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WHY IS THE FUNCTIONALITY DOCTRINE IN TRADE MARK LAW WORTH ADVANCED (RE)CONSIDERATION?

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ABSTRACT

This article considers the necessity of preparing a comprehensive study, over absolute refusal grounds pertaining to functional signs set in the EU trademark law, which would meet the business community's need to register non-traditional trade marks. The study aims to define the exact scope of the aforementioned exclusions through objective criteria that can render them a workable tool, distinct from refusal grounds pertaining to distinctiveness, and able to solve problems of overlapping rights. As its specific research methodology, the study adopts comparative results coming from the US trade dress functionality doctrine, and a specific input offered from a 'law and economics' perspective, including competition rules related to market definition and substitutability of products.

KEYWORDS

trade marks, functionality, public interest, US law, competition, products' substitutability

Intellectual property (IP) is an area of law that is strongly harmonized at the European Union level and subject to important international treaties. It is also the field most susceptible to the impact of new technologies that challenge the current legal framework. Such changes have a pace that any legislator can barely keep up with. One visible effect of this changing landscape concerns the situation when certain legal instruments are suddenly attaining new significance. This is the case of the functionality doctrine in trade mark law, also with relevance for other IP rights such as designs and copyright, which the Court of Justice of the European Union's judiciary has recently moved from a quasi-dormant status to a vividly debated one. The following remarks present some factors that have stimulated this development and identify major problems entangled by

the functionality doctrine, while discussing reasons to adopt a comparative approach to find flexible, market-tailored solutions.

1. SEIZING FUNCTIONALITY IN A 1 MINUTE READ

‘Functionality’ in trade mark law is a term designating a set of legal provisions that deny trade mark protection to signs consisting of certain product features that are technically or aesthetically important for competitors and consumers, for reasons pertaining to a risk of impeding effective competition on the market. In other words, granting legal exclusivity via trade mark registration on such a ‘functional’ sign on behalf of one undertaking would necessarily restrain competitors’ ability to trade in products with identical or similar features that could also be important for consumers. From an entrepreneurial perspective, trademarks play a paramount role.¹ Unlike other IP rights – considering here patents, utility models, designs, and even copyright – a trade mark registration, under the requirement of continuous use and payment of fees, may be renewed without time limits. This can make a successful product the object of a permanent exclusivity. This concept lays at the core of any competition concern.

2. FUNCTIONALITY: LEGAL STATUS AND CHALLENGES – A VIEW INTO THE LAW

From the very beginning of the EU trade mark harmonization process, functional provisions have constituted absolute grounds for refusal of registration.² They address the hypothetical situation of a sign, consisting of product features determined by the nature of such goods, or those features necessary to obtain a technical result or that give substantial value to the goods. The first and the last category of signs may be referred to under the notion of aesthetic functionality, whereas the second fits the term of technical/utilitarian functionality.

Speaking about product features, it appears obvious that functionality provisions have been targeting three-dimensional signs, but also two-dimensional representations of product shapes. High-profile judgements were delivered in cases such as the Philips

1 See recently R Skubisz, ‘Znaki towarowe i ich ochrona (refleksje ogólne)’ [Trade Marks and Their Protection (General Considerations)] in R Skubisz (ed), *Znaki towarowe i ich ochrona* [Trade Marks and Their Protection] (CH Beck 2019) 1–4; for a seminal study see R Skubisz, *Prawo z rejestracji znaku towarowego i jego ochrona. Studium z zakresu prawa polskiego na tle prawnoporównawczym* [Trade Mark Rights and Their Protection. Study of the Polish Law against Comparative Legal Background] (Stowarzyszenie Naukowe Pro Scientia Iuridica 2018) 17–33.

2 First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks [1989] OJ L 40/1, art. 3(1)(e) (i)–(iii); Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark [1994] OJ L 11/1, art. 7(1)(e)(i)–(iii) accordingly, followed by 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 [2008] OJ L 299/25, art. 3(1)(e) (i)–(iii) and Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L 78/1.

rotary shaver, LEGO brick and Stokke Tripp Trapp chair.³ This situation may change, however, because the latest amendments to EU trade mark law have broadened the scope of functional exclusions, extending beyond shapes to any other characteristic of goods (such as colours, texture, etc.).⁴ Challenges have already arisen from assessing the positioning of red colouring on a shoe sole, or two-dimensional decorative motifs affixed on fabric.⁵ Legal interpretation is needed to define the exact scope of the aforementioned exclusions, first identifying the category of signs that may fall under these provisions, and then finding objective, relevant criteria which can render these absolute refusal grounds a workable legal instrument, with foreseeable outcomes that are not detrimental to business practice.⁶

Such registration obstacles go against what the business community really wants to protect. A noticeable market trend consists of increased development of sophisticated branding strategies that are built upon appealing product features, addressing different human senses. The fastest way to make an impression on a consumer is not necessarily with words, as traditional trade marks used to do, but through shapes, colours, audio, moving icons and any combination thereof. This is the domain of so-called non-traditional marks, nowadays in full bloom. New technological means of communicating (product) information to consumers stimulate business interest in registering non-traditional signs.⁷ This trend is facilitated by the EU amendments which adopted a new definition of trade mark, departing from the problematic requirement of graphic representation, and enabling the filing of new types of marks.

3 Judgement of the CJUE C-299/99 EU:C:2002:377; Judgement of the CJUE C-48/09 EU:C:2010:516; Opinion in case C-205/13 EU:C:2014:322.

4 Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L 336/1, art. 4 (1) (e) (i)–(iii) and Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) and Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark [2017] OJ L 154/1, art. 7(1)(e)(i)–(iii) (which came finally into force on October 1, 2017 and replaced Regulation No 2015/2424).

5 Judgement of CJUE C-163/16 EU:C:2018:423; Judgement of CJUE C-21/18 EU:C:2019:199.

6 For recent analyses see E Rosati, ‘The Absolute Ground for Refusal or Invalidation in Article 7(1)(e)(iii) EUTMR/4(1)(e)(iii) EUTMD: In Search of the Exclusion’s Own Substantial Value’ (2020) *JIPLP* 15(2), 103–122 <<https://doi.org/10.1093/jiplp/jpz157>>; CJ Ramirez-Montes, ‘Louboutin Heels and the Competition Goals of EU Trade Mark Law’ (2019) *RIPL* 19(1) 38–63 <<https://repository.jmls.edu/ripl/vol19/iss1/2/>> accessed 25 Feb 2020; L Brancusi, ‘Funkcjonalność techniczna i estetyczna jako przeszkoda rejestracji’ [Technical and Aesthetic Functionality as a Registration Impediment] in R Skubisz (ed), *Znaki towarowe i ich ochrona* [Trade Marks and Their Protection] (CH Beck 2019) 26–36.

7 For a recent overall perspective see I Calboli, M Senftleben (eds), *The Protection of Non-Traditional Marks: Critical Perspectives* (OUP 2018) <<https://global.oup.com/academic/product/the-protection-of-non-traditional-trademarks-9780198826576?cc=pl&lang=en>> accessed 25 Feb 2020.

This possible dissonance between welcoming the filing of non-traditional trade marks and then immediately treating them to a chilling functionality test is strengthened by the interplay of another set of legal provisions, i.e. these related to distinctiveness. In many circumstances, a functional sign may also lack distinctive character, be descriptive or even customary, which form the object of distinct absolute refusal grounds.⁸ In contrast to functional prohibitions, these refusal grounds may be overpassed by proving acquired distinctiveness by the effect of use – so, registration remains a matter of time. Internationally, neither the Paris Convention⁹ or TRIPS¹⁰ formulated autonomous grounds for functional signs – there are doubts whether these acts were even meant to cover any non-traditional sign – with the effect that a strong legacy of national practices from a pre-harmonized EU landscape has blurred the relationship between distinctiveness and functionality issues.

From a practical point of view, it is vital that assessing functionality should permit a proper delineation of the scope of refusal grounds pertaining to distinctiveness issues. Distinctiveness has been already comprehensively analysed by the doctrine. Functionality stays within the ambit of this book.

3. FUNCTIONALITY AS A PUBLIC INTEREST POLICY AT THE CROSS-ROADS OF OVERLAPPING RIGHTS

An important input of the CJEU practice is the requirement to interpret functional provisions, and also the aforementioned refusal grounds linked to distinctiveness, through a ‘public interest’ rationale. The doctrine has been struggling to confer a sensible understating of this open-ended notion for a long period, adopting a fine-tuning method which leads to systemic, clear interpretation, though debates still remain.¹¹

As to functionality rules, two approaches, not necessarily mutually exclusive, may come into play. One reads functionality as a ‘channelling’ instrument aiming at delineating the scope of trade mark protection from other, time-limited, IP regimes. Functionality would ultimately act as a tool against simultaneous or sequential cumulation of rights on two frontlines: technical functionality would put trade marks aside from patents/utility models, and aesthetic functionality from design and copyright protection. Another approach recognizes the reasons of functionality as preventing negative effects on market competition, so that trade mark protection would only be denied in specific circumstances, namely when monopolization of essential product features may create disadvantages /

8 A Kur, ‘Absolute Grounds for Refusal’ in A Kur, M. Senftleben, with a contribution by V. von Bomhard, *European Trade Mark Law: A Commentary* (OUP 2017) 106–116; K Szczepanowska-Kozłowska, ‘Bezwzględne przeszkody rejestracji znaku towarowego’ [Absolute Refusal Grounds to a Trade Mark Registration] in R Skubisz (ed), *Prawo własności przemysłowej* [Industrial Property Law] (CH Beck 2017) 651–674.

9 Paris Convention for the Protection of Industrial Property of March 20, 1883, 21 UST 1583, 828 UNTS 305.

10 TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights, April 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 UNTS 299, 33 ILM, 1197.

11 I Fhima, ‘The Public Interest in European Trade Mark Law’ (2017) IPQ 4, 311 et subseq.

difficulties to competitors. At numerous times, CJEU has emphasized the effective competition rationale, although arguably without providing sufficient methods and criteria of assessment. This constitutes another good reason to deal with in a monograph.

Nowadays one of the critical situations that practice and doctrine have to face is the overlapping of IP rights. It is true that as a strategic means of growth, business entities are seeking to develop IP portfolios, which gather multifaceted forms of protection on the same asset. By way of example, in the pharma industry an innovative drug tends to exploit all the advantages given by patents, supplementary protection certificates and data exclusivity, but in addition, design, and especially trade mark protection, would come into play to cover important elements of the appearance of the product, such as the shape and colour of a pill.¹² Multiple concerns are formulated against the negative impact of ‘artificially’ prolonged legal exclusivity upon the scope of the public domain by reducing free access and thus obstructing follow-on creation and innovation.¹³

The functionality doctrine represents one of the possible instruments capable of creating order in what the doctrine calls the ‘eco-system’¹⁴ of rights. In design law, similar functional exclusions attack features solely dictated by product’s technical function and must-fit features enabling a mechanical connection (and resulting interoperability) of two products. There are multiple interactions between functionality rules in design and trade mark law, as CJEU guidelines for assessing functionality in trade mark law penetrate *mutatis mutandis* also into design matters. After a recent CJEU judgement in design law declaring ‘technical function’ an autonomous notion of EU law,¹⁵ Uma Suthersanen, an important voice of the doctrine, has noticed that CJEU tends to create a ‘harmonised exclusion’ for three-dimensional objects underlining ‘an aligned supra-rationale’ that

12 H Moir, L Palombi, ‘Patents and Trademarks: Empirical Evidence on ‘Evergreening’ from Australia’ (paper presented at 4th Asia-Pacific Innovation Conference at National Taiwan University in 2013) <<https://openresearch-repository.anu.edu.au/handle/1885/11418?mode=full>> accessed 25 Feb 2020; M Reitzig, ‘Strategic Management of Intellectual Property’ (2004) MIT SMR <<https://sloanreview.mit.edu/article/strategic-management-of-intellectual-property/>> accessed 25 Feb 2020.

13 A Tischner, *Kumulatywna ochrona wzornictwa przemysłowego w prawie własności intelektualnej* [The Cumulative Protection of Industrial Design in the Intellectual Property Law] (CH Beck 2015), 58–64. This concern was raised at numerous times by M Senftleben, ‘A Clash of Culture and Commerce: Non-Traditional Marks and the Impediment of Cyclic Cultural Innovation’ in I Calboli, M Senftleben (eds), *The Protection of Non-Traditional Marks: Critical Perspectives* (OUP 2018) 309 <<https://global.oup.com/academic/product/the-protection-of-non-traditional-trademarks-9780198826576?cc=pl&lang=en&>> accessed 25 Feb 2020; M Senftleben, ‘Impact on Competition Law: Monolithic Copyright, Market Power and Market Definition’ in KC Liu, RM Hilty (eds), *Remuneration of Copyright Owners: Regulatory Challenges of New Business*, (Springer 2017) 257.

14 A Tischner, ‘W ekosystemie ochrony własności intelektualnej’ [Within the Ecosystem of the Intellectual Property Protection] in A Adamczak (ed), *100 lat ochrony własności przemysłowej w Polsce. Księga jubileuszowa Urzędu Patentowego* [100 Years of Industrial Property Protection in Poland. Liber amicorum of the Patent Office] (Wolters Kluwer 2018) 1071–1085 discusses this notion in relation to cumulation of trade mark and copyright protection.

15 Judgement of CJUE C-395/16 EU:C:2018:172.

safeguards against conferring trade mark and / or design protection in cases restricting market competition.¹⁶ In addition, CJEU has currently also been asked to investigate the relevance of features dictated by technical function for the scope of copyright protection.¹⁷ From this perspective, functionality becomes an important legal doctrine transgressing several IP regimes which definitely calls for attention about its specific purposes in each IP right, and the means to adequately achieve those purposes.

4. FUNCTIONALITY WITHIN THE REALM OF COMPARATIVE RESEARCH WITH US LAW

Intellectual property law is an area in which many scholars have adopted comparative legal analysis as a prime research methodology.¹⁸ A reason for this is the fundamental role that intellectual property plays in international trade, because any IP territorial right may ultimately act as a barrier to trade. In a globalized world, goods and services travel fast, but frequently together with intangibles covered by legal ‘monopolies’ on behalf of particular undertakings. Comparative legal research is encouraged because it brings beneficial effects not only in ‘transposing’ some feasible solutions to legal issues arising within one national/regional system (here, specifically the EU) but, generally, for fostering more coherent solutions at an international level.

From this perspective, working on suitable methods of assessing functional trade marks on European grounds may noticeably benefit from a comparative insight into the US functionality doctrine. The latter consists of a vast body of law, judiciary and doctrinal guidelines which have been applied for more than a hundred years in relation to the protection of trade dress, first on the basis of unfair competition grounds, and later within the realm of registered trade marks.¹⁹ The interplay of distinctiveness requirement combined together with utilitarian or aesthetic aspects has led to important ‘tests’ to deal with the categories of ‘product packaging’ and ‘product configuration’.

It is true that US functionality practice may seem too wide, and perhaps sometimes ambiguous, which makes it difficult to manage for comparative purposes. But this is precisely why it may also turn out to be useful. A vast US corpus of case-law concerning myriad ‘functional’ product features, from different economic sectors, advocates to adjust

16 U Suthersanen, ‘Excluding Designs (and Shape Marks): Where is the EU Court of Justice Going?’ (2019) IIC 50, 160.

17 See case C-833/18 Brompton Bicycle, EU:C:2020:461. For an in-depth analysis of standards and challenges of copyright protection to designs post Cofemel judgement, see A Kur, ‘Unité de l’Art is Here to Stay – Cofemel and its Consequences’ (2019) Max Planck Institute for Innovation and Competition Research Paper 19-06 <https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3500845> accessed 25 Feb 2020.

18 I Calboli, ‘The Role of Comparative Legal Analysis in Intellectual Property Law: From Good to Great?’ in G Dinwoodie (ed), *Methods and Perspectives in Intellectual Property* (Edward Elgar 2013) 3–27 with further references.

19 Instead of many G Dinwoodie, M Janis, *Trade Dress and Design Law* (Aspen Publishers, Wolters Kluwer 2010).

any legal solution to the diverse necessities of business. This could be a valuable input for the EU practice, as it might help to foster flexible assessments and outcomes, suitable to meet the expectations and legal challenges associated with new categories of non-traditional marks.

Additional reasons in support of a comparative approach to the US law come from similarities over the public interest policy of denying protection to functional trade marks.²⁰ In US functionality cases, two schools of thought have been advanced: a ‘right to copy’ rationale (i.e. functionality as means of obstructing cumulation of rights and protecting public domain) in contrast to a ‘need to copy’ rationale (i.e. functionality as dealing with particular cases when the effective competition is impaired). The latter focusses on the availability of substitutable goods. In other words, if consumers have access to alternative products considered satisfactory substitutes, then functional features of a product may be trademarked on behalf of one entity without the risk of impairing competitors. A deeper insight into these approaches and the legal tests built upon them also seems useful for EU functionality cases.

5. A COMPLEMENTARY COMPARATIVE VIEW: FUNCTIONALITY WITHIN THE PARADIGM OF ‘LAW AND ECONOMICS’ AND PRODUCTS’ SUBSTITUTABILITY

Emphasizing an incentivizing aspect, intellectual property rights are said to reduce competition by imitation (i.e. legal exclusivity gives a right’s owner control over an asset and safeguards against its copying) but, in exchange, to enhance competition by substitution. Undertakings are encouraged to differentiate products and product information. This is acceptable according to competition law goals and welfare efficiency standards set by ‘law and economics’. Problems arise when competition by substitution is curtailed and consumers’ choice of price / quality / innovative products is narrowed. Such effects may result from granting trade mark protection to a functional sign. As previously noted, the functionality rationale touches upon the need to balance public interests against the private interests of trade mark owners, and this calls for finding some positive methods of evaluating cases of the negative impact of registrations on market competition.

Assuming that the core issue of functionality trade mark cases lies in assessing the availability of substitutable goods, an avenue of exploring such matters could constitute a competition law perspective on market definition and products’ substitutability.²¹

20 Such possibilities were explored in L Brancusi, ‘Alternative Products as a Factor to Determine the Functionality of Trade Marks – How the Criteria from the US Functionality Doctrine Could be Applied in the EU Law?’ in S Frankel (ed), *Is Intellectual Property Pluralism Functional?* (Edward Elgar Publishing 2019) 180-200.

21 See L Brancusi, ‘Assessing the Impact of Registering Non-Traditional Marks in the EU Law: A Competition Law Analysis’ in I Calboli, M Senftleben (eds), *The Protection of Non-Traditional Marks: Critical Perspectives* (OUP 2018) 248–256, <<https://global.oup.com/academic/product/the-protection-of-non-traditional-trademarks-9780198826576?cc=pl&lang=en>> accessed 25 Feb 2020.

Market definition is a key concept of competition law (antitrust in the US) proceedings for assessing market dominance / power. It focuses on the possibility of customers switching to alternative products in the event of a price increase or other modifications of product' qualities.²² For trade mark purposes, an interesting situation relates to narrowly defined markets restricted to one product, especially because of long-term branding strategies. There is a growing interest in competition law practice to take into account branding as an essential factor to induce consumers' insensitiveness to price changes and therefore negatively affect products' substitutability.²³ This calls for analysing here the extent to which 'product delineation' (i.e. defining the relevant product and its alternatives) may be useful for functionality cases.

In a more general manner, an interesting query can be posed on how functional trade marks are challenging the traditional view of trade marks' performing a pro-competitive role. It is quite known that trade mark rights help maintain supra-competitive prices after the lapse of patents, which is a significant circumstance for technical functionality. In addition, branding strategies are built on the loyalty of emotionally involved consumers, which ultimately affects the value of goods and is relevant for matters of aesthetic functionality too.

Summing up these aspects, it is the author's contention that a comparative view into the 'law and economics' perspective over trade marks and its direct link with competition law, and some specific methods of assessment, would be instrumental for finding appropriate solutions to functionality cases. An encouraging sign supporting such a research attitude comes from a recent conclusion by a leading IP scholar about functionality in design and trade mark law, that *the only real consideration is whether [...] protection will threaten the competitive practices within an identified product market.*²⁴

6. CONCLUSIONS

Circling back to the question initially set out, the author sees the need for a comprehensive study over the functional exclusions set in EU trade mark law, which would bridge comparative results originating from the US trade dress functionality doctrine, and specific input offered by a 'law and economics' perspective, including competition rules pertaining to market definition. The book prepared within the framework of the project 'Excellence in Legal Research. Promoting Polish achievements in the area of

22 P Podrecki, 'Porozumienia ograniczające konkurencję' [Agreements Restricting Competition] in M Kępiński (ed), *Prawo konkurencji* [Competition Law] (CH Beck 2014) 783–786; M Bernatt, A Jurkowska-Gomułka, T Skoczny, 'Zakaz nadużywania pozycji dominującej' [Prohibition of abuse of Dominant Position] in M Kępiński (ed) 976–981; D Miąsik, *Stosunek prawa ochrony konkurencji do prawa własności intelektualnej* [The Relationship Between Competition Law and Intellectual Property Law] (Wolters Kluwer 2012) 109–116.

23 For a multifaceted analysis see D Desai, I Lianos, S Waller (eds), *Brands, Competition Law and IP* (CUP 2015).

24 U Suthersanen 157–160.

legal sciences abroad’ will have the following structure. Chapter one will introduce the EU legal framework and discuss the notion of public interest across different absolute refusal grounds. Chapter two will touch upon functionality doctrine in the US law, with an aim of emphasizing common points. Chapter three will take an approach of ‘law and economics’ to discuss competition reasons for denying trade mark protection to functional signs. Special attention will be paid to the issue of market-definition and access to alternative products. The chapters that follow will focus on aspects of legal interpretation of the category of signs that are caught by the EU functional provisions and consist of product features determined by technical/utilitarian and aesthetic considerations. An important objective is to find sensible solutions to the problem of overlapping rights. The conclusions will sum up with practical tips and *de lege ferenda* suggestions.

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- Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) [2015] OJ L 341.
- Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks [2015] OJ L 336/1.
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- Judgement of the CJUE C-48/09 EU:C:2010:516.
- Opinion of the CJUE in case C-205/13 EU:C:2014:322.
- Judgement of CJUE C-395/16 EU:C:2018:172.
- Judgement of CJUE C-163/16 EU:C:2018:423.
- Judgement of CJUE C-21/18 EU:C:2019:199.
- Judgement of CJEU, C-833/18 EU:C:2020:461.