

TRADE NAMES IN THE TRADEMARK REGIME: COMEBACK OF THE FORGOTTEN TWIN?

Paul-George BUTA*

Abstract

Just like Venus, once considered Earth's twin and largely forgotten for more than 50 years, was back in the spotlight after an unexpected discovery, trade names, left in the shadows by their more successful 'twin' – trademarks, are surprisingly mentioned in the latest EU trademark Directive. Could this be the premise for a comeback of the forgotten right? We briefly analyze the position of trade names in the trademark regime before the new trademark Directive and the changes brought by the new EU act. Looking at the case-law and literature related to the previous regime, we argue that the premise the new regime was based on (in what concerns the interference between trade names and trademarks) is not accurate and that, as a consequence, an imbalance in the relative protection of these rights has been created. We propose that the appropriate remedy is the adopting, at the national level of the EU Member States, of specific legislation concerning the protection of trade names. Fortuitously, this would also allow some EU Member States to discharge an international obligation neglected for over a century.

Keywords: trade name, trademark, industrial property, overlapping rights, interference of rights, EU law, Paris Convention.

1. Introduction

“Every time the long-forgotten people of the past are remembered, they are born again!”
— Mehmet Murat Ildan

1.1. The Forgotten Twin

On 14 September 2020, news that phosphine (PH₃), an organic compound “only associated [on Earth] with life that does not need oxygen to survive (anaerobic microbes)”,¹ was detected in the clouds on Venus² has prompted a flurry of interest in developments related to our planet's closest neighbor.³

This was unusual because general interest in Venus had waned since the 80s.⁴ This happened because while Hollywood movies in the 60s (among the last of which was Curtis Harrington's 1965 film, “Voyage to the Prehistoric Planet”, a rip-off of the Soviet 1962 film “Planeta Bur”, with Harrington's film itself being remade into Peter Bogdanovich's 1968

“Voyage to the Planet of Prehistoric Women”, featuring a bikini-clad Mamie van Doren as leader of the Venusians) revealed a general perception of Venus as a jungle-covered planet, the Soviet Venera 3 probe of 1965 and the NASA Mariner 5 mission of 1967 revealed a surface temperature of 460 degrees Celsius which clearly excluded any type of life on the surface of Venus.⁵

Previously dubbed “Earth's twin”, Venus had become just a non-interesting uninspiring hot rock with no chances of supporting extraterrestrial life and consequently was, for a long time, forgotten to all but a handful of scientists who continued to look to Venus to find out why the planet has evolved in the way it has and what implications they can draw from that with regard to the evolution of conditions on Earth.

1.2. The Forgotten Right

Trade names were, just like Venus in the 60s, of significant interest at the end of the 19th century.

* Lecturer, PhD, Faculty of Law, “Nicolae Titulescu” University of Bucharest (e-mail: paul.but@univnt.ro).

¹ Planetary News, „Phosphine in Venus' Atmosphere Could Indicate Life in the Clouds”, https://www.lpi.usra.edu/planetary_news/2020/09/21/phosphine-in-venus-atmosphere-could-indicate-life-in-the-clouds/, accessed on 7 May 2021.

² Jane S. Greaves and Anita M. S. Richards and William Bains and Paul B. Rimmer and David L. Clements and Sara Seager and Janusz J. Petkowski and Clara Sousa-Silva and Sukrit Ranjan and Helen J. Fraser, „Recovery of Spectra of Phosphine in Venus' Clouds” *arXiv preprint arXiv:2104.09285* (2021).

³ Shortest distance from Earth to Venus is about 38 million km, while shortest distance to Mars is about 55 million km – Ms. O'Brien's Blog, „Shortest Distance from Planets to Earth”, <https://blogs.socsd.org/aobrien/science-2/curiosity-rover/shortest-distance-from-planets-to-earth/>, accessed on 7 May 2021.

⁴ Abigail Beall, „Race to Venus: What we'll discover on Earth's toxic twin”, in *Science Focus*, 16 January 2020, <https://www.sciencefocus.com/space/race-to-venus-what-well-discover-on-earths-toxic-twin/>, accessed on 7 May 2021.

⁵ Nole Tayler Redd, „Venus, once billed as Earth's twin, is a hothouse (and a tantalizing target in the search for life)”, in *Space.com*, <https://www.space.com/venus-earth-twin-evolution-life-search.html>, accessed on 7 May 2021.

Although some legal provisions for the protection of trade names had been instituted in some countries in the mid-1800s (notably in France where a special law for the protection of the manufacturer's name had been adopted in 1824), a protection of trade names at the international level was felt to be needed.⁶

In fact, at that time, trade names were argued to be "first among trademarks",⁷ subject to a "special property right", governed by natural international law, unlimited in time, not subject to any kind of estoppel and protected without need for any deposit or other formality.⁸

Thus, it is not surprising that trade names were on the agenda of international industrial property law protection ever since the principles that would ground the first ever international agreement on the subject (the 1883 Paris Convention for the Protection of Industrial Property) were drafted at the 1878 Trocadero Congress.⁹

Equally unsurprising is the fact that said Convention specifically provided for the international protection of trade names by means of article 8, which reads: "A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark."

What is surprising, on the other hand, are the fact that this provision has suffered no major amendment in nearly 140 years¹⁰ and that, in those 140 years, little research seems to have been undertaken in respect of this "first among trademarks" right relative to the significant interest raised by its 'twin' right, i.e., the 'regular' trademark right.

Just like Venus became uninteresting when the expectations as to how the planet was like were contradicted by the scientific findings, trade names have been relegated to the far background of the industrial property law debate when trademarks have become the better preferred means of securing protection for the purpose of distinguishing the economic output and activity of traders worldwide.

2. Trade names in the trademark regime

2.1. Trade names and trademarks prior to the new Trademark Directive

Trade names were not mentioned as such in the First Trademark Directive¹¹ nor in the 2008 Trademark Directive.¹²

The interferences between prior trade names and trademarks were dealt with under article 4 par. (4), letters (b) and (c) of the two Directives,¹³ and, with regard to maintenance of prior use of "an earlier right which only applies in a particular locality" in article 6 par. (2).

In the parallel system of the Community Trademark (as it then was), these provisions were mirrored by article 8 par. (4)¹⁴ and article 53 par. (2) of Regulation 207/2009¹⁵ while the maintenance of prior use was dealt with in article 111. Important mention should be made of the fact that, under the CTM system, the prior right to a sign "used in the course of trade of more than mere local significance" could only be

⁶ Count of Maillard de Marafy, "Rapport présenté au nom de la section des marques de fabrique et de commerce" in Ministère de l'agriculture et du commerce, *Congrès international de la propriété industrielle tenu à Paris du 5 au 17 septembre 1878*, Imprimerie Nationale (Paris – 1879), p. 101.

⁷ Conclusions of Jules Pataille, attorney for the appelants, in *Veuve d'Étienne-Beissel et fils v. Selckingham et Roger et Cie*, Paris Court of Appeals, 20 December 1878 in *Annales de la propriété industrielle, artistique et littéraire*, tome XXIII/1878, pp. 337-351.

⁸ Jules Bozérián, Commentary on *Veuve d'Étienne-Beissel et fils v. Selckingham et Roger et Cie*, French Court of Cassation, 13 January 1880 - *Annales de la propriété industrielle, artistique et littéraire*, tome XXV/1880, pp. 126-132.

⁹ Ministère de l'agriculture et du commerce, *Congrès international de la propriété industrielle tenu à Paris du 5 au 17 septembre 1878*, Imprimerie Nationale (Paris – 1879), pp. 360-361.

¹⁰ Only the words "or registration" were added at the Hague revision conference of 1925.

¹¹ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, *OJ L 040/11.02.1989*.

¹² The text was substantially identical in the two directives: "4. Any Member State may, in addition, provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that: [...] (b) 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; (c) 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 (b) 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;"

¹³ Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, *OJ L 299/8.11.2008*.

¹⁴ With the amendment that the sign opposed be "used in the course of trade of more than mere local significance".

¹⁵ Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, *OJ L 78/24.03.2009* which codified the first Community Trademark Regulation, Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, *OJ L 11/14.01.1994*, p. 1 which contained the same provisions with the same numbering, except for the maintenance of prior use which was provided for in article 107 in the initial Regulation.

invoked in trademark annulment proceedings and not in opposition proceedings.¹⁶

EU courts have established that the “use in commerce” and “more than of mere local significance” (where applicable) are to be evaluated according to Community law standards while the “anteriority” and “right to prohibit use of the mark” conditions are to be assessed by reference to applicable national law.¹⁷ In respect of which is the applicable national law, the EU court has indicated that this refers to the “law governing the sign relied on.”¹⁸ Without going into details, by application of article 8 of the Paris Convention, in respect of the existence and anteriority of the right to the trade name, the law of the state where the right is claimed to have been born should be applied while, in respect of the possibility that, claiming under such right, a prohibition of use of the mark is possible, application of the law of the state where protection is sought ought to apply. Mention should also be made of the fact that article 8 of the Paris Convention does not have direct horizontal effect between parties in the same Member State.¹⁹

Though the condition for the trade name to be used in commerce (mention should be made that the assessment of the conditions is made by reference to the deposit/priority date of the posterior trademark concerned)²⁰ is not subject to the strenuous test of the “effective use” for trademarks,²¹ the “attempt to obtain an economic advantage” criterion requires more than use in income statements and invoices unrelated to the sale of goods or services to customers.²²

The condition (only applicable under the CTM Regulation) that the sign be of more than mere local significance requires an *in concreto* assessment of the geographic scope of use (which needs to not be limited to a reduced part of the relevant territory, from the perspective of interested third parties)²³ and of the economic dimension of the use (showing the impact of that sign on the territory where used as a distinctive sign),²⁴ mere fact that the right is protected on a national scale or that it is used for a mail order business or proof of registration with the Trade Registry and use in catalogues is not sufficient *per se* to satisfy this condition.²⁵

Anteriority of the trade name is, usually, closely linked with its use (also on account of the application of article 8 of the Paris Convention) and its birth is assessed by reference to the law of the state where such trade name is first protected.

Meeting the last condition (prior right allows the owner to prohibit use of posterior trademark) seems to be the most difficult to meet since this condition (when involving trade names) relies on the national law of the state where protection is sought (in what CTMs are concerned, due to their unitary character, this is usually the same state where protection was obtained, if an EU Member State). The EU Courts have held that, for such condition to be met, the owner would need to show that “the sign at issue is within the scope of the law of the relevant Member State and that it allows prohibiting use of the more recent trademark”,²⁶ thus requiring proof “not only that this right arises under the national law, but also the scope of that law.”²⁷ Therefore the owner

¹⁶ Guy Tritton, Richard Davis, Michael Edenborough, James Graham, Simon Malynicz, Ashley Roughton *Intellectual Property in Europe*, 3rd ed., Sweet & Maxwell (London – 2008), p. 347.

¹⁷ TEU, *Alberto Jorge Moreira da Fonseca, Lda v OHIM (intervening: General Óptica SA)* (T-318/06-T-321/06), decision of 24 March 2009 in *ECR* 2009-II, p. 663, par. 33.

¹⁸ *Idem*, par. 34.

¹⁹ See *Camper, SL v Office for the Harmonization of the Internal Market (OHIM), JC AB (intervening)* (T-43/05), Decision of 30 November 2006 in *ECR* 2006 II-95; *Galileo International Technology LLC et al v Commission of the European Communities* (T-279/03), Decision of 10 May 2006 in *ECR* 2006 II-1296; TEU, *Conceria Kara Srl v OHIM (intervening: Dima – Gıda Tekstil Deri Insaat Maden Turizm Orman Ürünleri Sanayi Ve Ticaret Ltd Sti)* (T-270/10), Decision of 3 May 2012 *ECLI:EU:T:2012:212*, par. 70.

²⁰ OHIM, 1st Board of Appeal, *WIT-SOFTWARE, CONSULTORIA E SOFTWARE PARA A INTERNET MÓVEL, S.A. v CONSTRULINK, TECNOLOGIAS DE INFORMAÇÃO, S.A.* (R 1059/2013-1), Decision of 6 March 2014, par. 49.

²¹ See TEU, *Construcción, Promociones e Instalaciones, SA v OHIM (intervening: Copisa Proyectos y Mantenimientos Industriales SA)* (T-345/13), Decision of 4 July 2014 (unpublished), par. 43 and par. 44 referencing TEU, *Raffaello Morelli v OHIM (intervening: Associazione nazionale circolo del popolo della libertà and Michela Vittoria Brambilla)* (T-321/11 și T-322/11), Decision of 14 May 2013 (unpublished), par. 33; TEU, *Grain Millers, Inc. v OHIM (intervening: Grain Millers GmbH & Co. KG)* (T-430/08), Decision of 9 July 2010 in *ECR* 2010-II, p. 145, par. 30, 40, 41 and 45.

²² See TEU, *Construcción, Promociones e Instalaciones, SA v OHIM (intervening: Copisa Proyectos y Mantenimientos Industriales SA)* (T-345/13), Decision of 4 July 2014 (unpublished), par. 49-50.

²³ TEU, *Alberto Jorge Moreira da Fonseca, Lda v OHIM (intervening: General Óptica SA)* (T-318/06-T-321/06), decision of 24 March 2009 in *ECR* 2009-II, p. 663, par. 37.

²⁴ *Idem*, par. 38.

²⁵ *Idem*, par. 39. See also TEU, *K-Mail Order GmbH & Co. KG v OHIM (intervening: IVKO Industrieprodukt-Vertriebskontakt GmbH)* (T-279/10), Decision of 14 September 2011 in *ECR* 2011-II, p. 283, par. 23, 27. However use for one import operation and is a press release and press article, being means of advertising are enough – TEU, *Grain Millers, Inc. v OHIM (intervening: Grain Millers GmbH & Co. KG)* (T-430/08), Decision of 9 July 2010 in *ECR* 2010-II, p. 145, par. 43.

²⁶ CJEU, *Peek & Cloppenburg KG (Dusseldorf) v OHIM (intervening: Peek & Cloppenburg KG (Hamburg))* (C-325/13), Decision of 10 July 2014 (unpublished), par. 47.

²⁷ TEU, *macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie v OHIM (intervening: MIP Metro Group Intellectual Property GmbH & Co. KG)* (T-579/10), Decision of 7 May 2013 (unpublished), par. 62.

of the prior right to a trade name would need to provide “not only with particulars showing that he satisfies the necessary conditions, in accordance with the national law of which he is seeking application, [...], but also particulars establishing the content of that law.”²⁸

Moreover, in order to use the trade name as a prior right to bar registration to a more recent trademark, use in commerce of the trade name ought to be proved for all products or services for which the bar is sought.²⁹

Where the reliance on applicable national law is proven, the test provided for in that law is applied.³⁰ This is usually a risk of confusion test³¹ but can also be a passing off test.³²

The lack of specific national law provisions with regard to protection of trade names and the unclear protection conferred by article 8 of the Paris Convention (cumulated with the doubts as to the horizontal effect of the latter’s provisions) has proven a high hurdle in the willingness to oppose prior trade names to the registration of later trademarks.

Thus, although the interpretation on assessment of the use in commerce and priority conditions seem to give trade names an advantage over trademarks, the “more than of mere local significance” criterion (only applicable where CTMs are concerned) and, even more so, the possibility to prohibit use of a later trademark criterion, seem to have deterred only but the most resolute from basing their attacks on trademarks on prior trade names.

It is equally true that the reverse also holds true: cases where owners of a prior trademark have sought to prohibit use of a later trade name appear to have been even more rare.

Also, neither the two Directives nor the two CTM Regulations have provided, expressly, that the rights conferred by the trademark would allow its owner to prohibit use of a later trade name.

The Court of Justice of the European Union was very clear in its analysis of the interference in this direction when, in *Céline*,³³ it held that such

interference would fall under the ‘regular’ scope of the rights of the trademark owner, provided by article 5 par. (1) of the Directives (corresponding to art. 9 par. (1) of the CTM Regulations), with four conditions to be cumulatively met: (1) the trade name was used in commerce; (2) the trade name was used without the consent of the trademark owner; (3) the trade name was used for products/services identical³⁴ to the ones the trademark was registered for; and (4) use of the trade name affects/is likely to affect the functions of the trademark, especially its essential function of guaranteeing to consumers the commercial source of the products/services.

“Use for products/services” was considered to include application of the trade name to products but also use in such a manner so as to establish a link between the trade name and the products/services marketed by the owner of the trade name.³⁵ The court did point out, however, that use for purposes other than distinguishing between products/services would fall under the provisions of article 5 par. (5) of the Directives.³⁶

Where article 5 par. (5) is deemed applicable, the EU courts have held that national law is wholly responsible for providing whether trademark proprietors can obtain redress from such use being made of later trade names.³⁷ AG Sharpston has argued, in her conclusions in *Céline*, that such protection can however only be afforded under national law “where use of the sign is without due cause and takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”³⁸

The above seem to show that, under the previous EU harmonized trademark regime, the possibility of a prior trademark owner to prohibit later use of a trade name was limited to situations where the trade name was used as a trademark (and therefore infringement was assessed under the ‘regular’ scope of trademark rights as per the provisions of article 5 par. (1)) or, if not the case, was wholly dependent upon specific

²⁸ CJEU, *Edwin Co. Ltd v OHIM (intervening: Elio Fiorucci)* (C-263/09), Decision of 5 July 2011 in *ECR* 2011-I, p. 5853, par. 50.

²⁹ TEU, *Fundação Calouste Gulbenkian v OHIM (intervening: Micael Gulbenkian)* (T-541/11), Decision of 26 June 2014 (unpublished), par. 43–44.

³⁰ TEU, *Olive Line International, SL v OHIM (intervening: Reinhard Knopf)* (T-485/07), Decision of 14 September 2011 in *ECR* 2011-II, p. 280, par. 56.

³¹ See TEU, *Fercal – Consultadoria e Serviços, Lda v OHIM (intervening: Jacson of Scandinavia AB)* (T-474/09), Decision of 24 January 2013 (unpublished) – confirmed by the CJEU (C-159/13), Order of 12 December 2013.

³² See TEU, *Tresplain Investments Ltd v OHIM (intervening: Hoo Hing Holdings Ltd)*, Decision of 9 December 2010 in *ECR* 2010-II, p. 5659.

³³ CJEU, *Céline SARL v Céline SA* (C-17/06), Decision of 11 September 2007 in *ECR* 2007-I, p. 7041.

³⁴ The court in *Céline* was tasked with analyzing infringement under article 5 par. (1) (a) of the Directives, which presupposes double identity. The same conditions (alongside the additional test for likelihood of confusion) would apply if article 5 par. (1) (b) was claimed under, as literature has suggested – the indicated authors arguing that activities indirectly related to products/services could be qualified as retail services and would require that the analysis be made pursuant to the provisions of article 5 par. (1) (b) anyway: Spyros Maniatis, Dimitris Botis *Trade Marks in Europe: A Practical Jurisprudence*, 2nd ed., Sweet & Maxwell (London – 2010), p. 521.

³⁵ CJEU, *Céline SARL v Céline SA* (C-17/06), Decision of 11 September 2007 in *ECR* 2007-I, p. 7041, par. 22, 23.

³⁶ *Idem*, par. 20.

³⁷ CJEU, *Robelco NV v Robeco Groep NV* (C-23/01), Decision of 21 November 2002 in *ECR* 2002-I, p. 10913, par. 35.

³⁸ Opinion of AG Sharpston in CJEU, *Céline SARL v Céline SA* (C-17/06), Opinion of 18 January 2007, par. 41.

additional protection being granted under national law, itself limited to those situations where use of the trade name was deemed to be made “without due cause” and “taking unfair advantage or being detrimental to the distinctive character/repute of the trademark”.

One could conclude that, under the previous trademark regime, interferences between trade names and trademarks were exceptional as a result of both law and practice and therefore trade names could be mostly left to the realm of theoretical research.

2.2. Trade names and trademarks in the new Trademark Directive

Given the above, publication of the new Trademark Directive³⁹ was akin to the finding of phosphene on Venus. Preamble 27 of the Directive includes the following statement: “In order to create equal conditions for trade names and trade marks against the background that trade names are regularly granted unrestricted protection against later trade marks.”

While the statement could hold true in theory (meaning that, should national law of the Member States provide for such protection, this would not be restricted under EU law), the statement by itself seems to suggest that, somehow, trade names had regained their “first among trademarks” status and became a strong right trademark applicants were facing against.

We could not identify the evidence for this in the *travaux préparatoires* of the Directive. In fact, the very identical proposition exists ever since the Proposal for the Directive was adopted by the European Commission on 27 March 2013.⁴⁰ The Commission indicates at its “Detailed explanation of the proposal” that, given the judgment of the CJEU in *Céline*, which held that “Article 5(1) of the Directive is applicable where the public considers the use of a company name as (also) relating to the goods or services offered by the company”, “It is therefore appropriate to treat trade name use of a protected trade mark as an infringing act, if the requirements of use for goods or services are met.”

Preamble 20 of the Proposal then goes on to state that “Infringement of a trade mark should also comprise the use of the sign as a trade name or similar designation as long as the use is made for the purposes of distinguishing goods or services as to their commercial origin.” Preamble 25 continues to the effect that “The exclusive rights conferred by a trade mark should not entitle the proprietor to prohibit the use of signs or indications which are used fairly and in accordance with honest practices in industrial and

commercial matters. In order to create equal conditions for trade names and trade marks against the background that trade names are regularly granted unrestricted protection against later trade marks, such use should be considered to include the use of one’s own personal name.”

The text of the Directive itself was proposed to be amended so as to specifically include “using the sign as a trade or company name or part of a trade or company name” as one of the infringing acts which can “in particular” be prohibited by the trademark proprietor and the amendment of the provisions on limitation of the effects of a trademark in what concerns use of the “own name” to specifically only apply in respect of the “personal name”.

These proposals were unchallenged during the legislative procedure and were incorporated with only minor alteration in the final text of the new Directive. One change that is notable (personal name was finally enacted as name of the third party, where that third party is a natural person) is the elimination of the reference to “distinguishing goods or services as to their commercial origin” in preamble 20, which has lost, in its final version, the “as to their commercial origin” part, thereby potentially opening the door to the finding of infringement where trademark functions other than the indication of commercial origin are deemed affected by use of the trade name. We believe that this possibility already existed, at least in theory, after *Céline*, as the fourth condition under the test there provided for required that use of the trade name affects/is likely to affect the functions of the trademark, *especially* its essential function of guaranteeing to consumers the commercial source of the products/services.

The Directive therefore appears to have codified existing case-law (the *Céline* criteria) in respect of the possibility of trademark owners to pursue use of later trade names where these later trade names are used (1) without the trademark proprietor’s consent, (2) in the course of trade, and (3) in relation to goods or services, provided that the additional conditions under article 10 par. (2) are also met.

The new Directive also makes clear that protection is also conferred vis-à-vis identical and similar trade names where the trade name is used for products/services that are identical, similar or different from those for which the trademark is registered but, in the latter case, only where the prior trademark “has a reputation in the Member State”, (2) use of that trade name is without due cause, and (3) that use takes unfair

³⁹ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, *OJL* 336/23.12.2015.

⁴⁰ European Commission, Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (Recast), (COM/2013/0162 final), 27 March 2013.

advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

The change to the limitations to the effects of trademarks is, however, a roll-back on the findings of the CJEU in *Anheuser-Busch*⁴¹ where the court held the limitation to also cover use of a trade name.

This has left, as literature has stated, a narrow, if at all existent space, for the holder of a trade name “to use the sign in an area where conflicts may occur.”⁴²

The modifications were also mirrored by the new European Union Trademark Regulation.⁴³

The changes reflect an enhancement to the position of earlier trademarks when in conflict with later trade names,⁴⁴ with some commentators also arguing that the inclusion of article 9 (3) d) to the EUTM Regulation would allow trademark proprietors to overcome the hurdle (which is said to have been common in practice) of having their claims dismissed because the trademark was not affixed to the infringing products/services.⁴⁵

No changes were however made to the position of earlier trade names when in conflict with later trademarks, probably stemming from the position reflected in the preambles that trade names were already “regularly granted unrestricted protection against later trade marks.”

As we believe that proposition to not reflect the situation in practice, we consider that the new harmonized regime has created an imbalance between trade names and trademarks by only enhancing the protection of earlier trademarks against later trade names and not also that of earlier trade names against later trademarks.

This imbalance can be corrected either by legislative action (i.e. by specifically regulating under national law proper means of protection of the right to trade names) or jurisprudentially (by limiting the scope of application of article 10 of the Directive, in its national transposition form).

Needless to say that the preferred option should be the former, given that limiting application of article 10 would be of little effect (the *Céline* test has already been applied as such by national courts and a limiting interpretation would go both against the text of the Directive and the clear intention of the legislator), could be unjustified when considered in relation to rights other than those to a trade name, and would do nothing to address the imbalance created by the exclusion of

trade names from the application of article 14. Last, but not least, it would be the expression of a negative creation of an equilibrium (i.e. it would bring trademark protection down in order to limit the imbalance between owners of trademarks and owners of trade names).

Legislating specific protection for trade names would create the desired level of protection for trade names with no encroachment on EU law, would leave protection of earlier trademarks at the enhanced level wished by the European legislator, would allow for unitary application of the law in practice and would create a positive equilibrium, by enhancing the level of protection of earlier trade names up to a position closer to that of earlier trademarks.

3. The comeback

We’ve shown how trade names, once deemed the ‘better twin’ of trademarks, have lost their mainstream appeal in the last century.

Never mentioned in the main pieces of EU trademark law, trade names have only exceptionally surfaced in the core case-law of the EU courts and in the main debates on industrial property. The courts seem to have been intent on keeping the interference between trade names and trademarks to a minimum which has also contributed to the relegation of trade names to the far background of the industrial property law debate of late.

Starting from an assumption that appears strange when considered in practice, the new EU trademark package enhances the protection of trademarks vs. trade names.

This enhancement was neither contested nor discussed in the procedure for the adoption of the new EU trademark laws.

The normal and best way to remedy such imbalance would be to specifically address trade name protection at the national level of the EU Member States. Specifically legislating the protection afforded to trade names is an obligation that most EU Member States have arguably undertaken by joining the Paris Union and then tacitly neglected for over 100 years. Maybe the transposition into national law of new EU trademark Directive will provide those states with the occasion to do so. Perhaps the long-forgotten twin of trademarks will make a comeback and retake its place.

⁴¹ CJEU, *Anheuser-Busch Inc. v Budějovický Budvar, národní podnik* (C-245/02), Decision of 16 November 2004 in ECR 2004-I, p. 10989, par. 80-81.

⁴² Annette Kur, Martin Senftleben, *European Trade Mark Law. A Commentary*, OUP (Oxford – 2017), p. 411.

⁴³ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark OJ L 154/16.06.2017.

⁴⁴ Raneer van der Straaten, „The risks of personal branding” in *IEFnl*, 26 September 2017, <https://www.ie-forum.nl/artikelen/raneer-van-der-straaaten-the-risks-of-personal-branding>, accessed on 7 May 2021.

⁴⁵ Eddie Powell, Michael Beaber, „IP Update – EU Trade marks” in *ILN IP Insider*, 17 May 2016, <https://www.ilnipinsider.com/2016/05/ip-update-eu-trade-marks/>, accessed on 7 May 2021.

Pessimists will say it's more likely that Venus become the focus of our planetary interests than Member States legislating trade name protection but then again, before phosphine was thought to have been

found less than a year ago, Venus hardly ever came up in discussions in the previous 50 years, so we could yet be surprised.

References

- Beall, Abigail, „Race to Venus: What we'll discover on Earth's toxic twin”, in Science Focus, 16 January 2020, <https://www.sciencefocus.com/space/race-to-venus-what-well-discover-on-earths-toxic-twin/>, accessed on 7 May 2021;
- Bozérian, Jules, Commentary on *Veuve d'Étienne-Beissel et fils v. Selckingham et Roger et Cie*, French Court of Cassation, 13 January 1880 - *Annales de la propriété industrielle, artistique et littéraire*, tome XXV/1880, pp. 126-132;
- Greaves, Jane S. and Richards, Anita M. S. and Bains, William and Rimmer, Paul B. and Clements, David L. and Seager, Sara and Petkowski, Janusz J. and Sousa-Silva, Clara and Ranjan, Sukrit and Fraser, Helen J., „Recovery of Spectra of Phosphine in Venus' Clouds” arXiv preprint arXiv:2104.09285 (2021);
- Kur, Annette, Senftleben, Martin, *European Trade Mark Law. A Commentary*, OUP (Oxford – 2017);
- Maillard de Marafy, Count of, „Rapport présenté au nom de la section des marques de fabrique et de commerce” in *Ministère de l'agriculture et du commerce, Congrès international de la propriété industrielle tenu a Paris du 5 au 17 septembre 1878*, Imprimerie Nationale (Paris – 1879);
- Maniatis, Spyros, Botis, Dimitris *Trade Marks in Europe: A Practical Jurisprudence*, 2nd ed., Sweet & Maxwell (London – 2010), p. 521;
- Powell, Eddie, Beaber, Michael, „IP Update – EU Trade marks” in *ILN IP Insider*, 17 May 2016, <https://www.ilnipinsider.com/2016/05/ip-update-eu-trade-marks/>, accessed on 7 May 2021;
- Redd, Nole Tayler, „Venus, once billed as Earth's twin, is a hothouse (and a tantalizing target in the search for life)”, in *Space.com*, <https://www.space.com/venus-earth-twin-evolution-life-search.html>, accessed on 7 May 2021;
- Tritton, Guy, Davis, Richard, Edenborough, Michael, Graham, James, Malynicz, Simon, Roughton, Ashley *Intellectual Property in Europe*, 3rd ed., Sweet & Maxwell (London – 2008);
- Van der Straaten, Rancee, „The risks of personal branding” in *IEFnl*, 26 September 2017, <https://www.ie-forum.nl/artikelen/rancee-van-der-straaten-the-risks-of-personal-branding>, accessed on 7 May 2021;
- *Ministère de l'agriculture et du commerce, Congrès international de la propriété industrielle tenu a Paris du 5 au 17 septembre 1878*, Imprimerie Nationale (Paris – 1879);
- Ms. O'Brien's Blog, „Shortest Distance from Planets to Earth”, <https://blogs.socsd.org/aobrien/science-2/curiosity-rover/shortest-distance-from-planets-to-earth/>, accessed on 7 May 2021;
- *Planetary News*, „Phosphine in Venus' Atmosphere Could Indicate Life in the Clouds”, https://www.lpi.usra.edu/planetary_news/2020/09/21/phosphine-in-venus-atmosphere-could-indicate-life-in-the-clouds/, accessed on 7 May 2021;
- CJEU, *Robelco NV v Robeco Groep NV* (C-23/01), Decision of 21 November 2002 in *ECR* 2002-I, p. 10913;
- CJEU, *Anheuser-Busch Inc. v Budějovický Budvar, národní podnik* (C-245/02), Decision of 16 November 2004 in *ECR* 2004-I, p. 10989;
- CJEU, *Céline SARL v Céline SA* (C-17/06), Decision of 11 September 2007 in *ECR* 2007-I, p. 7041;
- Opinion of AG Sharpston in CJEU, *Céline SARL v Céline SA* (C-17/06), Opinion of 18 January 2007;
- CJEU, *Edwin Co. Ltd v OHIM (intervening: Elio Fiorucci)* (C-263/09), Decision of 5 July 2011 in *ECR* 2011-I, p. 5853;
- CJEU, *Peek & Cloppenburg KG (Dusseldorf) v OHIM (intervening: Peek & Cloppenburg KG (Hamburg))* (C-325/13), Decision of 10 July 2014 (unpublished);
- TEU, *Galileo International Technology LLC et al v Commission of the European Communities* (T-279/03), Decision of 10 May 2006 in *ECR* 2006 II-1296;
- TEU, *Camper, SL v Office for the Harmonization of the Internal Market (OHIM), JC AB (intervening)* (T-43/05), Decision of 30 November 2006 in *ECR* 2006 II-95;
- TEU, *Alberto Jorge Moreira da Fonseca, Lda v OHIM (intervening: General Óptica SA)* (T-318/06-T-321/06), decision of 24 March 2009 in *ECR* 2009-II, p. 663;
- TEU, *Grain Millers, Inc. v OHIM (intervening: Grain Millers GmbH & Co. KG)* (T-430/08), Decision of 9 July 2010 in *ECR* 2010-II, p. 145;
- TEU, *Tresplain Investments Ltd v OHIM (intervening: Hoo Hing Holdings Ltd)*, Decision of 9 December 2010 in *ECR* 2010-II, p. 5659;
- TEU, *K-Mail Order GmbH & Co. KG v OHIM (intervening: IVKO Industrieprodukt-Vertriebskontakt GmbH)* (T-279/10), Decision of 14 September 2011 in *ECR* 2011-II, p. 283;
- TEU, *Olive Line International, SL v OHIM (intervening: Reinhard Knopf)* (T-485/07), Decision of 14 September 2011 in *ECR* 2011-II, p. 280;

- TEU, Conceria Kara Srl v OHIM (intervening: Dima – Gıda Tekstil Deri Insaat Maden Turizm Orman Urünleri Sanayi Ve Ticaret Ltd Sti) (T-270/10), Decision of 3 May 2012 ECLI:EU:T:2012:212;
- TEU, Fercal – Consultadoria e Serviços, L^{da} v OHIM (intervening: Jacson of Scandinavia AB) (T-474/09), Decision of 24 January 2013 (unpublished);
- TEU, macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie v OHIM (intervening: MIP Metro Group Intellectual Property GmbH & Co. KG) (T-579/10), Decision of 7 May 2013 (unpublished);
- TEU, Raffaello Morelli v OHIM (intervening: Associazione nazionale circolo del popolo della libertà and Michela Vittoria Brambilla) (T-321/11 și T-322/11), Decision of 14 May 2013 (unpublished);
- TEU, Fundação Calouste Gulbenkian v OHIM (intervening: Micael Gulbenkian) (T-541/11), Decision of 26 June 2014 (unpublished);
- TEU, Construcción, Promociones e Instalaciones, SA v OHIM (intervening: Copisa Proyectos y Mantenimientos Industriales SA) (T-345/13), Decision of 4 July 2014 (unpublished);
- OHIM, 1st Board of Appeal, *WIT-SOFTWARE, CONSULTORIA E SOFTWARE PARA A INTERNET MÓVEL, S.A. v CONSTRULINK, TECNOLOGIAS DE INFORMAÇÃO, S.A.* (R 1059/2013-1), Decision of 6 March 2014;
- *Veuve d'Étienne-Beissel et fils v. Selckingham et Roger et C^{ie}*, Paris Court of Appeals, 20 December 1878 in *Annales de la propriété industrielle, artistique et littéraire*, tome XXIII/1878, pp. 337-351;
- First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, OJ L 040/11.02.1989;
- Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, OJ L 11/14.01.1994, p. 1;
- Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, OJ L 299/8.11.2008;
- Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, OJ L 78/24.03.2009;
- European Commission, Proposal for a Directive of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (Recast), (COM/2013/0162 final), 27 March 2013;
- Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, OJ L 336/23.12.2015;
- Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark OJ L 154/16.06.2017.