

# THE USE OF A MARK IN DIFFERENT FORMS

Article 5C(2) Paris Convention *juncto*  
Articles 15(1)(a), 8(1),(4),(5) and 9(1)  
EUTMR

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Every use of a mark implies a use in a particular form.

Every registration of a mark implies a particular representation of the mark. Every particular representation produces the mark in a particular form (in which the mark, in some cases, cannot even be used).

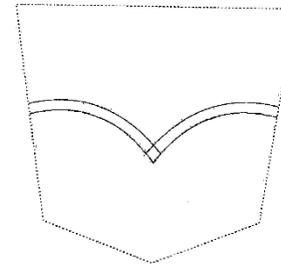
- A trade mark  $\neq$  the form in which it is used or registered  
 $\neq$  its description
- Indeed, every trade mark is an immaterial sign
- How to determine the precise subject-matter of a trade mark?

Through:

- Its representation in the registration
- Its description
- Its use

(CJEU's judgment in *Pi-Design*, C-337/12 P, EU:C:2014:129, paragraph 61)

Representation  
in the registration



Description  
in the registration

*"The design of two curved lines  
positioned in the design of a pocket."*

Use of the mark



## The use in forms which differ from the form in which the mark is registered

- Revocation?
- Protection of the mark in the form in which it is registered?
- Protection of the mark in the form in which it is used?

## Article 5C(2) of the Paris Convention

*“Use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union shall **not entail invalidation** of the registration and **shall not diminish the protection granted to the mark.**”*

## The primacy of the Paris Convention according to the CJEU

*“It is settled case-law that Union legislation must be, so far as possible, be interpreted in a manner that is consistent with international law (...)”*

(CJEU's judgment in Peek & Cloppenburg, C-456/06, EU:C:2008:232, paragraph 30)

*“Furthermore, it is clear from the 12<sup>th</sup> recital in the preamble to Directive 89/104 that the provisions of the directive must be ‘entirely consistent with those of the Paris Convention’.”*

(CJEU's judgment in Rintisch, C-553/11, EU:C:2012:671, paragraph 23)

## The rationale of Article 5C(2) of the Paris Convention

- Introduced into the Convention at the Revision Conference of London in 1934
- *“The purpose of this provision is to **allow unessential differences** between the form of the mark as it is registered and the form in which it is used, for example, in cases of adaptation or translation of certain elements for such use. (...) The differences in form must not alter the distinctive character of the mark.”*

(Bodenhausen, Guide to the Application of the Paris Convention)

## The rationale of Article 5C(2) of the Paris Convention

- “The said differences of form will not entail **invalidation** of the registration, which is self-explanatory.”
- “Neither will the said differences of form **diminish the protection** granted to the mark, which means not only that the mark, in the form in which it is registered cannot be considered as not being used in view of Article 5C, but also that, as regards possible infringement by marks of third parties, **it must be considered as having been used in its original form.**”

(Bodenhausen, Guide to the Application of the Paris Convention)

## The rationale of Article 5C(2) of the Paris Convention

***“Whether the different form in which the mark is actually used enters also into consideration depends on the national legislation of the country concerned.”***

(Bodenhausen, Guide to the Application of the Paris Convention)

# Which forms do not alter the distinctive character of the mark as registered?

## Word marks

- Every graphical representation (as long as the word can be read)
- Every pronunciation of the word (as long as it can be heard or understood)
- Every transliteration (in Roman, Greek, Cyrillic or Arabic script?)

Yes, in principle (by analogy the GC's judgment in *Chroma*, T-281/09, EU:T:2010:537, paragraph 34)

- Every translation (in one of the (official) languages of the EU)?

No, in principle not

# Which forms do not alter the distinctive character of the mark as registered?

## Figurative marks

- When the representation is 'colourless':

Use in all colours (as long as you can see the mark ...)

- Different graphical representation?

As long as it can be considered as another form of the same subject-matter.

## Revocation?

**No**, given:

- Article 5C(2) Paris Convention
- Article 15(1)(a) EUTMR: *“The following shall also constitute use (...): use of the EU trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor.”*

## Protection?

- **Of the trade mark in the form in which it is registered?**

Yes.

- **Of the trade mark in the form in which it is used?**

Yes, in principle.

Indeed, the CJEU ruled that the way the trade mark is used is a factor relevant to the circumstances of the case which must be taken into account in the global assessment of the likelihood of confusion or association:

*“At the very least where there is a trade mark which is registered not in a particular colour or characteristic, but in black and white, the colour or combination of colours in which the trade mark is later used affects how the average consumer of the goods at issue perceives that trade mark, and it is, therefore, liable to increase the likelihood of confusion or association between the earlier trade mark and the sign alleged to infringe it.”* (CJEU's judgment in *Specsavers*, C-252/12, EU:C:2013:497, paragraph 37)

## Examples

**OLA**

Earlier mark as registered

**ΟΛΑ**  
**ОлА**

Earlier mark as used  
in Greek and Cyrillic

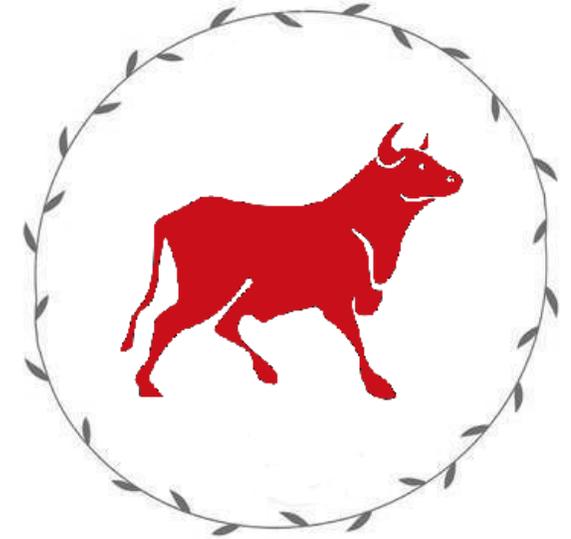
## Examples



Earlier mark as registered



Earlier mark as used



Contested mark

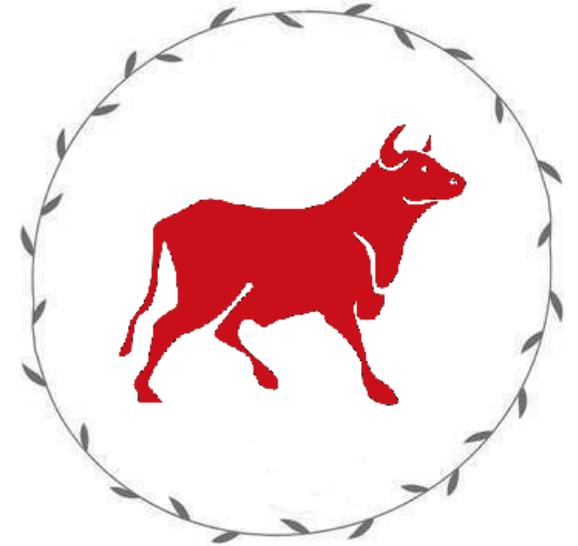
## Examples



Earlier mark as registered



Earlier mark as used



Contested mark

## Remaining questions

- Transliterations?
- Will the Court of Justice in case C-223/15 preserve or undermine the unitary character of the EU trade mark?
  - Geographical limitation of the protection of certain forms?

Presentation by Thierry van Innis at the EUIPO's IP Case Law  
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