

Top 10 posts on the Kluwer Trademark Blog in 2018

Kluwer Trademark Blog

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Kluwer Patent Blog

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As we enter a new year, we would like to take this opportunity to pass on our best wishes for 2019 to all of our readers, as well as reflect on developments in trademark law over the past year. Last year was a busy one with a number of landmark CJEU decisions and significant developments in a number of jurisdictions. Here is a quick look back at our 10 most read posts last year:

1. Norway: Ridicule as a response to claims of trade mark infringement

A trade mark infringement matter which has been making the headlines in Norway the last week concerns the small Norwegian beverage producer O. Mathisen's product JALLASPRITE, which is a lemon flavoured soft drink. Coca-Cola, being the proprietor of the registered and probably reputed trade mark SPRITE, are none too happy about this.

2. CJEU on the Kit Kat shape and acquired **distinctiveness of EU trade marks for shapes**

On 25 July 2018, the CJEU handed down its ruling in the latest edition of the battle between Nestlé and Mondelez over the KIT KAT shape (C-84, 85, 95/17 P). This time, the discussion focused on whether a non-traditional EU trade mark that is not inherently distinctive must be shown to have acquired distinctiveness in the EU as a whole, or in every single Member State. The 'reliance' factor discussed in the UK case (see also [here](#) and [here](#) in this blog) was not in issue, as the General Court

had confirmed that acquired distinctiveness had been shown to exist in 10 of the 15 relevant Member States (the KIT KAT mark is from 2002, pre-EU expansion).

3. CJEU puts old seniority claims at stake: If national marks were vulnerable when they lapsed or were surrendered, they still are!

On 19 April 2018, the CJEU handed down its judgment in the matter Peek & Cloppenburg (PUC), a referral from the German Supreme Court in a litigation between two German companies of that same name (one of which runs under the name of Peek & Cloppenburg [PuC] “North”, the other “West”) (C-148/17).

4. CJEU: Puma’s feline jumps high: EUIPO must take into account earlier decisions recognizing reputation of a mark invoked in an opposition

By judgment of 28 June 2018 (C-564/16 P), the CJEU rejected an appeal filed by the EUIPO. The case was, in essence, about whether and to which extent the EUIPO could or even had to take into account its own previous decision practice, including findings of fact (namely, that the trademark relied upon has a reputation) from previous cases. The General Court had gone quite far in imposing on the Office that it take such findings into account and potentially even request evidence from the opponent. The appeal of the Office was unsuccessful.

5. Ban of marks vs freedom of speech

*Fack Ju Göhte is the title of one of the most successful German comedy films in recent times. A EUTM application by Constantin Film Produktion GmbH for the wordmark “FACK JU GÖHTE”, mostly for merchandising products, was rejected by EUIPO for being “contrary to public policy or to accepted principles of morality”. On appeal, the Board of Appeal confirmed the EUIPO decision, finding i) the proposed mark resembled the English expression “f**k you”, although spelled differently; ii) the relevant consumers - i.e. those of German speaking countries - would perceive the mark as vulgar and shocking; iii) the reference to Johann Wolfgang von Goethe could only increase the immorality of the mark; iv) the popularity of the film could not lead to a different conclusion.*

6. The CJEU on the technical function exception for EU designs

EU Design law denies protection to designs which are solely dictated by a product’s technical function (art. 8(1) CDR). But how to determine if a product’s

appearance is solely defined by its technical function in order to deny protection to a design?

7. The Louboutin Saga in France: a new victory

The Paris Court of Appeal ruled that the French figurative trademark owned by Mr. Christian Louboutin and designating “high-heeled shoes (except orthopedic footwear)” in Class 25, reproduced above, is valid (Paris Court of Appeal, 15 May 2018, No. 17/07124).

8. Norway: PURPLE HAZE; Norwegian courts rule that purple is not perceived as a trade mark for inhalers.

This case has gone through all instances in the Norwegian court system, with the Norwegian Supreme Court rendering its first decision on colour marks in December 2017. Overall, the courts find that neither purple, nor specific shades of purple, have protection as unregistered trade marks for inhalers for GlaxoSmithKline in Norway.

9. Repackaging our Understanding of Legitimate Reasons in Parallel Imports

In the EU, any third party in possession of genuine goods put on the market in the European Economic Area (EEA) by the trade mark owner or with the trade mark owner’s consent is free to resell those goods within the EEA. This is because the EU imposes a system of “regional exhaustion”, which means parallel imports (genuine branded products put on the market by a rights holder in one territory and subsequently imported into a different territory by a third party without the rights holder’s consent) within the EU region cannot be prevented on the basis of the brand owner’s IP right. However, the rules relating to regional exhaustion of rights do not apply when the trade mark the owner can invoke legitimate reasons to oppose the further commercialisation of those goods.

10. The technical function of a potato snack

On the 21 March 2018 the Danish Board of Appeal (“The Board”) delivered its decision regarding the trademark protection of the shape of the following potato snack (decision no. AN 2017 00006). The snack originates from the famous snack brand Kims which is owned by Orkla Confectionary & Snack Danmark A/S (“Orkla”).

In the decision The Board concluded that the most significant feature of the shape of the product was the grooved surface, which could merely be considered as a feature which was necessary to obtain a technical result and/or followed from the nature of the goods themselves.