

European Court of Justice, 4 November 2008, Intel v CPM - Intelmark



TRADEMARK LAW

Link between the earlier mark and the later mark

- **Link must be assessed globally, taking into account all factors relevant to the circumstances of the case**

Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that whether there is a link, within the meaning of Case C-408/01 Adidas-Salomon and Adidas Benelux, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.

- **There is a link when the later mark calls the earlier mark with a reputation to mind**

The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks.

- **Reputation, dissimilarity and uniqueness of the earlier mark do not necessarily imply that there is a link**

- the earlier mark has a huge reputation for certain specific types of goods or services, and
 - those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
 - the earlier mark is unique in respect of any goods or services,
- does not necessarily imply that there is a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks.

Unfair advantage, detriment to the distinctive character or the repute of the mark

- **Mst be assessed globally**

Article 4(4)(a) of Directive 89/104 must be interpreted as meaning that whether a use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case.

- **Reputation, dissimilarity, uniqueness and association is not sufficient to establish unfair advantage or detriment to the distinctive character or the repute of the mark**

- the earlier mark has a huge reputation for certain specific types of goods or services, and
 - those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
 - the earlier mark is unique in respect of any goods or services, and
 - for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark to mind,
- is not sufficient to establish that the use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, within the meaning of Article 4(4)(a) of Directive 89/104.

- **Proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer or a serious likelihood that such a change will occur in the future**

Article 4(4)(a) of Directive 89/104 must be interpreted as meaning that:

- the use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique;
- a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark;
- Proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.

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European Court of Justice, 2 November 2008

(P. Jann, M. Ilešič, A. Tizzano, A. Borg Barthet and E. Levits)

JUDGMENT OF THE COURT (First Chamber)

27 November 2008 (*)

(Directive 89/104/EEC – Trade marks – Article 4(4)(a) – Trade marks with a reputation – Protection against the use of a later identical or similar mark – Use which

takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier trade mark)

In Case C-252/07,

REFERENCE for a preliminary ruling under Article 234 EC from the Court of Appeal (England and Wales) (Civil Division) (United Kingdom), made by decision of 15 May 2007, received at the Court on 29 May 2007, in the proceedings

Intel Corporation Inc.

v

CPM United Kingdom Ltd,

THE COURT (First Chamber),

composed of P. Jann, President of Chamber, M. Ilešič (Rapporteur), A. Tizzano, A. Borg Barthet and E. Levits, Judges,

Advocate General: E. Sharpston,

Registrar: L. Hewlett, Principal Administrator,

having regard to the written procedure and further to the hearing on 16 April 2008,

after considering the observations submitted on behalf of:

– Intel Corporation Inc., by J. Mellor QC, instructed by CMS Cameron McKenna LLP,

– CPM United Kingdom Ltd, by M. Engelman, barrister, and M. Bilewycz, registered trade mark attorney,

– the United Kingdom Government, by V. Jackson, acting as Agent, and S. Malynicz, barrister,

– the Italian Government, by I.M. Braguglia, acting as Agent, and G. Aiello, avvocato dello Stato,

– the Commission of the European Communities, by W. Wils, acting as Agent,

after hearing the [Opinion of the Advocate General](#) at the sitting on 26 June 2008,

gives the following

Judgment

1 This reference for a preliminary ruling concerns the interpretation of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1, ‘the Directive’).

2 The reference was made in proceedings in which Intel Corporation Inc. (‘Intel Corporation’) is applying for a declaration of invalidity against the registration of the INTELMARK trade mark owned by CPM United Kingdom Ltd.

Relevant provisions

Community law

3 Article 4 of the Directive, entitled ‘Further grounds for refusal or invalidity concerning conflicts with earlier rights’, provides:

‘1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

(a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there

exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

2. “Earlier trade marks” within the meaning of paragraph 1 means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks;

...

(ii) trade marks registered in the Member State ...

...

...

4. Any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

(a) the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

...’

4 Article 5(2) of the Directive, entitled ‘Rights conferred by a trade mark’, provides:

‘Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.’

5 The Court has interpreted that provision as follows in paragraphs 29 and 30 of its judgment in [Case C-408/01 Adidas-Salomon and AdidasBenelux \[2003\] ECR I-12537](#):

‘29 The infringements referred to in Article 5(2) of [Directive 89/104], where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, [Case C-375/97 General Motors \[1999\] ECR I-5421, paragraph 23](#)).

30 The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of Directive [89/104], be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, [\[Case C-251/95\] SABEL \[\[1997\] ECR I-6191\], para-](#)

[graph 22](#), and [\[Case C-425/98\] Marca Mode \[\[2000\] ECR I-4861\], paragraph 40](#).’

National law

6 The Directive was transposed in the United Kingdom of Great Britain and Northern Ireland by the Trade Marks Act 1994.

7 Under section 5(3)(a) of the Trade Marks Act, ‘[a] trade mark which ... is identical with or similar to an earlier trade mark ... shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark [or international trade mark (EC)] in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.’

8 Section 47(2)(a) of the Trade Marks Act provides that ‘[t]he registration of a trade mark may be declared invalid on the ground ... that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain’.

The dispute in the main proceedings and the questions referred for a preliminary ruling

9 Intel Corporation is, inter alia, the proprietor of the national word mark INTEL, registered in the United Kingdom, as well as of various other national and Community trade marks consisting of or including the word ‘Intel’. The goods and services in respect of which those marks were registered are, essentially, computers and computer-linked goods and services in Classes 9, 16, 38 and 42 under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

10 According to the order for reference, the INTEL mark has a huge reputation in the United Kingdom for microprocessor products (chips and peripherals) and multimedia and business software.

11 CPM United Kingdom Ltd is the proprietor of the national word mark INTELMARK, registered in the United Kingdom with effect from 31 January 1997 for ‘marketing and telemarketing services’ in Class 35 under the Nice Agreement.

12 On 31 October 2003 Intel Corporation filed at the United Kingdom Trade Mark Registry an application for a declaration of invalidity against the registration of the INTELMARK trade mark on the basis of section 47(2) of the Trade Marks Act, claiming that the use of that mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier INTEL trade mark within the meaning of section 5(3) of that act.

13 Its application was dismissed by decision of the Hearing Officer of 1 February 2006.

14 The appeal brought by Intel Corporation to the High Court of Justice of England and Wales, Chancery Division (Intellectual Property), was dismissed on 26 July 2006.

15 Intel Corporation then appealed to the Court of Appeal (England and Wales) (Civil Division).

16 Intel Corporation argued before that court that both Article 4(4)(a) and Article 5(2) of the Directive seek to protect a proprietor of a trade mark with a reputation against the risk of dilution.

17 Relying on the judgment in *Adidas-Salomon and Adidas Benelux*, it considers that, in order to enjoy the protection conferred by Article 4(4)(a) of the Directive, it is sufficient that the degree of similarity between the earlier mark with a reputation and the later mark has the effect that the relevant section of the public establishes a link between those two marks. A ‘link’ means any kind of mental association between those two marks, so a mere bringing to mind of the earlier mark is enough.

18 Furthermore, relying on paragraph 30 of the judgment in *General Motors*, Intel Corporation submits that, where the earlier mark both is unique and has a strong distinctive character, it must be accepted that detriment to it will be caused by virtually any use for any other goods or services. It adds that, where the earlier mark is unique and well known, it is important to stop any encroachment at the outset, otherwise that mark will suffer a death by a thousand cuts.

19 The national court states, first, that ‘Intel’ is an invented word with no meaning or significance beyond the products which it identifies, that the INTEL mark is unique in the sense that the word of which it consists has not been used by anyone for any goods or services other than those marketed by Intel Corporation and, finally, that that mark has a huge reputation in the United Kingdom for computers and computer-linked products.

20 Secondly, the national court considers that the INTEL and INTELMARK trade marks are similar, but starts from the premiss that the use of INTELMARK does not suggest a trade connection with Intel Corporation.

21 Thirdly, the national court states that the goods – essentially, computers and computer-linked products – and services for which Intel Corporation’s national and Community marks consisting of or including the word ‘Intel’ were registered are dissimilar to the services covered by the registration of the INTELMARK trade mark.

22 It is uncertain whether, in such factual circumstances, the proprietor of the earlier mark with a reputation is entitled to the protection provided for in Article 4(4)(a) of the Directive. More generally, it raises the question of the conditions and scope of that protection.

23 Accordingly, the Court of Appeal (England and Wales) (Civil Division) decided to stay the proceedings and to refer the following questions to the Court for a preliminary ruling:

‘(1) For the purposes of Article 4(4)(a) of the [Directive], where:

(a) the earlier mark has a huge reputation for certain specific types of goods or services,

(b) those goods or services are dissimilar or dissimilar to a substantial degree to the goods or services of the later mark,

(c) the earlier mark is unique in respect of any goods or services,

(d) the earlier mark would be brought to mind by the average consumer when he or she encounters the later mark used for the services of the later mark,

are those facts sufficient in themselves to establish (i) “a link” within the meaning of paragraphs 29 and 30 of [Adidas-Salomon and Adidas Benelux], and/or (ii) unfair advantage and/or detriment within the meaning of that Article?

(2) If no, what factors is the national court to take into account in deciding whether such is sufficient? Specifically, in the global appreciation to determine whether there is a “link”, what significance is to be attached to the goods or services in the specification of the later mark?

(3) In the context of Article 4(4)(a) [of the Directive], what is required in order to satisfy the condition of detriment to distinctive character? Specifically, (i) does the earlier mark have to be unique, (ii) is a first conflicting use sufficient to establish detriment to distinctive character and (iii) does the element of detriment to distinctive character of the earlier mark require an effect on the economic behaviour of the consumer?

The questions

Preliminary observations

24 It should be noted that the wording of Articles 4(4)(a) and 5(2) of the Directive is essentially identical and is designed to give trade marks with a reputation the same protection.

25 Accordingly, the interpretation of Article 5(2) of the Directive given by the Court in Adidas-Salomon and Adidas Benelux, applies equally to Article 4(4)(a) of the Directive (see, to that effect, [Case C-292/00 Davidoff \[2003\] ECR I-389, paragraph 17](#)).

The protection given by Article 4(4)(a) of the Directive

26 Article 4(4)(a) of the Directive establishes, for the benefit of trade marks with a reputation, a wider form of protection than that provided for in Article 4(1). The specific condition of that protection consists of a use of the later mark without due cause which takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark (see, to that effect, in respect of Article 5(2) of the Directive, *Marca Mode*, paragraph 36; *Adidas-Salomon and Adidas Benelux*, paragraph 27, and *Case C-102/07 adidas and adidas Benelux [2008] ECR I-0000*, paragraph 40).

27 The types of injury against which Article 4(4)(a) of the Directive ensures such protection for the benefit of trade marks with a reputation are, first, detriment to the distinctive character of the earlier mark, secondly, detriment to the repute of that mark and, thirdly, unfair advantage taken of the distinctive character or the repute of that mark.

28 Just one of those three types of injury suffices for that provision to apply.

29 As regards, in particular, detriment to the distinctive character of the earlier mark, also referred to as

‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is notably the case when the earlier mark, which used to arouse immediate association with the goods and services for which it is registered, is no longer capable of doing so.

30 The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see, in relation to Article 5(2) of the Directive, *General Motors*, paragraph 23; *Adidas-Salomon and Adidas Benelux*, paragraph 29, and *adidas and adidas Benelux*, paragraph 41).

31 In the absence of such a link in the mind of the public, the use of the later mark is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

32 However, the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 4(4)(a) of the Directive, which constitute, as was stated in paragraph 26 of this judgment, the specific condition of the protection of trade marks with a reputation laid down by that provision.

The relevant public

33 The public to be taken into account in order to determine whether registration of the later mark may be declared invalid pursuant to Article 4(4)(a) of the Directive varies depending on the type of injury alleged by the proprietor of the earlier trade mark.

34 First, both a trade mark’s distinctiveness and its reputation must be assessed, first, by reference to the perception of the relevant public, which consists of average consumers of the goods or services for which that mark is registered, who are reasonably well informed and reasonably observant and circumspect (as regards distinctive character, see [Case C-363/99 Koninklijke KPN Nederland \[2004\] ECR I-1619, paragraph 34](#); as regards reputation, see, to that effect, [General Motors, paragraph 24](#)).

35 Accordingly, the existence of injury consisting of detriment to the distinctive character or the repute of the earlier mark must be assessed by reference to average consumers of the goods and services for which that mark is registered, who are reasonably well informed and reasonably observant and circumspect.

36 Secondly, as regards injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, in so far as what is prohibited is the drawing of benefit from that mark by the proprietor of the later mark, the existence of such injury must be assessed by reference to average consumers of the goods or services for which the later mark is registered,

who are reasonably well informed and reasonably observant and circumspect.

Proof

37 In order to benefit from the protection introduced by Article 4(4)(a) of the Directive, the proprietor of the earlier mark must adduce proof that the use of the later mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark'.

38 The proprietor of the earlier trade mark is not required, for that purpose, to demonstrate actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive. When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future.

39 When the proprietor of the earlier mark has shown that there is either actual and present injury to its mark for the purposes of Article 4(4)(a) of the Directive or, failing that, a serious risk that such injury will occur in the future, it is for the proprietor of the later mark to establish that there is due cause for the use of that mark.

Point (i) of Question 1 and Question 2

40 By point (i) of Question 1 and Question 2, the national court asks, essentially, what the relevant criteria are for the purposes of establishing whether there is a link, within the meaning of the judgment in *Adidas Salomon and Adidas Benelux* ('a link'), between the earlier mark with a reputation and the later mark in respect of which a declaration of invalidity is sought.

41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *adidas and adidas Benelux*, paragraph 42).

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.

43 In that respect, the following points must be made.

44 As regards the degree of similarity between the conflicting marks, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. That is particularly the case where those marks are identical.

45 However, the fact that the conflicting marks are identical, and even more so if they are merely similar, is not sufficient for it to be concluded that there is a link between those marks.

46 It is possible that the conflicting marks are registered for goods or services in respect of which the relevant sections of the public do not overlap.

47 The reputation of a trade mark must be assessed in relation to the relevant section of the public as regards the goods or services for which that mark was registered. That may be either the public at large or a more specialised public (see *General Motors*, paragraph 24).

48 It is therefore conceivable that the relevant section of the public as regards the goods or services for which the earlier mark was registered is completely distinct from the relevant section of the public as regards the goods or services for which the later mark was registered and that the earlier mark, although it has a reputation, is not known to the public targeted by the later mark. In such a case, the public targeted by each of the two marks may never be confronted with the other mark, so that it will not establish any link between those marks.

49 Furthermore, even if the relevant section of the public as regards the goods or services for which the conflicting marks are registered is the same or overlaps to some extent, those goods or services may be so dissimilar that the later mark is unlikely to bring the earlier mark to the mind of the relevant public.

50 Accordingly, the nature of the goods or services for which the conflicting marks are registered must be taken into consideration for the purposes of assessing whether there is a link between those marks.

51 It must also be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered.

52 In such a case, it is possible that the relevant section of the public as regards the goods or services for which the later mark is registered will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services for which the earlier mark was registered.

53 For the purposes of assessing where there is a link between the conflicting marks, it may therefore be necessary to take into account the strength of the earlier mark's reputation in order to determine whether that reputation extends beyond the public targeted by that mark.

54 Likewise, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind.

55 Accordingly, for the purposes of assessing whether there is a link between the conflicting marks, the degree of the earlier mark's distinctive character must be taken into consideration.

56 In that regard, in so far as the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that mark and, therefore, its distinctive character are all the stronger if that mark is unique – that is to say, as regards a word mark such as INTEL, if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets – it must be ascertained whether the earlier mark is unique or essentially unique.

57 Finally, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or from economically-linked undertakings (see to that effect, *inter alia*, [Case C-342/97 Lloyd Schuhfabrik Meyer \[1999\] ECR I-3819, paragraph 17](#), and [Case C-533/06 O2 Holdings and O2 \(UK\) \[2008\] ECR I-0000, paragraph 59](#)).

58 However, as is apparent from paragraphs 27 to 31 of the judgment in *Adidas-Salomon and Adidas Benelux*, implementation of the protection introduced by Article 4(4)(a) of the Directive does not require the existence of a likelihood of confusion.

59 The national court asks, in particular, whether the circumstances set out in points (a) to (d) of Question 1 referred for a preliminary ruling are sufficient to establish a link between the conflicting marks.

60 As regards the circumstance referred to in point (d) of that question, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link.

61 As regards the circumstances referred to in paragraphs (a) to (c) of that question, as is apparent from paragraph 41 to 58 of this judgment, they do not necessarily imply the existence of a link between the conflicting marks, but they do not exclude one either. It is for the national court to base its analysis on all the facts of the case in the main proceedings.

62 The answer to point (i) of Question 1 and to Question 2 must therefore be that Article 4(4)(a) of the Directive must be interpreted as meaning that whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

63 The fact that for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.

64 The fact that:

– the earlier mark has a huge reputation for certain specific types of goods or services, and

– those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and

– the earlier mark is unique in respect of any goods or services,

does not necessarily imply that there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the conflicting marks.

Point (ii) of Question 1 and Question 3

65 By point (ii) of Question 1, the national court asks whether the circumstances set out in points (a) to (d) are sufficient to establish that the use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark. By Question 3, the national court asks, essentially, what the relevant criteria are for the purposes of assessing whether the use of the later mark is or would be detrimental to the distinctive character of the earlier mark.

66 First, as was pointed out in paragraph 30 of this judgment, the types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them.

67 The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that the current or future use of the later mark is taking unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier mark.

68 It follows that, like the existence of a link between the conflicting marks, the existence of one of the types of injury referred to in Article 4(4)(a) of the Directive, or a serious likelihood that such an injury will occur in the future, must be assessed globally, taking into account all factors relevant to the circumstances of the case, which include the criteria listed in paragraph 42 of this judgment.

69 As regards the strength of the reputation and the degree of distinctive character of the earlier mark, the Court has already held that the stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (see, regarding Article 5(2) of the Directive, *General Motors*, paragraph 30).

70 Secondly, the circumstances listed in points (a) to (d) of Question 1 are not sufficient to establish the existence of unfair advantage and/or detriment within the meaning of Article 4(4)(a) of the Directive.

71 So far as concerns, in particular, the fact referred to in point (d) of that question, as follows from paragraph 32 of this judgment, the existence of a link between the conflicting marks does not dispense the proprietor of the earlier trade mark from having to prove actual and present injury to its mark, for the purposes of Article 4(4)(a) of the Directive, or a serious likelihood that such an injury will occur in the future.

72 Lastly, as regards, more particularly, detriment to the distinctive character of the earlier mark, the answer to the second part of the third question must be that, first, it is not necessary for the earlier mark to be unique in order to establish such injury or a serious likelihood that it will occur in the future.

73 A trade mark with a reputation necessarily has distinctive character, at the very least acquired through use. Therefore, even if an earlier mark with a reputation is not unique, the use of a later identical or similar mark may be such as to weaken the distinctive character of that earlier mark.

74 However, the more 'unique' the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character.

75 Secondly, a first use of an identical or similar mark may suffice, in some circumstances, to cause actual and present detriment to the distinctive character of the earlier mark or to give rise to a serious likelihood that such detriment will occur in the future.

76 Thirdly, as was stated on paragraph 29 of this judgment, detriment to the distinctive character of the earlier mark is caused when that mark's ability to identify the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark leads to dispersion of the identity and hold upon the public mind of the earlier mark.

77 It follows that proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.

78 It is immaterial, however, for the purposes of assessing whether the use of the later mark is or would be detrimental to the distinctive character of the earlier mark, whether or not the proprietor of the later mark draws real commercial benefit from the distinctive character of the earlier mark.

79 The answer to point (ii) of Question 1 and to Question 3 must therefore be that Article 4(4)(a) of the Directive is to be interpreted as meaning that whether a use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case.

80 The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services, and

– for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark to mind, is not sufficient to establish that the use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, within the meaning of Article 4(4)(a) of the Directive.

81 Article 4(4)(a) of the Directive must be interpreted as meaning that:

- the use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique;
- a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark;
- proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.

Costs

82 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds,

the Court (First Chamber) hereby rules:

1. Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that whether there is a link, within the meaning of Case C-408/01 Adidas-Salomon and Adidas Benelux, between the earlier mark with a reputation and the later mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

2. The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks.

3. The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
- those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
- the earlier mark is unique in respect of any goods or services,

does not necessarily imply that there is a link, within the meaning of Adidas-Salomon and Adidas Benelux, between the conflicting marks.

4. Article 4(4)(a) of Directive 89/104 must be interpreted as meaning that whether a use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute

of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case.

5. The fact that:

- the earlier mark has a huge reputation for certain specific types of goods or services, and
 - those goods or services and the goods or services for which the later mark is registered are dissimilar or dissimilar to a substantial degree, and
 - the earlier mark is unique in respect of any goods or services, and
 - for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark to mind,
- is not sufficient to establish that the use of the later mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, within the meaning of Article 4(4)(a) of Directive 89/104.

6. Article 4(4)(a) of Directive 89/104 must be interpreted as meaning that:

- the use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique;
- a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark;
- Proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.

Opinion Advocate general Sharpston
delivered on 26 June 2008 (1)
Case C-252/07
Intel Corporation Inc.

v

CPM United Kingdom Limited
(Trade marks – Dilution)

1. This reference for a preliminary ruling from the Court of Appeal of England and Wales concerns the extent to which trade marks with a reputation may be protected against ‘dilution’.

2. Community trade mark law (2) allows a Member State to provide that a national trade mark may be declared invalid if it is similar to an earlier national trade mark, even though the two marks may be registered for dissimilar goods or services, if the earlier mark has a reputation in the Member State and if ‘use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark’.

3. The Court of Justice has interpreted that wording as requiring a degree of similarity between the two marks which need not be such as to give rise to a likelihood of confusion but may merely have the effect that the relevant section of the public ‘establishes a link’ between them.

4. The issue in the national proceedings is whether the owners of the trade mark ‘Intel’, which has a reputation in respect of computer related goods and services, may obtain invalidation of the later mark ‘Intelmark’, registered in respect of marketing services. In that context, the Court of Appeal seeks further clarification of the nature of the ‘link’ required by the case-law, and of the concepts of (i) unfair advantage and (ii) detriment to the distinctive character or repute of the earlier mark.

The notion of dilution

5. A significant function of a trade mark is to link goods or services to a source of supply, whether the original producer or a commercial intermediary. That is in the interest of both supplier and consumer. The supplier can establish a reputation, which is protected from usurpation by competitors, for products bearing the mark, and can thus promote trade in those products. Likewise, the consumer can make purchasing decisions on the basis of the qualities he perceives as attached to the mark. Since those decisions may be negative, suppliers have an incentive to maintain and improve the quality of the goods or services supplied under the mark.

6. In that context, marks which are identical, or similar enough to be confused, should not coexist unless the goods or services for which they are used are sufficiently dissimilar to rule out the danger of confusion. Trade marks are therefore protected by a basic rule (3) which prevents the registration or use of a sign identical or similar to a registered trade mark, for goods or services identical or similar to those for which the mark is registered. To put it more graphically, around each trade mark there is an ‘exclusion zone’ which other marks may not enter. The extent of that zone will vary according to circumstances. An identical or extremely similar mark must be kept at a greater distance in terms of the goods or services covered. Conversely, a mark used for identical or extremely similar products must be kept at a greater distance in terms of similarity with the protected mark.

7. Such protection is seen as sufficient as a general rule. Similar or even identical trade marks can coexist for dissimilar products without causing confusion in consumers’ minds or harming traders’ commercial interests.

8. But that is not true in all circumstances. In an apparent paradox, the best known trade marks are particularly vulnerable to the existence of similar marks even in highly dissimilar product areas, where actual confusion is unlikely. Moreover, such marks frequently perform functions which go beyond linking goods or services to a uniform source. They present a powerful image of quality, exclusivity, youth, fun, luxury, adventure, glamour or other reputedly desirable lifestyle attributes, not necessarily associated with specific products but capable of presenting a strong marketing message in itself. (4)

9. One can imagine how, if ‘Coca-Cola’ were registered only in respect of soft drinks, the distinctiveness of the mark could be eroded if it (or a similar mark or

sign) were used by others in respect of a host of unrelated products; or how its reputation could be harmed if it were used for low-grade engine oils or cheap paint strippers.

10. The notion of protecting trade marks against dilution arose in response to such concerns. As Advocate General Jacobs noted in *Adidas I*, (5) it was first articulated by Schechter in 1927 – although Schechter considered that it was ‘arbitrary, coined or fanciful marks’, rather than famous marks, which should benefit from such protection. (6)

11. Two types of dilution are commonly recognised: blurring and tarnishment. (7) Broadly, the former corresponds to the notion of detriment to the distinctive character of the earlier mark in Article 4(4)(a) of the Directive, and to my first example concerning Coca-Cola, while the latter corresponds to that of detriment to its repute, and to my second example.

12. Article 4(4)(a) adds a further category of abuse: taking unfair advantage of the distinctiveness or repute of the earlier mark, often referred to as free-riding. (8)

13. The protection thus afforded concerns less the link established between a product and its source than the use of the trade mark as a communication tool, carrying a broader marketing message.

Relevant legislation

14. Within the European Community, trade mark law comprises two limbs. On the one hand, there is a system of Community trade marks, valid throughout the Community and governed by the Community Trade Mark Regulation. (9) On the other, there are separate systems of national trade marks, each limited to the Member State concerned but to a very large extent harmonised by the Trade Marks Directive. (10)

15. According to its preamble, the basic protection afforded by the Directive – the function of which is in particular to guarantee the trade mark as an indication of origin – is absolute in the case of identity between the mark and the sign and between the goods or services covered, but applies also in the case of similarity between the mark and the sign and between the goods or services, in which case likelihood of confusion is the specific condition for such protection. (11)

16. Article 4(1) consequently provides:

‘A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

(a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.’

17. However, Member States may grant more extensive protection to those trade marks which have a reputation. (12)

18. In that connection, Article 4(4)(a) – the provision directly in issue in the present case – allows any Member State to provide that

‘a trade mark shall not be registered or, if registered, is liable to be declared invalid where, and to the extent that ... the trade mark is identical with, or similar to, an earlier national trade mark ... and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark’. (13)

19. In similar terms, Article 5(2) allows any Member State to give a trade mark proprietor the right to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, his trade mark in relation to goods or services which are not similar to those for which the mark is registered, where it has a reputation in the Member State and ‘where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark’.

20. The Directive and the Regulation were drafted in parallel, and many of their substantive provisions are similar, so that interpretation of one is often transposable to the other. That is relevant in the present case with regard to Article 8(5) of the Regulation, which allows proprietors of earlier national or Community trade marks having a reputation in the territory in which they are registered to oppose registration of a Community trade mark on the same grounds as those in Article 4(4)(a) of the Directive. (14)

21. The Directive – including the optional provisions in Articles 4(4)(a) and 5(2) – has been implemented in the United Kingdom by the Trade Marks Act 1994. The referring court expressly states that the Act has the same meaning as the Directive, so that it is unnecessary to refer separately to the provisions of the Act.

Case-law

22. The only occasion so far on which the Court has had to interpret Article 4(4)(a) of the Directive has been in *Davidoff II*, on a point not in itself directly relevant to the present case. (15) It has, however, made a number of more relevant rulings concerning the comparable provisions of Article 5(2). (16)

23. In *General Motors*, (17) the Court of Justice considered that the term ‘reputation’ in Article 5(2) implies a ‘knowledge threshold’ which is reached when a trade mark is known by a ‘significant part’ of the public concerned by the products or services covered by the mark, in a ‘substantial part’ of the Member State concerned. It is only where there is a sufficient degree of knowledge of the earlier mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged. In order to determine whether that threshold has been

reached, all the relevant facts must be taken into consideration, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it. The Court also observed that the stronger the earlier mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it.

24. In *Adidas I*, (18) the Court considered, in substance, that Article 5(2) of the Directive does not require a likelihood of confusion on the part of the public, but supposes a degree of visual, aural or conceptual similarity between the mark with a reputation and the sign (19) used such that the relevant section of the public 'makes a connection', or 'establishes a link', between the two, even though it does not confuse them. The existence of such a link must, just like a likelihood of confusion in other circumstances where that is required, be appreciated globally, taking into account all factors relevant to the circumstances of the case.

25. In *Adidas II*, (20) the Court confirmed its judgment in *Adidas I* and went on to state that the requirement of availability (namely, that the use of certain signs should not be unduly restricted for other traders, a concept known in German as *Freihaltebedürfnis*) is extraneous both to the assessment of the degree of similarity between the mark with a reputation and the sign used by the third party and to the link which may be made by the relevant public between that mark and the sign. It cannot therefore constitute a relevant factor for determining whether the use of the sign takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

Facts and procedure

26. Intel Corporation Inc. ('Intel') owns a number of United Kingdom and Community trade marks predating 1997, consisting of or including the word 'Intel', registered in classes 9, 16, 38 and 42 of the Nice Classification (21) for what the referring court describes as 'essentially, computers and computer linked goods and services'. The referring court finds that 'Intel' has a 'huge reputation' as a trade mark, already acquired by 1997. It is further stated to be 'an invented word with no meaning or significance beyond the products which it identifies', and to be 'unique' in that it has not been used by anyone for any goods or services other than Intel's own.

27. CPM United Kingdom Ltd ('CPM') owns the United Kingdom trade mark 'Intelmark', registered in 1997 in class 35 of the Nice classification for 'marketing and telemarketing services' (it was coined, according to the referring court, from the initial syllables of the phrase 'integrated telephone marketing').

28. Intel seeks a declaration, on the basis of the national provisions transposing Article 4(4)(a) of the Directive, that CPM's mark is invalid. Following dismissal at first instance and by the High Court, the fate of its claim now falls to be determined by the Court of Appeal, which seeks guidance from this Court on the following questions:

'(1) For the purposes of Article 4(4)(a) of [the Directive], where:

- (a) the earlier mark has a huge reputation for certain specific types of goods or services,
- (b) those goods or services are dissimilar or dissimilar to a substantial degree to the goods or services of the later mark,
- (c) the earlier mark is unique in respect of any goods or services,
- (d) the earlier mark would be brought to mind by the average consumer when he or she encounters the later mark used for the services of the later mark,

are those facts sufficient in themselves to establish (i) "a link" within the meaning of paragraphs 29 and 30 of [*Adidas I*] and/or (ii) unfair advantage and/or detriment within the meaning of that Article?

(2) If no, what factors is the national court to take into account in deciding whether such is sufficient? Specifically, in the global appreciation to determine whether there is a "link", what significance is to be attached to the goods or services in the specification of the later mark?

(3) In the context of Article 4(4)(a), what is required in order to satisfy the condition of detriment to distinctive character? Specifically, [(i) does] the earlier mark have to be unique, (ii) is a first conflicting use sufficient to establish detriment to distinctive character and (iii) does the element of detriment to distinctive character of the earlier mark require an effect on the economic behaviour of the consumer?'

29. Written observations have been submitted by Intel, by CPM, by the Italian and United Kingdom Governments and by the Commission, of whom all except the Italian Government also presented oral argument at the hearing. In a nutshell, Intel and the Italian Government favour a generous interpretation of the scope of the protection afforded by Article 4(4)(a), and CPM argues for a stricter interpretation (which also appears to be favoured by the referring court), while the United Kingdom and the Commission take a more nuanced approach.

Assessment

Preliminary remarks

The law to be interpreted

30. The theory of dilution has long been the subject of disagreement among commentators (and exasperation at the perceived obtuseness of others, including the courts). (22) Current United States and European legislation is sometimes criticised because it does not conform to Schechter's original view that highly distinctive marks should be protected rather than simply very famous marks. (23) Conversely, courts are sometimes criticised for not acknowledging the full extent to which famous marks should be protected. (24)

31. The Court's task, on the other hand, is not to define the doctrine of dilution, as articulated by Schechter or by others, but to interpret the wording of a Community directive. Only the latter is the law, however much light can be shed on it by the former.

32. But even when interpreting that wording as such, the Court cannot ignore the opposing forces in

play. Owners of famous marks have a particular interest in creating as wide an exclusion zone as possible around their marks, and other market participants have an interest in keeping that exclusion zone to the minimum. And there is a public interest not only in protecting such paradoxically vulnerable trade marks but also in preventing dominant traders – who, by and large, own those marks – from abusing that protection to the detriment of other, weaker operators. Any interpretation should, as far as possible, aim for a fair balance between those interests.

Advocate General Jacobs's description of dilution in Adidas I

33. Extensive reference has been made to points 36 to 39 of Advocate General Jacobs's Opinion in Adidas I. It may be helpful to set out in full the text (25) of those points. He stated:

'Article 5(2) protects the proprietor of a mark with a reputation against use of an identical or similar sign "where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark". There are thus in principle four types of use which may be caught: use which takes unfair advantage of the mark's distinctive character, use which takes unfair advantage of its repute, use which is detrimental to the mark's distinctive character and use which is detrimental to its repute.

The concept of detriment to the distinctive character of a trade mark reflects what is generally referred to as dilution. That notion was first articulated by Schechter, who advocated protection against injury to a trade mark owner going beyond the injury caused by use of an identical or similar mark in relation to identical or similar goods or services causing confusion as to origin. Schechter described the type of injury with which he was concerned as the "gradual whittling away or dispersion of the identity and hold upon the public mind" of certain marks. The courts in the United States, where owners of certain marks have been protected against dilution for some time, have added richly to the lexicon of dilution, describing it in terms of lessening, watering down, debilitating, weakening, undermining, blurring, eroding and insidious gnawing away at a trade mark. The essence of dilution in this classic sense is that the blurring of the distinctiveness of the mark means that it is no longer capable of arousing immediate association with the goods for which it is registered and used. Thus, to quote Schechter again, "for instance, if you allow Rolls Royce restaurants and Rolls Royce cafeterias, and Rolls Royce pants, and Rolls Royce candy, in 10 years you will not have the Rolls Royce mark any more".

In contrast, the concept of detriment to the repute of a trade mark, often referred to as degradation or tarnishment of the mark, describes the situation where – as it was put in the well-known Claeryn / Klarein decision of the Benelux Court of Justice – the goods for which the infringing sign is used appeal to the public's senses in such a way that the trade mark's power of attraction is affected. That case concerned the identically pronounced marks "Claeryn" for a Dutch gin and

"Klarein" for a liquid detergent. Since it was found that the similarity between the two marks might cause consumers to think of detergent when drinking "Claeryn" gin, the "Klarein" mark was held to infringe the "Claeryn" mark.

The concepts of taking unfair advantage of the distinctive character or repute of the mark in contrast must be intended to encompass "instances where there is clear exploitation and free-riding on the coattails of a famous mark or an attempt to trade upon its reputation". Thus by way of example Rolls Royce would be entitled to prevent a manufacturer of whisky from exploiting the reputation of the Rolls Royce mark in order to promote his brand. It is not obvious that there is any real difference between taking advantage of a mark's distinctive character and taking advantage of its repute; since however nothing turns on any such difference in the present case, I shall refer to both as free-riding.'

34. The referring court states that the passage is a 'far-reaching view of the scope of protection', but that the Court of Justice did not find it necessary to decide whether that view was correct.

35. I, however, do not read the passage as setting out a view of the extent of the protection afforded by Community law to marks with a reputation. Rather, it seems to me, Advocate General Jacobs was there presenting the historical and conceptual context in which that protection was adopted, as an aid to understanding, much as I have myself attempted to do at points 5 to 13 above.

The questions referred

36. The Court of Appeal's three questions overlap to a substantial degree.

37. Taken together, they ask, essentially, what factors are to be taken into account when assessing, and what is needed in order to establish, (i) a 'link' in the mind of the relevant public; (ii) unfair advantage taken of the distinctiveness or repute (26) of the earlier mark (free-riding); (iii) detriment to distinctiveness (blurring); and (iv) detriment to repute (tarnishment).

38. I shall therefore address those issues in that order, referring to the specific criteria suggested in the questions in their appropriate place. It is first necessary, however, to consider the relationship between the 'link' and the three other issues. Moreover, it seems clear from the case-file that the most important issues in the main proceedings are the criteria for determining the existence of a 'link' and of detriment to distinctiveness, to which I shall pay particular attention. I shall conclude with some more general considerations which affect all four issues.

Relationship between 'link' and 'infringement'

39. According to the case-law: (27) 'The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them'. By 'infringements' in that context, the Court means free-riding, blurring or tarnishment.

40. It seems clear from the structure of Articles 4(4)(a) and 5(2) of the Directive that registration or use can be prevented or halted, as the case may be, if two sets of conditions are fulfilled. First, there are the pre-conditions which are themselves cumulative: there must be an earlier mark and a later mark or sign, the two must be identical or similar, the earlier mark must have a reputation and the use of the later mark must be without due cause. (28) Second, there are the consequences to be guarded against, which are alternative: there must be, at least potentially, unfair advantage or detriment, relating to the distinctive character or repute of the earlier mark. If both the first and second sets of conditions are fulfilled, the trade mark owner may claim the protection of the relevant provision.

41. Where does the link to which the Court has referred in Adidas I and II (and which finds its origin in the ‘association’ referred to in General Motors) fit within that structure?

42. It seems to me to fit logically with the first set of conditions. It is bound up with the question of similarity or identity. And if the infringements, where they occur, are the consequence of a degree of similarity which leads to the public establishing a link between the marks, it is futile to enquire whether there is free-riding, blurring or tarnishment unless it has been established that such a link is made.

43. Moreover, the existence of a link in the public’s mind is a necessary, but not a sufficient, condition for the existence of an infringement. There are three types of possible infringement, each of which seems capable of occurring, in some circumstances, without the others. The mental link between the marks therefore cannot automatically, without further evidence, lead to the conclusion that any one of those infringements has occurred or would occur if the contested mark were registered.

44. Consequently, I do not accept the implication, which permeates Intel’s submissions to the Court, that once a relevant link has been established there is no need to look any further before granting the protection offered by the provision.

45. That said, I do accept that many of the factors which are relevant when assessing the existence of a link will be relevant also when, in the second stage of the analysis, one turns to assess the presence or likelihood of free-riding, blurring or tarnishment – and in particular of blurring, which seems likely to follow more closely on the heels of a mental link than do the other two. However, each criterion (whether in the first or the second stage of assessment) must be assessed separately and, when the factors in question are being used to assess a different criterion, they may have to be taken into account in different ways.

Existence of a link

46. First of all, it seems to me that, of the circumstances set out in the national court’s first question, (d) – the fact that for an average consumer the earlier mark would be ‘brought to mind’ by the later mark – is itself tantamount to the establishment of a link (or the making of an association or connection) between the two

marks, as expressed in the Court’s case-law. I would not distinguish between those terms, which all imply a mental process above the threshold of consciousness, something more than a vague, ephemeral, indefinable feeling or subliminal influence.

47. If the national court meant, by the term ‘brought to mind’, something less than the actual establishment of a link (which must be of a reasonably substantial nature, since it must be made by a significant part of the relevant public (29)), then clearly other factors must be examined too.

48. Of the remaining circumstances listed in question 1, it seems to me that (a) – the ‘huge reputation’ of the earlier mark for certain goods or services – is in part (as regards the existence of a reputation) simply one of the express conditions for the application of Article 4(4)(a) or 5(2).

49. Circumstance (b) – the use of the later mark for dissimilar goods or services – also represents a condition for the application of those provisions, although it no longer seems relevant since Davidoff II. This point is linked, however, to that raised in the second question, which I address below. (30)

50. It may be the case that the public will more readily establish a link between the two marks if the earlier mark has a ‘huge’ reputation and is ‘unique in respect of any goods or services’ (circumstances (a) and (c) in the first question). However, those facts seem more relevant when assessing the existence of free-riding, blurring or tarnishment.

51. There is thus nothing in facts (a) to (c) set out in the first question which would be inconsistent with finding a link between marks in the mind of the public, within the meaning of the case-law, though they do not appear sufficient in themselves for that purpose. The finding must be made in the light of all the relevant circumstances. Some indication can be given of the circumstances which may be relevant, but there can be no exhaustive list.

52. The Court has stated that the existence of a link must be appreciated globally, ‘just like a likelihood of confusion’. (31) Both that formulation and common sense suggest that factors relevant to establishing a likelihood of confusion will also be relevant when assessing the existence of a link, even though ‘the existence of a link’ in the mind of the public is not the same standard as ‘a likelihood of confusion ... which includes the likelihood of association with the earlier trade mark’. In that regard, it may be noted that the Court does not speak of the likelihood but of the existence of a link, which implies an assessment of a different nature – although, where the later mark is merely at the stage of application for registration and has not yet been used, it may be impossible to establish the current existence of such a link.

53. According to the 10th recital in the preamble to the Directive, the appreciation of a likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, [on] the association which can be made with the used or registered sign, [on] the degree of similarity between the

trade mark and the sign and between the goods or services identified’.

54. The Court, for its part, has consistently held that the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. (32) Moreover, likelihood of confusion may arise from conceptual similarity between marks and may be increased if the earlier mark has a particularly distinctive character, either per se or because of its reputation with the public. (33)

55. All those factors can be considered when assessing whether a link between the two marks is established in the mind of the relevant public.

56. It may be helpful to consider also the factors set out in Section 43(c) of the United States Trademark Act of 1946, as amended by the Trademark Dilution Revision Act of 2006. According to that provision, in determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the degree of similarity between the mark or trade name and the famous mark, the degree of inherent or acquired distinctiveness of the famous mark, the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark, the degree of recognition of the famous mark and any actual association between the mark or trade name and the famous mark.

57. That provision has of course no force in Community law, but the factors listed are fully consistent with the Court’s approach to the assessment of a likelihood of confusion. And even though those factors are to be considered when assessing the likelihood of dilution itself, rather than the existence of a link in the mind of the public (which is not an explicit condition in the American legislation), they also seem relevant to establishing whether such a link exists.

58. In the context of its second question, the Court of Appeal asks about the significance, for the establishment of a link, of the nature of the goods or services covered. It suggests that it is relevant whether, having regard to the nature of the goods or services for which the later mark is used, the average consumer would consider that there is an economic connection between the owners of the two marks.

59. I would agree that, if the circumstances were such as to cause the average consumer to suppose such a connection, that is more than enough to establish the existence of a link within the meaning of the case-law. However, the absence of such circumstances does not necessarily lead to the opposite conclusion. The Directive quite clearly speaks of goods or services which are not similar, and no requirement of similarity can be imposed. (34) That would come very close to effacing the

distinction between the respective conditions under which the basic protection against likelihood of confusion and the extensive protection under Article 4(4)(a) are available. Nor, the Court has held, are Articles 4(4)(a) and 5(2) dependent on a finding of a belief that the goods or services in question come from the same undertaking or from economically-linked undertakings. (35)

60. There is, however, a way in which the nature of the goods or services covered by the respective marks may be relevant when determining the existence of a link in the mind of the public. If two marks are similar, yet used in widely separated product areas, the fact that the earlier mark has a reputation in one area – say, deep-sea drilling equipment – might not lead to the establishment of a mental link with the later mark if it were used in a quite different area – such as agricultural pesticides – since there might be very little overlap between the two relevant publics. Where either mark is used for goods or services familiar to the general public, or where both are used for similar products, the likelihood of overlap and of the establishment of a link is correspondingly much stronger.

61. The nature of the goods or services may therefore be relevant when determining the existence of a link in the mind of the relevant public, but an absence of similarity between the product areas concerned cannot be taken to imply the absence of such a link, and belief in an economic connection between the marks is not a necessary criterion.

Free-riding

62. The concept of ‘unfair advantage’ focuses on benefit to the later mark rather than harm to the earlier mark. What must be established is some sort of boost given to the later mark by its link with the earlier mark. If, despite its reputation, the connotations of the earlier mark have a dampening or even merely neutral effect on the performance of the later mark, unfair advantage seems less likely. In the hypothesis, for example, of a select range of expensive hand-made jewellery sold under the trade mark ‘Coca-Cola’ or a similar mark, it does not seem inevitable that the marketing of the jewellery would benefit unfairly (or at all) from the Coca-Cola Company’s trade mark.

63. In that light, the facts set out in question 1 seem too flimsy on their own to support a finding of free-riding.

64. It is, of course, necessary as a precondition for such a finding that the earlier mark should have a reputation and that the later mark should bring the earlier mark to mind for the average consumer. There is (at least since *Davidoff II*) no necessity for the goods or services covered by the two marks to meet any particular standard of similarity or dissimilarity. Nor can it be concluded, simply from the fact that the earlier mark is unique, that the later mark takes unfair advantage of it.

65. That said, it seems clear that, as the reputation and distinctiveness of the earlier mark, and the similarity between the goods or services covered by the two marks, increase, so will the likelihood that the later

mark will derive advantage from any link established between the two in the mind of the public.

66. But more is needed. If the later mark is to derive unfair advantage, the associations of the earlier mark must be such as to enhance the performance of the later mark in the use that is made of it. A relevant factor to consider, therefore, will be the relationship between the prestigious connotations of the earlier mark and the context in which the later mark is used. Any advantage may well be greater if the earlier mark is unique, but there is nothing in the legislation to suggest that protection against free-riding can vary according to the extent of the unfair advantage derived.

67. If the later mark has already been registered and used (as in the main proceedings), or if it is a sign whose use it is sought to prevent under Article 5(2), it may well be possible to provide consumer survey evidence indicating whether there has been any boosting or enhancing effect on the later mark as a result of the existence of the earlier mark. If, under Article 4(4)(a), it is a question of preventing the registration of a mark that has not yet been used, such evidence may be less easy to obtain, and inferences may have to be drawn from all the circumstances of the case as to the likely effect.

Blurring

68. Unlike free-riding, the notion of blurring focuses on harm to the earlier mark. The concept of detriment to the distinctive character of a mark necessarily implies a lessening of distinctiveness.

69. The factors listed in the national court's first question again seem insufficient, on their own, to support a finding of detriment to the distinctive character of the earlier mark, although they are in no way inconsistent with such a finding. My remarks at point 64 above are equally applicable here.

70. It further seems to me impossible to assume that the establishment of a link in the mind of the relevant public will automatically entail detriment to the distinctive character of the earlier mark. If, for example, a food supplement were sold under the trade mark 'Kadok', (36) it might well be possible to find that purchasers made a link in their minds with the well-known Kodak trade mark, without its necessarily being possible to establish or conclude that the latter's distinctiveness was in any way impaired. The link is a precondition for examining the existence of blurring and, when the public does establish a link between the two marks, it may well be that the first step on the road to blurring has been taken, but other factors and evidence are needed to determine whether actual detriment is caused to distinctive character. (37)

71. In its third question, the Court of Appeal asks whether, in order to establish detriment to distinctive character, the earlier mark must be unique, whether a first conflicting use is sufficient and whether an effect on the economic behaviour of the consumer is required.

72. Uniqueness does not seem to me to be essential. I pause here for a moment to consider the word 'unique'. The Court of Appeal states that the 'Intel' mark has not been used for any category of product by

any person other than the claimant. Intel, in its observations, asserts that a mark which is 'truly unique' in that sense is very rare indeed, and that marks which are 'substantially unique' must also qualify for protection. I take that to refer to a looser (but commonly found) usage of the word 'unique', closer to 'very unusual'. (38) In any event, any distinctive mark is likely to be (at least 'substantially') unique in some regard. A 'truly' unique mark will be particularly distinctive. The more distinctive a mark is, the more likely it is that its distinctiveness will be impaired by the presence of other, similar marks.

73. The question whether a first conflicting use is enough to establish detriment seems to me misconceived. A first conflicting use may not in itself cause detriment, but the point of both Article 4(4)(a) and Article 5(2) is to prevent or pre-empt repeated conflicting use which would dilute, whittle away, disperse, lessen, water down, debilitate, weaken, undermine, blur, erode or insidiously gnaw away at the earlier mark, in particular its distinctive character. A first use cannot produce such an effect on its own, but the likelihood of its being caused by repeated use – which is, after all, the norm with trade marks – may be extrapolated from the circumstances of the use.

74. As to whether an effect on consumers' economic behaviour is required, it seems to me that detriment to distinctiveness need not necessarily involve economic detriment, so that a change in economic behaviour is not essential. If the trade mark Coca-Cola, or a similar mark or sign, were used for a range of unrelated goods or services, its distinctiveness might well be lessened, but people might drink the beverage in undiminished quantities. Clearly, however, any evidence of actual negative change in consumer behaviour would buttress the claimant's case.

75. In the context of its third question, the Court of Appeal proposes that the following factors should be considered when assessing whether there is detriment to the distinctive character of the earlier mark:

- whether the 'pulling power' of the earlier mark for its specific goods or services is really likely to be affected by the use of the later mark for its specific goods or services;
- whether the user of the later mark is likely to get a real commercial advantage from its use for its specific goods or services by reason of the repute of the earlier mark for its specific goods or services;
- whether, if the earlier mark is unique, it really matters that it is used for the dissimilar goods or services of the later mark;
- where the later mark is not the same as the earlier mark, what difference that will make on the average consumer and in particular whether there is merely a calling to mind of the earlier mark;
- whether the economic behaviour of the average consumer in relation to the earlier mark when used for its goods or services is likely to be affected;
- how inherently distinctive the earlier mark is; and

– how strong the reputation of the earlier mark for its goods or services is.

76. Of those, I have already dealt with the economic behaviour of the consumer, (39) and the question of the commercial advantage to the user of the later mark concerns free-riding rather than blurring. The question whether there is ‘merely’ a calling to mind of the earlier mark goes to the establishment of a link between the marks in the mind of the relevant public, and is thus logically prior to the question of blurring. The strength of the distinctiveness (whether inherent or acquired) and reputation of the earlier mark are, however, factors which must of course be examined and which may tend to indicate the extent of blurring. The degree of similarity or dissimilarity between the goods or services covered by the two marks (whatever the ‘uniqueness’ of the earlier mark) may also be an indication in that regard but cannot – in view of the wording of Article 4(4)(a) and of the judgment in *Davidoff II* – be decisive one way or the other. Finally, the effect on the ‘pulling power’ of the earlier mark seems to me to be simply another description of the very concept of blurring – detriment to distinctive character – itself.

77. I should mention, however, the word ‘real’ or ‘really’ used in the context of several of those factors. It might suggest that the Court of Appeal had in mind a threshold (perhaps rather a high threshold) below which the factor in question could be ignored. I do not think that would be the correct approach. The need for a global appreciation, taking all relevant facts into consideration, means that each factor must be accorded the significance which it deserves, but it is the overall balance which will be decisive.

78. Finally, the Court of Appeal suggests that ‘when the legislation refers to “detrimental to the distinctive character or repute of the earlier trade mark” it must mean the distinctive character or repute of the earlier mark for the goods or services for which it is registered’. As regards distinctive character, that is indeed the approach taken by Advocate General Jacobs in his Opinions in *Marca Mode* and *Adidas I* (40) and followed by the Court of First Instance in a number of judgments. (41) As regards repute, however, I do not see that a distinction can be drawn between tarnishment in general and tarnishment with regard to specific products – which brings me to the final issue.

Tarnishment

79. The final type of infringement with which Article 4(4)(a) is concerned again concerns harm to the earlier mark, in the form of detriment to its repute. It appears to be a step beyond blurring, in that the mark is not merely weakened but actually degraded by the link which the public makes with the later mark. Since no allegation of such damage appears to have been made in the main proceedings, and since much of what I have said above in relation to blurring is also relevant here, I shall deal with it only briefly.

80. First, the circumstances set out in the first question are clearly insufficient in themselves to establish tarnishment although, once the preconditions, including the link, have been established, the extent of the earlier

mark’s reputation and ‘uniqueness’ will be relevant when assessing the occurrence of such harm. The most important factor, however, must be whether the connotations of the later mark are indeed such as to harm the repute of the earlier mark.

81. I have above given two imaginary examples of unrelated goods sold under the name ‘Coca-Cola’, or a similar mark: on the one hand, low-grade engine oil or cheap paint stripper; on the other hand, a select range of expensive hand-made jewellery. It seems likely that the former, and unlikely that the latter, would damage the repute of the Coca-Cola Company’s trade mark. In each case of alleged tarnishment, it will be necessary to compare the connotations of each mark, in relation either to the goods or services covered or to the broader message which they may convey, and to evaluate the damage entailed.

General and concluding remarks

82. Finally, I would stress three points relevant to all four issues (mental link, free-riding, blurring and tarnishment).

83. First, the assessment must be a global one, taking all relevant facts into consideration. The types of fact which will be relevant will vary from case to case, and no exhaustive list can be formulated. It is likely that no single fact will be decisive. It will be a matter of evaluating a number of criteria, each representing a point on a scale. A ‘low score’ on one scale may be offset by a ‘high score’ on another scale. Only when all the points on all the relevant scales have been taken into consideration can it be decided whether the balance tips one way or the other.

84. Second, with regard to the need for evidence, on which CPM has laid great emphasis, it must be borne in mind that the provisions concerned cater for two types of situation: existing use of a registered mark or other sign, and future use of a mark which has not yet been registered. Where the later mark or sign is already in use, it is likely to be possible for the owner of the earlier mark to obtain actual evidence of the existence of a link in the mind of the public, and of the alleged infringement, to support his case, in particular from consumer surveys or marketing figures, although it may not be practicable for each element to be exactly quantified. Where the later mark is merely at the stage of application for registration, such evidence is unlikely to be readily available. Whenever evidence of that kind can be presented, it will obviously carry considerable weight in the assessment. If it is not available, or if only limited evidence is available, inferences must necessarily be drawn from that which can be established. Evidence of the reputation, repute and distinctive character of the earlier mark should however always be available, and those characteristics should never need to be established by inference.

85. Third, in that connection, I would agree with the line taken by the Court of First Instance in its case-law on Article 8(5) of the Regulation to the effect that, in order to prevent registration of a similar mark, the proprietor of the earlier mark ‘is not required to demonstrate actual and present harm to his mark. He

must, however, adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment'. (42)

Conclusion

86. In the light of all the above considerations, I propose that the Court should answer the questions raised as follows:

For the purposes of Article 4(4)(a) of Council Directive 89/104/EEC:

- the fact that the earlier mark would be brought to mind by the average consumer when he or she encounters the later mark used for the goods or services of the later mark is in principle tantamount to the establishment of a link in the mind of the relevant public within the meaning of paragraphs 29 and 30 of the Court's judgment in Case C-408/01 Adidas-Salomon and Adidas Benelux;
- the facts that the earlier mark has a huge reputation for certain specific types of goods or services, that those goods or services are dissimilar to the goods or services of the later mark and that the earlier mark is unique in respect of any goods or services are not sufficient in themselves to establish either such a link or unfair advantage or detriment within the meaning of that article;
- in order to decide whether a link or unfair advantage or detriment is established, the national court must take account of all factors relevant to the circumstances of the case;
- the nature of the goods or services may be relevant to determining whether there is a link, but an absence of similarity between the product areas concerned cannot be taken to imply the absence of such a link, and belief in an economic connection between the marks is not a necessary criterion;
- in order to satisfy the condition of detriment to distinctive character, (i) the earlier mark does not have to be unique, (ii) a first conflicting use is not in itself sufficient and (iii) an effect on the economic behaviour of the consumer is unnecessary.

1 – Original language: English.

2 – Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) ('the Directive' or 'The Trade Marks Directive'). I shall set out the legislation in greater detail below (point 14 et seq.).

3 – Such as that in Article 4(1) of the Directive; see point 16 below.

4 – See also the Opinion of Advocate General Ruiz-Jarabo in Case C-206/01 Arsenal Football Club [2002] ECR I-10273, at points 46 and 47.

5 – Case C-408/01 Adidas-Salomon and Adidas Benelux [2003] ECR I-12537; Opinion, points 37 and 38; quoted in full at point 33 below.

6 – Frank I. Schechter, 'The rational basis of trademark protection', *Harvard Law Review*, 1927, p. 813. Schechter himself drew inspiration from a 1924 decision of the Landesgericht Elberfeld, Germany, which

allowed the owner of the well-known trade mark 'Odol', registered for mouthwash, to obtain cancellation of registration of the same mark for steel products, on the ground that the complainant had 'the utmost interest in seeing that its mark is not diluted [verwässert]: it would lose in selling power if everyone used it as the designation of his goods' (Schechter's translation). It is satisfying to find that the concept of dilution has its origins in mouthwash.

7 – These are the terms used in the United States Trademark Dilution Revision Act of 2006. The term 'dilution' is, however, sometimes used only for blurring, with tarnishment treated as a separate concept.

8 – See point 39 of, and footnote 18 to, the Opinion in Adidas I. In this Opinion, when I use the terms 'free-riding', 'blurring' and 'tarnishment', I do so as shorthand for, respectively, the notions of taking unfair advantage of the distinctive character or repute of the earlier mark, being detrimental to the distinctive character of that mark and being detrimental to the repute of that mark, as embodied in the Directive.

9 – Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) ('the Regulation').

10 – Cited in footnote 2.

11 – See the 10th recital.

12 – Ninth recital in the preamble.

13 – It may be noted that the wording of this provision, as regards the terms 'reputation' and 'repute' used in English, is not consistent across the language versions of the Directive. Several versions (for example, French, Portuguese and Spanish) use the same term in both positions, while others (for example German and Dutch) draw a similar distinction to that drawn in English.

14 – Article 52(1)(a) of the Regulation provides for a Community trade mark, once registered, to be declared invalid on the same grounds, thus completing the parallel with Article 4(4)(a) of the Directive.

15 – Case C-292/00 Davidoff and Zino Davidoff [2003] ECR I-389. The Court decided that, notwithstanding their use of the words 'not similar', Articles 4(4)(a) and 5(2) extended also to cases where the goods or services covered were identical or similar (confirmed in Adidas I, paragraph 19, and Case C-102/07 adidas and adidas Benelux [2008] ECR I-0000 ('Adidas II'), paragraph 37).

16 – The Court of First Instance has also delivered a number of judgments concerning the equivalent provisions of the Regulation.

17 – Case C-375/97 [1999] ECR I-5421, especially at paragraphs 22 to 30.

18 – Cited above in footnote 5, paragraphs 27 to 30. The Court referred also to General Motors, paragraph 23; Case C-251/95 SABEL [1997] ECR I-6191, paragraphs 22 and 23; Case C-342/97 Lloyd Schuhfabrik Meyer [1999] ECR I-3819, paragraphs 25 and 27; and Case C-425/98 Marca Mode [2000] ECR I-4861, paragraphs 34, 36 and 40.

19 – Article 5(2) refers to signs which are not registered trade marks, whereas Article 4(4)(a) concerns

signs which have been registered, or which it is sought to register, as 'later' trade marks. Although the provisions thus differ in their sphere of application, the parallelism between them means that references to a 'sign' in one context are equivalent to references to a 'later trade mark' in the other.

20 – Cited above in footnote 15, paragraphs 41 to 43.

21 – International Classification of Goods and Services for the Purposes of the Registration of Marks, established by the Nice Agreement of 15 June 1957, revised at Stockholm in 1967 and Geneva in 1977.

22 – 'No part of trademark law that I have encountered in my forty years of teaching and practicing IP law has created so much doctrinal puzzlement and judicial incomprehension as the concept of "dilution" as a form of intrusion on a trademark. It is a daunting pedagogical challenge to explain even the basic theoretical concept of dilution to students, attorneys and judges. Few can successfully explain it without encountering stares of incomprehension or worse, nods of understanding which mask and conceal bewilderment and misinterpretation' – J. Thomas McCarthy, 'Dilution of a trademark: European and United States law compared', *The Trademark Reporter*, Vol. 94, 2004, p. 1163.

23 – See, for example, Sara Stadler Nelson, 'The wages of ubiquity in trademark law', *Iowa Law Review* 2003, p. 731.

24 – See, for example, Mathias Strasser, 'The rational basis of trademark protection revisited: putting the dilution doctrine into context', *Fordham Intellectual Property, Media and Entertainment Law Journal*, 2000, p. 375.

25 – For ease of reading, I omit the paragraph numbers and the footnotes.

26 – I agree with Advocate General Jacobs's view in *Adidas I* (point 39 of the Opinion, in fine) that there is no relevant difference between taking advantage of distinctiveness and taking advantage of repute.

27 – *Adidas I*, paragraph 29, and *Adidas II*, paragraph 41.

28 – On a literal reading, the two must also be registered or used in respect of dissimilar goods or services, but that condition was found to be superfluous in *Davidoff II*.

29 – *General Motors*, paragraph 26.

30 – Points 58 to 61.

31 – *Adidas I*, paragraph 30; see also *Adidas II*, paragraph 42.

32 – See, for example, with regard to Article 8(1)(b) of the Regulation, Case C-334/05 P *OHIM v Shaker* [2007] ECR I-4529, paragraphs 34 and 35 and the case-law cited there.

33 – See in particular *SABEL*, paragraph 24, and *Marca Mode*, paragraph 38 (both cited in footnote 18 above).

34 – That point is unaffected by the Court's ruling in *Davidoff II* to the effect that dissimilarity is not essential.

35 – See, most recently, *Adidas II*, paragraphs 28 and 40.

36 – Kadok is a Malaysian name for piper sarmentosum, a South East Asian plant used for aromatic and medicinal purposes and believed to have antioxidant properties. It has not to my knowledge been registered as a trade mark, although a figurative mark featuring the restaurant name 'Kadok's' is registered in the United States for various Asian foods.

37 – In that regard, I feel that the Court of First Instance may have gone too far in speculating (in Case T-215/03 *SIGLA v OHIM* [2007] ECR II-711, paragraph 48) that 'it is possible, particularly in the case of an opposition based on a mark with an exceptionally high reputation, that the probability of a future, non-hypothetical risk of detriment to or unfair advantage being taken of the mark cited in opposition by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end'.

38 – 'Those of us still on the burning deck of good usage believe that unique – the paradigm of absolute solitude – can never be modified with an insipid very, quite, rather, almost or practically' – William Safire, 'Uniquer than unique? I don't think so', *International Herald Tribune*, 24 June 2007.

39 – At point 74.

40 – At points 44 and 43 respectively.

41 – Most recently, Case T-47/06 *Antartica v OHIM* [2007] ECR II-0000, paragraph 55.

42 – See, most recently, Case T-181/05 *Citigroup v OHIM* [2008] ECR II-0000 (judgment delivered on the same day as the hearing in the present case), paragraph 77 and the case-law cited there.