence of multiple actual sales to consumers located in different Member States, the website's terms and conditions expressly providing for shipment to twenty-three EU countries, the use of alternative platforms such as AliExpress to continue sales following the adoption of interim measures, and the dissemination of promotional discount codes through Spanish media. The Court expressly rejected the argument that the use of English or pricing in U.S. dollars could neutralize those factors, stressing the economic reality of cross-border e-commerce and the ease of language and currency conversion in online transactions.

Having established use of the sign in the course of trade within the European Union, the Court went on to assess the existence of trademark infringement. It recognized the undisputed reputation of

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62 Judgment of the CJEU of September 5, 2019 (Case C-172/18) (AMS Neve Ltd. & Others v. Heritage Audio S.L. and Pedro Rodríguez Arribas).

63 Judgment of the CJEU of April 27, 2023 (Case C-104/22) (Länsen MCE Oy v. Berky GmbH, Senwatec GmbH & Co. KG).

the CAMEL trademarks, notwithstanding the advertising restrictions applicable to tobacco products, and on that basis found both a likelihood of confusion and, independently, unfair advantage taken of the reputation of the earlier marks. The Court held that the identity or near-identity of the signs used for everyday consumer goods such as clothing and footwear gives rise to an immediate mental link with the reputed trademark, enabling the defendants to benefit from its power of attraction, prestige, and reputation without due cause. It reiterated that the stronger the reputation and distinctive character of the earlier mark, the easier it is to establish infringement, in line with settled CJEU case law.

The judgment extended those findings to the use of the domain name camelstore.com, which it characterized as a clear tool for attracting customers through the exploitation of a third-party reputed trademark. The Court therefore declared the domain name infringing and ordered its cessation, blocking, and cancellation. Regarding damages, it rejected compensation for actual loss and quantification based on a hypothetical royalty due to insufficient substantiation of the claim, but accepted compensation calculated under the subsidiary criterion of 1% of turnover, together with the imposition of daily penalty payments until the infringement effectively ceased.

From a practical point of view, the decision is particularly significant for its rigorous and commercially realistic application of territoriality criteria in the context of e-commerce, as well as for reinforcing the protection of reputed trademarks against parasitic uses in entirely unrelated sectors where there is systematic exploitation of the sign within the EU market. It also illustrates the active role played by the European Union Trademark Court in Alicante in adapting CJEU case law to disputes arising from global online commerce.

4. Greece—Athens Administrative Court of Appeals—Are pending invalidity proceedings a proper reason for non-use?

In its decision,[64] the Athens Administrative Court of Appeals ruled on appeal in a trademark revocation action concerning the Greek trademark BY UNI-PHARMA PEPSI SODA. The revocation action was filed by PepsiCo, Inc. on the ground of non-use.

These proceedings formed part of a series of disputes between the same parties. PepsiCo had previously filed an invalidity action against the contested trademark on the basis of harm on reputation of its PEPSI trademarks and bad faith in filing of the contested trademark. In those parallel invalidity proceedings, the Trademark

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64 No. 618/2025.

Office, the Administrative Court of First Instance, and the Administrative Court of Appeals dismissed the invalidity action. Prior to the issuance of Court of Appeals decision on the invalidity action, a revocation action for non-use was filed by PepsiCo.

At first instance, the Trademark Office upheld the revocation action, finding that the proprietor of the contested trademark had failed to prove genuine use of the sign within the relevant five-year period and had not established a reasonable cause for non-use.

This decision was later annulled on appeal by the Athens Administrative Court of First Instance. Before this Court the proprietor of the contested trademark argued that the pending invalidity proceedings constituted a legitimate reason justifying non-use, since the proprietor could not reasonably have invested in production or advertising of products under the mark while it was the subject of invalidity proceedings, and that, for as long as this legitimate reason existed, the five-year period for genuine use should be suspended. The Court held that the proprietor implicitly acknowledged the non-use of the contested trademark. The Court further considered that when (and for as long as) a mark is the subject of litigation/invalidity proceedings, this may constitute a legitimate reason justifying non-use. Consequently, taking into account the existence of judicial disputes between the parties concerning the same trademark, as well as the fact that the revocation action was filed prior to the judgment of the Court of Appeals, the Court of First Instance accepted that reasonable cause for non-use existed.

Upon appeal, the Athens Administrative Court of Appeals reversed the first-instance judgment. The Court held that pending disputes relating to a trademark do not, as such, constitute a proper reason for non-use. Referring to both national and EU trademark law, as well as relevant CJEU case law, it stressed that the concept of proper reason must be interpreted strictly and is limited to circumstances independent of the trademark proprietor's will that objectively prevent use of the mark, such as regulatory restrictions or import bans.

The Court further noted that the initiation of revocation or invalidity proceedings does not prevent the trademark proprietor from using the contested sign. In the present case, the Court found that the existence of parallel litigation between the parties, including proceedings concerning the validity of the same trademark, did not amount to an objective obstacle to use.

Lastly, the Court observed that the trademark proprietor failed to demonstrate any preparatory acts evidencing a serious intention to use the contested trademark after the conclusion of the relevant disputes. No evidence was produced showing steps taken toward the commercialization of products under the sign during or after the litigation period. On that basis, the Court concluded that no proper

reason for non-use had been established and that the conditions for revocation due to non-use were met. Accordingly, the revocation of the trademark was confirmed.

5. UK—High Court—Can the provider of a generative AI model be liable for trademark infringing output generated by those models?

In *Getty Images (US) Inc. & Ors. v. Stability AI Ltd.*,[65] the High Court considered (among a range of other issues) claims of trademark infringement arising from the use of generative AI. The case examined, in part, whether Stability AI Limited ("Stability") had infringed the registered trademarks of the Getty Images group of companies ("Getty Images") through its AI model, Stable Diffusion, generating images bearing watermarks identical or similar to Getty Images' well-known GETTY IMAGES and ISTOCK marks.

Background

Getty Images is a well-known global visual content creator and marketplace, licensing millions of photographs, video footage, and illustrations through its websites at gettyimages.com and istockphoto.com. Each visual asset displayed on these websites bears a distinctive watermark containing the GETTY IMAGES or ISTOCK marks, positioned within a gray translucent banner overlaid on the image. A legitimate licensee will then be provided with a version of the visual asset without the watermark. Getty Images estimated that over 12 million images bearing its watermarks were included in the datasets used to train Stable Diffusion.

The first claimant, Getty Images (US) Inc., is the registered proprietor of three UK registered trademarks: two for GETTY IMAGES and one for gettyimages (the "Getty Images Marks"). The fifth claimant, iStockphoto LP ("iStock"), is the registered proprietor of two UK registered trademarks for ISTOCK (the "ISTOCK Marks"). It was common ground that the marks were inherently distinctive and had acquired substantial reputation through extensive use since 1995 (GETTY IMAGES) and 2003 (ISTOCK).

Stability is an open-source generative AI company that developed Stable Diffusion, a deep learning diffusion model that transforms prompts (text or images) into synthesized images. The model was trained on large-scale datasets created by scraping images from the Internet, which Stability accepted including watermarked content from Getty Images' websites. Various versions of the model were released from August 2022, accessible

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[65] [2025] EWHC 2863 (Ch).

via download, commercial platforms (DreamStudio), or developer APIs.

Getty Images alleged that when users employed Stable Diffusion, the model could generate synthetic images bearing watermarks identical or similar to its registered trademarks (a consequence of the training data containing Getty Images' watermarked content).

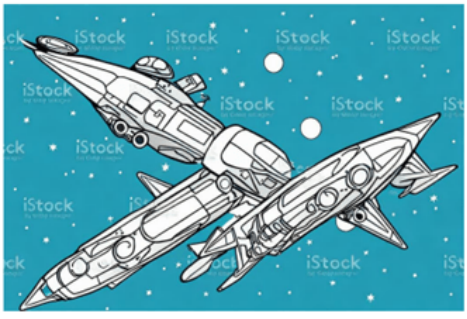
Responsibility for infringing "use"

Getty Images advanced trademark infringement claims under double identity, likelihood of confusion, and reputation-based grounds under Sections 10(1), 10(2), and 10(3) of the Trade Marks Act 1994 (the "TMA"), respectively. A key issue was whether it should be Stability or the end user deemed responsible for AI-generated outputs (and therefore whether Stability had "used" the signs at all). The Court held Stability responsible. Smith J concluded that Stability had active behavior and control over the images: in particular, Stability had trained the models, chosen which guardrails to install, and generated watermarks in the AI-generated outputs (something users actively wished to avoid).

A closely related second issue was whether or not the watermarks constituted trademark use affecting the functions of Getty Images' marks. Here, Smith J found that the origin function was engaged because the average consumer seeing a watermarked output would assume a commercial connection with Getty Images. This may include, for example, because the average consumer would assume the models were trained on licensed Getty Images content.

In its claim, Getty relied on various AI-generated images, some of which were produced "in the wild" and some of which were produced by its lawyers through experimentation. The Court declined to find infringement for signs produced in experiments only, given that there was no evidence that such signs would be produced in real life.

With respect to two AI-generated outputs (the "Spaceships Image," reproduced below, and the "Dreaming Image"), which were produced by real users and featured the iStock watermarks, the Court held that these outputs infringed the ISTOCK Marks. However, there was no evidence of the GETTY IMAGES marks being reproduced in identical form—one example contained an extra "i" (reading "imaiges"), which defeated an identity finding. The Court emphasized that where AI tools blur or distort marks in generated outputs, this may prevent a finding of identity under Section 10(1), but such outputs may nevertheless give rise to infringement under Section 10(2).



Regarding goods and services, the Court accepted that synthetic image outputs could be identical to the registered goods in Class 9 (digital media/images) and that their provision could be identical to the registered services in Class 41 (digital imaging services).

Likelihood of confusion

The Court conducted a global assessment of likelihood of confusion, taking into account the high distinctive character of the marks. Three categories of average consumer were identified, these being (i) technically skilled users downloading the model, (ii) developers accessing via API, and (iii) users of DreamStudio (who were less technologically sophisticated).

The Court found that where watermarks appeared clearly, a significant proportion of consumers would likely believe that there was a commercial connection between Getty and Stability (even for consumers that were technologically sophisticated, and understood why such watermarks arise). It was noted that platform branding and "garbled" watermarks (see image below) could reduce confusion, although it would not eliminate it.

Applying her assessment to the facts, Smith J found that certain AI-generated images (the Spaceships Image, the Dreaming Image and First Japanese Temple Garden Image) infringed the ISTOCK Marks and the Getty Images Marks under Section 10(2).

The Court also considered guidance on post-sale confusion from *Iconix v. Dream Pairs* [2025] UKSC 25,[66] namely regarding the "realistic and representative way in which the average consumer

[66] This judgment has also been included in this edition of *The Trademark Reporter*, at pages 466-469.

will encounter the sign." While Smith J acknowledged that users of Stable Diffusion will, on many occasions, share the images they generate with others, the specific facts here pointed away from this finding: users found the watermarks undesirable and actively sought their removal.

Reputation claims

Getty Images pleaded unfair advantage, detriment to distinctive character, and detriment to repute. The Court dismissed all three limbs. On unfair advantage, there was no evidence of any intention by Stability to exploit Getty's reputation, nor any indication that consumers sought images bearing watermarks. Regarding dilution, the hypothesis that users turned to Stable Diffusion to avoid license fees was rejected, and there was no proof of any change in economic behavior. In relation to tarnishment, while Stable Diffusion could generate inappropriate content, there was no real-world UK evidence of Getty-style watermarks appearing on such material, and the alleged reputational harm was considered speculative absent evidence of actual market impact.

Outcome

Smith J characterized the trademark findings as "both historic and extremely limited in scope" given infringement was found with respect to only three AI-generated images, but historic in light of the principles laid down in the case.

Nevertheless, important takeaways from the case include:

1. AI model providers *can* be responsible for AI-generated outputs;
2. Trademark use can arise, for example, where the average consumer attributes a commercial connection between the provider and the third party's marks; and
3. Post-sale confusion may have an important role to play in future cases—for example, where AI-generated content featuring a third party's trademarks goes viral on social media.

6. Switzerland—Swiss Federal Administrative Court—Does advertising goods as being available on an international website count as genuine use in Switzerland?

In the CANNA (fig.) / CANNAVITAS case,[67] the Swiss Federal Administrative Court ("FAC") was asked to determine whether the

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[67] B-5828/2023.

international trademark Registration No. 687207  had been used in Switzerland in a manner sufficient to maintain protection and thereby serve as a valid basis for opposing the Swiss word mark No. 715825 CANNAVITAS. The opponent, holder of the CANNA (fig.) trademark, registered for fertilizers, opposed the registration of CANNAVITAS for plant protection products, fertilizers, and agricultural goods. The respondent invoked the non-use defense, arguing that the earlier mark had not been genuinely used in Switzerland during the relevant five-year period from March 2014 to March 2019. The Swiss Federal Institute of Intellectual Property rejected the opposition, finding that the opponent had failed to demonstrate genuine use, whereupon the opponent lodged an appeal with the FAC.

On appeal, the appellant submitted a wide range of evidence, including invoices, website screenshots, magazines, an affidavit, and alleged license agreements. The Court carefully examined each category of evidence. It found the affidavit unreliable, as the signatory was not clearly identifiable and the annexes incomplete. Screenshots and Wayback Machine extracts of websites did not prove actual use in Switzerland, since no data on access or sales was provided. Invoices from an affiliated company of the opponent were addressed to Swiss entities but were either not authentic or showed the mark only as a company identifier rather than as a trademark. Magazines bearing the trademark did not demonstrate distribution in Switzerland. Finally, the license agreements were undated and contained inconsistencies, such as listing trademarks not yet registered, which rendered them unconvincing.

A particularly important aspect of the Court's reasoning concerned the requirements of Article 11 of the Swiss Trademark Protection Act ("TmPA") and the principle of territoriality. In its judgment, the Court emphasized that mere advertising or offering of products via the Internet does not in itself constitute genuine use in Switzerland. Even if a website is accessible in Switzerland or written in a Swiss national language, this is insufficient. A concrete link to the Swiss market is required: the products must be regularly and specifically advertised under the mark for Swiss consumers or ordered from within Switzerland. The Court emphasized that an Internet presence constitutes relevant use only if it is capable of generating serious demand in Switzerland. This clarification is significant, as it sets a high threshold for proving trademark use through online activity. It is insufficient to show that a website exists or that it displays the trademark; there must be evidence of targeted marketing or actual transactions involving Switzerland.

Applying these principles, the FAC concluded that the complainant had not demonstrated genuine use of CANNA (fig.) in Switzerland during the relevant period. As a result, the appeal was dismissed to the extent it was admissible, and the opposition against

CANNAVITAS failed, allowing the contested mark to remain on the register.

7. Norway—Borgarting Court of Appeal—What evidence is required to show a slogan has acquired distinctiveness as a trademark?

On March 19, 2025, the Borgarting Court of Appeal considered[68] the registrability of the slogan FUCK CANCER as a trademark. The parties to the case were the Norwegian Cancer Society ("Kreftforeningen") and the organization Young Cancer ("Ung Kreft") (together "the appellants") and the Board of Appeal for Industrial Property Rights (in Norwegian, abbreviated as "KFIR"). The main issue for the Court to assess was whether the mark FUCK CANCER was eligible for registration on the basis of either inherent distinctiveness or distinctiveness acquired through use.[69]

Kreftforeningen is a nationwide, non-profit organization active in the cancer field, as is Ung Kreft, which specifically focuses on young people affected by cancer and their families. The appellants collaborated on the "Fuck Cancer" concept by organizing workshops in which participants created beaded bracelets (shown below) featuring the slogan, which were then sold to raise funds for the fight against cancer.[70]

The appellants filed trademark applications for the mark as a word mark in several classes, and registration was denied for the following: Class 14: jewelry (bracelets); Class 36: charitable fundraising; and Class 41: workshops for cultural purposes, specifically beading bracelets. The proceedings before Borgarting Court of Appeal were limited to an assessment of whether the conditions for registration were met for these classes.

The Court of Appeal first considered whether the mark, at the time of application, was distinctive enough to act as a trademark for the goods and services in question. The Court emphasized that a trademark must be capable of identifying the commercial origin of

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68 Case LB-2024-155800 (Borgarting Court of Appeal, March 19, 2025).

69 Chapter 2, Article 14 of the Norwegian Trademark Act (2010-03-26-8).

70 Image retrieved from the Norwegian Cancer Society's website: https://nettbutikk.kreftforeningen.no/butikk/fuck-cancer/armband-fuck-cancer/.

a product or service, distinguishing it from those of others. For slogans such as "FUCK CANCER," the threshold for inherent distinctiveness is higher, as such expressions are by their nature not generally perceived as an indication of commercial origin.

The Court analyzed the mark linguistically and found that the expression consisted of common English words. The expression is interpreted as a rallying cry against cancer and expressing solidarity with those affected by the disease. Although the use of a swear word can make a mark eye-catching, the Court found that this effect was diminished by the context in which the swear word was used. Furthermore, there were no semantic or syntactic features in the word mark, such as puns, contradictions, grammatical errors, or other surprising elements. The expression did not appear particularly original or distinctive.

The Court therefore found that the mark lacked inherent distinctiveness and was not suitable as an identifier of commercial origin. In comparison, the Court referred to case law from the General Court, notably the judgment where the court found that the expression "RUSSIAN WARSHIP, GO FXXK YOURSELF" would be perceived by the average consumer as a political message and could not be registered as a trademark,[71] supporting the Court's conclusion that such expressions lack distinctiveness.

The Court also emphasized the need for free availability of descriptive terms, and that no single party should have exclusive rights to such a general slogan, as multiple parties may have a legitimate interest in using it in the fight against cancer. In this regard, it was observed that other entities were also selling bracelets bearing the words "fuck cancer." The Court therefore concluded that FUCK CANCER lacked inherent distinctiveness for all relevant goods and services at the time of application.

As for the question of acquired distinctiveness, the Court considered whether the relevant public had learned to associate FUCK CANCER with a specific commercial origin, namely the appellants. The Court clarified that, for a mark to acquire distinctiveness through use, a significant proportion of the target audience must have developed this association, and the assessment must relate exclusively to use before the application date. The Court pointed out that use of the slogan in Norway first began with an individual who produced and sold bracelets to support the fight against cancer. Hence, historically—at least initially—the slogan was used as a general catchline for the cancer cause, not to identify a particular commercial provider.

Even though the appellants had sold between 150,000 and 160,000 bracelets across Norway and received significant media coverage, the Court held that this was insufficient. Media coverage

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[71] Case T-82/24 (GC, November 13, 2024).

indicated that the expression was used broadly and often independently of the organizations, and for most people it functioned as a general slogan for the cancer cause, not as a trademark of a specific entity.

Furthermore, no market analysis documenting that the relevant public associated the mark with the applicants had been presented, and the use of the mark had not been consistent or long-lasting enough to have changed public perception. For comparison, the Court referred to an earlier decision from the Norwegian Supreme Court where the marketing activities in question were much more intensive and the acquired distinctiveness much clearer, and where the Supreme Court "with some doubt" found that distinctiveness had been achieved through use.[72] The Court of Appeal therefore found no basis to conclude that FUCK CANCER had acquired distinctiveness through use at the time of application and upheld KFIR's decision.

8. Switzerland—Swiss Federal Administrative Court—Which matters can the Swiss Federal Institute of Intellectual Property consider in a simplified cancellation procedure for non-use?

In the *ROMPIDEE* case,[73] the Swiss Federal Administrative Court ("FAC") examined the scope of the simplified cancellation procedure under Articles 35a and 35b of the Swiss Trademark Protection Act ("TmPA"), focusing on whether arguments beyond mere non-use can be considered. The revocation provision allows any person to request cancellation of a trademark that has not been used for five consecutive years, reflecting the public interest in maintaining an accurate and reliable register.

The dispute concerned the Swiss trademark ROMPIDEE (No. 658'600), which was registered in 2014 for alcoholic beverages (Class 33) and is owned by Chiodi Ascona SA. In 2022, Giovanni and Giorgio Caverzasio filed a request to revoke the mark. They argued that it had not been in genuine use in recent years and that its registration was abusive. According to them, they were the original creators and promoters of the wine marketed under the name ROMPIDEE, and Chiodi Ascona SA had wrongfully registered the trademark in its own name. The Swiss Federal Institute of Intellectual Property ("IPI") in first instance rejected the request for cancellation, finding that non-use had not been established. The applicants appealed to the FAC, reiterating claims of unlawful appropriation and their long-standing collaboration with the respondent.

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72 Case Rt-2002-391 (Norwegian Supreme Court, April 11, 2002).

73 B-2126/2023.

Chiodi Ascona SA countered that the mark had consistently been used in commerce and that the wine continued to be produced and sold under the ROMPIDEE label. It argued that the applicants' further allegations regarding the abusiveness of the registration were irrelevant to the limited scope of a non-use cancellation procedure. The IPI likewise defended its decision, emphasizing that questions of ownership or abusive filing must be pursued in civil nullity proceedings, not in administrative proceedings.

The FAC confirmed that the simplified cancellation mechanism is of a summary nature and is limited to examining whether a trademark has been used in accordance with Article 11 TmPA or whether valid reasons justify its non-use. Broader issues such as allegations of filings in bad faith, disputes over entitlement or ownership, or claims of unfair competition do not fall within the scope of the simplified cancellation procedure. The Court emphasized that, although the applicants had referred to their decades-long business relationship with the respondent, such historical circumstances are irrelevant in this context. The sole question to be determined is whether the contested trademark was genuinely used during the relevant five-year period, or whether compelling reasons justified its non-use.

On the central issue, the Court agreed with the IPI that the applicants had failed to provide credible evidence of non-use. In fact, the applicants' own documents pointed to continued use of the trademark, at least until 2020. They included evidence of vinification and marketing activities carried out under the ROMPIDEE trademark, as well as correspondence regarding a potential transfer of the mark. All in all, these indications supported the conclusion that the mark had remained in genuine use during the relevant period.

The FAC therefore dismissed the appeal. It held that the applicants had not established non-use and that their submissions concerning abusive filing and historical collaboration were outside the scope of the simplified procedure. The mark ROMPIDEE remains registered.

VI. TRADEMARK INFRINGEMENT

A. Introductory Comments

This Part VI considers cases on infringement of the exclusive rights conferred on trademark proprietors by the EUTM Regulation and the TM Directive (and equivalent rights for non-EU territories).

The exclusive use rights of a trademark proprietor relating to EUTMs are found in Article 9 of the 2017 EUTM Regulation. The parallel rights conferred by a trademark in relation to the national trademark authorities of EU Member States are set out in Article 10 of the 2015 TM Directive. As always, readers should note in

particular that the rights of a trademark proprietor to sue for infringement of EUTM or national marks in the EU are broadly harmonized, whereas the rights, remedies, and entitlement of a successful litigant are only *partially* harmonized by the IP Enforcement Directive (Directive 2004/48/EC), leaving considerable scope for divergence, forum shopping, or even inconsistent results across the EU.

This year offers an unusually rich selection of trademark infringement cases. Questions of acquiescence and modified use arose in the Netherlands, where in *Lucovitaal v. Leef Vitaal* the Dutch Supreme Court held that where a proprietor has tolerated use for five years, it cannot subsequently oppose modified packaging so long as the underlying mark remains unchanged. The Danish Eastern High Court found infringement where an unauthorized distributor sold expired and mixed products under BECKERS branding, holding that such conduct exceeded the limits of exhaustion and gave rise to personal liability. Across the Benelux, national courts examined the interplay between confusion and reputation-based claims: the Dutch Supreme Court confirmed that the absence of a "link" for dilution purposes does not preclude a separate finding of confusion, while the Brussels Court of Appeal dismissed confusion claims between figurative marks for food products, finding low visual similarity and no proven reputation. In Poland, the Supreme Court clarified the boundaries of trademark use, holding that including a word element in a regulatory permit application, without market-facing deployment, does not constitute infringing use. The extended protection afforded to marks with a reputation was considered by the Brussels Business Court, which granted an EU-wide injunction against PINK LADY-branded electronic cigarettes, finding that use on dissimilar goods took unfair advantage of the fruit mark's healthy, natural image. In the UK, the *Iconix v. Dream Pairs* (UMBRO) decision saw the Supreme Court confirm that post-sale confusion outside a transactional context can establish infringement, while cautioning against appellate re-balancing of multi-factorial assessments in the absence of a clear error at first instance. Finally, also in the UK, the landmark Court of Appeal judgment in *Thatchers v. Aldi* held that look-alike cider packaging with a deliberate imitation to convey a "like brands, only cheaper" message constituted unfair advantage and free riding.

B. Legal Texts

Article 9 of the 2017 EUTM Regulation

1. The registration of an EU trade mark shall confer on the proprietor exclusive rights therein.

2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:
   (a) the sign is identical with the EU trade mark and is used in relation to goods or services which are identical with those for which the EU trade mark is registered;
   (b) the sign is identical with, or similar to, the EU trade mark and is used in relation to goods or services which are identical with, or similar to the goods or services for which the EU trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
   (c) the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark.
3. The following, inter alia, may be prohibited under paragraph 2:
   (a) affixing the sign to the goods or to the packaging thereof;
   (b) offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;
   (c) importing or exporting the goods under that sign;
   (d) using the sign as a trade or company name or part of a trade or company name;
   (e) using the sign on business papers and in advertising;
   (f) using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC.
4. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall also be entitled to prevent all third parties from bringing goods,

in the course of trade, into the Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical with the EU trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

The entitlement of the proprietor of an EU trade mark pursuant to the first sub-paragraph shall lapse if, during the proceedings to determine whether the EU trade mark has been infringed, initiated in accordance with EU Regulation No 608/2013, evidence is provided by the declarant or the holder of the goods that the proprietor of the EU trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

Article 125(2) of the 2017 EUTM Regulation

1. If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in which he has an establishment.

Article 10 of the 2015 TM Directive

1. The registration of a trade mark shall confer on the proprietor exclusive rights therein.
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:
   (a) the sign is identical with the trademark and is used in relation to goods or services which are identical with those for which the trade mark is registered;
   (b) the sign is identical with, or similar to, the trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the trademark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;

(c) the sign is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to, those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

3. The following, in particular, may be prohibited under paragraph 2:
   (a) affixing the sign to the goods or to the packaging thereof;
   (b) offering the goods or putting them on the market, or stocking them for those purposes, under the sign, or offering or supplying services thereunder;
   (c) importing or exporting the goods under the sign;
   (d) using the sign as a trade or company name or part of a trade or company name;
   (e) using the sign on business papers and in advertising;
   (f) using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC.
4. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into the Member State where the trade mark is registered, without being released for free circulation there, where such goods, including the packaging thereof, come from third countries and bear without authorization a trade mark which is identical with the trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

The entitlement of the trade mark proprietor pursuant to the first subparagraph shall lapse if, during the proceedings to determine whether the registered trade mark has been infringed, initiated in accordance with Regulation (EU) No 608/2013, evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

5. Where, under the law of a Member State, the use of a sign under the conditions referred to in paragraph 2 (b) or (c) could not be prohibited before the date of entry into force

of the provisions necessary to comply with Directive 89/104/EEC in the Member State concerned, the rights conferred by the trade mark may not be relied on to prevent the continued use of the sign.

6. Paragraphs 1, 2, 3 and 5 shall not affect provisions in any Member State relating to the protection against the use of a sign other than use for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

C. Cases

1. The Netherlands—Dutch Supreme Court—Can a trademark owner oppose the use of a mark where it has acquiesced to its initial use in a different form?

In *Lucovitaal/Leef Vitaal*,[74] the Dutch Supreme Court (*Hoge Raad*) rendered a decision addressing the issue of trademark-related acquiescence (*rechtsverwerking*). The Court held that where a trademark owner has failed to take action against the use of a younger trademark for a period of five successive years, thereby barring further legal action, it cannot subsequently enforce its rights against the use of that same trademark even if there have been changes in the manner of its use.

The case revolves around an infringement action brought by PK, the owner of the older LUCOVITAAL trademarks for food supplements, against the Vemedia, alleging a risk of confusion due to Vemedia's use of the LEEF VITAAL trademarks for identical goods. In 2009, the trademark owner sent a cease-and-desist letter objecting to the defendant's use of LEEF VITAAL on the bottom of its packaging (the "2009 Packaging") but did not pursue further legal action after the defendant denied all claims. The defendant continued its use and later redesigned its packaging in 2019, among others prominently displaying the LEEF VITAAL trademark at the top (the "2019 Packaging"). The 2019 Packaging was argued to be closer in appearance to the trademark owner's own products.

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[74] Dutch Supreme Court, October 10, 2025, ECLI:NL:HR:2025:1549, *NJ* 2025/332, Lucovitaal v. Leef Vitaal.

Trademark owner's use

2009 Packaging

2019 Packaging

The central issue before the Dutch courts was whether PK could oppose the modified 2019 Packaging given its failure to act against the 2009 Packaging for more than five years before bringing proceedings. As per the principle of acquiescence in the Benelux Convention on Intellectual Property (implementing Article 9 of the 2015 TM Directive), a trademark owner loses the right to enforce its trademark against a younger trademark if it does not take action for a continuous period of five years. PK argued that acquiescence should not apply as the 2019 Packaging significantly differed from the earlier 2009 Packaging, such that the new, specific use had not been tolerated.

The Court of Appeal[75] dismissed all claims, ruling that the defendant had forfeited its rights to object, noting that modified use does not prevent acquiescence continuing to apply, and in any event, there was no substantial change to the use by the defendant as any similarity merely resulted from non-distinctive elements.

Before the Supreme Court, the trademark owner argued that it is not objecting to the younger LEEF VITAAL trademark but to the 2019 Packaging sign (which is a new composite mark, of which the LEEF VITAAL trademark is a part). It claimed that the new packaging sign was not registered as a trademark as such and the use of that (as a registered) trademark has not been tolerated for more than five years within the context of the principle of acquiescence. The Supreme Court rejected this argument and upheld the appeal decision. The Supreme Court held that Court of Appeal correctly did not consider the new packaging sign *as a whole* to be trademark relevant, or as a composite mark, but rather as the use of the LEEF VITAAL trademark in a certain context, specifically in combination with other elements deemed non-distinctive and thus not legally relevant under trademark law.

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75 The Hague Court of Appeal, September 19, 2023, ECLI:NL:GHDHA:2023:2673, *IER* 2024/4, Lucovitaal v. Leef Vitaal.

2. Denmark—The Danish Eastern High Court—Does labelling of products amount to trademark infringement?

On October 3, 2025, the Danish Eastern High Court ("EHC") delivered judgment in a dispute between PPG Coatings Danmark A/S ("PPG") and person A and corporate entity B (in bankruptcy) concerning alleged trademark infringement through exploitative marketing and alteration of trademarked products.[76]

The case was an appeal by A and B from a June 3, 2024, judgment of the Danish Maritime and Commercial Court ("MCC"). B entered bankruptcy in January 2025, and the estate chose not to participate in the defense.

Facts of the matter

PPG is the Danish subsidiary of PPG Industries Inc., a multinational paint and coatings manufacturer. Its products are sold through PPG outlets and authorized dealers. PPG owns various trademarks, including EUTM Registration No. 007279417 BECKERS (word), EUTM No. 010374122 BECKERS (figurative), and EUTM No. 018004694 BECKERS PERFEKT (all registered in Class 2).

B, founded on February 10, 2023, marketed and sold paint and related goods from six shops and an online shop acquired from the estate of C, which went bankrupt on February 24, 2023, under A's ownership. PPG had supplied BECKERS-branded products to C and its stores until 2023 under an authorized dealership agreement, which was terminated upon C's bankruptcy.

After C's winding-up began, PPG moved to retrieve its tinting computers, which contained PPG's recipe database and labels referencing PPG trademarks. PPG discovered B had obtained access to PPG's user interface, recipes, and labels from C, and continued to market itself as an authorized BECKERS seller. B used PPG's trademarks on marketing materials, storefronts, signs, websites, and on labels printed for toned coatings sold to customers. PPG also identified sales of BECKERS products after the expiry date and sales of mixtures combining PPG and competitor's products in BECKERS-branded cans. B applied labels from both companies to indicate this.

Personal liability for infringements

The EHC agreed with the MCC that A was instrumental in the infringements and incurred personal liability. He initiated the conduct and bore significant responsibility for its continuation by B.

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[76] Case No. BS-31311/2024-OLR.

Trademark infringement

The EHC also agreed—consistent with the MCC's judgment—that B and A's conduct amounted to trademark infringement. The intensity of B's marketing and presentation, including storefront signage, in-store screens, labels, and web content exploiting PPG's marks, created the impression of authorized dealership beyond the limits of exhaustion under Article 15(1)-(2) of the 2017 EUTM Regulation and Section 10a(1)-(2) of the Danish Trademark Act.[77]

The EHC further held that selling BECKERS-branded products up to eighteen months past the expiry date and mixing coating contents (toner and base) from PPG and a competitor of PPG in BECKERS-branded cans infringed PPG's rights. The EHC found that an average consumer could mistake these for "pure" BECKERS products (precisely) matched to PPG's color recipes. Consequently, the EHC found that PPG had reasonable grounds to oppose continued marketing under Article 15(2) of the 2017 EUTM Regulation and Section 10a(2) of the Danish Trademark Act, and that the conduct violated Section 22 of the Danish Marketing Practices Act, cf. Section 3(2).[78]

Finally, the EHC confirmed the MCC's reasoning on PPG's database rights under the Danish Copyright Act and on PPG's trade secrets in its formulae. The continued use evidenced by the interface/labels and test purchases constituted unlawful acquisition, disclosure, and use of trade secrets under the Danish Trade Secrets Act and a breach for making promotional statements without adequate documentation under the Danish Marketing Practices Act. A and B were ordered to pay damages and compensation. A was jointly liable with B to pay DKK 750,000 (c. EUR 100,000) to PPG, and B was ordered to pay DKK 1,500,000, plus costs.

3. The Netherlands—Dutch Supreme Court—Can a risk of confusion still exist if the similarity between the signs is deemed too low to establish a "link"?

In *Puma/Monshoe*,[79] the Dutch Supreme Court (*Hoge Raad*) rendered a decision addressing the relationship between the infringement under a risk of confusion and where the use of a sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark. The case

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77 Equivalent to the EU Trademark Regulation Article 15(1) and (2).

78 The Provisions of the Danish Marketing Practices Act relates to unauthorized use of other traders' business identifiers and actions in contravention with good marketing practices.

79 Dutch Supreme Court, November 7, 2025, ECLI:NL:HR:2025:1654, NJ 2026/3, Puma v. Monshoe.

particularly deals with the necessary degree of similarity required under both grounds.

Puma

Monshoe

Puma initiated a trademark infringement action based on its reputed "formstrip" trademarks against Monshoe due to the latter's use of a similar stripe on footwear. Puma based its claims on both a risk of confusion (Article 9(2)(b) of the 2017 EUTM Regulation and equivalent in the Benelux Convention on Intellectual Property for national marks) as well as unfair advantage of, and detriment to, the distinctive character or the repute of the trademark (Article 9(2)(c) 2017 EUTM Regulation and corresponding article in the Benelux Convention on Intellectual Property).

The court of first instance had initially found trademark infringement in favor of Puma, but that decision was subsequently overturned by the Court of Appeal in The Hague.[80] The Court of Appeal first assessed the infringement under Article 9(2)(c) EUTMR. It held that the signs were similar but that the degree of visual similarity of the signs was not sufficient to establish a "link" between the Monshoe's stripes and Puma's older trademarks, as required for trademark infringement under this ground. Subsequently, it ruled that this judgment relating to the low degree of similarity also implied that there was no risk of confusion under Article 9(2)(b) of the 2017 EUTM Regulation.

Before the Supreme Court, Puma argued that the Court of Appeal's judgment erroneously concluded that the absence of a "link" between the signs implied no risk of confusion. Puma asserted that a minimal degree of similarity could still lead to confusion due to other relevant factors. The Supreme Court clarified that as soon as a certain, even minimal, degree of similarity is established between the allegedly infringing sign and the invoked trademark, it must be assessed whether there is a risk of confusion. Even with a minimal degree of similarity, there can still be a risk of confusion due to the presence of other relevant factors, such as the general recognition or reputation of the invoked trademark.

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[80] The Hague Court of Appeal, June 9, 2024, ECLI:NL:GHDHA:2024:569, Puma v. Monshoe.

The Supreme Court concluded that the Court of Appeal had not overlooked this point and thus upheld the appeal decision. In particular, the appeal decision implicitly considered that other relevant factors besides the degree of similarity could not lead to a different conclusion in this case. This judgment is consistent with the case law of the Court of Justice of the European Union. This case law indicates that, for establishing a risk of confusion, a stronger degree of similarity between the trademark and the sign is required than is necessary for an infringement for dilution and/or unfair advantage where the connection may be fleeting and shallow and only a "calling to mind." In the latter test, it is sufficient that the public sees a connection between the sign and the trademark, simply because the observation of the sign evokes the memory of the earlier trademark, even if they are not confused with one other.

4. Poland—Does using PROSECCO in relation to cosmetics infringe the protected designation of origin despite dissimilarity of goods?

In case *XXII GW 744/24 PROSECCO*,[81] the Regional Court in Warsaw (Intellectual Property Division) considered an action brought by the Consorzio di Tutela della DOC Prosecco against a Polish distributor of cosmetics over the use of the word PROSECCO on product names and labels and in marketing for body-care and fragrance lines. The claimant relied on the Act on Combating Unfair Competition and Regulation (EU) 2024/1143 governing protection of geographical indications for wine, and adduced marketplace materials showing the defendant using terms, such as "Pink Prosecco," "Sparkling Prosecco," and "Bubbly Prosecco," together with social media posts featuring glasses of sparkling wine, "toast" motifs and #prosecco hashtags. The defendant argued that the term "prosecco" was used only as a fanciful descriptor of fragrance notes, that cosmetics are far removed from wine, and that widespread third-party usage had been tolerated.

The Court began by addressing standing and the applicable legal framework. It held that the Consorzio qualified as an "entrepreneur" within the meaning of Article 2 of the Act on Combating Unfair Competition, based on its professional activities connected with licensing, promotion and enforcement of the PDO, and that Polish law provided the cause of action to enforce the EU-level right. It then set out Article 26(1) of Regulation 2024/1143, which protects registered geographical indications against direct or indirect commercial use for any product where such use exploits or diminishes the PDO's reputation, against any misuse, imitation, or evocation, and against false or misleading indications concerning

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[81] Case XXII GW 744/24 (Regional Court, Warsaw, June 11, 2025).

origin or essential characteristics, including in advertising and online interfaces. The Court underlined that this protection does not depend on similarity or comparability of goods, and that national proceedings must give full effect to the Regulation's uniform and comprehensive safeguards.

Turning to reputation and evocation, the Court found that PROSECCO enjoys a high level of recognition in the European Union and in Poland, and that this renown character is inherently linked to the quality and image of the wine covered by the PDO. The Court then held that the repeated appearance of the term PROSECCO in product names and descriptions, coupled with imagery of sparkling wine and "toast" references in promotional content, created a sufficiently direct and unambiguous mental link with the PDO. Recalling *Glen Buchenbach*[82] and applying the Court of Justice's evocation test, the Court considered that a consumer confronted with these indications would immediately call to mind Prosecco wine, regardless of the fact that the products were cosmetics. The suggestion that "Prosecco" served merely as a fanciful olfactory cue was rejected as incompatible with the deliberate marketing choices designed to capitalize on the PDO's prestige.

The Court further held that the uses at issue also fell within the prohibitions on exploitation of reputation and on misleading indications. By transferring the attractiveness and recognition of the PROSECCO name to non-wine products, the defendant sought to derive undue benefit from the PDO's image. In addition, placing PROSECCO on labels and advertising for goods that do not contain Prosecco wine or share its essential characteristics risked misleading consumers as to the nature or qualities of the products. The argument that widespread third-party uses evidenced tolerance was dismissed; occasional inaction by a rights holder in the face of multiple infringements does not establish acquiescence, particularly where the rights holder demonstrates ongoing enforcement activity.

Having applied the Regulation's standards, the Court also considered the Polish unfair competition claims and found the conduct to be contrary to law and good practice because it exploited the PDO's reputation and threatened the claimant's protected interests. In consequence, the Regional Court in Warsaw prohibited the defendant from using the indication PROSECCO for cosmetics and fragrance products and in related advertising and marketing, including online, and ordered the destruction of packaging, labels, and promotional materials bearing the indication.

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[82] Case C-44/17 (CJEU, June 7, 2018) (Scotch Whisky Association v. Michael Klotz, "Glen Buchenbach" Whiskey).

5. Belgium—Brussels Court of Appeal—Did a rebrand of a corporate visual identity create a likelihood of confusion with another brand in an adjacent field?

Materne, primarily active in the jam and fruit compote sector, owns the following Benelux figurative trademark, filed in 2013 for goods in Classes 29, 30, and 32:

In 2016, Nutricia adopted a new visual identity and a new presentation for its Olvarit baby food products:

Materne considered that this new sign and related communication materials were likely to create confusion among consumers. It brought proceedings before the Brussels Business Court, seeking a finding that Nutricia's use of the contested OLVARIT sign created a likelihood of confusion with Materne's Benelux trademark and/or infringed its reputed trademark (Article 2.20(2)(b) and (c) of the Benelux Convention on Intellectual Property). Dissatisfied with the first-instance judgment, Materne lodged an appeal.

Regarding the likelihood of confusion, the Brussels Court of Appeal[83] found that the MATERNE and OLVARIT signs share only:

- a low degree of visual similarity: both signs consist of a green shape (a kidney-shaped form for MATERNE vs. a heart

[83] Brussels Business Court, June 26, 2025, Ing.-Cons., 2025/2, p. 415-438.

shape for OLVARIT) containing white lettering with the same number of letters;

- no phonetic similarity; and
- a very weak conceptual similarity: while the color green may evoke nature and healthy food products in both cases, it is only weakly distinctive, as it is common in the food sector.

Moreover, the figurative element of Materne's trademark only remotely resembles a symbolic representation of a heart.

The products are only partially similar, as OLVARIT baby food is comparable to Materne's goods solely with respect to compotes. The relevant public consists of average consumer in general, although consumers of OLVARIT products display a slightly higher level of attention given the child-oriented nature of those goods.

Materne also failed to demonstrate that its Benelux trademark enjoys a reputation, or that the figurative element—whether taken alone or combined with the word "MATERNE"—possesses strong distinctiveness, even though the word "MATERNE" on its own has a high degree of distinctiveness.

Accordingly, the Brussels Court of Appeal confirmed that no likelihood of confusion had been established, as correctly held by the first-instance judge. In the absence of any proven reputation, Materne's claim based on Article 2.20(2)(c) of the Benelux Convention on Intellectual Property, was also rejected. The appeal was therefore dismissed.

6. Poland—Does including a sign in a regulatory permit application amount to trademark use?

In case II CSKP 2109/22,[84] the Supreme Court considered an appeal from a judgment of the Court of Appeal in Łódź (I AGa 161/20) concerning alleged infringement of a figurative mark for fertilizers. The claim had been brought by the earlier mark owners against a competitor that, before any market launch, submitted an application to the Minister of Agriculture and Rural Development to obtain a permit for a fertilizer designated by the word element of the claimant's mark.

The first-instance court found infringement despite the absence of sales, packaging, or advertising, reasoning that a final permit created a real and immediate risk of confusion. The Court of Appeal largely endorsed that approach, treating the use of the word element in administrative documents as sufficient and adding that the defendant's conduct amounted to an unfair competitive act.

The defendant brought an appeal to the Supreme Court. The Supreme Court first restated that infringement presupposes use of a sign in the course of trade for the purpose of distinguishing goods

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[84] Case II CSKP 2109/22 (Supreme Court, January 30, 2025).

or services, in a manner that impairs or threatens the origin function of the earlier mark. The Court underscored that it is not enough that the public might associate two signs; there must be a real risk that consumers would be misled about commercial origin. Therefore, the Court stated, not every appearance of a protected expression constitutes infringing "use"—the use must serve, or be able to serve, as a badge of origin in the marketplace.

Applying those principles, the Court held that the lower courts' finding of infringement was based on an incomplete and legally flawed assessment. First, the registered sign was a figurative mark with distinctive graphic features that the courts themselves had identified as dominant, whereas the conduct at issue consisted solely of inserting the word element into materials filed in an administrative authorization procedure. More importantly, there was no finding that the defendant had used the protected sign in the market, on packaging, in advertising, or otherwise in communication with consumers, nor that the use in the permit application functioned as an indication of origin. Treating a non-public, pre-launch filing as infringing "use" stretched the concept beyond its function-based limits and bypassed the necessary, global assessment of confusion.

In consequence, the Supreme Court overturned the judgment of the Court of Appeal and remitted the case for reconsideration. The Court clarified that inserting a word element of a registered word-device mark into a permit application, without any market-facing deployment and without the sign functioning as an indicator of origin, does not in itself amount to trademark use or establish infringement.

7. UK—Supreme Court—Can post-sale confusion outside a transactional context ground infringement, and may similarity be assessed by reference to realistic post-sale viewing angles?

In *Iconix Luxembourg Holdings SARL v. Dream Pairs Europe Inc & Anor.*,[85] the Supreme Court considered whether, under Section 10(2)(b) of the Trade Marks Act 1994 ("TMA 1994"), (i) a court may assess similarity by reference to realistic post-sale viewing angles, and (ii) whether post-sale confusion arising outside any transactional context can amount to actionable infringement.

Background

The Claimant ("Iconix") was the registered proprietor of various trademarks that are part of the well-known UMBRO brand. These

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[85] Iconix Luxembourg Holdings SARL v. Dream Pairs Europe Inc. and another, [2025] UKSC 25.

included a series of devices depicting a monochrome flattened double-diamond (the "668 Mark" (below left and middle) and the "459 Mark" (below right)). Iconix focused its appeal on the (below left) version of the 668 Mark.

Iconix sued Dream Pairs Europe Inc. and Top Glory Trading Group Inc. (together "Dream Pairs") for infringement arising from use of a figurative logo on footwear (the "DP Sign," depicted below). Since late 2018, Dream Pairs had sold a variety of footwear bearing the DP Sign in the UK, primarily via Amazon and, to a lesser extent, eBay.

In July 2021, Iconix brought a trademark infringement action against Dream Pairs relying on the 668 Mark and the 459 Mark. At first instance, Mr. Justice Miles dismissed infringement based on likelihood of confusion, finding "at most a very low degree of similarity" and no likelihood of confusion (under Section 10(2)(b) TMA 1994). He also dismissed the claim based on reputation grounds (under Section 10(3) TMA 1994), finding there had been no unfair advantage of, or detrimental character to, the distinctive character or repute of the marks. The Court of Appeal allowed Iconix's appeal on Section 10(2)(b), concluding:

1. There was a moderately high level of similarity between the marks; and
2. A likelihood of confusion existed.

In so finding, the Court of Appeal: (i) emphasized that the first-instance decision was incorrect in light of the post-sale observation of the footwear "from above" (i.e., the observation by Dream Pairs that post-sale, consumers would view the DP Signs from above, when looking at another person's footwear); and (ii) held that Mr. Justice Miles had erred in principle by predominantly comparing side-by-side graphic images of the marks, rather than comparing

the 668 Marks to the DP Sign as affixed to footwear. Dream Pairs appealed to the Supreme Court.

The Supreme Court's decision

The legal framework comprised Section 10(2)(b) of the 1994 Act, interpreted in line with EU law principles requiring a global assessment through the eyes of the average consumer with imperfect recollection. The appeal crystallized two issues of principle:

1. The "Similarity issue": whether realistic, representative post-sale viewing angles may be considered at the similarity stage, or whether such "marketing circumstances" are confined to the subsequent global assessment of confusion.
2. The "Confusion issue": whether post-sale confusion must be in the context of a subsequent transactional decision to be actionable, or whether confusion arising outside any transactional context suffices.

On similarity, the Supreme Court rejected a rigid, "intrinsic-features-only" side-by-side approach. It analyzed *Equivalenza*,[86] which the Supreme Court explained does not prohibit consideration of how a sign is realistically and representatively seen in use as part of the overall visual impression for similarity. Rather, it bars using marketing context to erase similarities. Representative post-sale vantage points—such as how a side logo appears on a worn boot viewed from head height—are part of the way the average consumer encounters the sign and may shape the perceived overall impression at the comparison stage.

The Supreme Court, reading *Audi*[87] in light of *Equivalenza*, held that similarity is assessed by reference to the overall impression of the signs, and realistic angles that reflect actual perception may be taken into account to establish similarity; broader marketing conditions that would reduce or negate similarity are reserved for the subsequent global assessment.

Applying those principles, the Supreme Court found that, in any event, Mr. Justice Miles had conducted both a side-by-side graphic comparison and a practical assessment of the DP Sign as affixed to footwear from different angles; he found only the faintest resemblance, identifying key differences (including the DP Sign's tilted, broken, slightly rounded square and its "P"-like inner form) which he regarded as distinctive and dominant.

On the Confusion issue, the Court confirmed that post-sale confusion outside a transactional context can, in principle, ground infringement under Section 10(2)(b). The essence is the origin

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86 EUIPO v. Equivalenza Manufactory SL (Case C-328/18 P), EU:C:2020:156.

87 Audi AG v. GQ (Case C-334/22), [2024] Bus. L.R. 1056.

function: damage is complete if an average consumer is confused about the origin of the relevant goods or services; there is no additional requirement that confusion occur at the point of any sale or further transactional decision, nor that it be confined to potential purchasers.

Appellate standards

The Court stated that the issues of similarity and likelihood of confusion were classic examples of multi-factorial assessments, which might result in opposing conclusions by individuals applying the same principles to the same facts. It reiterated that the overturning of a first-instance multi-factorial assessment requires an identifiable error of principle or law, a gap or inconsistency undermining cogency, or irrationality. It was therefore not open to an appellate court to re-balance the factors in a multi-factorial assessment simply because it would have reached a different view. The Court examined Miles J's reasoning and the criticisms made by the Court of Appeal, concluding that the appellate court's criticisms were not borne out when Mr. Justice Miles's judgment was read as a whole.

Accordingly, the appeal was allowed and the High Court's dismissal of Iconix's likelihood of confusion claim was restored. Although the Court did conclude that infringement under likelihood of confusion could be based on post-sale confusion outside of the transactional context (all that is required is that the average consumer would be confused; there being no requirement that this occur when the relevant goods are purchased), that was not established on these facts.

8. Belgium—Brussels Business Court—Can a mark with a reputation prevent use of an identical mark for products wholly different from those for which the mark is registered?

In a dispute concerning the famous PINK LADY brand (a variety of apple), the Brussels Business Court addressed whether the owner of a trademark with a reputation in relation to fruit can prevent its use on electronic cigarettes.[88]

The case was brought by Apple and Pear Australia Ltd. ("APAL"), the owner of the PINK LADY trademarks registered in Class 31 in the EU and Benelux, together with its licensee Star Fruits. They discovered that Eurolit, a Lithuanian producer of electronic cigarettes, marketed certain vapes bearing the sign PINK LADY. APAL and Star Fruits initiated proceedings seeking an

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[88] Pres. Dutch-speaking Brussels Business Court, April 10, 2025, Ing.-Cons., 2025/1, p. 47-66.

EU-wide injunction. Eurolit responded with counterclaims for invalidity and, alternatively, revocation of the PINK LADY trademarks.

The counterclaim for invalidity was based on Article 7(1)(m) EUTMR and its Benelux equivalent, relating to earlier plant variety denominations. The Court, applying the CJEU's *Textilis* judgment,[89] held that the grounds for refusal introduced by the Regulation 2015/2424 do not apply retroactively. Since APAL's EU trademark dated from 2001, that is, before the entry into force of Article 7(1)(m) of the 2017 EUTM Regulation (March 23, 2016), and its Benelux trademark dated from 1994, that is, before the entry into force of its Benelux equivalent under the 2015 TM Directive (June 1, 2018), Eurolit's invalidity counterclaim was dismissed.

Eurolit also sought revocation under Article 58(1)(b) 2017 EUTM Regulation and its Benelux equivalent, alleging that PINK LADY had become a common name on the fruit market. The Court rejected this argument, finding no evidence of loss of distinctiveness nor any negligence by the rights holders.

Regarding APAL and Star Fruits' main claim, they relied on Article 9(2)(c) EUTMR and its Benelux equivalent, provisions protecting trademarks with a reputation. The Court confirmed that PINK LADY enjoyed very high recognition in the Benelux and the entire EU, based on extensive evidence including market studies, press coverage, market share data, presence at international trade fairs and significant marketing investments.

Because a trademark with a reputation enjoys extended protection, the Court ruled that it is irrelevant that apples and electronic cigarettes are totally different products: the trademark owner is entitled to act against infringing use both within and outside its sector of activity, whether for identical, similar, or dissimilar goods or services. The Court further found that the products could even be regarded as complementary, since electronic cigarettes often refer to flavorings inspired by foodstuffs such as apples or other fruits.

Moreover, consumers encountering a vape labelled PINK LADY would make a connection with the renowned apple trademark. The use was found to take unfair advantage of the trademark's distinctiveness and to harm its reputation, which is built on associations with natural and healthy products. The harm was exacerbated by the proximity of the term "KURWA," a vulgar insult in several EU languages, further degrading the trademark's image.

As a result, the Court found that Eurolit infringed the trademark rights of APAL and Star Fruits by using the PINK LADY trademark within the EU for electronic cigarettes and other nicotine

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89 CJEU, March 14, 2019, Case C-21/18, EU:C:2019:199, Textilis Ltd., Ozgur Keskin / Svenskt Tenn AB.

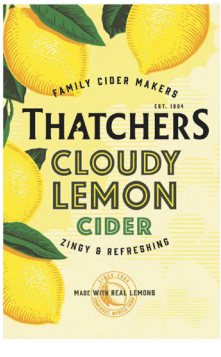
products, and granted an EU-wide injunction, ordering Eurolit to cease all use of these products.

9. UK—Court of Appeal—How close does "look-alike" packaging have to be to take unfair advantage of a trademark with a reputation?

In *Thatchers Cider Company Ltd. v. Aldi Stores Ltd.*,[90] the Court of Appeal considered whether a discount supermarket's own brand of lemon cider product infringed a registered trademark under Section 10(3) of the Trade Marks Act 1994 ("TMA 1994") by taking unfair advantage of the trademark's reputation through the use of "look-alike" packaging.

Background

Thatchers Cider Company Limited ("Thatchers"), the largest family-run independent cider producer in the United Kingdom, launched Thatchers Cloudy Lemon Cider (the "Thatchers Product") in February 2020. Thatchers was the proprietor of UK Registered Trademark No. 3489711 (the "Trademark") in respect of cider and alcoholic beverages in Class 33.



Aldi Stores Limited ("Aldi"), a discount supermarket known for its slogan "like brands, only cheaper," launched Taurus Cloudy Lemon Cider (the "Aldi Product") in May 2022 as a seasonal variant within its "Taurus" cider range.

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90 [2025] EWCA Civ 5.

In developing the Aldi Product, Aldi engaged in "Benchmarking" (identifying a market leader as the quality barometer for a new own-brand product), selecting the Thatchers Product as the benchmark for both quality and packaging design. Aldi's design agency was instructed to "add lemons as per Thatchers" and create "a hybrid of Taurus and Thatchers."

Thatchers commenced proceedings claiming infringement under likelihood of confusion and reputation-based grounds under Sections 10(2) and 10(3), respectively, of the TMA 1994. At first instance, HHJ Melissa Clarke dismissed all claims. Thatchers appealed only the dismissal of its claim based on reputational grounds.

The Court of Appeal's decision

Section 10(3) provides that a person infringes a registered trademark by using a similar sign where the mark has a reputation and the use, without due cause, takes unfair advantage (also known as parasitism or free riding) of, or is detrimental to, the mark's distinctive character or repute. The leading authority remains *L'Oréal SA v. Bellure*,[91] holding that advantage is taken unfairly where a third party seeks by that use to ride on the coattails of the mark with a reputation to benefit from its power of attraction, reputation, and prestige and to exploit the proprietor's marketing investment in respect of that mark. Lord Justice Arnold, delivering the Court of Appeal's decision, found that the judge erred in treating the relevant sign ("Sign") as the three-dimensional appearance of a single can. On proper interpretation, the Sign consisted of the "graphics on the cans and on the cardboard 4-can pack"; a two-dimensional design (as depicted above).

Regarding similarity, the Court held that the first-instance judge erred in assessing similarity by wrongly treating the

[91] NV [2009] ECR I-5185.

difference between a two-dimensional mark and three-dimensional product as a distinguishing factor, and by failing to consider how Thatchers actually used the Trademark on cans. On that basis, similarity was *stronger* than that under the first-instance judge's decision.

The Court held that the judge confused an intention to deceive (relevant to infringement under likelihood of confusion) with an intention to exploit the Trademark's reputation (relevant to infringement of trademarks with reputations). The Sign represented a "manifest departure" from the Taurus house style, and, in the context of Section 10(3), the judge wrongly discounted the faint horizontal lines present in both the trademark and the Sign; "it is often the reproduction of inessential details which gives away copying." Although this was not a copyright infringement case, the copying did show that the Aldi Product was a close imitation of the trademark. The Court concluded: "The inescapable conclusion is that Aldi intended the Sign to remind consumers of the Trademark. This can only have been in order to convey the message that the Aldi Product was like the Thatchers Product, only cheaper."

In relation to unfair advantage, the Court held that the judge committed a "clear error of principle" by failing to address Thatchers' pleaded case on transfer of image (exploiting a mark's image by transferring its qualities to goods identified by a similar sign). Reassessing this point, the case fell "squarely within" the *L'Oréal v. Bellure* description of riding on the coattails of a trademark. Social media evidence showed consumers describing the Aldi Product as "a Thatchers Lemon cider rip off." The advantage was held to be unfair because "it enabled Aldi to profit from Thatchers' investment in developing and promoting the Thatchers Product rather than competing purely on quality and/or price."

The first-instance decision also dealt with allegations of tarnishment (i.e., detriment to the repute of the Trademark), on the basis of: i) a difference in taste between the products; and ii) alleged deceptive wording on the Aldi Product that it was made with premium fruit when it did not contain lemon juice. Regarding the first argument, the first-instance court found that the tastes were "very similar" but still different, and held that consumers drinking the Aldi Product who did not like its taste would not as a result form a negative view of the Thatchers Product. Regarding the second argument, any deception of the consumer was liable to lead to negative consequences for Aldi only, with no reason to suppose that Thatchers would lose trust from consumers. The Court of Appeal held that the first-instance finding regarding the first question was "unassailable."

Regarding the second question, The Court of Appeal noted that the judge assessed Thatchers' second argument on a factually mistaken basis. Contrary to the judge's assumption, Aldi's

packaging did not disclose on the information panels that the product lacked real lemon juice. While the packaging stated "made with premium fruit," which consumers would likely understand to mean lemons, the only indication that the product did not contain real lemon juice appeared in small print describing it as "cloudy lemon flavoured cider." Although this was potentially misleading, it did not amount to detriment to the reputation of the Trademark. There was no evidence that consumers realized they had been misled, complained, or transferred any negative perception to the Thatchers Product.

The Court also observed that any attentive consumer would notice a clear distinction between the two products: Thatchers' packaging expressly stated "made with real lemons" and included detailed, transparent ingredient information, reinforcing that any misleading aspect of Aldi's presentation would not damage the reputation of the Trademark.

Finally, Aldi argued that even if infringement were established, it had a defense under Section 11(2)(b) of the TMA 1994. The Court rejected this, finding that Aldi's use was not in accordance with honest practices in industrial and commercial matters (a requirement for the defense to apply) because Aldi's conduct constituted unfair competition.

Departure from L'Oréal v. Bellure*?*

As a last resort, Aldi invited the Court to depart from *L'Oréal v. Bellure*. The Court declined to do so for several reasons, including: (i) Parliament had not repealed or amended Section 10(3) since Brexit, indicating legislative intent that such claims should remain available; (ii) the will of Parliament was that UK trademark law should remain harmonized with EU law in this respect; and (iii) the ruling had been applied in numerous domestic decisions without causing commercial difficulties.

The Court of Appeal therefore allowed Thatchers' appeal and substituted a finding that Aldi had infringed the Trademark pursuant to Section 10(3). Aldi sought permission to appeal the decision to the UK Supreme Court but that permission was refused in June 2025.

VII. LIMITATION OF RIGHTS AND DEFENSES

A. Introductory Comments

EU trademark law contains a variety of specific defenses and other limitations on the exclusive rights conferred upon trademark proprietors.

A trademark proprietor in Europe may find the route to enforcement is ultimately barred by statutory acquiescence under

Article 9(1) and (2) of the 2015 TM Directive and Article 138(2) of the 2017 EUTM Regulation. These provide that the proprietor of an earlier trademark who has *knowingly* acquiesced to the use of a later trademark for five consecutive years may not apply for invalidity or opposition proceedings against that mark.

Article 14 of the 2017 EUTM Regulation (together with Article 14 of the 2015 TM Directive) sets out various restrictions and limitations to ensure certain "descriptive" uses of a mark or term may not amount to an infringement, or where use of a mark or term is necessary to indicate spare parts, compatibility, or intended use of a product or service, all of which might otherwise have the effect of limiting fair competition and improperly expanding the scope of protection of a trademark proprietor's rights. Such defenses are not absolute, but apply only where such use is in accordance with "honest practices" in the relevant context.

Proprietors of national marks in EU Member States may also face a limitation on their ability to prevent the use of a third-party earlier right that applies in a particular locality (Article 14(3) of the 2015 TM Directive).

Other common instances of limitation arise from the ability (or otherwise) of trademark proprietors to object to further commercialization of their goods once lawfully placed on the market, more commonly known as "exhaustion," set out in Article 15 of the 2017 EUTM Regulation and Article 15 of the 2015 TM Directive. Again, the ability of a trademark proprietor to interfere with "downstream" use of the relevant mark may have an impact on fair competition and the proper functioning of the market.

Cases in this Part VII remain characteristic in considering the balance the law must strike between fair competition and the rights of a trademark proprietor in a particular circumstance. This is perfectly illustrated by *HP v. Digital Revolution*, in which the Hague Court of Appeal held that resale of original HP cartridges without outer packaging did not infringe a trademark where the origin and image functions of the mark were unimpaired—the products being standard office items rather than luxury goods, and the HP trademarks remaining visible on the cartridges and inner packaging. By contrast, the Danish Eastern High Court in *HPE v. A* took a stricter approach to parallel imports from outside the EEA, confirming that where goods are undisputedly purchased outside the territory and the defendant cannot demonstrate genuine attempts to verify lawful marketability, exhaustion will not apply, imposing personal liability on a company director who derived significant income from the infringing trade.

Artistic freedom of expression as a limitation on trademark rights was also tested in two jurisdictions. In Germany, the Court of Appeal Hamburg held that use of a modified Red Cross symbol on a book cover critical of health policy infringed the German Red Cross's

well-known mark, finding that artistic freedom under the Constitution did not justify the use absent direct criticism of the rights holder, particularly given the mark's special protection under criminal and civil law. In Denmark, the Maritime and Commercial Court reached a similar conclusion, holding that an artist's systematic commercial exploitation of a supermarket chain's trademarks on hats, mug, and t-shirts could not be justified by parody or artistic expression when weighed against the proprietor's rights.

B. Legal Texts

Article 14 of the 2017 EUTM Regulation

1. An EU trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:
   (a) the name or address of the third party, where that third party is a natural person;
   (b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of the goods or services;
   (c) the EU trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of that trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.
2. Paragraph 1 shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.

Article 15 of the 2017 EUTM Regulation

1. An EU trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Union under that trade mark by the proprietor or with his consent.
2. Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

Article 138 of the 2017 EUTM Regulation

Prior rights applicable to particular localities

1. The proprietor of an earlier right which only applies to a particular locality may oppose the use of the EU trade mark in the territory where his right is protected in so far as the law of the Member State concerned so permits.
2. Paragraph 1 shall cease to apply if the proprietor of the earlier right has acquiesced in the use of the EU trade mark in the territory where his right is protected for a period of five successive years, being aware of such use, unless the EU trade mark was applied for in bad faith.
3. The proprietor of the EU trade mark shall not be entitled to oppose use of the right referred to in paragraph 1 even though that right may no longer be invoked against the EU trade mark.

Article 9 of the 2015 TM Directive

Preclusion of a declaration of invalidity due to acquiescence

1. Where, in a Member State, the proprietor of an earlier trade mark as referred to in Article 5(2) or Article 5(3)(a) has acquiesced, for a period of five successive years, in the use of a later trade mark registered in that Member State while being aware of such use, that proprietor shall no longer be entitled on the basis of the earlier trade mark to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless registration of the later trade mark was applied for in bad faith.
2. Member States may provide that paragraph 1 of this Article is to apply to the proprietor of any other earlier right referred to in Article 5(4)(a) or (b)
3. In the cases referred to in paragraphs 1 and 2, the proprietor of a later registered trade mark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later trade mark.

Article 14 of the 2015 TM Directive

Limitation of the effects of a trade mark

1. A trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

(a) the name or address of the third party, where that third party is a natural person;

(b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;

(c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of the trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

2. Paragraph 1 shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.

3. A trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality, if that right is recognised by the law of the Member State in question and the use of that right is within the limits of the territory in which it is recognised.

Article 15 of the 2015 TM Directive

Exclusion of rights conferred by a trade mark

1. A trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Union under that trade mark by the proprietor or with the proprietor's consent.

2. Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

C. Cases

1. Denmark—The Danish Eastern High Court—Is an owner/director personally liable if ex-EEA imports infringe a trademark?

On October 1, 2025, the Danish Eastern High Court ("EHC") decided an appeal brought by A, a private individual and former owner-director of company B (then in bankruptcy), against Hewlett Packard Enterprise Development LP and Hewlett-Packard

Development Company L.P (together "HPE"). The case concerned parallel importation of branded products.[92]

Facts of the case

The dispute was whether A was liable for infringement of HPE's trademark rights through B's parallel import into, and sale within, the European Economic Area ("EEA") from June 2016 until measures to preserve evidence were executed in December 2019. The Danish Maritime and Commercial Court ("MCC") had found infringement and imposed liability on A in a January 3, 2024, judgment, which A appealed.

It was undisputed before the EHC that the products sold in the EEA bore HPE's EU trademarks. The questions were whether import, marketing, and sale contravened Article 15 of the 2017 EU Trade Mark Regulation, in conjunction with Article 9, and the scope of compensation and damages for which A was liable. An in-court expert appraisal found B achieved turnover exceeding DKK 100 million (approx. EUR 13.5 million) from HPE-branded products purchased outside the EEA and resold within it, and that significant proceeds were paid out to A.

Trademark infringement and burden of proof

The EHC held that, as a starting point, the defendant bears the burden of proving that the goods were placed on the EU/EEA market by the trademark proprietor or with its consent. The Court clarified that this may be subject to exceptions such as those identified by the CJEU in *Hewlett Packard Development Company*.[93] In particular, where the defendant bears the burden to prove exhaustion but substantiates a risk of partitioning national markets by the trademark proprietor, the burden of proof may be adjusted.

The EHC examined HPE's general terms for authorized dealers in the EEA and Switzerland and found they permitted sales throughout that area, but not outside it, while dealers elsewhere were limited to sales in their country of registration. This supported that HPE's selective distribution system did not partition the EEA.

Referring again to *Hewlett Packard*, the EHC noted that the burden of proving exhaustion does not rest solely on the defendant if goods do not bear market-identifying markings, the defendant sought assurances from sellers regarding lawfulness, or the trademark proprietor refused to verify the sale upon the buyer's request.[94]

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92 Case No. BS-2627-2024-OLR.

93 Case C-367/21—Hewlett Packard Development Company LP, para 60.

94 Case C-367/21—Hewlett Packard Development Company LP, para 67.

Here, unlike in *Hewlett Packard*, the goods were undisputedly purchased outside the EEA and then resold within it. A showed no evidence that B or A made genuine attempts to obtain verification from HPE that the products were marketable in the EEA or to secure assurances from sellers. To the contrary, the EHC found evidence that B and A sought to circumvent HPE's efforts to prevent unlawful parallel imports into the EEA. The EHC therefore held that B had infringed HPE's trademark rights (and thus also A).

Personal liability of A

Turning to A's personal liability, the EHC found A had no income other than from B and had derived significant income from B's earnings from the infringing parallel imports. On that basis, the EHC affirmed the MCC's finding that A was personally liable, at least on grounds of gross negligence.

The EHC agreed that HPE was entitled to compensation and damages under Section 43 of the Danish Trademarks Act.[95] In assessing the award, the Court considered the turnover of approx. DKK 100 million (EUR 13.5 million), the nature, severity, scale, and duration of the infringement, and the significant profits generated, as well as the likelihood of market disruption. The Court found no basis to award additional amounts for losses, as none were proven. The EHC ordered A (jointly liable with B), to pay DKK 7,500,000 (approx. EUR 1 million) in compensation to HPE and to pay the costs of the case.

2. Germany—Court of Appeal Hamburg—Can the use of a well-known mark be permitted under freedom of speech or artistic expression?

The decision[96] of the Court of Appeal Hamburg published in early 2025 had to decide on the relationship between trademark infringement and freedom of speech and artistic expression. The plaintiff, the national Red Cross Society of the Federal Republic of Germany, has more than three million members in Germany. It is the owner of the following German trademark:

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95 The provision articulates the liability to pay compensation and damages to the trademark proprietor and implements the Intellectual Property Rights Enforcement Directive Articles 3(2) and 13.

96 Court of Appeal Hamburg, dec. of November 28, 2024, Case No. 5 U 112/23—Rotes Kreuz auf weißem Grund.

The trademark covers a broad range of goods and services.

The defendant, a publishing company, had sold a book/ebook with the title *HEILE UND HERRSCHE! Eine gesundheitspolitische Tragödie* (translated, "HEAL AND RULE! A tragedy in health policy") with a red cross on the white cover as shown below.

The book comments on the health system in Germany and criticizes what the author considers to be misguided health policy. The plaintiff was not mentioned in the book. However, the defendant took the position that the book was indirectly dealing also with the plaintiff in a way that the satirically distorted symbol addresses the plaintiff as a major service provider representing the bleeding system. Further, the defendant argued that the use of the red cross was merely decorative.

The German Red Cross sued the publishing company for trademark infringement and was successful before the Regional Court of Hamburg. Upon appeal, the Court of Appeal of Hamburg upheld the decision. It found the plaintiff's trademark as well known for health-related services and that use as a trademark by the defendant was not required—it was sufficient that the public associated the red cross on the book cover with the plaintiff's trademark.

The Court of Appeal of Hamburg also found that the use took unfair advantage of the trademark's distinctiveness, as it was clearly important to the defendant that the relevant public recognized the allusion. The court considered the use was also detrimental to the reputation of the plaintiff's trademark since by using the trademark as a symbol for a "bleeding" health system the trademark had an inappropriate association. The plaintiff's mark was not a general symbol for the entire health system, not least as

its use was restricted by the German Red Cross and its unauthorized use was an administrative offense.[97] Such controls and restrictions were to ensure that the emblem always clearly and unambiguously identified the function of the mark and its associated conditions of use.

Further, the court held that the defendant's use was not justified by freedom of speech or artistic expression. Artistic freedom under the German Constitution[98] is not unlimited. Rather, it is limited by other conflicting fundamental rights, including the guarantee of property rights,[99] which included the plaintiff's trademark rights. The conflict between values protected by fundamental rights must be resolved on the basis of the constitutional value system. Weighing the competing fundamental rights, the court decided in favor of the plaintiff. In order to be justified, the contested use of the trademark must be clearly linked to criticism or other substantive discussion. Since the book did not directly address the plaintiff or its activities, there could be no critical or satirical use that could justify the use of the mark.

The court also recognized the overriding public interest in protecting the red cross trademark from unauthorized use. This particular sign enjoys additional protection under criminal and civil law. As such, special justification would be required to use this sign in the exercise of artistic freedom, which was not established here.

3. Denmark—The Maritime and Commercial Court—Can artistic freedom of expression provide a legitimate justification for the use of a third party's trademark?

On February 21, 2025, the Danish Maritime and Commercial High Court (the "MCC") held that artistic freedom of expression does not trump registered trademark rights when a third party's trademark is affixed to "artworks" sold as ordinary consumer goods at scale by an "artist." The case follows prior preliminary injunction proceedings between the same parties.[100]

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97 § 125 of the German Administrative Offenses Act.

98 Articles 5(1) and (3).

99 Article 14(1) of the German Constitution.

100 Case BS-30388/2023-SHR and Case BS-162/2024-OLR. On December, 5, 2023, the MCC granted a preliminary injunction against AP's exploitation of Coop's trademarks. On September 23, 2024, the Eastern High Court (the "EHC") upheld the decision. The matter was then brought before the MCC as a case on the merit. The case is under appeal to the Danish Eastern High Court scheduled for oral pleading in August 2026.

Facts of the matter

The Copenhagen-based gallery Artpusher and the artist Love Party (together "AP") marketed and sold hats, mugs, t-shirts, bags, and print works bearing modified versions of Danish supermarket chain Coop Denmark's ("Coop") Danish trademark Registrations No. VR 2011 00222 (figurative) (the "Irma Figure"), VR 1949 00635 IRMA (word), and Danish trademark Registration No. VR 2002 00847 COOP (word). The Irma Figure mark is stylized as "a blond girl on the way to the shops" (collectively, the "Coop Trademarks"). AP's modifications included adding cigarettes, spray cans, alcohol, and tears to the Irma Figure and altering backgrounds to depict, for example, Copenhagen and Paris.

Trademark registration: VR 2011 00222, "Irma-pige"

Examples of some contested artworks

Trademark registration: VR 2010 01401

Infringement of COOP's trademark rights

The MCC found that AP infringed Coop's rights in the Coop Trademarks under Section 4(2)(3) of the Danish Trademark Act.[101] The court held that Coop may prohibit use for economic purposes of signs identical or similar to its well-known marks where such use, without due cause, takes unfair advantage of or is detrimental to the distinctive character or repute of the marks. In assessing unfair

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[101] Equivalent to Article 10(1)(c) of the 2015 EU Trade Mark Directive.

exploitation, the MCC noted that AP used the Irma Figure as a central motif and marketed products with systematic, continuous references to the Coop Trademarks, thereby taking unfair advantage of their characteristics without legitimate reason. The court also found a significant risk of harm to the marks and held that AP's freedom of expression and any societal relevance of certain motifs did not justify the use.

The MCC further assessed that the similarity between the Coop Trademarks and AP's artwork on products could cause public confusion and lead buyers to assume a connection between Coop and AP's products.

The freedom of (artistic) expression versus Coop's proprietary rights

AP invoked the copyright parody exception and artistic freedom of expression, relying on the CJEU case of *Deckmyn*[102] and the Danish Supreme Court's 2023 judgment on *The Little Mermaid*.[103] The MCC found that AP had not shown that most of the artworks amounted to humor or mockery. Referring to the commercial purpose underpinning the creation and marketing of the works and to the CJEU's decision *Arsenal*,[104] the MCC held the exploitation fell within Section 4(2)(3) of the Danish Trademark Act as described above.

While some works could be protected under Article 11 of the EU Charter and Article 10 ECHR—protecting artistic freedom—because they were created in connection with public debate about Coop's closure of the IRMA chain, this did not permit AP to freely exploit the Coop Trademarks for commercial gain.

The MCC held that AP's use constituted systematic and sustained commercial exploitation of such scope and magnitude that freedom of expression and any societal relevance could not justify the use when balanced against Coop's trademark and copyright interests. AP's marketing, which suggested AP had acquired rights in the Coop Trademarks, reinforced this conclusion. Coop's rights under the Danish Trademark Act were therefore enforceable against AP.

Given the risk of confusion whereby the average consumer might reasonably perceive AP as an authorized distributor of products bearing the Coop Trademarks, the MCC also held that AP acted contrary to Sections 3(1), 4, 20(1), and 22 of the Danish Marketing

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102 Case C-201/13—Deckmyn og Vrijheidsfonds.

103 Case BS-24506/2022–HJR, *The Little Mermaid*.

104 Case C-206/01.

Practices Act.[105] The MCC ordered AP to pay Coop DKK 750,000 (app. EUR 100,000) in compensation and damages.

4. The Netherlands—The Hague Court of Appeal—Can the resale of original goods without the outer packaging amount to trademark infringement or are the rights exhausted?

In *HP/Digital Revolution*,[106] the Court of Appeal in The Hague delivered a decision concerning the resale of original goods. The court assessed whether HP had legitimate reasons to oppose further commercialization of exhausted goods where the outer packaging has been removed after the products had been put on the market.

Inner packaging

Outer packaging

HP brought proceedings against Digital Revolution, which offers for sale original HP cartridges without the outer packaging, based on—among other factors—trademark infringement. The Court of Appeal considered that the HP cartridges at issue had been put on the market in the EEA by or with the consent of HP and that the principle of exhaustion of trademark rights under Article 15(1) of the 2017 EUTM Regulation would thus apply. HP could therefore oppose further commercialization of the goods only if there is a "legitimate reason" (as referred to in Article 15(2) of the 2017 EUTM Regulation). The main issue for the court was whether such legitimate reasons existed due to the removed original outer packaging.

In the present case, HP could *not* successfully rely on Article 15(2) of the 2017 EUTM Regulation according to the Court of Appeal. Specifically, it held that impairment of the origin function or of the image of the trademark, being the two situations

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105 This includes a prohibition on disloyal actions in the Danish marketplace as well as deceptive marketing practices.

106 The Hague Court of Appeal, June 8, 2025, ECLI:NL:GHDHA:2025:735, HP v. Digital Revolution.

establishing legitimate reasons as accepted in CJEU *L'Oréal/eBay*,[107] were not present in this case.

First, the origin function was not impaired as, even without the outer packaging, it was clear that the products were produced and marketed by the HP Group through other uses of the HP trademarks, such as on the cartridges themselves and the inner packaging.

Secondly, in relation to the image function of the trademark, the court held that, according to the CJEU judgment in *L'Oréal/eBay*, harm to the image can occur when the outer packaging contributes to the way the image created by or for the trademark owner is shown, and that it is the responsibility of the trademark owner to provide evidence of this. The current cartridges do not qualify as luxury products but rather as fairly standard office items. HP could not demonstrate that the outer packaging contributed to the image of the HP cartridges or that its removal harmed the reputation of the HP trademarks. As a result, all of HP's trademark claims are rejected.

VIII. PRACTICE AND PROCEDURE

A. Introductory Comments

This final Part VIII contains cases that are of more general interest to brand owners and trademark practitioners, containing important points of principle or updates on trademark practice and procedure affecting EUTMs or national trademarks in the EU or other European countries.

In 2025 CJEU delivered guidance on the compatibility of Swedish cross-protection for company names with EU law, holding that while the Trademark Directive does not harmonize rules on trade names, national measures must satisfy Articles 34 and 36 of the Treaty on the Functioning of the European Union, requiring that activities be described with sufficient precision to inform third parties and that failure to use a company name may, under certain conditions, lead to revocation of exclusive rights. The Italian Supreme Court referred to the CJEU the question of whether the Italian "stability" rule (permitting preliminary injunctions to remain in force indefinitely without proceedings on the merits) is compatible with Article 9(5) of the Enforcement Directive, a ruling that may substantially alter Italian enforcement practice. In Spain, the Supreme Court in *Bodegas Vega Sicilia v. Bodegas Sanviver* established that where validity of an EUTM is challenged before the EUIPO, the EU Trademark Court must stay infringement proceedings ex officio, irrespective of the defendant's procedural

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[107] CJEU, July 12, 2022, Case C-324/09, ECLI:EU:C:2011:474, *IER* 2011/58, L'Oréal v. eBay.

choices or whether the EUIPO decision has become final. Finally, the Turkish Court of Cassation rendered a landmark decision on state emblems, holding that a white cross on a red background incorporated in an industrial design for a disinfectant bottle would be perceived as the Swiss flag and could not be registered under Article *6ter* of the Paris Convention—rejecting the argument that the symbol denoted medical services and setting an important precedent for the registrability of designs and trademarks evoking state flags.

B. Legal Texts

None applicable in this Review.

C. Cases

1. CJEU—Can individual member states create additional bars to EUTM enforcement rights not included in the 2015 TM Directive?

In *Lunapark Scandinavia Oy Ltd. v. Hardeco Finland Oy*,[108] the CJEU considered whether a Finnish national general principle of private law could preclude a trademark proprietor from enforcing its exclusive rights due to inactivity in circumstances not expressly provided for by EU trademark legislation.

Background

Lunapark Scandinavia Oy Ltd. ("Lunapark") was the proprietor of the Finnish word mark DRACULA, filed on August 29, 2003, and registered on August 14, 2009, in respect of confectionery goods. It imports and markets confectionery in Finland bearing the DRACULA word and figurative signs depicting the famous fictional character, Dracula. Prior to Lunapark's registration, Karkkimies Oy—Candyman Ltd. ("Karkkimies") had imported and sold confectionery under the sign DRACULA, without any exclusive rights acquired through registration or use, and without any agreement with Lunapark. In October 2019, Hardeco Finland Oy ("Hardeco") acquired Karkkimies, and from November 2019 started importing and selling "Dracula"-branded confectionery.

On October 6, 2020, Lunapark issued a trademark infringement action against Hardeco before the Finnish Market Court ("Market Court"). The Market Court found that the sign used by Hardeco was identical to Lunapark's registered DRACULA mark and that its use on identical goods (confectionery) resulted in a likelihood of confusion.

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[108] Case C-452/24, ECLI:EU:C:2025:618 (CJEU August 1, 2025).

Despite this finding, the Market Court dismissed Lunapark's claim. Acquiescence (deriving from Article 9, 2015 TM Directive) did not apply because Hardeco had no exclusive rights in the sign. However, the Market Court held that Lunapark had lost its right to bring an infringement action under a well-established principle of Finnish private law, requiring rights to be asserted within a "reasonable time." The Market Court held that Lunapark's long period of inaction in asserting its rights (by failing to challenge the predecessor's use of the sign over many years) meant that it had effectively forfeited the right to bring an infringement claim against Hardeco under the national "reasonable time" principle.

Lunapark appealed to the Finnish Supreme Court, arguing that applying Finland's general "reasonable time" rule to bar its claim was inconsistent with the 2015 TM Directive and unlawfully restricted its exclusive rights under EU law, which permits loss of rights only in the specific circumstances set out in the 2015 TM Directive's acquiescence rule.

Lunapark's arguments

Lunapark submitted that the 2015 TM Directive fully harmonizes the circumstances in which a trademark owner can lose the right to enforce its mark in circumstances when it has been aware of a third party's infringing use (see Article 18(1), and Article 9(1)–(2))—namely acquiescence. The rule of acquiescence provides that an owner can lose the right to enforce its trademark rights only if it knowingly tolerates a later registered mark for at least five consecutive years. Lunapark argued that this regime is exhaustive and does not extend to unregistered marks. On the facts, neither Karkkimies nor Hardeco had acquired any exclusive right in the "Dracula" sign, and therefore there was no basis for statutory acquiescence.

In those circumstances, the Finnish Supreme Court decided to stay the proceedings and to refer the following question to the CJEU:

> Does Article 10 of [Directive 2015/2436] preclude the application, in a dispute concerning a trademark infringement, of a national principle whereby the proprietor of a trademark, also in cases other than those covered by Article 18(1) and Article 9(1) or (2) of [that directive], could forfeit the right conferred on him or her by Article 10(2) and (3) [thereof] to prohibit a third party from using a sign the use of which adversely affects or is liable adversely to affect one of the functions of the trademark, on the ground that, though being aware of the use of the mark, he or she has not applied for prohibition of that use within a reasonable time?

Guidance of the CJEU

The CJEU considered whether Article 10 permits EU Member States to apply national principles that bar enforcement of trademark rights due to inactivity, outside the harmonized framework outlined above.

Recital 10 of the 2015 TM Directive makes it clear that EU trademark law is intended to secure consistent protection across all Member States. Allowing additional national rules relating to the consequences of inactivity would fragment that protection and undermine legal certainty. Harmonization means that the 2015 TM Directive itself sets the complete conditions under which exclusive rights may be limited.

The CJEU explained that acquiescence under Article 18(1), read together with Article 9(1)–(2), is narrowly defined. It applies only in situations where a proprietor knowingly tolerates a later registered trademark for five consecutive years. This mechanism addresses conflicts between registered trademarks. It does not extend to unregistered signs, which confer no exclusive rights.

Against this framework, the CJEU assessed the facts referred by the Finnish Supreme Court. Neither Karkkimies nor Hardeco had obtained exclusive rights in the "Dracula" sign, whether by registration or through use. In such circumstances, there could be no acquiescence on the facts. Introducing a national requirement for enforcement action to be taken within a "reasonable time" would therefore amount to creating a jurisdiction-specific, new inactivity-based defense not recognized under EU law. A principle of national law cannot limit a trademark owner's rights to bring an infringement action beyond what is set out in the Trade Marks Directive. The Finnish rule was incompatible with the Trade Marks Directive and hence ineffective.

2. EU—CJEU—Was the Swedish protection of company names compatible with the Trademark Directive, free movement, and the EU Treaty?

In the 2024 edition of this *Annual Review*, we reported on the Swedish system of cross-protection between company names and trademarks and whether this system is compatible with EU law. The question arose in the context of proceedings before the Swedish Patent and Market Court of Appeal, which subsequently referred questions to CJEU for a preliminary ruling. On July 10, 2025, the CJEU delivered its judgment in Case C-365/24.

By way of background, in Sweden, company names are granted similar protection to trademarks. According to Chapter 1, Section 8, of the Swedish Trademark Act (2010:1877) the holder of a company name or other business mark has the exclusive right to use the sign as a trademark. Furthermore, Chapter 1, Section 10, of the

Trademark Act states that the exclusive right to a trademark under Chapter 1, Section 8, means that no party other than the holder, without its permission, may use a sign for goods or services in commercial activities if the sign is identical with or similar to the trademark and is used for goods or services of the same or a similar type, where there is a risk of confusion, including the risk that use of the sign leads to the perception that there is a connection between the party using the sign and the holder of the trademark. Accordingly, the use of a trademark that is confusingly similar to a third party's company name may constitute an infringement of the exclusive *trademark right* to the *company name*.

Similarly, according to Chapter 1, Section 3, of the Swedish Company Names Act (2018:1653), the holder of a trademark has the exclusive right to use the sign as a business mark (or *trade name*, to use the same wording as the CJEU). These corresponding provisions, wherein a trademark is granted the same protection as a company name and vice versa, is referred to as "cross-protection" (in Swedish: "det korsvisa skyddet").

The Swedish Trademark Act implements the 2015 Trademark Directive. However, there is no provision in the Trademark Directive equivalent to the cross-protection found in Chapter 1, Section 8, of the Swedish Trademark Act. Article 5.4(a) of the Trademark Directive states that Member States may provide that a trade name (referred to in the Directive as "another sign used in the course of trade") can constitute grounds for refusing the registration of a younger trademark if the sign confers on its proprietor the right to prohibit the use of a subsequent trademark. However, the Directive does not specify under what circumstances the proprietor of a company name may prevent the use of a sign as a trademark.

The case before the Swedish courts concerned the question of whether the marketing and sale of dog food and dog treats on a website under the domain name doggie.se and use of the sign DOGGIE in the course of such activities infringed the company name Doggy AB and the registered trademark DOGGY.

The Swedish Patent and Market Court originally found that the use of DOGGIE constituted an infringement of that trademark and company name. The decision was appealed to the Swedish Patent and Market Court of Appeal. The proceedings were stayed on May 20, 2024, and the Court of Appeal referred the following two questions to the CJEU:

1. In the light of the Treaty on the Functioning of the European Union (TFEU) and the fundamental principle of the free movement of goods and services under EU law, is it compatible with the provisions of the Trademark Directive, in particular Articles 1 and 5.4, to have a system under national law whereby *an earlier right in a company name may constitute a basis for prohibiting the use of a subsequent*

trade sign (in Swedish: "varukännetecken") *in the entire field of activity in respect of which the company name is registered and without any requirement that the company name must have been used to distinguish goods or services*?

2. If the answer to Question 1 is in the negative, is it compatible with the Trademark Directive and EU law in general for a company name, which is used *per se* as a sign to distinguish certain kinds of goods or services in the field of activity in respect of which the company name is registered, to constitute *grounds for prohibiting the use of a subsequent trade sign in connection with kinds of goods or services other than those in respect of which the company name is used as a sign*?

The CJEU reformulated the two questions to ask whether the Trademark Directive and Articles 34 and 36 TFEU preclude national rules under which the exclusive right conferred by a company name allows its proprietor to prohibit a third party from using an identical or similar sign *as a trade name* (in Swedish: "näringskännetecken") *or domain name* for goods or services identical or similar to those falling within the registered activities, even though those rules do not require genuine use or specification of the goods and services as required for trademarks.

The CJEU first clarified that the Trademark Directive seeks to approximate national trademark laws, but not those relating to trade names. Furthermore, it was held that, in the absence of harmonization at EU level, the protection of trade names is a matter for national law.

The CJEU interpreted the dispute before the national court to not concern any trademarks, but rather a conflict between an earlier company name, and the sign DOGGIE, used as a trade name or as a domain name. The Court pointed out that the Trademark Directive is not relevant in cases of conflict between two trade names and held that the compatibility of national measures governing such conflicts must instead be assessed in the light of primary law. The assessment was then focused on the compatibility of the Swedish protection for company names with Articles 34 and 36 TFEU.

The CJEU held that a prohibition preventing an undertaking from using the same trade name in one Member State as it uses in other Member States may constitute a restriction on the free movement of goods contrary to Article 34 TFEU. Such a restriction may, however, be justified by overriding reasons in the public interest relating to the protection of industrial and commercial property, as provided for in Article 36 TFEU, namely the protection of trade names against the likelihood of confusion. The Court emphasized that any such restriction must not go beyond what is necessary to attain that objective.

Regarding the concern that company names may enjoy broader protection against the likelihood of confusion than trademarks due to a more lenient approach in defining activities falling within the object of an undertaking, the CJEU noted that Swedish law requires that the nature of the activities is described with sufficient precision so as to enable third parties to be effectively informed of them.

Furthermore, the Court acknowledged that while the absence of genuine use of a company name is not subject to limits or penalties identical to those laid down in Article 16 of the Trademark Directive, it noted that failure to use a company name may, under certain conditions, lead to the revocation of the exclusive right that it confers.

On this basis, the CJEU concluded that it would not appear that the Swedish system goes beyond what is necessary to attain the objective of general interest relating to the protection of industrial and commercial property. Although the Court's reformulation of the referred questions meant that the underlying issues of cross-protection in Sweden that the Patent and Market Court sought to have clarified remains unresolved, the judgment nevertheless established conditions that national legislation on company names must satisfy in order to be compatible with EU law.

As such it is now settled law that failure to use the company name may, under certain conditions, lead to the revocation of the exclusive right which it confers; and the proprietor is required to describe and limit the nature of the activities falling within its object with sufficient precision to enable third parties to be effectively informed of them.

3. Spain—Supreme Court—Is a stay of infringement proceedings mandatory when EU trademark validity is under challenge?

The First Chamber of the Supreme Court of Spain[109] addressed a procedural issue of considerable practical relevance in the field of European Union trademark law: the scope and mandatory nature of the suspension of infringement proceedings where the validity of the trademark relied upon has been challenged before the EUIPO, pursuant to Article 132 of the 2017 EUTM Regulation.[110]

The dispute arose from an infringement action brought by Bodegas Vega Sicilia, S.A. based on an EUTM word mark ÚNICO against Bodegas Sanviver, S.L., for marketing a vermouth under the same mark. During the course of the judicial proceedings, the defendant brought invalidity proceedings before the EUIPO with

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109 Judgment No. 92/2025 of January 14, 2025 (Cassation Appeal 3915/2020, Bodegas Vega Sicilia S.A. v. Bodegas Sanviver S.L.).

110 (EU) 2017/1001.

respect to the ÚNICO trademark, without filing a counterclaim before the European Union Trademark Court or expressly requesting a stay of the infringement proceedings. The EU Trademark Court[111] upheld the infringement claim in substance, and the Provincial Court of Alicante[112] confirmed that judgment, even after an EUIPO decision declaring the trademark invalid, which was not yet final, had been submitted on appeal.

The Supreme Court upheld the appeal on grounds of procedural infringement and concluded that, in circumstances such as those at issue, the European Union Trade Mark Court was under an obligation to stay the infringement proceedings, even of its own motion, once it became aware that the validity of the trademark relied upon was being challenged before the EUIPO.

In reaching that conclusion, the Court recalled that the 2017 EUTM Regulation establishes a procedural mechanism designed to ensure coordination between infringement proceedings before national courts and validity proceedings before the EUIPO. Where an application for revocation or invalidity of an EU trademark is pending before the Office, the infringement court must, as a general rule, suspend the proceedings, subject only to the existence of specific reasons justifying their continuation and after giving the parties an opportunity to be heard.

The Supreme Court emphasized that this obligation is mandatory and is not dependent on the procedural choices made by the defendant. In particular, it does not require the filing of a counterclaim before the EU trademark court, nor does it depend on the EUIPO decision on invalidity having become final. Once the court has knowledge of the pending challenge to the validity of the trademark, the stay of proceedings follows as a matter of law.

From the Supreme Court's perspective, the existence of pending invalidity proceedings before the EUIPO gives rise to a genuine risk of prejudice, since the existence and validity of the trademark constitute an essential prerequisite for infringement proceedings. If the trademark were ultimately declared invalid with *ex tunc* effect, the infringement action would necessarily have to be dismissed. Accordingly, the purpose of Article 132 of the 2017 EUTM Regulation is to prevent conflicting decisions and, in particular, to avoid a final judgment of infringement producing res judicata effects that are incompatible with a subsequent declaration of invalidity, bearing in mind that the Regulation itself limits the retroactive effects of invalidity with respect to final decisions that have already been enforced.

The Supreme Court further held that the failure to order a stay, both at first instance and on appeal, deprived the defendant of an

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111 Judgment of EUTM Court No. 1 of Spain (January 2, 2020).

112 Judgment of the Provincial Court of Alicante, Section 8 (July 6, 2020).

effective defense and infringed the right to effective judicial protection enshrined in Article 24 of the Spanish Constitution. As a result, it set aside the judgment under appeal and ordered that the proceedings be stayed until the decision on the invalidity of the trademark before the EUIPO becomes final, without examining the grounds of cassation relating to the substantive trademark dispute.

The ruling therefore establishes a clear doctrine with significant practical implications: where a European Union trademark court is aware that the validity of the trademark relied upon in an infringement action is being challenged before the EUIPO, it must order a stay of the proceedings ex officio, after hearing the parties, irrespective of the procedural strategy adopted by the defendant. In doing so, the judgment reinforces the mandatory nature of Article 132 2017 EUTM Regulation and corrects a judicial practice that had tended to downplay the obligation to stay proceedings in the absence of a final administrative decision or a formal counterclaim. In Spain, a single Supreme Court judgment does not technically create jurisprudence, but it does establish an authoritative doctrinal criterion that lower courts are expected to follow.

4. Italian Supreme Court—Compatibility of the Italian "stability" rule for preliminary injunctions with EU law—Must such measures lapse if no proceedings on the merits are brought?

The decision of the Italian Supreme Court of February 10, 2025, in *M.M. Ristorazione S.r.l. v. Villa Ramazzini S.r.l.*,[113] does not resolve the issue, but instead refers it to the Court of Justice of the European Union for a preliminary ruling under Article 267 of the TFEU (under Case C-132/25), with the domestic proceedings stayed pursuant to Article 295 of the Italian Code of Civil Procedure.

According to Italian law, injunctions granted in interim proceedings in principle remain in place even without instituting proceedings on the merits afterwards (the so-called "stability" rule). The Italian Supreme Court has now asked the CJEU whether this Italian rule is compatible with the Enforcement Directive.[114] Under Italian law, the issue is governed by Article 132(3) and (4) of the Italian Industrial Property Code. Article 132(3) provides that an interim measure loses effect if proceedings on the merits are not initiated within the mandatory time limit, or if such proceedings are extinguished after they have begun. Article 132(4), however, makes an exception to this rule for interim measures capable of anticipating the effects of the judgment on the merits, such as preliminary injunctions. In such cases the relevant measures

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113 Case No. 3332.

114 Directive 2004/48/EC.

remain in place irrespective of whether proceedings on the merits are instituted (either party retains the right to bring an action on the merits). The core of the debate concerns the compatibility of this derogation with Article 50(6) of the TRIPS Agreement and Article 9(5) of the Enforcement Directive. Under those provisions, Member States must ensure that provisional measures are revoked or otherwise cease to be effective, at the defendant's request, if the applicant fails to institute proceedings leading to a decision on the merits within a given period.

Turning to the case at issue, in 2018, at Villa Ramazzini S.r.l.'s request, the Court of Rome issued an injunction ordering M.M. Ristorazione S.r.l. to cease any use of the sign "Mò Mò," remove the sign from its premises, and pay a daily penalty in the event of non-compliance. As Villa Ramazzini S.r.l. did not subsequently initiate proceedings on the merits, M.M. Ristorazione S.r.l. applied to the Court of Rome for a declaration that the injunction had lost effect.

In 2020, the Court of Rome dismissed the application, holding that, under Article 132(4) of the Italian Industrial Property Code, the mandatory time limit for initiating proceedings on the merits does not apply to urgent measures and other anticipatory protective measures capable of anticipating the effects of the judgment on the merits, such as preliminary injunctions. The Court of Appeal of Rome upheld that decision. It reasoned that such injunctions are not necessarily instrumental to the adoption of a subsequent decision on the merits and that their regime is consistent with Article 3 of Directive 2004/48/EC, which requires enforcement measures to be fair, equitable, effective, and proportionate, and not to entail unreasonable delays. M.M. Ristorazione S.r.l. then appealed to the Italian Supreme Court, arguing that the Italian rules governing interim proceedings in intellectual property matters are incompatible with Article 9(5) of the Enforcement Directive, which requires provisional measures to lapse if proceedings on the merits are not brought within a reasonable period.

Italian courts have addressed this specific issue only sporadically. In its decision, the Italian Supreme Court reviewed the limited body of domestic case law and the main doctrinal positions that have emerged over time. An early decision is the judgment of the Court of Florence of June 8, 2016, which held that the Enforcement Directive does not extend to injunctions issued under the Italian Industrial Property Code. According to that court, such injunctions—aimed at preventing imminent infringements or stopping ongoing violations—fall outside the scope of the "provisional measures" contemplated by Article 9(5) of the Enforcement Directive. More recently, the Court of Milan, in its judgment of January 5, 2024, adopted a different line of reasoning. It emphasized that the Italian system preserves the defendant's rights of defense, since the addressee of an injunctive measure may

challenge it through appellate remedies and may also initiate proceedings on the merits. On that basis, the court excluded any incompatibility between Article 132(4) of the Italian Industrial Property Code and EU law.

The Italian Supreme Court also reviewed the positions taken by scholars, who are divided on this issue. Some commentators argue that Article 132(4) of the Italian Industrial Property Code is plainly incompatible with Article 9(5) of the Enforcement Directive, as this provision does not allow for any derogation from the requirement that provisional measures lapse if proceedings on the merits are not brought within a given period. Other authors take the opposite view, relying on different arguments. Some refer to Article 2 of the Enforcement Directive, which allows Member States to provide for measures that are more favorable to rights holders. Others—in line with the reasoning adopted by the Court of Rome—stress the distinction between measures capable of anticipating the effects of a judgment on the merits and purely provisional measures. In this respect, they recall the CJEU's definition of provisional measures as those intended to preserve a factual or legal situation pending a decision on the substance.

Given this background, the Italian Supreme Court held that the issue could not be resolved through interpretative tools available at national level and that a reference for a preliminary ruling was therefore necessary. In particular, the Supreme Court noted that Article 9(5) of Directive 2004/48/EC plays a central role in the EU system of provisional measures, as it is intended to safeguard defendants against the lasting effects of measures adopted in summary proceedings where no action on the merits is subsequently brought. At the same time, Italian law expressly allows certain anticipatory protective measures to remain effective even in the absence of proceedings on the merits, provided that either party retains the right to initiate such proceedings.

The Court observed that this divergence has significant practical implications in intellectual property litigation and that an incorrect interpretation of EU law could lead to inconsistent levels of protection across Member States, undermining the objectives of the Enforcement Directive.

It is also worth noting that the Italian rule whose compatibility with EU law is now before the CJEU has been practically very significant in enforcement of IP rights in Italy, as it can deliver swift relief where the rights holder's primary objective is to stop the infringement rather than seek damages, which would typically require longer and more costly ordinary proceedings on the merits. For that reason, the CJEU's ruling on this issue may have a substantial impact on Italian practice.

5. Türkiye—Court of Cassation—Was a white cross figure on a red background too similar to the Swiss flag to be a valid sign for industrial designs?

The 11th Chamber of the Turkish Court of Cassation rendered a landmark decision[115] holding that an industrial design relating to a disinfectant bottle could not be registered pursuant to Article 58/4-ç of the Turkish Industrial Property Code ("IPC"), on the grounds that it contained a white cross on a red background that would be perceived as the Swiss flag.

The plaintiff had filed an opposition against the applicant/defendant's industrial design application for a disinfectant bottle (shown below) based on Article 58/4-ç of the Industrial Property Code, which governs industrial designs that cannot be registered pursuant to Article 6ter of the Paris Convention, on the grounds that the white cross on a red background featured in the application constitutes a reproduction of the Swiss flag, which may be registered only with the consent of the competent Swiss authorities. The Re-examination and Evaluation Board ("REEB") of the Turkish Patent and Trademark Office ("TPTO") rejected the opposition, reasoning that the red and white cross sign used in the industrial design did not amount to a reproduction of the Swiss flag, but rather represented a symbol commonly used to denote medical services.

The plaintiff appealed the decision before the IP Court, arguing that the red and white cross figure incorporated in the industrial design would be perceived as a reproduction of the Swiss flag rather than as a generic medical symbol. The plaintiff further contended that the internationally recognized medical emblem consists of a red cross on a white background (the reverse of the Swiss flag) and that the use of this emblem in trademarks and industrial designs is likewise prohibited pursuant to Article 53 of the Geneva Convention

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[115] 11th Civil Division of the Turkish Court of Cassation, 19.03.2025, 2024/3543 E, 2025/1974 K.

of August 12, 1949. On these grounds, the plaintiff sought annulment of REEB's decision.

The expert report obtained during the first-instance proceedings had concluded that the red and white cross figure featured in the industrial design creates the same overall impression as the Swiss flag and would therefore be perceived as a reproduction of it. The experts further rejected REEB's assessment that the red and white cross figure could be considered a symbol of medical services. The first-instance court also adopted the findings of the expert report, accepted the lawsuit, and decided to annul the REEB's decision and invalidate the disputed industrial design.

The first-instance court's decision was appealed before the Regional Court of Justice ("RCJ"). The RCJ, in its decision, explained that the cross figure on the industrial design differs from the Swiss Flag, and it is commonly used as a medical symbol, accepting the defendants' appeal and rejecting the plaintiff's lawsuit seeking the annulment of the REEB's decision.

The plaintiff appealed the RCJ's decision before the Court of Cassation. In its landmark decision, the Court of Cassation reversed the RCJ's judgment, holding that the red and white cross figure incorporated in the industrial design subject to the lawsuit would be perceived as the Swiss flag, despite the minor differences between the two. Furthermore, the Court of Cassation rejected the argument that the red and white cross figure is a symbol widely used for medical services.

The Court of Cassation sent the case back to the RCJ, and the RCJ decided to comply with the Court of Cassation's decision. Rendered by the Court of Cassation, the decision addresses the misconception that a white cross on a red background resembling the Swiss flag may be used as a medical symbol and highlights the strong protection of state flags and emblems under international and Turkish law, setting an important precedent for future cases concerning the registrability of industrial designs and also trademarks involving signs evoking Swiss Flag, or other state flags and emblems.

IX. GLOSSARY

CJEU:	The Court of Justice of the European Union, which refers to itself simply as "the Court of Justice" and is also often referred to as the "ECJ" or "European Court of Justice." (The Treaty of Lisbon officially renamed the Court the "Court of Justice of the European Union" effective as of December 2009.)
COA:	Court of Appeal.
EEA:	European Economic Area.
EUIPO:	The European Union Intellectual Property Office, being the office that handles EUTM applications, oppositions, and cancellation actions. It was previously called (in its English language version) the "Office for Harmonization in the Internal Market" or "OHIM." (The name was changed effective as of March 23, 2016.)
EUTM or EU trademark:	A registered trademark obtained by means of the EU's centralized procedure (i.e., by application to the EUIPO), which provides rights throughout the entire area of the European Union. (Note that the name was changed from "Community Trademark" ("CTM") to "EU Trademark" ("EUTM") effective as of March 23, 2016.)
EU General Court (GC):	The EU court with jurisdiction to hear appeals from the Boards of Appeal of EUIPO.
Member State:	A country that forms part of the European Union from time to time.
sign:	As used (but not defined) in the EUTM Regulation and the TM Directive, "sign" is used to refer to the subject matter of which a trademark may consist and is also used (in the context of trademark infringement) to refer to the offending word, device, or other symbol that the defendant is using; often used in practice when the word "mark" could be used.
Union:	The European Union.
2008 TM Directive:	Directive 2008/95/EC of October 22, 2008, which provides for the harmonization of the

	laws of the EU Member States in relation to trademarks; it codified the earlier Council Directive 89/104/EEC of December 21, 1988. This has now been amended and recast as the 2015 TM Directive, which repealed the 2008 TM Directive as of January 15, 2019.
2015 TM Directive:	Directive (EU) 2015/2436 of December 16, 2015, which provides for the harmonization of the laws of the EU Member States in relation to trademarks, and takes over from the 2008 TM Directive.
2009 EUTM Regulation:	Council Regulation (EC) No. 207/2009 of February 26, 2009, which provides for EUTMs; it codified the earlier Council Regulation (EC) No. 40/94 of December 20, 1993. This was amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council (December 15, 2015) with the amendments taking effect on March 23, 2016. (However, references to the EUTM Regulation in this Review are still generally to the 2009 version of the Regulation unless stated otherwise).
2017 EUTM Regulation:	Council Regulation (EU) No. 2017/1001, which provides for EUTMs. It is a codified form which reflects the amendments made by Regulation (EC) 2015/2424 to the 2009 EUTM Regulation.

Note: European trademark laws and lawyers use the term "trade mark" rather than "trademark." However, references in this issue have been changed to "trademark" where appropriate to conform to the norms of *The Trademark Reporter*. Statutory references or direct quotes remain in the EU form.

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