

# 12 Why are the Trademarks Protected?

## A Comparative Approach to the Questions of the Trademark Functions in Europe and Japan<sup>(\*)</sup>

Invited Researcher: Yann Henri BASIRE<sup>(\*\*)</sup>

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*In Europe, the question of the trademark's function is essential with regard to the development of the case law of the European Court of Justice. It is classical to consider the trademark as a guarantee of origin. But, since 2009, the Court of Justice recognized four new functions: quality, advertising, investment, communication. This new approach of the community judges has for consequences to make harder the understanding of the meaning of the doctrine of the trademark's function. In order to have a better understanding of this issue, it could be interesting to compare the question of trademark's functions in another country, and more particularly Japan. Indeed, the Japanese trademark system recognizes also three legal functions: origin, quality and advertising. Therefore, a transversal approach and an analyze of the use of the trademark in both systems could allow determining what the European system and the Japanese one could learn from each other's experiences.*

### I Introduction

The trademarks are important assets for the companies. Even, may be, one of the most important. In 2012, the most valuable brand is "Apple" whose estimated value is around 182 billion of Dollars. The trademark "IBM" has a value of 115 billion of Dollars<sup>1</sup>. With regard to this importance, the law must intervene in order to ensure the protection of the owner and of the free competition.

In Europe, the trademark system is little bite complicated: a directive has harmonized the national trademark systems. Therefore, even if there are still the national systems, they are harmonized and must be respectful of the directive and of the interpretation given of this text by the European Court of Justice (now called the Court of Justice of the European Union)<sup>2</sup>. There is also a community system with a community trademark which can be registered in the OHIM and which enforces in all the Member States<sup>3</sup>. In Japan, there is the Japanese Trademark Act of 1959, which has been amended many times since this date.

The issue of the trademark's function is without any doubt one of the main issue in the field of trademark. Actually, the understanding of the function of a right allows determining the content of this right. Thus, the understanding of

the trademark's functions allows us to determine the legal regime of the trademark's right.

Nowadays, in Europe but also in Japan, the commentator and the courts recognized many functions. This study has for aim to explain the European approach and the Japanese one. On one hand, the explanation of the Japanese system could allow having a better understanding of the European one that is particularly difficult to understand. On the other hand, the Japanese system could learn from the recent development in the European case law.

The study is divided in two parts: the first one is related to the definition and the description of the trademark's functions and then the second is related to their practical use.

### II The definitions of the trademark functions

The Court of Justice recognized officially five functions. We can add to this function the one of exclusivity<sup>4</sup>. On the contrary, in Japan, the doctrine and the judges recognize only three functions. Therefore, the functions shared by both systems must be considered in a first time (1) and then it is necessary to study the functions which seem exclusive to the European system (2).

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(\*\*) Doctor in Private Law, Associate Professor at the University of Orleans (France) and Lecturer at the Centre for International Intellectual Property Studies (CEIPI), University of Strasbourg (France)

## 1 The functions shared by both systems

The European and the Japanese systems share three functions. In Japan, the recognition of these functions was easy but in Europe it was more controversial. These functions are the function of guarantee of origin (1), the quality function (2) and the advertising function (3).

### (1) The function of guarantee of origin

In Europe, this function is considered as the main one, as the essential function of the trademark. This function is used in almost each case related to the trademark law since the famous Arsenal decision of 2002<sup>5</sup>. This function is also aimed in the preamble of the European Directive. It was early recognized in France and was aimed notably by some decisions in the middle of the nineteenth century<sup>6</sup>. Many commentators aimed also this function in their study or papers.

However, in a first time, the European Court of Justice in the Hag decision in 1974 denied this function and recognized it only in 1976, after many criticisms, in the Terrapin/Terranova decision. The Court noticed that: *“the basic function of the trademark to guarantee to consumers that the product has the same origin is already undermined by the subdivision of the original right”*<sup>7</sup>.

The judges speak about the function of origin or also about the function of guarantee of identity of origin.

In Japan, the recognition was less controversial. The doctrine and the commentators seem unanimous to recognize the function of indication of origin as the first function of the trademark. O. SHOEN quotes thus that *“Marks that are attached to goods or services serve to indicate the origin and ownership of those goods or services. This function is based on the identification power of marks”*<sup>8</sup>. For the Professor Tamura, *“there is no doubt in that the source identifying function is protected under the Trademark law”*<sup>9</sup>. The Japanese courts seem also use this function for a long time, as in the decision Lacoste, Chanel and Cartier<sup>10</sup>.

Even if this function appears as the main one, it is opened to criticisms. Indeed, the words used to define this function are ambiguous. According to this function, it appears that the trademark could be understood as a kind of tool for the consumer, and more precisely a tool guaranteeing the source or the origin of the goods. The terms guarantee, identity and even origin or source are

ambiguous. According to these words, does it mean that the trademark allows the consumer to know the identity of the owner? Do we have to understand the trademark as a kind of company name?

We could understand this function differently and we could use different words in order to qualify this function.

The words guarantee used in Europe is definitely misleading. In France, this term is notably used in the field of contract law. The word identity – used in Europe – must be understood as the “same”. Concerning the word origin, obviously a trademark does not allow the consumer to identify the owner. With the globalization, such an approach cannot be retained. The term origin means that the trademark guarantees that the goods put on the market under the trademark always proceed from the legitimate owner of this sign.

It could be better to speak about the function of identification. Indeed, as any sign, and more particularly the legal signs, the trademark has an identification function. Indeed, the owner uses a trademark in order to identify its goods or services. It is provided by the article 2 of the Japanese Trademark Act and by the article 2 of the Trademark Directive.

Understanding the main function of the trademark as an identification function is not a new approach. In Europe, many decisions remind that the trademark serves to identify goods or services<sup>11</sup>. It means that the trademark allows the owner to distinguish its goods or services from those of other companies. In Japan also, many decisions prefer to assert that the first function of trademark is an identification function<sup>12</sup>.

Such a qualification is important and allows reminding that the manufacturers or the traders use the trademarks in order to designate the goods or services with the aim to be distinguished from its competitor. The trademark does not have to be understood as a tool for the consumers and this qualification prevents the confusion.

### (2) The function of guarantee of quality

In Europe, some commentators recognized this function. CORNISH says that *“Marks deserve protection because they symbolize qualities associated by consumers with certain goods or services and guarantee that the goods or services measures up to expectation”*<sup>13</sup>.

In France, with regards to the new developments of the case law of the Court of

justice, more and more authors assert that the trademark has also a function of quality<sup>14</sup>. Nevertheless and fortunately, some other authors contest the existence of this function<sup>15</sup>.

As defined by Cornish, the quality function does not appear as a legal function. If we can understand that the consumer believes that the trademark is an indicator of same, it is important to underline that the owner is free to change the quality of its goods without any sanction on the basis of the trademark right. Therefore, it is difficult to understand the quality function as a legal one.

Concerning the Courts, some decisions of the European Court of Justice aimed the concept of quality<sup>16</sup>. The official recognition of this function was made by the decision *L'Oréal versus Bellure* in June 2009<sup>17</sup>. However, despite this recognition, the Court of Justice has not defined and used this function yet.

In Japan, the recognition of the quality function seems more natural. It is recognized not only by the authors but also by the Courts. S. ONO quotes that *"if a mark is used repeatedly (...) users of goods or services will come to expect that goods or services under the same mark hold the same quality"*<sup>18</sup>. This definition reminds obviously the one of Cornish. More interesting is the use that the Japanese judges make of this function. Indeed, they take into account the quality function when the infringement concerns authentic goods, like in the cases of parallel importation or of repackaging<sup>19</sup>. Thus, it is interesting to notice that the Supreme court hold in the *Fred Perry* case that *"the import of trade-marked goods does not qualify as an infringement of a trademark where (...) the imported goods are not different in quality from the goods marketed under the registered trademark in Japan due to the position of the right holder in Japan directly or indirectly to enforce a quality control of the goods"*.<sup>20</sup>

The Japanese approach allows understanding what the quality function is and how it could be used in Europe. Actually, the quality function should be considered as a part of the identification function. Indeed, a trademark is a sign and it is necessary to apply here the semiotic rules. As every sign, a signifier and a signified constituted a trademark. The signifier is the component of the sign, as the logo, the word or the shape, and the signified is the good or the service. The trademark is this whole and the protection concerns this whole. In other words, the protection conferred by the trademark right

does not concern only the sign itself – i.e. the signifier itself – but the relation between a signifier and a signified.

Usually, the signifier is harmed when there is a reproduction or an imitation. Nevertheless, it happens that it is also the signified. Therefore, the identification function concerns in consequence not only the sign – i.e. the signifier – but also the signified. We can therefore assume that if one part of this sign – the signified or the signifier – is modified by a third without the authorization of the owner, it could constitute an infringement. It means that if a manufacturer or a trader puts on a market a good with a specific registered sign, he does not want to see the sign or the good modified by someone else. In one hand, when someone reproduces or imitates a sign the function of identification and the signifier are harmed. On the other hands, the quality function is harmed when the goods put on the market by the owner or with it authorization is modified in a sense that the quality of the good is harmed and does not correspond anymore with the will of the owner. More generally, we can also assume that the function of quality is infringed when the owner is not able to control the quality of the goods put on the market. In such a case, it does not correspond anymore to the will of the owner and to the role that he wants to give to its trademark.

### (3) The function of advertising

In Europe, many commentators recognize the advertising function. CORNISH asserts: *"Marks are ciphers around which investment in the promotion of a product is built and that investment is a value which deserves protection as such, even when there is no abuse arising from misrepresentations either about origin or quality"*<sup>21</sup>. With regard to this definition, the advertising function cannot be considered as a legal function. Therefore, it should not be taken into consideration to assess the infringement.

Nevertheless, the concept of advertisement appears in many decisions. The General advocate COLOMER quoted that *"The matter is thus one of establishment of a dialogue between manufacturer and consumer. The manufacturer gives the consumer information in order to make him aware of the goods, and sometimes persuades him as well. A trade mark is in reality communication"*<sup>22</sup>. And finally, in the *L'Oréal Bellure* case<sup>23</sup>, the European Court of Justice recognized the advertising function as a legal one. Then, this function was implemented in the *Google Adwords* case<sup>24</sup>. With

regard to this decision, we can say that this function could be harmed only when the competitor who uses the owner's trademark prevent the owner from promoting its own goods.

In Japan, once again, the recognition of this function was less controversial and was aimed by the authors<sup>25</sup> and the judges<sup>26</sup>. Nevertheless, despite this recognition, this function appears more as a commercial function and not as a legal one. Indeed, even if some decisions make reference to this function, it is not used as the origin or the quality function. May be this function could be used more efficiently outside the scope of the trademark right, in the cases of dilution of the well-known trademark<sup>27</sup>.

## **2 The function exclusive to the European system**

### **(1) The function of investments**

The concept of investment and reward exists in the field of the patent right<sup>28</sup> and of the databases right<sup>29</sup> but does not exist in the trademark law. The trademark right has never been considered as a reward of financial or intellectual investment.

If this function was also recognized in the L'Oréal case in 2009, we waited for September 2011 and the Interflora case to understand what this function means<sup>30</sup>. In this case the judges specified that "*in addition to its function of indicating origin and, as the case may be, its advertising function, a trade mark also be used by its proprietor to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty*"<sup>31</sup>. Thus, even if this function overlaps the advertising function, it must be understood broader than this latter. The Court adds that this function is harmed when "*the use by a third party, such as competitor of the trade mark proprietor, of a sign identical with the trade mark in relation to goods or services identical with those for which the mark is registered substantially interferes with the proprietor's use of its trade mark to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty*"<sup>32</sup>. In the case where the owner has already a reputation, the function of investment is harmed when "*use by a third party of a sign identical with that mark in relation to identical goods or services affects that reputation and thereby jeopardizes its maintenance*"<sup>33</sup>.

### **(2) The function of communication**

The communication function was also

recognized by the Court of Justice in the L'Oréal case. Nevertheless, as the quality function, it is not defined and not used for the moment by the CJEU.

### **(3) The function of exclusivity**

In the case Centrafarm<sup>34</sup>, in 1974, the court of justice recognized that the specific subject matter of the industrial property is the guarantee that the owner of the trademark has the exclusive right to use that trademark. Therefore, we can say that the trademark right has a function of exclusivity. Such an assessment is logical when we know that the trademark right is a property right.

Nevertheless, despite this decision, and even if the Directive recognize that the trademark right is a property right, there is no official recognition.

## **III The use of the trademark functions**

In order to consider the usefulness of these functions, we need to distinguish in a "classical way" this usefulness for the existence of the trademark right (1) and for the exercise of the right (2).

### **1 The use of the trademark functions in the assessment of the existence of the trademark right**

In the field of the conditions of the existence of the trademark, it appears that the trademark functions play a fundamental role for the granting of the right, and more particularly for the assessment of the distinctiveness (1), and for the loss of the right, and more particularly for the question of the lack of genuine use (2).

#### **(1) The use of the trademark functions for the granting of the right**

##### **(i) The use of the trademark functions for the assessment of the distinctiveness**

The distinctiveness can be defined as the ability for the sign to identify goods and services and allowing the distinction with the ones of the competitors. In other words, a sign can be registered as a trademark only if the sign is able to fulfill the function of identification. As we can see, the condition of distinctiveness and the function of origin are firmly bound, insofar as this latter explained this requirement.

In Europe, a sign is not distinctive when it is descriptive or generic. More generally, even if the sign is not descriptive or generic, the sign can be considered as being not distinctive. In such a case, we speak about the distinctiveness *per se*. The Court of Justice considers thus, notably in the particular cases of slogan, that a sign is not distinctive because it is not perceived as an indication of origin<sup>35</sup>. The function of identification justifies the requirement of the distinctiveness *per se*.

As mentioned above, a sign must not be generic, usual, common or descriptive. This requirement can be explained by the rule of free competition. It is necessary to prevent the registration of signs which could be useful for the competitor. It also can be explained by the function of identification. Indeed, these signs are not able to play efficiently the role of the trademark.

In Japan, the article 3 of the Trademark Act is actually quite similar to the European text. Indeed, it aims the question of the distinctiveness *per se* and of the signs which do not have to be generic or descriptive. Therefore, it is possible to assume that the function of identification plays also a crucial role. Such an assumption is confirmed by the fact that many decisions related to the article 3 aim the identification function<sup>36</sup>.

#### (ii) The use of the trademark functions for the assessment of the other requirements

Concerning the others requirement for the registration, the function does not play the same role. Indeed, the requirement of lawfulness is not concerned or justified by the identification function. Concerning the availability, it is not directly concerned or justified by the identification function. This requirement allows the protection of the previous exclusive rights, as author's right, design right, personality right or trademark right. Nevertheless, we have to admit that the coexistence of the identical signs in the same specialty and with two different owners harms their distinctiveness. The second trademark creates a risk of confusion and prevents both signs to play their role. On this occasion, the function of origin must be assessed in order to determine if the sign is available or not.

In Japan, the requirements are the same as in Europe. Therefore, the function of identification is not used or is not justified in the case of lawfulness. Concerning the case of availability, when the previous exclusive right is a trademark,

the judges make often reference to the function of identification in order to assess the validity of the litigious trademark<sup>37</sup>.

#### (2) The use of the trademark function for the loss of the right

In Europe, the trademark right can be lost for lack of genuine use during a period of five years. Obviously, this provision is justified by the function of trademark. The Court of justice in the *Ansul* case stated that "*The protection the marks confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d'être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertaking*"<sup>38</sup>.

The revocation can be obtained when the sign has become misleading or deceptive. Such a revocation is not justified by the function of trademark but more by the rules of free competition. The revocation can also be obtained when the trademark becomes a common name. With regard to the identification function, this sanction is logical. Indeed in becoming a common designation, the trademark is incapable to fulfill its function.

As in Europe, the trademark right can be rescinded in Japan for lack of genuine use. This provision, as in Europe, can be explained because of the function of identification. The trademark can also be rescinded because of the misuse of the sign. Thus, a trademark right must be rescinded when the sign causes a risk of confusion with another business. In this case, the function of identification is harmed and justifies the revocation.

#### 2 The use of the trademark functions in the assessment of the exercise of the trademark right

##### (1) The use of the trademark functions for the assessment of the counterfeiting

The trademark right, even if it is a property right does not have to be considered as an absolute right. Indeed, in order to notice an infringement two requirement must be fulfill. The use of a litigious sign by a third must be done in the course of trade and must correspond to a trademark use. This second requirement is explained by the trademark function. Indeed, the trademark right protects a sign which is used to identify goods or services. Therefore, if someone

else use this sign in another way, the trademark right cannot be enforced.

(i) **The case of the double identity**

In such hypothesis, the third part reproduces and uses the same sign as the one of the first trademark in order to designate the same goods. In such a case, the question of the trademark function should not be taken into account insofar as such a behavior from the competitor harmed necessary the property rights of the owner: it harms the function of exclusivity of the trademark right. That is why the paragraph 11 of the Directive's preamble provides that the protection should be absolute, i.e. there is no need to refer to the risk of confusion. In other words, there is no need to consider if the identification function is harmed or not. Such an assessment of the infringement is logical with regard to the nature of the trademark right. In a case of double identity, you contest the exclusivity of the owner on its sign. It can be compared with an encroachment known in civil law. Therefore, the mere noticing of this fact should be enough to consider that there is an infringement.

Nevertheless, since the decision Arsenal<sup>39</sup>, even in the case of double identity, it is necessary to demonstrate that the essential function is infringed. The owner has to demonstrate that it exists a risk of confusion. In other words, if the defendant can show that its use does not create a risk of confusion, the judges will consider that the identification function is not harmed and notice the lack of infringement. According to such an approach, the protection of owner became narrower.

Since 2009, the situation evolved and is more complicated as ever. Since the Bellure case<sup>40</sup>, it is also possible to take into account the other functions. But as explained above, these functions do not confer to the owner a broader protection.

Indeed, in the case of double identity, when the judges recognized that the use is as a trademark, it seems that there is no need to refer to the risk of confusion. Is it because of the nature of the trademark right? Or is it because the risk of confusion is presumed and this presumption cannot be disputed? In such cases of double identity, it appears that the Japanese judges notice only that there is a risk of confusion without a real assessment<sup>41</sup>.

(ii) **The case of the similarity**

The case of similarity is less controversial

even if the assessment of the risk of confusion is a big issue. Actually, it is important to notice that the scope of trademark right is determined by the trademark function. In Europe and in Japan, the identification is taken into account. Indeed, in order to assess the counterfeiting in the case of similarity, it is necessary to demonstrate the existence of a risk of confusion or a risk of association. Therefore, in such a case, the identification function is harmed and determines the scope of the trademark right beyond the same goods or services. It is also important to notice that in Europe, the other trademark function are useless in the cases of similarity.

**(2) The use of the trademark functions for the assessment of the exhaustion**

In Europe, the question of the exhaustion of the trademark right is crucial. It allows conciliating the IP rights and the principles of the European Union as the free movement of goods. The exhaustion rules are applied for all IP rights. But Concerning the trademark right, it is interesting to notice that if the first paragraph of the article 7 of the directive limits the function of exclusivity – i.e. the property right - the second paragraph allows the trademark functions to limit the rule of the exhaustion. Thus, in the case of parallel importation or of repackaging, the Court of justice uses the function of origin to limit the exhaustion rule. The Court of justice uses also the concept of the reputation and of the trademark image to justify such a limitation. Therefore, in the future, the Court of Justice should use the function of investment. It is also possible to assume that one day, as in Japan, the function of quality will be use.

In Japan, the question of exhaustion is also considered. As explained before, in the case where authentic goods are involved, the Japanese judges use the identification function and the quality function. It is used in the case of parallel importation or in the cases of repackaging.

## **IV Conclusion**

With regard to this study, it appears that both in Europe and in Japan, the trademark's functions exist and play a key role. It justifies the protection conferred to the trademark owner. The trademark functions are used in order to assess the existence of the trademark right – the distinctiveness, the revocation – and the exercise of the right – the counterfeiting and the exhaustion –. Even if the both systems are quite

similar, we noticed that the European one, under the influence of the Court of Justice, does not consider – even if it is not official – the trademark as a property right. It is a kind of exclusive right whose the scope is relative and determined by the trademark’s functions. On the contrary, the Japanese system seems more respectful of the trademark right and always considers the trademark right as a property right. Then, even if the question of the trademark’s functions seems more developed in Europe than in Japan, the Court of Justice should learn about the Japanese approach concerning the quality function. On the other hand, if one day, the Japanese Courts wants to follow the same was as the European one, they have to be very careful in order to stay respectful of the trademark’s right and to avoid that this latter be scarified because of the free competition principle.

Obviously, this study could not be exhaustive. Indeed, we tried to consider only the trademark’s functions for the owner. It could be also interesting to study the function for the consumers and therefore the place of the signs used as trademark in the consumer’s right<sup>42</sup>. It could be also interesting to consider the question function of the well-known trademark.

<sup>1</sup> [http://www.millwardbrown.com/brandz/2012/Documents/2012\\_BrandZ\\_Top100\\_Chart.pdf](http://www.millwardbrown.com/brandz/2012/Documents/2012_BrandZ_Top100_Chart.pdf). The values of Toyota and Docomo are respectively estimated to 21 and 15 billion of Dollars.

<sup>2</sup> 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.

<sup>3</sup> Council regulation (EC) n° 207/2009 of 26 February 2009 on the community trademark.

<sup>4</sup> This function was recognized implicitly in the Centrafarm decision. ECJ, 31 Oct. 1974, n° 16/74, Sté Centrafarm B.V et Adriaan de Peijper c. Sté Winthrop B.V, Rec. 1974, p. 1183, para. 8.

<sup>5</sup> ECJ, 12 Nov. 2002, C-206/01, Arsenal football club, Rec. 2002, p. I-10273.

<sup>6</sup> Paris, 16 Janu. 1868, Ann. propr. ind. 1869, p. 336.

<sup>7</sup> ECJ, 22 June 1976, aff. 119-75, Terrapin c/ Terranova, Rec. 1976, p. 1039, para. 6.

<sup>8</sup> S. ONO, Overview of Japanese trademark law, Yuhikaku, Tokyo, 2nd ed., 1999, Chap. 1, p. 36 – translated and available from [http://www.iip.or.jp/e/e\\_publication/ono/ch1.pdf](http://www.iip.or.jp/e/e_publication/ono/ch1.pdf).

<sup>9</sup> Y. TAMURA, What functions of trademark are protected by Japanese trademark law, Conference in Chongqing.

<sup>10</sup> See for example, Tokyo District Court, 7 Dec. 1984, AIPPI Journal, March 1985, p. 29, obs. Y. YAMASAKI; Tokyo District Court, 47th Civil division, 20 Dec. 2005, 2005 (Wa) n° 8928.

<sup>11</sup> See for example, ECFI, 8 Febr. 2011, aff. T-157/08, Paroc c/ OHIM, para. 44.

<sup>12</sup> See Supreme Court, 30 Dec. 1960, Minshu, Vol. 14, p.

201 quoted by Y. HARIMA, Shohyo no kinou ni kansuru houritsugakuteki kentou, Minshoho Zasshi, p. 371-391, 1978 ; Osaka District Court, 24 Febr. 1976, AIPPI Journal, March 1977, p. 20.

<sup>13</sup> W. CORNISH, D. LLEWELYN and T. APLIN, Intellectual property: patents, copyright, trade marks and allied rights, Sweet and Maxwell, 7th ed., 2010, 16-22.

<sup>14</sup> C. GAVALDA & G. PARLÉANI, Droit communautaire des affaires, JCPE 1997, I, n° 18-19, 653, n° 16 ; A. FOLLIARD-MONGUIRAL, note sous CJCE, 18 juin 2009, aff. C-487/07, L’Oréal e.a., Rec. 2009, p. I-05185, Propr. ind. 2009, n° 9, comm. n° 51, n° 3 ; C. DE HAAS, Le non-sens d’une marque sans usage ou le vice fondamental du droit des marques français et européen, Propr. ind. 2010, n°1, étude n° 1, spéc. n° 9 ; J. LARRIEU, Glissements progressifs vers une nouvelle image de la marque, Propr. ind. 2010, n° 9, alerte n° 87.

<sup>15</sup> A. KAMPERMAN SANDERS and S. MANIATIS, A consumer trade mark: Protection based on origin and quality, EIPR 1993, 11, p. 406, spec. 407; F.-K. BEIER, Territoriality of trademark law and international trade, IIC 1970, 48, p. 63. See in the same sense, Y. SAINT-GAL, Marque et qualité, in Marque et droit économique in Les fonctions de la marque, Colloque du 6 et 7 novembre 1975, Union des fabricants, 1976, p. 36, spec. p. 42.

<sup>16</sup> ECJ, 11 July. 1996, C-427/93, Bristol-Myers Squibb c/ Paranova, C-429/93, Boehringer, C-436/93, Bayer, Rec. 1996, p. I-3457; ECJ, 23 Apr. 2009, C-59/08, Copad, Rec. 2009, p. I-3421.

<sup>17</sup> ECJ, 18 June 2009, C-487/07, L’Oréal e.a., Rec. 2009, p. I-05185, para. 58.

<sup>18</sup> S. ONO, Overview of Japanese trademark law, Yuhikaku, Tokyo, 2nd ed., 1999, Chap. 1, p. 37 – translated and available from [http://www.iip.or.jp/e/e\\_publication/ono/ch1.pdf](http://www.iip.or.jp/e/e_publication/ono/ch1.pdf).

<sup>19</sup> See for example, Osaka District Court, 27 Febr. 1970, IIC 1971, p. 325, obs. S. KUWATA.

<sup>20</sup> Supreme Court of Japan, 27 Febr. 2003, KK Three M v. Hit Union Co. Ltd., “Fred Perry III”, IIC 2004, p. 216.

<sup>21</sup> W. CORNISH, D. LLEWELYN and T. APLIN, *op. cit.*, 16-22.

<sup>22</sup> D. R.-J. COLOMER, Concl., 6 nov. 2001, aff. C-273/00, Sieckmann, para. 19.

<sup>23</sup> ECJ, 18 June 2009, C-487/07, L’Oréal e.a., Rec. 2009, p. I-05185, para. 58.

<sup>24</sup> CJEU, 23 mars 2010, C-236/08, C-237/08 and C-238/08, Google France et Google, Rec. 2010, p. I-02417, para. 91.

<sup>25</sup> See, S. ONO, *op. cit.*, p. 38.

<sup>26</sup> Osaka District Court, 24 Febr. 1976, Osaka Sankei K.K. v. Ox K.K., in T. Doi, Trademark and unfair competition law of Japan, Digest of Court Decisions, Vol. 1, AIPPI Japan, p. 130.

<sup>27</sup> K. L. PORT, Protection of famous trademark in Japan and the United States, 15 Wisconsin International Law Journal 259, 1997, p. 273.

<sup>28</sup> The ECJ recognized that “*the specific subject matter of the industrial property is the guarantee that the patentee, to reward the creative effort of the inventor, has the exclusive right to use an invention with a view to manufacturing industrial product and putting them into circulation for the first time*”. ECJ, 31 oct. 1974, 15/74, Centrafarm B.V. e.a. c/ Sterling Drug, Rec. 1974, p. 1147, para. 9.

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- <sup>29</sup> The Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases in its article 7: “*Member States shall provides for a right for the maker of a database which shows that there has been qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents to prevent extraction and/or re-utilization of the whole or of a substantial part, evaluated qualitatively and/or quantitatively, of the contents of that database*”.
- <sup>30</sup> CJEU, 22 sept. 2011, C-323/09, Interflora e.a..
- <sup>31</sup> para. 60.
- <sup>32</sup> para. 62.
- <sup>33</sup> para. 63.
- <sup>34</sup> ECJ, 31 oct. 1974, 16/74, Sté Centrafarm B.V et Adriaan de Peijper c. Sté Winthrop B.V, Rec. 1974, p. 1183, para. 8.
- <sup>35</sup> See notably, ECFI, 11 Dec. 2001, T-138/00, Erpo Möbelwerk c/ OHIM, Rec. 2001, p. II-3739 ; ECFI, 5 Dec. 2002, T-130/01, Sykes Enterprises c/ OHIM, Rec. 2002, p. II-5179.
- <sup>36</sup> See for example, Intellectual Property High Court, First Division, 17 Oct. 2006, 2006(Gyo-Ke) n° 10231 ; Intellectual Property High Court, Third division, 20 July 2005, 2005(Gyo-Ke)n° 10233.
- <sup>37</sup> See Intellectual Property High Court, Third Division, 27 June 2007, 2006(Gyo-Ke)10543; Intellectual Property High Court, Second Division, 10 April 2007, 2006(Gyo-Ke)10532; Intellectual Property High Court, Second Division, 25 October 2007, 2007(Gyo-Ke)10205; Intellectual Property High Court, Second Division, 19 July 2007, 2006(Gyo-Ke)10519; Intellectual Property High Court, Second Division, 19 Apr. 2005, 2005(Gyo-Ke) n° 10103.
- <sup>38</sup> ECJ, 11 March 2003, aff. C-40/01, Ansul, Rec. 2003, p. I-2439, para. 37.
- <sup>39</sup> ECJ, 12 Nov. 2002, C-206/01, Arsenal football club, Rec. 2002, p. I-10273.
- <sup>40</sup> ECJ, 18 June 2009, C-487/07, L'Oréal e.a., Rec. 2009, p. I-05185.
- <sup>41</sup> See for exemple, Tokyo District Court, 47th Civil Division, 20 Dec. 2005, 2005(Wa)n° 8928.
- <sup>42</sup> Indeed, as Osamu Sugawara quotes, the protection of consumer resulting from the Japanese Trademark Act is only indirect. O. Sugawara, *Consumeris kara no Shouhyouhou Tenbou*, Patent, Vol. 29, n° 8, p. 49-55, 1976. The same thing can be asserted for the trademark system in Europe. See on this question, Y. Basire, *Les fonctions de la marque : essai sur la cohérence du régime juridique d'un signe distinctif*, Thèse Strasbourg sous la direction du Professeur Y. REBOUL, 2011, para. 711.