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Trademark Law in the Technology-Driven Global Marketplace

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INTRODUCTION

¶1 The computer technology revolution is reshaping few, if any, areas of the law more than intellectual property law. In the first place, new technology by its nature tends to embody the various legal creatures now referred to as "intellectual property," such as patentable inventions, semiconductors protectable as mask works, copyrightable computer programs, know-how protectable as a trade secret, or trade identity symbols protectable under the trademark and unfair competition laws. In the second place, our new technology has enabled commerce and communication to be conducted by such new methods and at such unprecedented speeds that the new global marketplace is rendering national and even continental boundaries nugatory.

¶2 This challenges a global legal structure where trademark rights, the focus of this paper, are traditionally territorial. Subject to only a few exceptions, trademark rights generally must be acquired on a country-by-country basis. In the absence of a multilateral treaty which creates unitary rights among its signatories (such as the European Union Community Trade Mark), or the enforcement of a "well-known mark" under the Paris Convention, ownership of a trademark in one country does not imply ownership in another without satisfying the local prerequisites for acquiring such rights. Technology-enabled global commerce further challenges a territorial legal system in which the trademark laws and the outcomes of similar cases can vary significantly from country to country, as they do today. Reminiscent of the tractor-trailer mud flap rules which burdened U.S. interstate highway commerce in the past, these national differences can operate as barriers to the international free flow of goods.

¶3 In response to these challenges, individual nations and international organizations have taken initiatives to harmonize national trademark laws and to create new treaties to improve and standardize trademark protection internationally. Europe offers the best example of multilateral harmonization. For ten years now, the fifteen European Union member countries have been amending their national trademark laws to bring them into compliance with the European Trademark Harmonization Directive of 1989. That process is now essentially complete, and even some non-EU member countries such as Hungary,[1] desirous of joining the EU, have taken the progressive step of revising their trademark laws to bring themselves in line with European trademark standards. But even outside Europe, each year sees many individual countries either adopting a new, modernized intellectual property statute, or modernizing their trademark laws to comply with the evolving international norms. It is not insignificant that the World Trade Organization has added the pressure of trade sanctions to encourage lesser-developed countries to give better protection to the intellectual property rights of signatory countries, in compliance with TRIPs minimum standards.

¶4 In short, there is a lot of action on the international trademark front -- legislative, diplomatic and judicial -- and much of it is directly traceable to the technology revolution. This paper will attempt to provide some perspective by reviewing the major developments in multilateral trademark treaties and international trends, as well as some cases on certain recurring issues: parallel importation; the protectability of a 3-D product design as a trademark; the role of reputation in trademark infringement; and the protection of well-known marks - all against the backdrop of whether the law is respecting or ignoring the realities of the marketplace.

TRADEMARK TREATIES AND INTERNATIONAL TRENDS

¶5 ***Paris Convention.*** The oldest and perhaps most important international treaty with significant trademark provisions is the Paris Convention for the Protection of Industrial Property (1883). To date, 160 countries have signed the Paris Convention,[2] including the following recent signatories in 1999 - 2000: Botswana, Cambodia, Dominica, Ecuador, Grenada, Guatemala, Laos, Mozambique, Oman, Papua New Guinea and Sao Tome and Principe. India joined as recently as 1998.

¶6 Article 4C of the Paris Convention provides a six-month filing priority period that starts running upon the first filing of a trademark application in a Convention country. Within that period, the applicant may file corresponding applications (same applicant, same mark, same goods) in other Convention countries and claim as the filing date the first, or "priority", filing date. This can be important because in foreign countries the filing date of an application usually establishes priority for dispute purposes.

¶7 Article 6*bis* of the Paris Convention is extremely important to trademark owners who discover adverse applications or registrations in Convention countries where they do not have their own prior application or registration. Under this Article, the owner of a "well-known mark" can oppose such adverse applications even if it does not have rights of record in that country. Since the Paris Convention does not contain details or standards for determining which marks qualify as "well-known", there are inconsistent decisions on this around the world. To achieve more clarity and uniformity, the World Intellectual Property Organization ("WIPO") in Geneva, Switzerland, has taken the initiative to formulate standards that eventually will be the subject of a diplomatic conference intended to embody them in a new treaty or perhaps a protocol to the Paris Convention.

¶8 WIPO has proposed the following non-exhaustive guidelines for determining whether a mark is well known in a member state:

1. The degree of knowledge or recognition of the mark in the relevant sector of the public;
2. The duration, extent and geographical area of any use of the mark;
3. The duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
4. The duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
5. The record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities; and
6. The value associated with the mark.[3]

¶9 Under Article 6*septies* a trademark owner has the right to oppose an unauthorized application to register its trademark by its agent or representative, another important protection. Finally, under Article 8 of the Paris Convention, trade names are protected without the need to be registered, and thus can form an additional basis for opposition. There are many other important provisions in the

Paris Convention, but those discussed above are the most useful in opposing adverse applications and registrations.

¶10 ***Trademark Law Treaty.*** The Trademark Law Treaty ("TLT") is another harmonization initiative of WIPO. Concluded at a diplomatic conference in Geneva in October of 1994, the TLT reduces red tape and simplifies trademark filing procedures. The TLT is an "anti-harassment" treaty, in that it minimizes the potential for member nations to harass trademark owners by imposing cumbersome and expensive filing, renewal and maintenance information and documentation requirements. Twenty-six countries have signed the TLT to date,[4] with U.S. implementation having taken effect on October 30, 1999. To ameliorate burdens on the less-developed countries in revamping their trademark systems, the TLT provides for phase-in periods for those countries of up to ten years.

¶11 ***Madrid Agreement and Madrid Protocol.*** The Madrid Agreement of 1891 has 61 signatories.[5] It provides for obtaining an "International Registration" on the "International Register" maintained by WIPO in Geneva, which can be extended to member countries. The terminology is misleading, however, since this is really just a multi-jurisdiction filing mechanism. After the filings, the applications are subjected to national processing and examination in the usual manner. Thus an "International Registration" is not a unitary registration that covers multiple countries, like a European Community Trade Mark registration, nor is it procured by an application subject to a single, unitary examination process.

¶12 The other major trademark treaty that is currently in the process of garnering signatories is the Madrid Protocol. The United States never adhered to its predecessor, the Madrid Agreement of 1891, because of its built-in bias in favor of the European "deposit" countries over examination systems. A home country registration was required in order to take advantage of Madrid's "international registration" procedure, and most European nationals could get a home-country registration faster and with less scrutiny than U.S. nationals. However, that problem and other objectionable features (such as central attack, where all the extensions fall if the basic registration is successfully attacked) were eliminated or ameliorated in the "new and improved version," the Madrid Protocol, which has been signed by thirty-nine countries thus far.[6] Although the U.S. trademark community seems to be united in favor of joining the Madrid Protocol,[7] an unanticipated diplomatic problem over voting rights, having nothing to do with trademark law, has prevented the United States from joining so far. The Madrid Agreement and Protocol jointly create an Assembly of signatories who have voting rights on amendments to the treaty. Intergovernmental organizations such as the European Unions have a vote in addition to the fifteen votes of their individual members. Thus, the EU would have a sixteenth vote in addition to the individual votes of its fifteen members. This has been unacceptable to the U.S. State Department as a matter of principle and for some time created an impasse on Madrid.

¶13 There seemed to be a breakthrough in August, 2000, when an agreement was reached whereby the EU would have its sixteenth vote, but agree to consult with the U.S. in the event it was ever necessary to exercise it, but now a new problem has materialized. Pernod-Ricard brought a dispute to the U.S. courts over the trademark HAVANA CLUB.[8] Pernod-Ricard purchased that brand from the Cuban government, which apparently had illegally seized it from the prior owners. The prior owners sold the brand to Bacardi, which lobbied the U.S. Congress to enact Section 211 of the Omnibus Consolidated and Emergency Supplemental Appropriations Act, which prohibits the U.S. courts from protecting trademarks in confiscation cases without getting the consent of the original owners. The Second Circuit ruled in Bacardi's favor, but the larger controversy is still unsettled, as the EU has sued the United States before the World Trade Organization ("WTO") for enacting discriminatory legislation in violation of the WTO Trade Related Intellectual Property ("TRIPs") provisions.[9] Although the Madrid Protocol has already passed the House, this WTO dispute is holding up Senate approval based on strained relations with the European Union.

¶14 ***Pan-American Convention.*** The Pan-American Convention of 1929 is another important treaty that contains significant trademark protection provisions. Its contracting parties are Bolivia, Brazil, Chile, Colombia, Costa Rica, Cuba, Dominican Republic, Ecuador, Guatemala, Haiti, Honduras, Mexico, Nicaragua, Panama, Paraguay, Peru, United States, Uruguay and Venezuela. Like the Paris Convention, the Pan-American Convention contains useful provisions for opposing (Article 7) or canceling (Article 8) adverse applications or registrations, where the moving party's mark is previously registered or used in a contracting country. Article 12 protects the trademark owner against registration of its mark by its agent, representative or customer. Article 14 protects trade names, irrespective of registration, and Article 15 even protects individual names and surnames.

¶15 ***Cargtagena Agreement / Andean Community.*** In 1969 the Cartagena Agreement was signed among Bolivia, Colombia, Ecuador, Peru and Venezuela, as a ten-year customs convention. It was renewed from time to time and decisions rendered by the governing Andean Commission became the framework of Andean Community trademark law. Since 1993 Decision 344 of the Andean Community had stated the rule structure. That decision has just been superceded by Decision 486, which is a very comprehensive and modern trademark rule structure. It became effective December 1, 2000.

¶16 Decision 486's most important features include: (a) eliminating the definitional requirement that registrable marks must be "perceptible by the senses"; (b) requiring a specific list of goods or services and prohibiting the reference to "all goods in the class"; (c) allowing more flexibility in the amendment of applications; (d) allowing registration of marks based on acquired secondary meaning; (e) replacing "observations" with "oppositions"; (f) retaining opposer's right to rely on rights in another Andean Community country, provided it files a local application to demonstrate its interest in the mark; (g) extending anti-dilution protection to notorious marks; and (h) maintaining international exhaustion of rights.[10]

¶17 ***USTR Special 301.*** Pursuant to its statutory mandate, the U.S. Trade Representative continues to monitor foreign countries under the U.S. Special 301 provisions of the Trade Act of 1974 to determine whether U.S. trading partners deny adequate and effective protection to U.S. companies' intellectual property rights. Last year, the USTR kept China and Paraguay on the list for monitoring, placed sixteen countries on the Priority Watch List,[11] and thirty-nine others countries on the Watch list.[12]

¶18 ***Domain Name Disputes.*** Disputes over Internet domain names have become an extremely hot area of activity, and to do it justice would require a separate paper. Suffice it to say, for purposes of this overview, that WIPO has again taken laudable initiative towards achieving a global rule structure for dealing with this difficult and rapidly-changing area of disputes. WIPO has constituted and made available a panel of arbitrators to decide disputes under the Internet Corporation on Assigned Names and Numbers ("ICANN") Uniform Dispute Resolution Policy ("UDRP"). While the UDRP primarily applies to generic top level domain disputes in the United States, some of the cctld (country code top level domain) registrars have accepted the UDRP.[13] In other countries, resolving domain name disputes will require resort either to the courts or alternative local dispute resolution mechanisms.

SELECTED CASE STUDIES

¶19 Despite the efforts toward international trademark law harmonization, however, not all countries around the world treat the same trademark issues the same way. Some of the similarities and differences are revealed by reviewing recent cases involving parallel imports, 3-dimensional and design trademarks infringement standards, and the treatment of well-known marks.

PARALLEL IMPORTATION

¶20 Parallel import cases always involve a delicate balancing act between trademark and free trade rights, and representative recent cases from the Pacific Rim, Europe, and South America are examined below. The local trademark owner eventually prevailed in two of the three cases, but under considerably different circumstances and with quite different policy consequences.

¶21 Parallel imports (called "gray market goods" when the trademark owner does not itself import the products) are genuine trademarked goods, lawfully purchased in a second country but imported into the subject country without the trademark owner's authorization. Parallel importers engage in this business because they can make a profit buying authentic products (usually bearing a trademark of some repute) in one market at a low price, then shipping and reselling them in a second market where the same goods bear a higher price. Thus, the parallel importer competes with the trademark owner's own marketing and distribution network.

¶22 Trademark owners contend parallel importers undermine their investments in distribution and product support networks, and infringe their trademark rights. Parallel importers say it is simply not a trademark problem, because the resale of authentic goods deceives no one, and merely evens out the trademark owner's international price discrimination. Hence, the conflict between trademark owners and parallel importers recurs in many jurisdictions.

AUSTRALIA

¶23 In *Montana Tyres Rims & Tubes Pty. Ltd. v.Transport Tyre Sales Pty. Ltd.,*[14] the Japanese tire manufacturer, Ohtsu, assigned its Australian trademark registrations to its Australian distributor, Transport Tyres, to enable it to stop parallel imports by Montana. Ohtsu reserved an option to re-acquire the marks. Transport Tyres then sent Montana a cease-and-desist letter objecting to its importation of authentic Ohtsu tires purchased in Singapore. Montana filed suit to invalidate the trademark assignment, and Transport Tyre counterclaimed for trademark infringement.

¶24 Under prior case law, such an assignment had been held valid where the distributor had developed its own reputation under the mark. Here, however, the trial court found that the marks were associated only with the manufacturer. Furthermore, Ohtsu retained the right to re-acquire the registrations and had taken no action to publicly dissociate itself from the marks. The court held that Transport Tyre's ownership and use of the marks were therefore fraudulent. The court canceled the assignment, and restrained Transport Tyre from threatening to bring legal action against any other person for infringement of the Ohtsu trademarks.

¶25 On appeal, the appellate court found the assignment valid but still held there was no trademark infringement because Ohtsu exhausted its rights when it sold the tires in Singapore. However, the court did not address the issue of the validity or invalidity of the assigned marks, in the hands of Transport Tyre, after the assignment was recorded.[15] Australian commentators have speculated that both would have been held invalid if the court had reached the issue.[16]

EUROPEAN UNION

¶26 In *Silhouette International Schmied GmbH v. Hartlauer Handelsgsesellschaft GmbH,*[17] the European Court of Justice ("ECJ") decided in favor of an Austrian trademark owner in an important application of the exhaustion doctrine. Under that theory, as noted above, a trademark owner's right to stop sales of goods bearing its trademark are exhausted when the trademark owner, or someone else with its authorization, has first sold the subject trademarked goods, the resale of which it then tries to stop by asserting its trademark rights. Unlike the Australian case discussed above, the court held trademark rights are exhausted when the first sale is within the European Union, but not when the first sale is outside the EU. In short, the court found EU exhaustion but not international exhaustion.

¶27 Silhouette, an Austrian company, sold high-fashion spectacles through a network of subsidiaries and distributors, and owned trademark registrations of SILHOUETTE in Austria and elsewhere. Hartlauer sold inexpensive spectacles through its own subsidiaries in Austria. Silhouette's policy was not to sell to Hartlauer for distribution because it believed that would compromise its top-end, high fashion reputation.

¶28 In 1995, Silhouette sold some out-of-date spectacles to a Bulgarian company with instructions to resell them only in the former Soviet Union countries. Hartlauer bought those spectacles in Bulgaria, and imported them back into Austria for resale under the authentic SILHOUETTE brand. Silhouette sued Hartlauer in Austria for trademark infringement. Hartlauer argued Silhouette's trademark rights were exhausted by its first sale of the authentic goods to the Bulgarian company, and that Hartlauer was perfectly entitled to resell its lawfully-acquired genuine goods in Austria.

¶29 Article 7(1) of the European Harmonization Directive provides:

1. The trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Community under that trade mark of the proprietor or with his consent.

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

Silhouette argued its rights were not exhausted because the Directive provides for exhaustion only when the first sale is made within the European Economic Area ("EEA")[18] by the trademark owner or with its consent, and the first sale Silhouette made was in Bulgaria, outside the EEA. Hartlauer argued there is no restriction in Article 7 preventing the goods' importation into the EU, that Austria was within its discretion to apply a principle of international exhaustion of rights, and the case should therefore be dismissed.

¶30 The Austrian Court, Oberster Gerichstot, referred to the European Court of Justice ("ECJ") the question of whether Article 7 of the Directive entitles the trademark owner to enjoin use of the registered mark on goods which that trademark owner first sold, under that mark, outside the European Union. In other words, does the Harmonization Directive, which expressly permits EEA exhaustion, allow member states to go further and apply a rule of international exhaustion?

¶31 The ECJ held the Directive does not permit member states to deny relief for trademark infringement based on a principle of international exhaustion of trademark rights and a first sale outside the European Union. It relied not on the express terms of the Directive, which do not expressly preclude international exhaustion, but rather the policy and purpose of the Directive that trademarks should enjoy the same scope of protection under the legal systems of all the member states. Absent harmonization, some member states would be allowed to impose international exhaustion while others did not, thus resulting in trade barriers within the market and promoting price differentials between member states.

¶32 The ECJ held it is fully permissible for a member state to rely on trademark registrations to prevent importation of genuine trademarked goods into the European Union from outside the European Union. Under this case, no principle of international exhaustion of rights exists, and it is contrary to EU law for national courts to decide otherwise. Even though the glasses were genuine goods, placed on the market with the consent of the trademark owner in Bulgaria, it is now

European law that they cannot be imported into EU countries where the trademark proprietor has national registrations, without its consent.

¶33 Subsequent to its decision in Silhouette, the ECJ applied the same reasoning and reached a similar result in *Sebago Inc. v. GB-Unic SA*.[19] In this case Sebago sued GB-Unic for selling in Benelux shoes bearing the Benelux-registered marks SEBAGO and DOCKSIDES purchased outside the EEA. GB-Unic tried to circumvent the ruling of *Silhouette,* and to argue Sebago's rights were exhausted, because Sebago had consented to the marketing of such shoes *by others* within the EEA. But the ECJ held Sebago's rights were not exhausted as to the shoes sold by GB-Unic just because Sebago had consented to the sale of similar shoes in Benelux by others.

¶34 These European decisions respect marketplace realities, as the old SILHOUETTE spectacles sold through Bulgaria probably would indeed have compromised Silhouette's upscale reputation in Austria, and Sebago did not completely waive its right to control importation by giving its limited consent in one case. Exhaustion remains a very important and controversial issue in Europe, however, and subsequent to the *Silhouette* decision, the European Commission (DGXV) undertook a study of the economic consequences of that decision and of alternative models of exhaustion policy, studying both sides of the issue. [20]

ANDEAN PACT

¶35 A recent Andean Community Court of Justice case involved analogous policy issues of trademark rights versus free trade, even though it was not a true parallel import case, because it did not involve the authentic goods of the single trademark owner. The court came down on the side of the local trademark owner, but under circumstances that seem unfair to the importer.

¶36 The Andean Pact includes the five signatories to the Cartagena Agreement, Bolivia, Colombia, Ecuador, Peru and Venezuela. Like the European Union, the Andean Pact embraces the principles of promoting the free flow of goods, and harmonizing trademark law within the community. In *Cigarrera Bigott C.A. v. Philip Morris re: BELMONT cigarettes*,[21] the Andean Community Court of Justice had to balance trademark rights against free trade rights.

¶37 The Venezuelan subsidiary of British American Tobacco ("BAT"), Cigarrera Bigott C.A., had been selling its BELMONT cigarettes in Venezuela for some time, had acquired a significant reputation as the leading brand in Venezuela, and owned a Venezuelan trademark registration of BELMONT. Believing it was acting in accordance with Andean Community rules, BAT began exporting its BELMONT cigarettes to Ecuador, where a Philip Morris subsidiary was the registered owner of the BELMONT trademark. Philip Morris had exported BELMONT cigarettes out of Ecuador (which was sufficient to defend its trademark registration against a non-use challenge) but had not used the mark in Ecuador itself. Philip Morris sued and the court enjoined BAT from using BELMONT in Ecuador.

¶38 Offended by the issuance of the injunction, the government of Venezuela sued the government of Ecuador, alleging Ecuador's ruling violated Article 107 of Decision 344, the basic intellectual property rule structure in the Andean Community, and unduly restricted the free flow of goods contrary to Community policy. Andean Community Decision 344, Article 107, paragraph 3, provides:

> In any case, imports of a product or service which is found in the situation described in paragraph one of this article shall not be prohibited ***when*** the trademark is not being used in the importing country's territory . . . except if the holder of said trademark proves to the competent national office that the non-use of the trademark is due to justified causes. (emphasis added).

The Andean Community Court of Justice ruled in favor of Ecuador and Philip Morris, holding that BAT's exports to Ecuador were legitimate only so long as Philip Morris did not use the BELMONT mark in Ecuador. However, as soon as Philip Morris began using the mark in Ecuador, BAT's exporting BELMONT into Ecuador became an infringement. In effect, it held the statutory term "when" meant "only as long as."

¶39 The problem, of course, was that Philip Morris had developed no goodwill in Ecuador because it had not sold any BELMONT cigarettes in Ecuador. BAT, relying on the seemingly plain language of Article 107, launched its BELMONT brand in Ecuador and began to develop goodwill through those sales. The policy of protecting legitimate business and legal expectations would have dictated that if BAT's initial sales into Ecuador were lawful, its subsequent sales there would be equally lawful. However, the court's decision allowed Philip Morris to wait in the wings for BAT to start developing goodwill, and then stop it from using the BELMONT brand so that Philip Morris could step in and capitalize on it. This result is contrary to the policy of promoting legitimate expectations, and creates uncertainty and instability. It also escalates a paper trademark registration above goodwill in the marketplace, and for that reason completely ignores marketplace realities.

3-DIMENSIONAL TRADEMARKS

¶40 As in the United States, trademark rights are often asserted abroad in product shapes, and the cases raise recurring issues of functionality and distinctiveness. Do the product shapes serve a trademark purpose of indicating origin? Are the shapes unprotectable under the trademark laws because they are dictated by a functional engineering design? Does protecting the shape unduly hinder competition in production of the subject type of product? If the marks are protectable, what are the standards for determining likelihood of confusion? Several cases on point will be examined below.

¶41 A.I.P.P.I. has recently concluded an extensive study of whether and to what extent trademark rights and design patent or industrial design rights can coexist. Approximately forty national group reports summarizing the local legal position, a summary report, and the A.I.P.P.I. resolution adopted at the Executive Committee Meeting in Sorrento, Italy, in March of 2000 can be found online at the A.I.P.P.I. web site.[22]

AUSTRALIA / UNITED KINGDOM

¶42 These issues are illustrated by the decisions in recent litigation over electric, rotary cutting-head shavers between Philips and Remington in the United Kingdom, *Philips Electronics v. Remington Consumer Products*,[23] and Australia. Australia has its own trademark law, though as a British law "Commonwealth" country, its laws closely parallel those of the United Kingdom and its courts routinely rely on British decisions as persuasive or authoritative, especially when there is no Australian court decision directly on point.

¶43 In separate actions in Australia and the United Kingdom, Philips, the first seller and market leader, sued Remington, the later comer, for infringing its alleged trademark rights in the cutting head shape of its electric shavers. Philips ultimately lost in both jurisdictions for similar reasons, mainly the functionality of the alleged mark and the finding that the defendant's sale of a shaver with a very similar cutting head design was not the infringing use of a trademark.

¶44 In 1966, Philips introduced an electric shaver with a triangular face plate containing three rotary cutting heads within the points of the triangle. Philips's product was very successful and it captured the entire market in men's rotary shavers in the United Kingdom and held it until 1995, when Remington started selling a similar product. Philips showed a picture of its shaver in its advertising and on its boxes through the years, along with Philips's PHILI-SHAVE trademark. Philips also registered a picture of its shaver head configuration as a trademark in the U.K., and claimed it had acquired distinctiveness and notorious fame in that mark. Both parties and the court treated the trademark registration as covering a three-dimensional shape.

¶45 Remington counterclaimed for expungement of Philips's registration, on grounds it failed to comply with various requirements of the European Harmonization Directive, including:

- it did not satisfy the requirements of section 1 (1)/Art. 2, providing:

  A trademark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings;

- the trademark was devoid of distinctive character, contrary to Art. 3.1(b) Sec. 1b;

- the trademark consisted exclusively of a sign or indication which serves to designate, in trade, the kind or intended purpose of the goods, contrary to Art. 3.1(c);

- the trademark fell within one or more of the categories of non-registrable subject matter listed in Art. 3.1(e), Sec. 3(2)(a) to (c), which provides: The following shall not be registered or if registered shall be liable to be declared invalid: . . . signs which consists exclusively of:

  1. the shape which results from the nature of the goods themselves, or
  2. the shape of goods which is necessary to obtain a technical result, or
  3. the shape which gives substantial value to the goods

¶46 Philips argued to defend its mark as non-functional, since shavers can be successfully sold and used in many shapes that do not have three heads arranged in an equilateral triangle on a face plate. In fact, Philips itself had produced other shavers with one and two shaving heads.

¶47 On the distinctiveness issue, Philips relied on its extensive advertising, using pictures of its triple shaving heads, and on testimony from members of the general public and traders in electric shavers. However, that evidence generally indicated the triple-head design was viewed as showing how the shaver worked, rather than its origin with Philips.

¶48 Thus, the critical issues in the case were functionality and distinctiveness. The court ultimately held trademark protection was precluded because the subject design was, in U.S. legal terms, functional. In British terminology, the court held Philips was not entitled to a "monopoly" of a desirable form of product manufacture, namely three headed rotary shavers in which the heads are arranged in an equilateral triangle. The court also found the registered mark lacked distinctiveness.

¶49 The court held, *inter alia*, the registered mark was functional because it failed the test which asks "in substance does the shape solely achieve a technical result?" Since the shape was the "business end" of the shaver and has a "shaving shape", the shape solely achieved a technical result.

¶50 Regarding distinctiveness, the court conceded Philips's trademark conveyed a message, and therefore was within the definition of a sign, namely "anything which could convey information as long as it is capable of being represented graphically." However, it concluded the three headed shaver was incapable of distinguishing the goods of Philips from those of others and was thus devoid of distinctive character. The court noted the evidence showed the sign conveyed to the consumer that there was a three-headed rotary shaver, not that it was a Philips shaver. The court found that the rotary head mark primarily denoted function and could never denote shavers made by Philips and no one else.

¶51 The court held that the trademark was not distinctive because it was simply a three-dimensional representation of a three-dimensional functional object, with no capricious additions that served in trade to designate the kind of goods for which it was registered and the intended purpose of the goods.

¶51 The court acknowledged that its decision was at odds with a recent Swedish decision holding the same Philips shape was not exclusively necessary to achieve a technical result because there were other configurations of cutting heads that worked. Given the court's interpretation of the customer and trade testimony, and the finding that Philips's advertising of the shape did not really effectively indicate source, the decision seems in harmony with the realities of the marketplace. The case is on appeal to the European Court of Justice on several questions of interpretation of the Trademark Harmonization Directive.

¶52 In *Philips Electronics v. Remington Consumer Products*,[24] Philips fared better at first in the same dispute in Australia, where the court granted Philips a preliminary injunction pending a full trial on the merits, but came out with the same result as in the U.K. after a full trial on the merits.

¶53 The Australian Trade Marks Act of 1995 allows registration of product shapes and packaging, sounds, colors and scents as trademarks, but only when those product and service features are capable of functioning as a trademark. Features of particular products must perform, or at lease must be capable of performing, a trademark function. In order for a product feature to function as a trademark, it must be capable of distinguishing products or services of one business from those of others in the same or a similar field of activity. In other words, the trademark must indicate a unique trade origin.

¶54 Philips sought an interlocutory injunction to restrain Remington from selling, advertising for sale or promoting or marketing its rotary electric shavers, which were of course similar to Philips's products. The court granted the injunction because it found there existed serious questions of trademark infringement, namely whether the shape of Remington's shaver is substantially identical with, or deceptively similar to, Philips's shaver; whether the shape is decorative or functional; and whether Remington engaged in passing off by selling a product similar to Philips's product, even though it was clearly marked with Remington's mark.

¶55 However, after the trial was held in December, 1998, a decision on the merits adverse to Philips was entered on June 18, 1999.[25] The court found the Philips shape did not denote origin, and that there were sufficient differences between the products of the parties to preclude infringement. Philips appealed on the limited question whether Remington's two-dimensional packaging depicting the alleged three-dimensional Philips mark, but was unsuccessful.

¶56 With respect to whether the Australian and British decisions in this litigation respect marketplace realities, it must be observed that the party asserting trademark rights in a product feature that operates as a part of the product carries a heavy burden indeed. Like a descriptive word that acquires trademark significance through extensive advertising and promotion and public recognition as a symbol of source, it is of course possible for a product feature to acquire trademark significance, but not easy. In these electric shaver cases, it is hard to say the court decisions finding a functional, operating product feature not to be a trademark are wrong in terms of the ordinary perceptions of purchasers and users of those products, and thus they would seem to be in accord with the realities of the marketplace.

NEW ZEALAND

¶57 In *Bluebird Foods Ltd. v. Cerebos Greggs Ltd.*,[26] Bluebird Foods Ltd. ("Bluebird") had sold a multi-grain snack cracker under the trademark GRAINWAVES for about five years. The cracker has a distinctive corrugated shape. Bluebird spent nearly $1 million (NZ) in advertising and promoting the product, and sales in New Zealand were about $6 million (NZ) in 1998. Cerebos Greggs Ltd. ("Cerebos") launched a competing multi-grain cracker, under the mark MEXICAN WAVES, with a very similar corrugated shape.

¶58 Bluebird sought an injunction to restrain passing off and misleading or deceptive conduct through adoption of MEXICAN WAVES and the corrugated shape, claiming that there was likelihood of confusion that the public would confuse MEXICAN WAVES as a product or sub-product of Bluebird's GRAINWAVES. Bluebird argued that once the chips were served to the public in a bowl outside the packaging, there was a particularly strong risk that the public would think that the snacks were either GRAINWAVES or were at least associated with them, thus evidencing post-sale confusion. Bluebird submitted surveys which showed that 75% of consumers presented with MEXICAN WAVES in a bowl identified them as GRAINWAVES.

¶59 Cerebos argued the differences in packaging precluded confusion at the point of sale, and that to grant relief to Bluebird would confer impermissible monopoly rights. The court granted an interim injunction pending full resolution of the issues at trial. The court reasoned "the defendant's product can be seen as piggy backing on the plaintiff's and the reputation which the plaintiff has established for it in the snack food market."

¶60 Even though this was only an interlocutory decision, the court gets high marks for taking commercial realities into account by considering consumer surveys, and all the facts and circumstances surrounding the purchasing and post-purchase consumption environments.

REPUTATION, FAME AND WELL KNOWN MARKS

CANADA

¶61 *United Artists Corp. v. Pink Panther Beauty Corp.*[27] explores the familiar issue of whether the owner of a well-known trademark can stop the adverse registration of that mark for different and quite unrelated goods and services.

¶62 United Artists ("UA") produced the popular series of Peter Sellers "Pink Panther" films, owns the Pink Panther cartoon character, and owns the registered PINK PANTHER trademark in Canada for "phonograph records, motion picture films, film leasing and distribution services, entertainment services by means of motion picture films." UA opposed an adverse application by the Pink Panther Beauty Corporation to register PINK PANTHER for "hair care and beauty product supplies and the operation of a business dealing in the distribution of hair care and beauty product supplies, and instructing and educating others in the distribution of beauty products and hair care supplies."[28] However, the Trademark Registrar dismissed the opposition[29] and UA appealed to the Federal Court of Appeal.[30]

¶63 The court stated the issue as whether there is a likelihood of confusion in the mind of the average consumer, as between United Artists's mark and Pink Panther Beauty Supplies' mark, with respect to the goods and services. Unlike the United States, Canada has no "dilution" statute. The court held no such likelihood existed, given the "gaping divergence in the nature of the wares and in the nature of the trade."[31] The court held that because the applicant's mark did not appear with any design or music, a reasonable average person would not confuse their proposed mark with that of United Artists'.[32]

¶64 The dissent disagreed on the ground that the majority's decision "launches trademark protection down a slippery slope which will result in the protection of famous names in only the very clearest of cases."[33] The dissent maintained that, "There are many other feline animals the Appellant could have chosen for its business, but instead of choosing one of these, the Appellant chose the very famous name, PINK PANTHER . . . this [decision] tips the balance too far in favor of the copycat artist seeking to profit financially from someone else's creative fortune."[34]

¶65 This decision limits the protection accorded to famous trademarks to garden-variety infringement cases where there is a connection or similarity in the products or services in association with the famous trademark and newcomer's trademark. The Canadian Supreme Court has granted an appeal, but it was discontinued during its pendency by the appellant.

EUROPEAN UNION

¶66 The European Court of Justice provides a contrasting approach and conclusion in another case involving similar marks but dissimilar goods and services, *Canon K.K. v. Metro-Goldwyn-Mayer, Inc*.[35]

¶67 In 1986, Metro-Goldwyn-Mayer, Inc. ("MGM") applied to register CANNON in Germany for films recorded on video tape cassettes (video film cassettes); production, distribution and projection of films for cinemas and television organizations. Canon K.K. ("Canon") opposed the application on the ground that under the Warenzeichengesetz (former German Trade Mark Law, hereinafter "WZG"), CANNON infringed its earlier registration of CANON for still and motion picture cameras and projectors; television filming and recording devices, television retransmission devices, television receiving and reproduction devices, including tape and disc devices for television recording and reproduction. The first examiner found the two marks similar and refused registration of CANNON; the second examiner set aside the decision and dismissed the opposition for lack of similarity. Canon appealed the dismissal of its opposition.

¶68 The Bundespatentgericht (German Federal Patent Court) dismissed Canon's appeal, holding that there was no similarity within the meaning of the WZG. It held similarity could exist only where the goods or services were so similar that the average consumer might believe they were manufactured by the same company. Canon appealed this decision to the Bundesgerichtshof which then certified the following question to the European Court of Justice:

> May account be taken, when assessing the similarity of the goods or services covered by the two marks of the distinctive character, in particular the reputation, of the mark with earlier priority (on the date which determines the seniority of the later mark), so that, in particular, likelihood of confusion within the meaning of Art. 4(1)(b) of the Directive must be taken to exist if the public attributes the goods and/or services to different places of origin?[36]

The Bundesgerichtshof noted that CANNON and CANON are pronounced the same, that CANON has a reputation, but that public perception is that video film cassettes and video recorders do not come from the same manufacturer.

¶69 Canon, supported by representatives of France and Italy, argued the reputation and distinctive character of the earlier trademark must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion. MGM and representatives for the U.K. argued to the contrary, that similarity between goods and services must be assessed objectively and independently, and no account should be taken of the distinctive character or reputation of the earlier mark.

¶70 The ECJ held for Canon on the issue, ruling the reputation and distinctive character of the earlier trade mark must be taken into account when determining likelihood of confusion. There may be a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive even when the public perception is that the goods or services have different places of production. However, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking. Significantly, the court found that the more distinctive the earlier mark is, the greater the risk of confusion. Since protection of a trade mark depends, in accordance with Art. 4(1)(b) of the Directive, on there being a likelihood of confusion, marks with a highly distinctive character, either *per se* or because of their reputation, enjoy broader protection than marks with a less distinctive character. The court therefore held that registration of a trademark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark is highly distinctive.

¶71 MGM and U.K. representatives argued that this interpretation would prolong the registration procedure. However, the court held that even if it did prolong the registration process, the rule should still be adopted because it is necessary to prevent registration of conflicting trademarks.

¶72 The CANON decision should be applauded in the sense that it respects and takes into account marketplace realities, including the important fact of a strong reputation in the marketplace.

¶73 Another recent case in the interplay between likelihood of confusion and likelihood of association under European trademark law and the standards for determining trademark conflict, is *Lloyd Schuh-fabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*[37] The debate has been over whether likelihood of association is a sub-species of likelihood of confusion, or a separate phenomenon and legal test. Many lawyers in the Benelux countries, from whose trademark law the risk of association concept originated, argued it was separate and distinct from likelihood of confusion. However, the European Court of Justice in *Sabel v. Puma*[38] held likelihood of association is essentially a sub-species of likelihood of confusion and is not actionable in the absence of the likelihood of confusion

¶74 This case arose in the German courts, and involved a challenge by the owner of the trademark LLOYD for shoes to the use of the mark LOINT'S for shoes and footwear. The ECJ was asked to elaborate on the factors to be considered in determining likelihood of confusion, and it provided a useful checklist, summarized as follows:

1. Similarity of goods and marks are correlative, such that greater similarity in one regard can compensate for less similarity in the other.

2. More distinctive marks are more easily infringed.

3. Assessing distinctiveness is a function of:
    a. descriptiveness or lack thereof;
    b. market share;
    c. intensity;
    d. geographical distribution, and
    e. duration of the mark's use;
    f. advertising expenditures;
    g. segment of the public that recognizes the mark;
    h. third party statements acknowledging the mark.
    i. a percentage approach to distinctiveness (as performer German practice) is expressly rejected).
4. The marks in their entireties are compared, considering:
    a. distinctive and dominant parts;
    b. the mental image retained by consumers;
    c. the average consumer; and
    d. the degree of similarity in sound, appearance and meaning.

All in all, this comprehensive checklist is refreshingly familiar to U.S. trademark practitioners.

United States

¶75 In *Buti v. Perosa*,[39] the U.S. Court of Appeals for the Second Circuit addressed the issue of whether a company's U.S. advertising and promotional activities, on behalf of its restaurant in Milan, Italy, constituted "use in commerce" within the meaning of Section 45 of the Lanham Act, even though the company operated no restaurants in the United States.

¶76 Impressa Perosa opened its restaurant FASHION CAFÉ in Milan, Italy in 1987 and registered the trademark FASHION CAFÉ in Italy in 1988. Impressa never opened a restaurant in the U.S. and did not conduct any formal advertising or public relations campaign in the U.S. Impressa's principal, Giorgio Santambrogio, claimed that during visits to the U.S., he personally distributed "literally thousands of T-shirts, cards, and key chains" with the FASHION CAFÉ name and logo on them to persons associated with the modeling and fashion industry which entitled them to free meals at the restaurant in Italy.

¶77 In 1993, Tommasso Buti opened a series of FASHION CAFÉ restaurants in the U.S. After conducting a trademark availability search, which did not reveal any prior use or registration of FASHION CAFÉ in the U.S., Buti applied in 1995 to register FASHION CAFÉ for restaurant services and clothing based on a *bona fide* intent to use the mark. In 1994, Impressa learned of Buti's plans to open a Fashion Café in New York City. Impressa applied to register the mark in the U.S. and threatened litigation if Buti did not cease and desist using FASHION CAFÉ. Buti responded by filing a suit requesting a declaratory judgment that Impressa had no trademark rights in FASHION CAFÉ for restaurant services and clothing in the United States.

¶78 The main issue was whether Impressa's distribution in the U.S. of T-shirts, cards and key chains constituted sufficient "use" of FASHION CAFÉ in commerce to merit protection under the Lanham Act. It was undisputed that Impressa rendered no restaurant services, and operated no other business under the FASHION CAFÉ mark in the U.S. The court cited well settled trademark legal principles enunciated in *United Drug*, where the Supreme Court held that the right to a particular mark grows out of its use, not its mere adoption; a mark's function is to designate the source or origin of goods and to protect the trademark owner's goodwill against the sale of another's product as his; and it is not the subject of property rights, except as necessary to prevent deception in the marketplace.[40]

¶79 The court held that mere advertising or promotion of a mark in the U.S. is insufficient to constitute "use" of the mark "in commerce," where that advertising or promotion is unaccompanied by any actual rendering of services in the U.S. or in commerce with the U.S.[41] The court concluded there was insufficient evidence in the record to show that Santambrogio's promotional activities in the U.S. constituted trademark use of the FASHION CAFÉ name in anticipation of the opening of a U.S. Fashion Café.

¶80 Instead, the Court found Santambrogio was really attempting to promote the Milan Fashion Café by distributing T-shirts and other items, including meal vouchers, to persons associated with the modeling and fashion industry which entitled them to free meals at the Milan Fashion Café. The critical issue was which party first used the name in U.S. commerce. Since Impressa did not serve customers in the U.S., this activity did not substantially affect commerce. Accordingly, the court held that an Italian restaurant is not entitled to trademark protection in the U.S., when it advertised and promoted its services in the U.S., but served its customers in Italy. The court held that such activity was not "commerce" within Congress's commerce power and therefore did not come within the ambit of the Lanham Act.

¶81 This decision is not ground-breaking in the U.S. law dealing with what activities are and are not sufficient to create trademark rights. However, it is interesting in today's milieu of "well-known mark" cases and discussions, because the issue often comes down to whether a foreign company's trademark is protectable against local adverse appropriation based on some reputation in the subject country, even in the absence of actual goodwill, which comes only from actual trade under the name. In this case, it would seem that the FASHION CAFÉ trademark must have enjoyed some degree of reputation in the U.S. as a result of Santambrogio's promotional activities. But the court did not focus on the question of whether the extent of those activities or the resulting reputation was sufficient. It focused instead on the absence of goodwill, resulting from the absence of trading and the absence of preparations to trade in the United States.

¶82 Whether the commercial realities are respected is somewhat arguable in this case. On one hand, it is sound to say that enforceable trademark rights to a restaurant name do not emanate from just handing out a bunch of key chains, T-shirts and vouchers for a restaurant in Milan. Especially in the absence of provable plans to open a restaurant in the United States, it seems satisfactory not to block a real commercial use of a name by another here based solely on such activities. On the other hand, there is an element of tension with the many oppositions and other proceedings brought by U.S. companies in foreign countries, seeking to assert their well-known marks under Article 6*bis* of the Paris Convention in countries where they have no actual business and thus must rely on reputation. So, perhaps American companies are seeking to receive treatment abroad which the corresponding U.S. tribunals do not themselves extend under analogous circumstances.

CONCLUSION

¶83 The worldwide trends in trademark law seem to be going in a positive direction. The European and WIPO initiatives seem designed to produce a higher degree of harmony in national laws, and the Trademark Law Treaty will eliminate much of the unnecessary and frustrating red tape that has traditionally attended the process of international trademark registration. The Madrid Protocol, once it is finally adopted as seems inevitable, will also provide a lower cost international filing mechanism that will enable many smaller mid-size companies to take advantage of international trademark protection. The news also seems generally positive in comparing the legal trends to the marketplace realities. Most countries, courts and trademark opposition tribunals have come a long way from the older-style of hypertechnical trademark analysis, relying on the class in which a mark was registered rather than the actual goods for which it is registered and used or to be used. Many of the cases reviewed above reveal a laudable focus upon the realities of marketplace perceptions in determining whether alleged trademarks are eligible for protection in the first place (as distinguished from functional operating product features, for example), and whether trademarks are truly in conflict. Though there are exceptions (the Pink Panther case in Canada comes to mind) the courts seem generally to be considering the extent of use and advertising, the extent of the mark's fame and reputation among the public, and even post-sale possibilities of confusion, in determining the ultimate likelihood that the relevant purchasing public will be confused or deceived by the junior party's similar mark. And as the legal infrastructure of trademark laws becomes more harmonious than discordant, companies will be able more efficiently to utilize the new technologies to distribute their products globally and with a minimum of trade identity problems.

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1 Hungary revised its trademark law effective July 1, 1997, to comply with the Harmonization Directive. Act XI, 1997. World Intellectual Property Report ("WIPR") No. 11-6, June 1997, at 192.

2 Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as last revised at the Stockholm Revision Conference, July 14, 1967, and as amended on Oct. 2, 1979, *available at* http://www.wipo.org/treaties/ip/paris/index.html.

3 "Proposed Joint Resolution Concerning Provisions on the Protection of Well Known Marks" Final Text as decided by the WIPO Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications, (SCT), Draft Document A/34/14, June 11, 1999.

[4](#) Current signatories are Australia, Burkina Faso, Cyprus, Czech Republic, Denmark, Egypt, Guinea, Hungary, Indonesia, Ireland, Japan, Latvia, Liechtenstein, Lithuania, Monaco, Netherlands, Moldova, Romania, Russia, Slovakia, Spain, Sri Lanka, Switzerland, Trinidad and Tobago, Ukraine, United Kingdom, United States, Uzbekistan and Yugoslavia; *available at* http://www.wipo.int/treaties/ip/trademark-law/index.html.

5 *Available at* http://www.wipo.int/treaties/registration/madrid/index.html.

6 *Available at* http://www.wipo.org/eng/ratific/g-mdrd-m.htm.

7 *But see* Richard Brown, *Does the Madrid Protocol Put Trademark Rights in Peril?*, IP Worldwide, May-June 1997, at 3 (offering an interesting dissenting view).

8 *Havana Club Holding, S.A. v. Galleon S.A.*, 203 F.3d 116 (2nd Cir.), *cert. denied*, 2000 U.S. App. LEXIS 1442 (2000).

9 World Intellectual Property Report, No. 14-3, at 91.

10 Barreda Moller, *Intellectual Property*, Peru Newsletter, Sept. 2000.

11 Including Argentina, Dominican Republic, Egypt, the European Union, Greece, Guatemala, India, Israel, Italy, Korea, Malaysia, Peru, Poland, Russia, Turkey and the United Kingdom; *available at* http://www.ustr.gov/html/special.pdf.

12 *Id*.

13 The current list of countries accepting the UDRP are: AC (Ascencion Island), AG (Antigua & Barbuda), AS (American Samoa), BS (Bahamas), CY (Cyprus), GT (Guatemala), NA (Namibia), NU (Niue), PH (Philippines), SH (St. Helena), TT (Trinidad and Tobago), TV (Tuvalu), VE (Venezuela), and WS (Western Samoa). *Available at* http://arbiter.wipo.int/domains/cctld/index.html

14 [1998] 708 FCA (19 June 1998), *rev'd*, [1999] 329 FCA (29 March 1999). *See generally* Kathryn Everett & Irene Zeitler, *Assignment of a Trade Mark To Local Distributor Fails to Stop Parallel Importation*, In Depth (Freehill Hollingdale & Page), Sept. 1998; James W. Dwyer & David L. Yates, *The Montana Case on Appeal - Dealing with "Parallel Importers,"* 10 Austl. Intell. Prop. J., May 1999, at 111.

15 *See* Dwyer & Yates, *supra* note 15, at 122-23.

16 *Id*.

17 Case C-355/06, 7 E. Trademark R. 539 (1998).

18 The European Economic Area includes the 15 European Union countries plus Norway, Iceland, and Liechtenstein.

19 Case C-173/93, 1999 E.C.J. Celex LEXIS 2740 (July 1, 1999). The opinion was until recently unreported, but the case has been widely discussed. *See, e.g.*, Nauta Dutilh, I.P. Newsletter, July 1999, at 5; Lovell White Durrant, *Parallel Import Battle Still Rages*, Intell. Prop. L. Newsletter, June 1999, at 7; Steinhauser Hoogenraad, NewsFlash, July 9, 1999, at 3.

20 Linklaters & Alliance, *The Economic Consequences of Exhaustion*, Intell. Prop. News No. 3, Mar. 1999.

21 Process 2-A1-96, Judgment of June 20, 1997. *See generally* Gabriela Mancero-Buceli, *Intellectual Property and Rules on Free Movement: A Contradiction in the Andean Community*, 4 NAFTA L. & B. Rev. Am. 125 (1998); Alain Coriat, *Controversy Looms Over Andean Community Trademark Ruling*, I.P. Worldwide, Jan.-Feb. 1998, *available at* http://www.ljx.com/trademark/01-98andeantm.html.

22 *Question 148, Three-Dimensional Trademarks: The Borderline Between Trademarks and Industrial Designs*, A.I..P.P.I. Reports, April 2000, *at* http://www.aippi.org. The national groups reporting are: Argentina, Australia, Bulgaria, Czech Republic, Denmark, Egypt, Finland, France, Germany, Great Britain, Greece, Hungary, Indonesia, Israel, Italy, Japan, Mexico, Netherlands, Portugal, Republic of Korea, Romania, Singapore, Slovak Republic, Spain, Sweden, Switzerland, Thailand, Uruguay, United States and Yugoslavia.

23 Chancery Division Action No. Ch. 1995 P No. 7585, December 22, 1997, [1998] RPC 283.

24 NG 637 of October 14, 1997. *See generally* Peter Hansen, *Getting Into Shape - The Trade Mark Issues,* In Depth (Freehill Hollingdale & Page), March 1999.

25 [1999] FCA 816.

26 [1998] 323 N.Z.P.C.C. 98. *See generally* Andrew Brown, *Intellectual and Industrial Property*, IV N.Z. L. Rev. 20, 61 (1998).

27 80 C.P.R. (3d) 247; 1998 C.P.R. LEXIS 93.

28 Id. at 252.

29 34 C.P.R. (3d) 135, 136; 1990 C.P.R. LEXIS 2077

30 67 C.P.R. (3d) 216; 1996 C.P.R. LEXIS 2083.

31 80 C.P.R. (3d) 247, 269; 1998 C.P.R. LEXIS 93.

32 *Id*.

33 *Id*. at 272.

34 *Id*. at 271-272.

35 [1998] All ER (EC) 934, [1999] 1 CMLR 77

36 *Id* .

37 Case C - 342/97, 1999 E.C.J. Celex LEXIS 1939 (June 22, 1999).

38 Case C-251-95, [1997] E.C.R. I-6191, 1997 E.C.J. Celex LEXIS 7568 (Nov. 11, 1997).

39 139 F.3d 98 (2d Cir. 1998).

40 United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90 (1918).

41 *Buti*, 139 F.3d at 102.