

EXCLUSIVE RIGHTS AND THEIR SCOPE

Marco Ricolfi, Università di Torino,
Studio Tosetto Weigmann

marco.ricolfi@studiotosetto.it

TM infringement: the three “conflicts” I

- **Artt. 10(2) TMD and 9(2) EUTMR**
- **Second conflict, lett. b), likelihood of confusion**
- **First conflict, lett. a), double identity**
 - **But see also Artt. 14(1)(c) TMD and 12(1)(c) EUTMR**

TM infringement: the three “conflicts” II

- **Third conflict, lett. c): marks with a reputation**
 - **The linguistic update: «irrespective»**
 - **How about Impulse? EUC 2015 C-125/14;**
 - **The principle of unitarity of EUTM at the enforcement stage (back to lett. b);**

Rights conferred: 1

- What is (apparently?) new:
- **Artt. 10(3) TMD and 9(3) EUTMR:**
 - Lett. d) [company name] and f) [CAD]
- **Artt. 10(4) TMD and 9(4) EUTMR:**
 - **overruling Philips and Nokia EUC 2011 C-446/09 and C-495/09;**
 - **Art. 5 GATT (and the Losartan consultation in patent)**

Rights conferred: 2

- **Artt. 11 TMD and 9a EUTMR: preparatory acts,**
 - Lett. b) labels and
 - Lett. a) affixing: the position of bottlers, see EUC 2011 C-119/10 Frisdranken

Limitations 1

- **Artt. 14(1)(c) TMD and 12(1)(c) EUTMR**
 - The general referential use defence
 - has it made obsolete the test of adverse effect or “prejudice” in double identity situations? See also Google and Interflora;
 - Burden of proof?

Limitations 2

- **Recital 27 TMD and 21 EUTMR: fundamental rights and freedoms in particular freedom of expression;**
 - Implications of the provision
- **See also Art. 10(2) Directive (+ Artt. 9(2) and 99(3) ETMR + Art. 16 TRIPs)**