The concept of trade mark series: 
Origin and implications for the scope of protection

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WARNING

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<td>Advocate General</td>
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<td>Cass.</td>
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<td>PIBD</td>
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“Trademarks allow firms to tie in desired mental images with the advertised goods and to compete in perception advertising”.


“Du côté de la clientèle, la marque a une image ; du côté de l’entreprise, elle a une identité “.

Every species on Earth face an important dilemma: living alone or within a group more or less hierarchical and organized. As the most advanced animal species, human beings are also confronted to this Cornelian choice. While traditional animal species have adopted a long time ago their own way of life, the human beings’ lifestyle is still uncertain and has evolved since prehistoric times. According to the theory of natural selection resulting of Darwin’s studies, solely the strongest species can survive in the jungle of life, the weakest being eliminated or submitted by dominant ones. Thus, the resistance of human beings to predators and hard conditions of living during the first millenniums of their appearance on Earth is partly due to the fact that they chose to live in groups. This choice could be qualified as natural when it is specified that each group was mainly composed of people sharing common roots and origins. As a matter of fact, the key composition of those groups was families.

Basically, the term family designates a division used to classify animal, plant and bacterial species related by features that they have in common. But beyond this technical biological definition, the principal meaning of the concept of family covers the existence of blood ties existing between persons. In consequence, the scope of the definition is restricted and concerns almost exclusively people. But the said scope should be specified. Thus, under the common sense of the concept of family is hidden a tripartite relationship between a man, a woman and their children, if any. These connexions between those family members constitute the essential core of the said concept.

However, the progressive mutation of the society had lead to an opening of the family to what it could be called para-familial members, including without limitation aunts, uncles and cousins. This phenomenon has been noted by the sociologist Parsons after the study of centuries of evolutions, and has been identified under the scientific term of "nuclear family"¹. The comparison of modern families to an atom appears to be quite logical since the abovementioned para-familial members gravitates around at least a minimal core. Such a mutation between basic and modern family reflects the progress made all over the centuries, mainly since the Industrial Revolution occurred during the XIX\textsuperscript{th} century. The individual and familial well being were a priority among others.

But beyond the modern family, a concept of post modern family rises. This concept, appeared after the Second World War. It results of the society’s mutations, more particularly of the liberalization of morals and ideas, as reflected the research of equality between genders or the erosion of the marriage institution. As consequences of this last

¹ T. PARSONS, 1955.
example, the number of divorces increases exponentially, leading to the development of mono-parental families or stepfamilies. The traditional definition of the said concept is obsolete. Nowadays, a family includes all the persons living under the same roof.

After all those transformations, conservative people could think that the traditional concept of family has been shaken and deconsecrated. This feeling is exacerbated with the progressive opening within the European Union of the marriage and adoption to people of the same sex. But despite all those mutations, family was, is and always will be the pillar of any society.

Thus, it appears that the concept of family is not unitary. It exists numerous variations and qualifications depending on multiple elements, for instance the period. Whatever the definition and the period are, the key component of the concept of family is species, and more particularly human beings.

As ARISTOTLE asserted, “human being is by nature a political animal”\(^2\). If this statement is still relevant today, the concerns of human beings are now more oriented to consumption than to politics. The progressive globalization of the market during the XX\(^{th}\) century and its intensification since the 1970s leads to the conclusion that human being becomes a consumerist animal!

The propensity of European citizens to consume is partly due to the diversity of goods and services they have access to. The model of distribution has also evolved and has been adapted to create and stimulate consumers’ demands. Thus, the business model of the distribution sector has mutated from small local shops to large superstores, in order to adapt to the correlative increase of the number of goods and services offered to the public.

Of course, who says expansion of the number of products and services says multiplication of the number of trade marks because “In default of soul, objects have trade marks”\(^3\). Thus, in the everyday life, consumers are nowadays flooded with brands, whether for instance in the street or in the media (television, radio, printing press, internet) with large advertisement campaigns, or directly on goods and services in shops. Trade marks are everywhere and people absorb them.

Behind each trade mark is hidden a company, more of less powerful, more or less international. But whatever the size of the business owning the trade mark, they all have the same ambition : sell to make profits. To fulfil this objective, almost all of them are

\(^2\) ARISTOTLE, Politic, 330 B.C.

seeking to capitalize on their respective trade marks. Thus, brands become a strong asset among the classical ones.

Beyond companies, mass-media have understood that brands could also become an important source of revenue for them, by assuring – *inter alia* – their promotion. To satisfy the largest companies’ requirements, directors of large media will do anything to conclude advertising contracts, particularly when 30 seconds of diffusion on television of an advertisement spot could cost up to 150 000 euros. The lure of profit can lead to inappropriate speech, just like Patrick LE LAY – former CEO of the French channel TF1 – who declared in the book “Les dirigeants face au changement”, “What we sell to Coca-Cola is available human brain time”. By such a comment, Patrick LE LAY confessed entertaining the audience with stupid programs just to show off advertisement spots, which are sources of revenues. Thus, in this context, trade marks have passed in the foreground to the detriment of TV shows.

In addition, the reason why the market has been progressively structured around trade marks could be explained by the intention of brands’ owners to conquer the maximum of consumers in a European open market. As a matter of fact, after the trauma of the Second World War, the founding fathers of Europe – such as Jean MONNET and Robert SCHUMANN – wanted to unify all European nations and peoples as to create a common and unique market where goods, services, people and capital could freely move between the different Member States of the zone. The signature of the Treaty of Rome in 1957 constituted the first step of a complete opened market, whose construction has been marked by both the adoption of structural treaties, e.g. the Treaty of Maastricht in 1992 or the last Treaty of Lisbon of 2009, and its successive enlargements to numerous states within geographical Europe.

At the same time, the market needed an intervention of the European legislator to maintain coherence between the Member States. Thus, its has been decided to proceed to the harmonization of European trade mark law. Inspired by the successful Paris Convention of the 20th March 1883, the ambition was to create a community trade mark law enforceable within all the Member States of the community and with a common procedure. The adoption and enforcement of the Community Trade Mark Regulation5 of the 15th March 1994, as well as the European Directive 2008/95 of the 22nd October 2008 represent the backbone of the community trade mark.

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5 Hereinafter CTMR.
Even if this system has been recently instituted, it should be noted that in less than fifteen years, the Office for Harmonization in the Internal Market\(^6\) – authority created in 1994 by the CTMR – has registered more than 800 000 trade marks, asserting its legitimacy in the same time. In parallel to its role of registration office, OHIM is also invested of prerogative to resolve disputes among trade mark owners. The Office already solved numerous cases and consequently appreciated various situations. But in 2006, due to a claim submitted by the Italian company Il Ponte Finanziaria, OHIM was confronted to a new problematic : the question of trade mark series.

Just like human families, the composition of trade mark series is variable and this diversity represents a difficulty for both OHIM and the European Court of Justice\(^7\), to appreciate the scope of the concept. The following decisions concerning this notion did not provide any convincing lighting on the said concept since 2006.

Thus, the *Bainbrige* decision\(^8\) constitutes a revolution in trade mark law by referring to a brand new principle. The said following decision shows that the concept is not completely controlled by the ECJ which uses it from the top of the lips. Indeed, the consideration of the series represents a few lines and a small argumentation at the end of each concerned judgment. Seeing the ECJ’s reaction, it could be asserted that, because of its obscure mechanism, families of brands are treated as the ugly duckling of trade mark law. The consideration of the notion of trade mark family by the European Court as an obiter dictum illustrates the hard appreciation of this concept.

However, beyond the difficulties of the concept’s interpretation by the ECJ is hidden a very useful tool made by and for companies in order to reinforce their position and reputation in a saturated market. The comprehension of companies' logic to group trade marks by common features implies questions about the origin of such a concept and the basic construction of a trade mark family. Then, the understanding of trade mark family’s mechanism leads automatically to the will to know impacts of the new trade mark law’s notion on the scope of protection compared to a traditional trade mark right.

Such an inventory of the situation appears to be completely relevant nowadays due to the multiple cases pending before the ECJ interesting directly and primarily this concept, just

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\(^6\) Hereinafter OHIM.

\(^7\) Hereinafter ECJ.

\(^8\) CFI, 23\(^\text{rd}\) February 2006, Il Ponte Finanziaria SpA v. OHIM, case T-194/03 ; ECJ, 13\(^\text{th}\) September 2007, Il Ponte Finanziaria SpA v. OHIM, case C-234/06.
like the *CitiGate* case\(^9\) and mostly the *Smart Notebook* case\(^10\) which are actually examined by the Court of First Instance\(^11\). The stakes are high for series because it may be supposed that the solutions brought by those judicial matters will constitute the future guideline on this point for the next coming years.

Basically, as it has been mentioned above, the concept of trade mark series within the European Community appeared at the occasion of the *Bainbridge* saga between the judgments held by the OHIM’s opposition chambers and the decisions of the ECJ. Nonetheless, it will be highlighted that the said concept is not a pure invention of the European Court as its main features have already been drawn by several states around the world. Moreover, the new notion is based on different concepts perfectly known by the ECJ (Part One).

In addition, the principal inputs of ECJ’s decisions result of interpretations that could be made on the judges’ argumentation. Both judgements and opinions of Advocates General contain clues that could help understanding the brand-new concept. To fully appreciate the notion of trade mark family, it is mandatory to read between the lines of the few decisions held on this topic in order to extract the substance of each judgment. To raise the complete value of the impact on the scope of protection of the said concept, a cross-reading should be made between information identified directly in the ECJ decisions, and business concepts (Part Two).

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\(^9\) CFI, IG Communications v. OHIM, Case T-301/09, case in progress.

\(^10\) CFI, Smart Technologies v. OHIM, Case T-648/11, case in progress.

\(^11\) Hereinafter CFI.
Part One: Origin, legal basis and elaboration of the concept of trade mark series

Six years ago, the concept of trade mark series was almost unknown within the European Union. Solely a couple of very concerned persons, who have worked in or have connexion with some third EU states, have already heard and keep a vague idea of what could be a trade mark family. With the decision held in the Bainbridge case in February 23rd, 2006, things have completely changed. Today, the concept of trade mark family becomes a strong argument in opposition procedures. To understand this spectacular mutation, it is necessary to analyze the whole context of appearance of the brand new notion (Chapter One) before entering into the details of its characteristics (chapter Two).

Chapter One: Origin and legal basis of the concept of trade mark series

As it has been specified above, the concept of trade mark series was not very popular. Thus, it seems interesting to study the reason why the said concept becomes crucial by understanding its origins (Section One) before starting to draw the portrait of companies which may use it (Section Two).

Section One: The origin of the concept of trade mark series

The concept of trade mark series did not come up from nowhere in the judges’ minds. If this concept was unknown by the ECJ before the Bainbridge decision (§1), it has been used for a long time in several states around the World (§2).
§1 : Definition of the concept

Because of the recent developments in the field of trade mark series, only few professors and professionals have thought about this brand new theory. Indeed, the concept of trade mark series – which can also be designated under the terminology of trade mark family – just emerged from limited number of decisions taken by the Court of Justice of the European Communities since 2006, year of the Bainbridge decision which can be qualified as the first modern judgment interesting this point.

In this case, a private Italian company – Il Ponte Finanziaria SpA – introduced an opposition procedure against a competitor before the Office for Harmonization in the Internal Market. The legal basis of this opposition was based on the existence of several anterior community trade marks. The particularity of these anterior rights was that they were all composed of the common element Bridge, element which was used as trade mark by the defendant for the same type of products. In order to sit its claims, the applicant asserted that all the prior trade marks belonging to her formed a series, due to the presence of the common element Bridge.

Thus, the European Court of Justice was asked to rule inter alia on rather or not several anterior community trade marks sharing a common denominator could constitute a series, even though some of these marks were not used in business life.

To this question, the ECJ had answered negatively, by calling to the support of its argumentation the previous Hiwatt case12 whose main input was based on the requirement of serious use of any mark in business life, as the point 36 stated that “Genuine use is therefore to be regarded as excluding minimal or insufficient use when determining that a mark is being put to real, effective use on a particular market. In that regard, even if it is the owner’s intention to make real use of his trade mark, if the trade mark is not objectively present on the market in a manner that is effective, consistent over time and stable in terms of the configuration of the sign, so that it cannot be perceived by consumers as an indication of the origin of the goods or services in question, there is no genuine use of the trade mark”.

In consequences, neither the tribunal of the OHIM, nor the ECJ, had received the argument of the Italian company because of the lack of “consistent” presence in the market of the abovementioned trade marks.

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Nonetheless, the Bainbridge decision was the occasion for the judges of the ECJ to work out on a universal case law definition. The first sketch of this definition was performed through the point 123 of the aforesaid case which states that “It must be held that, when the opposition to a Community trade mark application is based on several earlier marks and those marks display characteristics which give grounds for regarding them as forming part of a single ‘series’ or ‘family’, which may be the case, inter alia, either when they reproduce in full a single distinctive element with the addition of a graphic or word element differentiating them from one another, or when they are characterised by the repetition of a single prefix or suffix taken from an original mark, such a circumstance constitutes a relevant factor for the purpose of assessing whether there is a likelihood of confusion”.

This judgement reveals that the recognition and the consecration of the concept of trade mark series seem to be fulfilled at two cumulative conditions. On the one hand, a trade mark family can only be formed around a common distinctive element which must be present in each mark of the potential series taken individually. On the other hand, each of these marks must be used separately in a business context. In a matter of clearness, it appears to be appropriate to refer to those requirements respectively as the internal condition and the external one.

It is of interest to note that due to the expansion of this theory, the jurisprudential definition recently developed has just been recalled once, in connection to the Torres case\textsuperscript{13}, at point 80.

Therefore, the few cases dealing with the topic of the trade mark series, and the fact that this issue is treated as an obiter dicta by the judges of the ECJ, are characteristic both of the total disinterest of judges and business companies for such a concept. Indeed, both entities consider it as the last argument of defence or as the last mean to look at before reaching to a decision.

Thus, that attitude has encouraged the doctrine to focus on the theory of trade mark families in order to refine and to consolidate it.

However, the doctrine also seems not to dwell on this issue, to the point that the publication of the Bainbridge decision has only been followed by a few commentaries and reviews from University Professors of the whole European Union\textsuperscript{14}. This behaviour is

\textsuperscript{13} CFI, 18\textsuperscript{th} December 2008, Torres v. OHIM, case T-287/06.

\textsuperscript{14} The data base Eur-lex reported only three commentaries.
symptomatic of the underestimation of the importance, which should be attached to the concept.

The analysis of that couple commentaries, leads to a unanimous definition highlighting two elementary but cumulative conditions required to admit the existence of a trade mark series.

The economic entity seeking to rely on the shield of a trade mark series should, at first, justify that it is the true owner of several marks taken individually which are supposed to constitute a family. It is necessary to mention that the use of each of these marks must be serious and consistent in business life.

Moreover, these marks have to share a common denominator, which can be a suffix, a prefix, or a syllable, and which has as effect to make the target consumer sensitive. The intellectual association of the individual trade marks sharing the same distinctive denominator will create in the targeted consumer a new way to perceive these trade marks, no longer individually but as a group, a family, a series\textsuperscript{15}.

While the global doctrinal definition does not lead to any relevant precision vis-à-vis the case law one, the French view – led by A. FOLLIARD-MONGUIRAL – seems to point some essential elements. In fact, to constitute a trade mark series, the doctrine has brought out the condition of distinctiveness which must be fulfilled by the common denominator. This distinctiveness may be inherent to the mark or may be acquired by use.

In the mean time, it had been established that the common distinctive element must be stable ; which means that such a denominator should be identical in all the marks constituting the series. To illustrate this idea, the distinctive element of a trade mark series can be compared to the root of a tree or to a family name.

The \textit{Bainbridge} decision represents a turning point in the ECJ case-law history because it is the judgment which has given rise to the concept of trade mark series. But beyond the definition brought by the ECJ judges and understand it better, it is interested to consider the background of this concept.

\textsuperscript{15} Definition inspired by the article written by P. RODHAIN, « \textit{Familles de marques la fin des privilèges} », in La Revue des Marques, n° 62, avril 2008.
§ 2: Sources of a pan-European concept

As any concept and principle of Intellectual Property Law, the concept of trade mark series appeared in Europe through companies’ practices and case-law. Indeed, it did not exist and still do not exist European provisions properly dealing with this concept. Neither the European directive 2008/95\(^\text{16}\) nor the CTMR\(^\text{17}\) had been amended in order to take into account this brand-new concept.

The praetorian approach of the said concept started with the first Bainbridge decision, held by the Court of First Instance on February, 23\(^{\text{rd}}\) 2006. In that case, an Italian company – Il Ponte Finanziaria – which was the owner of eleven trade marks, all composed of the common distinctive element “Bridge”, had made an opposition to the Community Trade Mark application against a third party company which had registered the mark Bainbridge for the similar goods and services. To support its claim, the Italian company argued that, due to the existence this common denominator, the court had to consider that it was the owner of a family of marks. Therefore, it is not fair that a competitor tries to raise doubts in the consumers’ mind who may be mistaken on the origin of the competitor’s product and service. The fact is that the claim of Il Ponte Finanziaria was dismissed, particularly on this argument which was disassembled by the CFI. Indeed, before comparing the anterior trade marks with the third party’s one, the judges of the European court tried to examine the consistency of the alleged family and they spread six brands, which according to those judges, did not fulfil the criteria of the series in question.

The first attempt to consider the new concept appeared a little bit “clumsy” or could be interpreted as a refusal by the ECJ to take into account the argument of the series. Instead of appreciating the opposition claim on the basis of the whole global series, the decomposition and exclusion of certain trade marks shows the intention to reduce and contain the scope of the family.

The ECJ had confirmed its position in post-Bainbridge decisions, notably through its Uni case held on July 16\(^{\text{th}}\), 2011\(^\text{18}\). In this case, it was question of an opposition procedure made by the company Union Investment Privatfonds – a banking business – against the


\(^{17}\) Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.

\(^{18}\) ECJ, 16\(^{\text{th}}\) June 2011, Union Investment Privatfonds GmbH v. OHMI, case C-317/10.
company Unicredito, for the trademarks “Uniweb” and “Unicredit Wealth Management” to designate banking services. The opposition was based on the marks “Unifonds” and “Unirak”, and the figurative trademark “Unizins”.

The European court set aside the judgement of the CFI which firstly held that neither the distinctive character of the prefix “uni” nor the other aspects of the comparison between the trademarks in issue made it possible to conclude that there was a likelihood of confusion. The prefix “uni” by itself has not the characteristic required to be considered as a common distinctive element in a series and specially in this case, is not sufficient for average consumers to associate the prefix with a particular banking company. To support this statement, CFI’s judges considered that the denominator “uni” is too recurrent in the banking field to be able to be related to a particular company. The CFI strictly applied the solution held in the Bainbridge case. The ECJ quashed the former decision considering that the CFI distorted the content of the contested decisions by holding that the Board of Appeal had concluded, “almost automatically” and without “thorough examination” of the requirement of connection of the trademarks applied for with the series, that there was a likelihood of confusion, confining itself to noting the existence of that series and the fact that those trademarks are composed of the common element “uni” combined with different expressions which are devoid of distinctive character.

The ECJ decision is even more regrettable that the CFI had initiated a revision of the traditional case-law. While the ECJ adopts frequently an innovative and liberal approach on new theories and concepts, it seems that in the case of the trade mark series, the European court has backed down vis-à-vis national decisions concerning the said concept.

The inventory of national decisions interesting this specific point demonstrates that the concept is only emerging. The large majority of national courts in the European Union has not had yet the occasion to state on this subject. Nonetheless, one series of cases held by the French Cour de Cassation could have been taken into account by the ECJ so as to shape its position. The Commercial section of the French Supreme Court had held three decisions the same day of March, 16th 200619. The merit of those judgments was to reverse the well-established opinion on the matter of the use in commerce of a slightly altered form of a registered trade mark since the “Lotus” case20. While the French courts


used to refuse the use of slightly modified registered marks, the 2006’s decisions reversed the ruling by applying strictly the provisions of the article L714-5 of the French Intellectual Property Code which requires that the trade mark in use only differs from the registered trade mark in elements which are not the distinctive ones, no matter the altered trademark is registered or not.

This modern approach was aborted a few months latter by the Bainbridge decision, with which the Cour de Cassation became compliant by the “A&F” judgement21.

However, the French approach was not so disconnected to business realities and was in line with some national laws which had integrated the concept of trade mark series.

One of the first system that had legislated on the purpose was undoubtedly the United Kingdom which dedicated the 41st section of the Trade Mark Act 1994 to the trade mark series. This section states notably that “(1) Provision may be made by rules as to (...) (c) the registration of a series of trade marks.

(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark”.

The main advantages of enacting rules on such a principle is that the Act brought a definition of what is a trade mark family, and also established instructions to clarify what a series is and how it is composed. All the greys zones of the European system had been anticipated and treated in one section of an Act. But to understand how the United Kingdom came to this system, it should be taken into account the influence of Beck Koller who in 1947 defined the said concept as “a number of trade marks which resemble each other as to their material details and differ only as to matters of non-distinctive character that does not affect the identity of the trade mark”22.

This definition draft was completed further in an application formed by Logica PLC23 in which it was specified that “the marks in the series must resemble each other in their material particulars.[...] The differences between the trade marks must not comprise matter, which when considered as a separate element of the trade mark would be regarded as having distinctive character; and [...] the differences between the trade


23 Application n° 2214271.
marks must not comprise matter, which when considered in the context of the trade mark as a whole, substantially affects the identity of the trade mark”.

While United Kingdom is the only state of European Union which has integrated the concept of trade mark series in its legislation, other countries such as the United States or India have made the same choice. Nevertheless, the integration of the principle of families of trade marks in their own legislation does not take the same form.

In accordance with their case-law system, the United States had recognized the said concept through the famous decision J & J Snack Foods v. McDonald’s Corporation\(^{24}\) in which a family of marks was defined as “a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trade mark owner”.

A few years latter, India adopted an other approach on the topic and formalized this business practice in the Trademark Act 1999 dedicating a whole section to the series. Thus, section 15 of the abovementioned Act states that:

“(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and the part as separate trade marks.

(2) Each such separate trade mark shall satisfy all the conditions applying to and have all the incidents of, an independent trade mark.

(3) Where a person claiming to be the proprietor of several trade marks in respect of the same or similar goods or services or description of goods or description of services, which, while resembling each other in the material particulars thereof, yet differ in respect of –

(a) statement of the goods or services in relation to which they are respectively used or proposed to be used; or

(b) statement of number, price, quality or names of places; or

(c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or

(d) colour,

seeks to register those trade marks, they may be registered as a series in one registration”.

The worldwide overview made about the concept of trade mark series could lead to the conclusion that the European Union is late compared to its international competitors. The system of families is well incorporated in the abovementioned national legislation while the UE starts to discover and to appreciate the advantages of such a concept. However, the situation of the European Community must be put in perspective with the global tendency of ignorance of the concept by the largest part of the states around the world.

The Indian trade mark system should be considered as a leader in the field of the series. The rules enacted encourage companies to file global and multiples registrations in order to reduce the cost of the said registrations as well as making their trade marks stronger. The main advantage of the Indian system is the possibility granted to trade mark owners to proceed to the registration of the whole trade mark or solely to a part of this mark. This option is crucial when the owner of the family would like to ensure a special protection to the common distinctive element shared by all the brands of the series. This protection could be qualified as agglomerating because all the rights – individual or common – of a trade mark series converge to the core of the family: the common distinctive denominator. But this mechanism guarantying a “super protection” to all the trade marks of a series could also have perverse effect because it could lead an anti-competitive attribution of a right on a word, a letter, a sign or a sound for a particular category of goods or services.

As it has been specified above, any European directive or regulation is properly dedicated to the concept of trade mark series as in the examples previously mentioned. Nonetheless, the development of the said concept is not devoid of legal basis. Indeed, the mechanism of trade mark families could be justified by general provisions of both the directive 2008/95/EC and the CTMR.

Taking and analysing the 2008 European act, the conclusion that article 5(1)(b) applies logically to the concept and states that “The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade: (b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark”. The quasi systematic reference to this provision is due to the fact that for the moment, almost all cases decided or which are pending before the ECJ concerned or concern famous trade marks or trade marks with reputation.
In the meantime, the article 15(2)(a) of the CTMR fits perfectly to the families as it provides that “The following shall also constitute use within the meaning of paragraph 1: (a) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. The application of this disposition in this context is so obvious that the ECJ used it as a legal basis to hold its Bainbridge decision.

Talking about the said article of the Regulation, it is impossible not to draw a parallel with article 5-C-2 of the Paris Convention whose main features are took up in the CTMR.

Thus, from the worldwide overview of the concept of trade mark series, some elemental features start to appear. But the introduction of new elements raises new questions, starting with what kind of company is the more entitled to use the said concept?

Section Two: Interests in the concept of trade mark series

The creation and development of a new concept always responds to a request. In a first instance, in the case of this study, it would help to understand for whom the said concept is design (§1). Then, in order to avoid any confusion, the notion of trade mark family should be compared to very close concepts to see how it differs from the existing ones (§2).

§ 1: A family of trade marks : for whom, what and why?

The development of the concept of trade mark series in the last six years could be perceived as an answer to the global requirement of identification of goods and services in a market starting to be saturated. Indeed, the diversity of products and services has exponentially increased since the globalization and the creation of an international market. Consumers’ needs are fulfilled before they appear. Thus, facing the commercial jungle, consumers should be able to make relevant choices in front of the large panel of goods and services proposed.
But not only the three musketeers of Alexandre DUMAS have adopted the famous adage “united we stand, divided we fall”. Thus, it also designates the strategy of companies which intend to become stronger in a saturated market. To fulfil this purpose, companies adopt the technique of the grape with their trade marks. If those trade marks present a common distinctive element, they will be agglomerated together in the framework of a family structured around the said denominator.

After having studied both the market and the decisions held on this topic, it can be easily asserted that the option of trade mark series is in most cases chosen by large international companies with strong abilities to communicate on their brands.

The formation of a family of trade marks is not a simple and fast process. Companies do not initially present their marks as a family. From time to time, they introduce individual trade marks on the market, each trade mark sharing a same distinctive element. Thus, at first, most consumers will not remark the common feature. The trade mark family will win in strength when the company put all the trade marks related by the common denominator together and present the said trade marks under another angle. This is notably the marketing strategy adopted by Apple or Mac Donald which present their range of products and services as a group on their respective internet web site or stores for instance.

Talking about Apple and Mac Donald, it must be considered that the concept of trade mark series is, for the moment, almost reserved to multinational companies with a strong power of communication and advertisement. The principle purpose of the concept is to make individual trade marks stronger and in parallel to reduce the cost of the communication budget (with the association created in the consumers’ minds, the communication made around one product or service will touch indirectly the products or services of the family due to the closeness of their structures). Thus, such a marketing strategy is really expensive and is “naturally” reserved to large businesses.

In the same time, it is interesting to notice that the abovementioned concept only concerns services and non-food products. The principle of trade mark family seems to be a mutation of the concept of umbrella marks which applies exclusively to food products and cosmetics.

To realize a complete study on that topic, it should be mentioned the particular interest of IT (i.e. Intelligent Technologies) and pharmaceutical industries to trade mark families. As it was already mentioned, Apple is one of the most famous illustration of the concept. Nonetheless, researches have made appear that pharmaceutical companies have bet on
the series to reinforce their notoriety to face competitors. The "war" between this type of industries is no longer made on the patent field. It started to invade the trade mark rules.

The concept studies could be qualified as a weapon with the used that is made of it by multinational companies. But it could also be considered as an armor by the same businesses. The frontier is very thin between trade mark series and umbrella or dam brands. Nonetheless, those three notions are completely independent and should not be confounded.

§ 2: A concept departing from umbrella or dam brands

Despite the possible similarities and parallels which could be made between the concept studied presently and the mechanism of umbrella marks, the two theories must not be confounded. Indeed, an umbrella mark can be understood as a trade mark whose importance and reputation benefit to other trade marks all owned by the same business entity or by entities economically related. To illustrate the above statement, general trade marks such as Nestlé, Danone or L’Oreal should be legitimately mentioned. Indeed, for instance, the umbrella mark L’Oreal covers, protects and puts under its aura targeted trade marks as, without limitation, Garnier, Kérastase or Lancome.

As it has been discussed and stated above, those concepts do not cover the same material scope. While the umbrella mark is designed to fit food and cosmetic (and fashion) products, trade mark series applies to services and non-food products, more specifically IT and pharmaceutical goods.

Moreover, differences may be highlighted concerning the functioning of those two concepts. Contrary to the trade mark series which is based on the sharing of a common denominator by several brands of a same company, the umbrella mark works more like a superior layer which applies above marks put directly on the products they designate. The working process of the umbrella mark may be qualified as a downward vertical relationship. From the top of the pool of company’s trade marks, the umbrella mark cover each individual trade marks of the said pool separately. The umbrella mark does not intend to create a link between each individual trade marks of the business. On the contrary, following the example of a traditional family, the concept of trade mark series intends to establish a link between each individual trade marks composing the series. Thus, they share more than a denominator. They are the vectors of the company’s spirit.
Due to those features, the concept of trade mark series seems to ensure a more powerful relationship between the trade marks.

The quantitative scope is also different depending on the concept applicable. Indeed, it must be borne in mind that the concept of trade mark series is based on the use of a denominator shared by several trade marks belonging to one company. Instead of this, the concept of umbrella mark is entitled to cover all the trade marks of a multinational company, no matter they share a common structure or not. Regarding and confronting the current examples in the market, e.g. Apple v. L’Oreal, it can be easily noted that while the Apple family is composed of a few individual marks (such as iPhone, IMac or ITunes), the “L’Oreal umbrella” covers all the marks owned by L’Oreal. Such differences constitute clues helping to qualify and categorize the relationship in a group of trade marks.

In another aspect, the concept of trade mark series should not be associated with the principle of brand dam which designates numerous registered trade marks with common characteristics. In this concept only one of the trade marks will actually be used, the others constituting a rampart around the used mark. Starting from this definition, it cannot be discussed that those two concepts are very close. But they are not chasing the same purpose. The concept of trade mark family is designed to ensure the global protection of several trade marks united around a common element. On the contrary, the purpose of the concept of brand dam is to reserve a perimeter of security around a registered trade mark used in commerce by registering at the same time as the registered mark a series of brands which will probably never be used on the market. However, for this theory to be applicable, all the trade marks registered at the same time must present a common element. According to this method, companies reserve the right to choose in their pool of registered brands which one will designate the new product or service.

Thus, it is easy to see that what splits the two concepts is the requirement of use of all the registered trade marks. Thus, in the case of a series, all the trade marks composing the family must be used individually, while facing brands dam, it should be noted that on the multiple global registration only one mark will be used in commerce, the unused marks forming a perimeter of protection around the used one.

To illustrate the mechanism of protection of the brand dam concept, it might be compared to concentric circles which lead to the core of the target, or to the walls of the Middle Age castles which were built to protect the apartment of the lords and to slow down assaults of enemies.
Nonetheless, it should be noted that the protection based on unused trade marks is only temporary. Thus, if the registered trade marks are not seriously used during the five years of their registration, or if the owner does not used those marks seriously during an uninterrupted period of five years without good explanation, then those brands are revoked and the dam is no longer effective. The advantage of this system is that during this period of five years, the owner can make an almost unlimited use of its trade mark with the certainty that any competitor will not be able to use a close one in order to take unfair advantage of it. This concept ensures a quasi monopoly on a sign in a speciality, which is an important asset to become the reference in a specific area of the market.

One of the best examples to illustrate the brand dam concept is the marketing strategy of the company Peugeot. Indeed, before the creation and \textit{a fortiori} the release of a model of vehicle, Peugeot proceeds to multiple registrations and solely one of the multiple registered trade marks will be used in commerce to designate the brand-new car. But the situation of Peugeot is not that simple. As a matter of fact, the marketing strategy of the said company is at the crossroad between the brand dam concept and the concept of trade mark series. By registering multiple marks without using all of them, this car constructor adopts a strategic marketing which falls into the concept of brand dam due to the protective effect resulting from the perimeter established by all the unused trade marks. However, it may also be considered that all the individual trade marks registered and owned by Peugeot constitute a series. Indeed, every brands of the group are build around at least a central “0” which constitute the common distinctive element of the family. This denominator must be perceived as the cement between all the marks of the series and also as the particularity of the whole company. The corporate identity is based on this neutral number which refers to the period when cars started with a crank, the “0” still represent the hole of the crank, and by this way the quality, the known-how and the pride of the company. The particular and unique case of Peugeot illustrates perfectly the reasons why companies should have recourse to those two concepts cumulated.

An analysis of the existing legal provisions adopted in third party states to the European Union and the comparison of the concept of trade mark series to the existing principles is capital to fully appreciate the origin and the scope of the studied concept. But a complete comprehension of the said concept goes also through a study of its composition by both internal and external forming conditions.
Chapter Two: Trade mark series’ formation, a balance between internal and external conditions

As it has been specified above, the trade mark series’ standards have not been developed in any European provisions. Thus, the conditions of formation of a family of brands are not yet fixed. Nonetheless, a repartition could already be made between “internal” conditions (Section One) and “external” ones (Section Two).

Section One: The "internal" conditions

Under the wording “internal conditions”, it should be refers to requirements which impact the construction of the series. Thus, all the brands constituting a trade mark series should at least show the use of a common element (§1) which should be strong, distinctive and stable (§2).

§ 1: The necessity of a common element

Since the end of Middle Age, human families distinguish one another thanks to the instauration of the concept of family name. Indeed, before the Renaissance, families were not unified around a name shared by every member of the said particular social group. They were “classified” by works or living places, with explicit relation made to the patriarch of the family. This system, which looked like the caste system of India, was source of confusion so it was decided that each family would share a patrimonial heritage by being related to a common name, which would be transmitted to future generations. Thus, because of this political decision and this social mutation, people are nowadays able to establish their genealogical tree to discover their origin, understand their roots and maybe make the contact with people whose existences were completely unknown.

For trade marks, it works exactly the same. The development of the concept of trade mark series since the Bainbridge decision can be compared to the creation of family names. Indeed, prior to this case, the potential existence of a structured mechanism related to
trade marks was not admitted. Even if they belonged to the same economical entity, trade marks were exclusively seen individually. The *Bainbridge* decision had the merit of highlighting the potential existence of a common element between brands of one unique company or companies economically related. Thus, when multiples trade marks all owned by the same business entity show and share a common distinctive denominator, they constitute a series. The fact that trade marks could be regrouped in a same family lead to the partial conclusion that the brands composing the series have to be regarded under two different angles, from an individual and a collective one. Those appreciations are alternatives and correspond to different timing of trade marks’ life. The purpose of a brand is to be applied on a product or a service in order to individualize it and prevent the consumer from confusing it with a competing one. So trade marks are designed to be used separately. Nonetheless, it is frequent that owner of a brand has to introduce an opposition because of the closeness of a competing mark. In that case, if the claimant is the owner of several trade marks sharing a common denominator, he is entitled to invoke the benefice of the series. It will have for consequences to encourage the judges to appreciate the opposition claim by taking into account the balance of power between a single trade mark and a combination of multiple trade marks. Due to the “mass effect” induced by the family, the magistrate – if he recognizes that a series is formed – may appreciate the likelihood of confusion provoked by the third party’s trade mark with the whole family. In consequence, the legal clash is unbalanced and could be seen as a fight between a mosquito and an elephant.

The other debate relating to the requirement of a common distinctive element in order to form a series, is the place that should be taken by the denominator in all the brands composing the family. Indeed, the strength and the credibility of the family are conditioned by the stability of its common denominator.

The impact of the series will be higher if consumers are able to note the existence of a common element shared by multiple trade marks owned by a unique company. The fact that the said denominator is always located at the same place in every trade marks makes the series stronger and more stable, which influence the credibility of the series.

After having determined that the common distinctive element must be stable, the other question is: does a prefix or a suffix is more efficient for the strength of a trade mark series? Cognitive studies show that the repetition of a prefix is more efficient than the recurrence of a suffix. Indeed, people are more able to focus on the beginning of a word than on its end. Thus, the more a prefix will be applied to trade marks owned by a unique company, stronger the series will be on the market, at consumers’ eyes and before a
court. Today, the series which “dominate” the market have adopted this *modus operandi*. Apple as Mac Donald have opted for the use of a prefix, respectively “I” and “mac”.

Before using a prefix or a suffix, the owner of the trade mark family should make sure that the element he intends to connect with all his trade marks is distinctive and not necessarily in the business field. The common denominator must have an identity sufficiently strong to gather the brands, but without impairing the liberty of competitors. To illustrate this dichotomy, the “Uni” case should be bared in mind. The CFI in this case has decided that the use of the prefix “Uni”, even if it is distinctive, is too frequent in the banking and assurance field to be appropriated and reserved to a unique company.

In a theoretical point of view, it should be mentioned the possibility of creating a trade mark series which common denominator would occupy a central place in each brand. This trade mark family’s configuration is not optimum and its idea is rejected by companies. Indeed it might be difficult to isolate the distinctive denominator of the series, which would lead to a weak family, even non-existent.

The use of an element appears to be a basic feature of the concept’s formation because, as an element of each brand, the purpose of a trade mark is to be used in commerce. Nonetheless, a non-evident requirement follows the first one, since the common element must be distinctive, strong and stable.

**§ 2: The terms of strength, stability and distinctiveness of the common element**

As it has been evocated above, since the common element has been identified in a series, it is also necessary for this denominator to be strong. The strength of this common element depends on the consumers’ perception of the series. Indeed, if customers do not observe that multiple trade marks have an element in common, it implies that the series has no impact on the relevant public.

Due to the non-evidence of the constitution of a series, companies have to insist on their effort to create a coherent system in their trade marks. This communication around the trade mark family results mainly in advertising campaigns on multiple supports in order to touch the largest part of the population. The task of the marketing and communication
departments is to build a mechanism or a strategy due to which consumer will make the link between the individual trade marks and will automatically associated those marks to each other. The force of the common element can be compared to the different states of water. Indeed, when it becomes colder, particles of water will pass from the gaseous to the solid state. For trade marks, as the advertising campaigns make their effects, consumers will start to consider trade marks as a series, and no longer as individual ones, when they share an element.

What the existence of a strong common element implies is that companies have to be the watchdogs of their own families in order for the common denominator not to become generic. Indeed, this element – as the trade marks it partly composes – must be controlled by its owner who must limit its propagation to other competitive marks in the same speciality but not economically depending of the true owner. Thus, the leak of this element is synonymous of depletion of both the common element and each individual trade mark which would have for consequence a total lost of power of the said element. The most popular the element is, higher the risk of being declared generic will be. So it is important for companies to establish the defence of its assets, notably its trade marks and the cement of those mark, the common denominator. Due to a permanent control, Apple or Mac Donald succeeded in building an empire based on their respective marks and denominators.

Moreover, A. FOLLIARD-MONGUIRAL has mentioned in his article the requirement of stability of the common denominator. The commercial effectiveness of the series is based on the necessity for customers to have references. The power and credibility of the series on the market will depend on the stability of its structure. When all the trade marks constituting the family are constructed on the same model, the series will gain in coherence and in impact, and also will the marks taken individually.

As usual, the most significant examples are Apple and Mac Donald which have understood the importance of the requirement of stability of the common element by always positioning the said element at the same place in each individual marks of the series.

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25 A. FOLLIARD-MONGUIRAL, CJCE, arrêt Bainbridge ou les aléas de la vie en famille (de marques), Propriété Industrielle n° 11, November 2007, comm. 89.
But when the necessity of a stable common element has been identified, the perception of the series by consumers remains. Indeed, trade marks are designed to be put on the market, in contact with consumers. Their perception is essential and will condition their success or their failure. Thus, the common element should be distinctive in order to be efficient. The distinctiveness of the said element is based on multiples features, such as – and without limitation – the position of the denominator (in preference a prefix), its length (the shorter it is, the more efficient it will be), the speciality in which it operates (in the Apple case, the distinctive element “/ ” which refers to the internet is super distinctive due to the products and services it applies on). The common distinctive element can also acquire its notoriety by use and large advertising campaigns on multiple supports.

Due to the recent development of the concept of trade mark series, it is difficult to appreciate with exhaustiveness all the internal features which can make a series stronger. However, even if the common distinctive element of the potential series is sufficiently strong, the perception of the series by consumers is a key element. Thus, it is necessary for the family to be use in commerce.

**Section Two: The "external" conditions : a necessary condition of use**

The main purpose of trade marks is to be put in contact with customers so as to help them make their choices between the goods and services on the market. Trade marks also provide important information to consumers, notably by guarantying and certifying them the origin of the goods they consume or the service they use. Starting from this point, the multiple references to the brands’ contact with customers imply that all trade marks must be used in commerce to be fully effective, and more specifically those which form a series. Judges of the ECJ had underlined this requirement through their Bainbridge decision. Indeed, they brought to the support of their demonstration the articles 15 and 43 CTMR which are focused on the trade mark use. In this case, magistrates concentrated their attention on the use of each individual trade marks of the Bridge series in order to challenge the family invoked by the claimant and to determine the relevant series by keeping the pertinent individual trade marks and dismissing the useless ones for this case.

Moreover, what should also be taken into account is the relevant public in contact with the family. The degree of strength of the concept will depend of the type of customers who
consume the good or the service on which the brand-new concept applies. Thus, a family can be considered as unknown by most of consumers while it will be super famous for professionals of a certain field. This situation is frequent in particular in the pharmaceutical industry.

Some lessons should be learned from the Bainbridge decisions. In fact, a series is composed of trade marks effectively used. When a brand is not seriously and continuously used for a period of five years, the trade mark series applicant cannot pretend to benefit of this trade mark in order to constitute his series. Such a non-use falls into the category of dam marks previously studied, which is excluded of the concept, object of the study. The seriousness of the use of each individual trade mark composing the series is one of the most important requirement which is asked from the owner of the potential family and its inobservance compromises the strength, the credibility and the structure of the concept of trade mark family. This obligation is the consequence of the strict interpretation and application by judges of the European court of articles 15 and 43(2) CTMR.

Cumulatively to the requirement of effective use, in order to pretend to incorporate a series, trade marks should be used meaningfully, i.e. they should be attached to a sole and unique good or service. This condition was identified by the judges in the Bainbridge case in which they found that some trade marks of the Bridge family were not sufficiently used in commerce to be considered as part of the family. This lack of use results from the

26 Article 15 CTMR states that “1. If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the Community trade mark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.

2. The following shall also constitute use within the meaning of paragraph 1:
   (a) use of the Community trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;
   (b) affixing of the Community trade mark to goods or to the packaging thereof in the Community solely for export purposes.

3. Use of the Community trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor”.

27 Article 43(2) CTMR states that “If the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years. In the absence of proof to this effect, the opposition shall be rejected. If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services”.
refusal by the ECJ to consider as an effective and meaningful use the utilisation of a registered trade mark slightly different instead of the relevant and appropriate trade mark.

The focus on the requirement of use in a series is crucial, not only for the constitution of a strong series, but also and mainly when the family is involved in an opposition procedure. Indeed, beyond the research of supremacy on the market by companies, the concept of trade mark series is very useful before courts. More than an autonomous argument, the said concept should be regarded as a tool underpinning the argument concerning the likelihood of confusion.

The directive principle that represents the likelihood of confusion emerged of the Sabel case. Thus, judges focused their attention on the potential risk of confusion that could rises from the use of a mark structurally close of a prior one, or in the case of this study, of a prior family. When a likelihood of confusion is proved, it could automatically be deduced a harm to the main function of trade marks, the guaranty of origin. To take advantage of a likelihood of confusion, it is not necessary that the confusion has been constituted but only that a risk that the average consumer may be mistaken on the real origin of the good or service exists.

The likelihood of confusion is becoming a central element particularly on the occasion of litigations. Indeed, every opposition procedure is based on this argument since the development of a case law line, which started with the Sabel case, and was confirmed among others by the Canon case. The importance of this theory had lead the European legislator to adopt the directive 2008/95 in which the eleventh ground states that “The protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the case of identity between the mark and the sign and the goods or services. The protection should apply also in the case of similarity between the mark and the sign and the goods or services. It is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion. The likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, should constitute the specific condition for such protection. The ways

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What it has been highlighted through this statement is that the resemblance between a third mark and a prior one or a prior series is analysed under three different aspects which are the visual, the phonetic and the conceptual aspects resulting of the comparison.

What it is interesting to notice is the mutation of the likelihood of confusion to the likelihood of association in the contact of a trade mark series. The ECJ had identified and differentiated those two concepts in the Sabel case. Nonetheless, it should be noted that the European Court had confirmed its position though the Bainbridge case by saying that the concept of likelihood of association is not an alternative to the concept of likelihood of confusion, but serves to define its scope (See in this connection: ECJ, 11 November 1997, Sabel, C-251/95). Transposed to trade mark series, this likelihood of association or indirect confusion comes to question the approximation that the consumer may make between trade mark families and one brand of a competitor, and the possibility that the consumer perceives the third mark [i.e. the competitive mark] as a new member of the family. The benefits attached to the recognition of the existence of a series of trade marks, including the extension of the protection related to each individual mark, are nevertheless subject to the meeting of prerequisite conditions which the owner must always subscribe. The risk of indirect confusion or association as it could be mentioned constitutes one step prior the likelihood of confusion.

The ECJ's conception of the interaction likelihood of confusion / likelihood of association could be regretted. Indeed, it can be considered that the European Court takes the situation in the wrong way when these principles are confronted to a series. Indeed, in the classic hierarchy, the likelihood of association is not sufficient to justify an infringement of a prior trade mark right, but it is perceived as a tool leading to the demonstration of a likelihood of confusion. Or in a case of a trade mark series, due to the strength of the general perception of the family, the simple demonstration of the rise of a risk of association in the consumer's mind should be sufficient to motivate the judges' decisions in favour of series. The number of trade marks involved in a procedure opposing a series to a single third mark should be sufficient to compensate the weakness of the likelihood of association compared to the strength of the likelihood of confusion. As a consequence, the likelihood of association occurring in a court action involving a trade mark family should have the same impact as the traditional application of a likelihood of confusion. If consumers are able to believe that a good or service on which is applied a third mark,
sharing the common features of a series, comes to the same company, the demonstration of a likelihood of confusion must not be required any longer. The harm made of a simple association to multiples related trade marks is multiplied and is equivalent to a likelihood of confusion.

For a trade mark series to be materially constituted, it is also necessary to bring the proof of its composition by a sufficient number of trade marks. Indeed, if a parallel is made between the said concept and human families, it should be noted that the primary social group is composed of a least of two people who share a connexion beyond a name. Thus, a family of brands can theoretically be constituted of a minimum of two marks. But the reality of the market imposes much more trade marks for its composition.

However, it must be specified that the qualification and the composition of a series is not an exclusive prerogative of the sole owner of the trade marks composing it. Of course, this owner is the first person or entity who will highlight this relationship between the brands. Nonetheless, judges are really vigilant on this composition. As such, they do not hesitate to reconsider and requalify the series when it is brought to their attention. That is what happened in the Bainbridge decision. The applicant sought to take advantage of an eleven trade marks’ series in order to oppose to a third party’s brand. In the course of the opposition procedure, the ECJ judges had reduced to six the number of the trade marks that were considered as relevant in the constitution of the series taken into account in this particular case. The five other marks were put aside because of their use in commerce had been deemed insufficient.

After this observation, it could be said that the trade mark series is a concept of variable geometry. The said concept does not obey to a unique perception and varies in function of the situation in which it is used. Thus, a pure marketing vision of the concept will tend to take into account all the marks sharing the same distinctive denominator, while from a legal point of view, the vision will be narrower in order to balance between the defence of the family owner’s rights and the freedom to use any term or sign as a trade mark in the limit of the speciality.

The first impression resulting of the concept of trade mark series’ study is that the idea of associated multiple brands sharing a common distinctive element allow the owner of the series to reinforce and reaffirm its intellectual property rights. This new mechanism of protection gives consistence to the range of trade marks and products he owns. Despite
the fact that this concept is still weak due to a lack of legal basis, its legitimacy within the scope of trade mark law exists.

What it is put into perspective through that concept is the strength resulting of the agglomeration of trade marks presenting a common feature. Trade marks are consequently no longer “alone predators” but work in group to impose themselves on the market.

Thus, such a mutation of trade mark law lead to study the impacts that the said concept may have on classical notions of this intellectual property field. In order to clarify the picture, those impacts could be split between internal and external consequences.
Part Two: Implications for the scope of protection – the added value of the concept of trade mark series on trade mark law

As it has been discussed above, the creation of the concept of trade mark series responds to a will of multinational companies to sit their domination on the market, and in the same time, to reinforce the power of their trade marks which are now considered as assets. Thus, even if the said concept raised a few years ago, it has the intrinsic capacity to deeply transform the landscape of trade mark law. Firstly, the notion will influence internally intellectual property law by shaking the existing concepts (Chapter One). Then, the impacts of the concept of trade mark family is broader because it will notably change the perception of competition law. So it should be noted and analysed the external effects that the notion could have (Chapter Two).

Chapter One: The "internal" implications

When a series of brands could be formed, the traditional trade mark law's concepts should be reviewed and adapted. Indeed, the traditional protection granted by the classic registration procedure is no longer sufficient. Thus, in the presence of a brands' series, the scope of protection would be substantially extended (Section One). Moreover, this new trade mark law’s feature challenges the traditional procedure of registration regarding the characteristics of the said concept as much as the mechanisms adopted by the abovementioned foreign states (Section Two).

Section One: The effects on the scope of protection

The perimeter of protection traditionally granted by trade mark law around an individual trade mark is limited and allows competitors to register closes brands. When the concept of trade mark series can be applied, the situation significantly changes as the protection
granted becomes stronger (§1). This extension of protection also raises the question of an independent protection granted to the sole series (§2).

§ 1: Strengthening the protection of trade mark series

The major impact related to the development of the concept of trade mark series is that such a conglomerate of marks sharing a common distinctive element is perceived as much more stronger than each of these marks taken individually.

Indeed, a trade mark family will be regarded as a powerful defence by competitor who will be tempted to benefit the notoriety of the anterior registered industrial property rights. Thus, in such theory, all the marks of the series reinforce each other, to such an extent that they can be perceived either individually or collectively, depending not only on the public concerned but also according to the context in which the marks are.

For instance, in the case of an opposition procedure, theses industrial property rights should be considered as a group in order to draw up a strong dam against the alleged counterfeiter and subsequently to guaranty the strength of the anterior trade marks.

The pool of trade marks assembled around a common element could be compared to the structure of an atom, the common distinctive denominator being the core of the atom and each individual trade marks representing electrons gravitating around this core.

From the exegesis of the successive decisions relating to this issue, it emerges that the aforementioned concept could be considered as an element for assessing the likelihood of confusion. Indeed, the main risk which can occur for a company owning a portfolio of trade marks sharing a common denominator is that a competitor in bad faith could try to take advantage of anterior industrial property rights by using both a similar structure and the same denominator of the said trade marks. Such an operation will lead the former owner to sue its competitor before the competent court, which will decide whether of not there is a likelihood of confusion.

Thus, such a behaviour will for sure impact the consumer’s perception of the market, especially of the trade mark concerned, and by extension the company to which belong the former industrial property rights. Though these competing marks are not identical, the closeness of the brands and the sharing of the same distinctive denominator are likely to mislead the consumer. He will perceive the trade mark as global and general, and will not
be able to distinguish them. The direct consequence of this misperception is that the consumer will associate these two brands with a unique economical entity.

The main risk for the family’s owner is to be confused with a competitor producing low quality goods or services, because of a resemblance in the trade marks misleading consumers. Indeed, the analytical comparison is no longer based on two isolated trade marks, but between the contested trade mark and the prior family. Due to the imbalance – which benefits to the series – in the balance of power, the likelihood of confusion must not be appreciated under each individual trade marks composing the family but under the family taken as a whole and exclusive right.

The strength that represents the application of this concept of trade mark series is a real capital gain compared to the total of individual trade marks. As a matter of fact, the ECJ acknowledges that the power of a trade mark family is likely to cause the mutation of the likelihood of confusion into a simple likelihood of association. Thus, if the judge identifies a risk that the target consumer might associate a competing trade mark with a prior series, this simple likelihood of association will be sufficient to receive the opposition claim.

As soon as the judge admits the existence and the validity of the series, it is much easier to demonstrate a likelihood of association than a likelihood of confusion whose conditions are restrictive.

Therefore, this time, the application of the concept of trade mark family in an opposition procedure may be compared to a shoal of fish : each mark of the series has its own business life and when there is a predator – such as an infringing mark – these prior marks congregate to become stronger in order to defend themselves.

Thus, the concept of trade mark series could be perceived alternatively and considering the situation as a technic of defense or as a technic of assault, if it is used in an opposition procedure respectively as an argument of defense or of attack.

Beyond the consequences on trade mark strength, the concept of trade mark series impacts significantly the protection which could be qualified as autonomous.
§ 2: The acquisition of an independent protection for the trade mark family

Due to the development of the concept of Trade Mark Series, it seems that the traditional trade mark protection could be adapted. Indeed, the harmonization of the trade mark law by the directive 2008/95 CE provides in its article 5(1) that only the registered trade marks can pretend to be protected, at the exception of the famous brands. The aforementioned article states that “the registered trade mark shall confer on the proprietor exclusive rights therein”. Thus, this provision establishes the basic requirement of registration of the trade mark for every person – physic or moral – who seeks a protection of its rights on this mark.

In the case of the emergence of the concept of Trade Mark Family, this base should not be considered as an end, but should be regarded as a first step in the complex mechanism of protection. In fact, the common structure of every trade mark family can justify the declination and the enrichment of the traditional “mono-protection” of the article 5(1) of the directive.

While the classic protection “one mark = one registration” always falls to be applied in case of a trade mark family, such a family taken as a whole could also be protected in parallel. Thus, it is possible to imagine a multi-layers protection, the first layer through each classical individual registration and the second one granted by the recognition of the family due to the common distinctive element.

In order to take advantage of this brand new protection, every single mark of the potential family must share this common distinctive denominator. This requirement has to be analysed as a prerequisite. Indeed, reflecting the original ethnological concept of family, membership to this particular group is conditioned by the sharing of a common history as much as a common name inter alia.

The transposition of the aforementioned concept to the trade mark law appears to be a clever way to illustrate the links that can be drawn between marks belonging to the same economic entity and goods and services of the same nature. Thus, these brands, through their common distinctive element, share the history and the identity of the company of which they are the property and asset.

The fact that the individual trade marks are united around a common element, brings a first consequence related to the original function of the mark. Indeed, by its decision in the
Terrapin v. Terranova case\textsuperscript{30}, the ECJ had identified the function of the origin of the mark. The merit and “the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin”\textsuperscript{31}. Thus, trade marks turn out to be a tool for the average consumer who is able to distinguish between similar goods and services due to their respective brands. That same consumer is also able to associate trade marks to the companies they belong to. If any consumer sufficiently aware and informed is able to make a link between a mark and an economic entity, he is also capable of creating an intellectual and conceptual association between marks sharing a distinctive denominator. This reflection leads to the conclusion that the aforementioned customer will be encouraged to trust goods and services which are produced by the same economical entity if he enjoys the experience he has lived with some of these related products and services. The function of the origin of the mark wins in strength with this concept. The individual potential of every single marks of a family is increased tenfold.

But the said concept does not simply impact the function of origin of trade mark. With its decision \textit{L’Oreal v Bellure}\textsuperscript{32}, the ECJ had once again extended the range of functions of the marks by discovering the functions of communication, investments and advertising. This list appears not to be exhaustive and might be completed essentially by new functions from the economic and strategic fields. Thus, the concept of trade mark series heavily impacts these features. As a matter of fact, when the consumer is satisfied by a good or a service, he will try to fill both his needs and his expectations by acquiring the full range of products and services made by the same economical entity. The concept of trade mark family increases the range effect which usually takes part in the business strategy of many companies.

\textsuperscript{30} ECJ, 22\textsuperscript{nd} June 1976, Société Terrapin (Overseas) Ltd. v. Société Terranova Industrie CA Kapferer & Co., case C-119/75.

\textsuperscript{31} ECJ, 12\textsuperscript{th} November 2002, Arsenal Football Club plc v. Matthew Reed, case C-206/01 (point 48).

\textsuperscript{32} ECJ, 18\textsuperscript{th} June 2009, L’Oréal SA, Lancôme parfums et beauté & Cie SNC and Laboratoire Garnier & Cie v. Bellure NV, Malaika Investments Ltd and Starion International Ltd., case C-487/07 (point 58 : “These functions include not only the essential function of the trade mark, which is to guarantee to consumers the origin of the goods or services, but also its other functions, in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising »).
The range effect is mostly composed by a production aspect and a marketing one. To stimulate the propensity of the customer to consume, companies need to establish and develop an identity around their goods or services and more particularly around their brands. The reputation of a company is built on the quality of its production and on the image conveyed by its trade marks. When several marks share a distinctive element, a cohesion effect pops up, which makes the identities of the marks stronger. Thus, due to the conscious or unconscious association between the marks of a series in the consumer’s mind, the entire family of marks wins in notoriety. In some cases, the consumer will not be able not to associate one mark with the others ones composing the family. In that case, the family acquires an indirect autonomy which justifies an autonomous protection. The aforementioned autonomy can only be qualified as indirect because the trade mark family solely exists through the marks composing it.

The impact of the concept of family is important both in terms of economy and of reputation, not only on the advertising and communication, but also on the company’s strategy.

Another reason can be put forward in order to plead for an autonomous protection of the series. To fully appreciate the role and the scope of this concept, it is necessary to put the family in the middle of an opposition procedure. Indeed, the “reaction” of the plaintiff is not the same when a family exists. When there is a family, all the marks of this group will come together to support the merits of the claim. Thus, the owner of the series could base his action not only on the prior right of the disputed mark, but also on every prior rights constituted by all the brands of the series. This way, the penetration of an external trade mark of the family is more difficult or even impossible, depending on the density of the series. The richer the composition of the family is – quantitatively and qualitatively speaking –, the harder it will be for a competitor to take unfair advantage of any mark of the family. Because they share a common element, all the trade marks composing a series are mutually helping themselves both upstream in the business life and downstream during an opposition procedure.

On the other hand, the concept of trade mark series raises a new interrogation in relation to the potential but controversial application of article 15(2)(a) of the Community Trade Mark Regulation to this theory. This provision states that “The following shall also constitute use within the meaning of paragraph 1: (a) use of the Community trade mark...”

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33 Only to remember, the paragraph 1 of the CTMR states that "If, within a period of five years following registration, the proprietor has not put the Community trade mark to genuine use in the Community in..."
in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered." To be exhaustive, it is also important to notice that the aforementioned article is simply the verbatim transposition of the article 10(2)(a) of the Directive 89/104/CEE whose purpose was to approximate the laws of the Member States relating to trade marks. This provision was introduced in all the national legislations, such as the French one by the article L714-5 of the Intellectual Property Code.

Through this article, the European Community recognizes the principles of the Paris Convention for the protection of Industrial Property of 1883, and notably the one established by its article 5-C-2 which states that “Use of a trademark by the proprietor in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered in one of the countries of the Union shall not entail invalidation of the registration and shall not diminish the protection granted to the mark.”

Professor Bodenhausen, who commented the Paris Convention in 1968 in its publication “Guide to the application of the Paris Convention for the protection of industrial property”, highlighted that “The purpose of the provision is to allow for unessential differences between the form of the mark as it is registered and the form in which it is used [...] The differences in form must not alter the distinctive character of the mark.”

Thus, according to both courts of the OHIM and the ECJ, the adhesion to the previous provisions should extend the protection to slight variations of a registered trade mark duly used.

However, both seem not to follow this principle, and in the same time, they adopt a really restrictive approach of the concept of trade mark family.

Indeed, in the famous Bainbridge decision, the judges of the ECJ held that “The use of the trademark The Bridge has not been established, and cannot therefore in any way serve as evidence of the use of the trademark Bridge.” In order to justify and to establish their position, they argued that “In any event, while it is possible to consider a registered
As a matter of fact, despite the adhesion of France to the Paris Convention, the French Supreme Court took the 16th July 1992 its famous decision “Lotus / Au Lotus”. The principle issued from this case-law is that “l'utilisation de la marque « Lotus » […] ne constituerait pas […] l'utilisation de la marque « Au Lotus », l'utilisation d'une marque enregistrée, analogue à une autre marque enregistrée, ne vaut pas exploitation de cette dernière et l'article 5-C-2 de la convention de Paris ne trouve application que si une seule marque est en cause”.

In this decision, the French judges intended to distinguish two different situations. On the one hand, they identified the situation when a registered trade mark is used instead of another analogous registered trade mark. On the other hand, they considered the case where a slight variation of a registered trade mark, which is not registered, is used instead of the actual registered trade mark.

To clarify the picture, they concluded that the first scenario was not covered by the article 5-C-2 of the Paris Convention, this Convention being only applicable when the situation implies a registered trade mark and a non-registered variation of the first one.

This decision appears to be logical from a legal point of view but may also be regarded as a handicap in business life for owners of close trade marks potentially able to constitute a family. In fact, that decision has restricted the scope of protection of registered trade marks while slight variations of the initial mark were registered to.

Due to a reading a contrario of the judgement, it may be possible to understand that the owner of a registered mark is free to use in business life any altered form of its initial mark.

36 ECJ, 13th September 2007, Il Ponte Finanziaria SpA v. OHMI, case C-234/06, pt. 86.
in both conditions that the variation does not alter the distinctiveness of the registered mark and this variation is not registered. However, this observation appears to be paradoxical because it contradicts directly the principle of acquisition of a trade mark right by registration and no more by occupation. Indeed, the judges of the Cour de Cassation seem in favour of granting the trade mark law protection to the owner of an unregistered trademark on grounds that it is a variation of a previous registered one owned by the same person or economical entity.

After this decision, two divergent lines of thought developed. The first one – more liberal – supported the idea of an application by analogy of the article 5-C-2 of the Paris Convention, while the opposite theory was based on the deliberate intention of the owner of a trade mark who, by deciding to register several marks which are slight variations of the same mark, expresses his wish to distinguish those marks from one another by obtaining an exclusive right for each trade mark. This approach was notably inspired from the decision taken by the Court of Appeal of Paris the 21st March 1983 in the “Napoléon” case.

Due to the uncertainty surrounding the situation, the French Cour de Cassation reversed its position through a series of three decisions all taken the same day. The judges abandoned the condition of registration just to focus on the distinctiveness of the marks. Thus, it was decided that “le texte précité [the article L714-5 of the French Intellectual Property Code] exige seulement que la marque exploitée diffère de la marque première et non exploitée par des éléments n’en altérant pas le caractère distinctif, peu important que la marque modifiée ait été elle-même enregistrée”.

The supreme court did an about-turn by admitting the relevance of the economic point of view on that topic. Indeed, companies owning a draft of trade mark family were no longer bound by the principle that all registered trade marks should be used in commerce independently of the presence of slight registered variations. The use of one form cannot be considered as a use of an altered one.

One the one hand, such a statement is entitled to create legal uncertainty for competitors who are more exposed to an opposition procedure, but one the other hand, it announces an enlargement of the scope of protection of trade mark in general. Thus, the

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aforementioned judgements were in line with one of the main issue of the trade mark law which is to ensure competition on the global market.

Nonetheless, it may be argued that the aforementioned judgements were not in line with the theory developed by Roubier who considered the trade mark law to be an instrument of regulation of competition by preventing any owner of a distinctive sign to create a monopoly around the said sign\footnote{P. ROUBIER, Treaty, T. 2, p.524.}. Given the diversity of words and languages – not to forget the creative imagination of marketing departments of companies and agencies – combinations are almost unlimited insomuch that it seems difficult to dry up the source of distinctive signs. Moreover, it is important to notice that this theory is limited to the relation between the sign and its application to the good or service it designates. Thus, the sign must be necessary for the exploitation of the good or service. This hypothesis falls into the category of descriptive signs which is covered by the article 7(1)(c) of the regulation 207/2009 which codified the CTMR\footnote{Community Trade Mark Regulation n° 40/94.}.

But the progress made by the Cour de Cassation as much as its boldness, were stopped by the Bainbridge decision announcing a turn back by endorsing the previous position of the French supreme court in the “Lotus” case. Subsequently, the Cour de Cassation has complied with the position of the ECJ, notably in 2010 through the “Abercrombie & Fitch” case\footnote{Cass. Com. 16\textsuperscript{th} February 2010, « A & F Trademark », PIBD 2010 n° 916-III-243.}.

On the occasion of the Bainbridge case, the same questions which were asked fifteen years ago to the French Cour de Cassation, have now been raised before the ECJ.

Nonetheless, while the judges in the “Lotus” case came to this solution without any doubt, it appears that the decision taken in Bainbridge case is not so obvious, starting with the dissenting opinion of the Advocate General SHARPSTON\footnote{Opinion of Advocate General Sharpston delivered on 29 March 2007 on the case Il Ponte Finanziaria SpA v. Office for Harmonisation in the Internal Market.}. In fact, in point 72 of his opinion on the abovementioned case, he came to the conclusion that “\textit{Since the aim of the provision} [art. 15(2)(a) CTMR] \textit{is that a trade mark proprietor should not have to register all minor variants of his mark which he may use in trade, it should not be interpreted to the detriment of one who has in fact registered such variants. The fact that mark ‘Bridge’ was registered separately from mark ‘THE BRIDGE’ should therefore not}
have affected assessment of their use jointly, as differing in elements which did not alter their distinctive character”.

Moreover, he went further (in the same paragraph) by criticising the decision of the court of first instance highlighting that “The Court of First Instance misapplied that provision by limiting its scope to ‘situations in which the sign actually used by the proprietor of a trade mark to identify the goods or services in respect of which the mark was registered constitutes the form in which that same mark is commercially exploited’, to the exclusion of use of a similar mark covered by a separate registration”.

The disagreement that has crystalized between the members of the ECJ is symptomatic of the complexity of the problem and illustrates perfectly the two opposite doctrines on the recognition or not of the concept of trade mark series.

In a context of economic crisis where the watchwords are growth, economic revival and production, the actual jurisprudential line appears not to be appropriate. It does not encourage companies to take risks by offering ranges of goods or services with trade marks articulated around a common distinctive denominator. As a matter of fact, in case of encroachment by a competitor, those companies will not be able to take advantage of their family, which will not be recognized by both national and european courts in opposition procedures.

Paradoxically, large companies owner of famous series of marks – such as Mac Donald or Apple – have succeeded in capitalizing on their trade mark families, considering them as assets. Indeed, due to the reputation of those respective companies’ trade marks, the ranges of marked products and services which are offered to the consumers enjoy a really large success and provide huge benefits to their companies. Thus, in 2011, the revenue of Mac Donald was almost 24 billions of dollars and Apple’s one was over 100 billions of dollars. To illustrate the power of the principal trade marks of theses to businesses, the value of the trade mark “Mac Donald” is 95 billions of dollars in 2012 while the trade mark “Apple” is estimated at 183 billions of dollars, which makes this mark the most valuable brand in 2012.

46 Apple Form 10-K 2011
In consequences, from a legal as much as an economical point of view, it seems relevant to bear in mind the two previous example in order to reconsider the conservative position of the ECJ on the concept of trade mark family.

It has been demonstrated that the concept of trade mark series strongly impact the protection of the whole series as much as each individual mark benefiting of the family’s aura. But the said concept also influences significantly the record of such a series.

**Section Two: Effects on the record**

Traditionally, trade mark rights were acquired by the use in commerce of the word or sign associated to a particular and single good or service. But this principle is nowadays marginal and European statements, as much as national provisions, made the registration the essential step for trade mark owner before using their brands. However, the concept of trade mark series has shaken this established principle by introducing the idea of an

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independent registrations procedure and consequently of an independent protection of the series and of the common distinctive element which federate all the brands (§2). This protection would ideally work as a superior protective layer added to the traditional requirement of individual and separate registration of each brand of the series (§1).

§ 1: The requirement of individual registration for every trade mark composing a series

The evolution of trade mark law over the centuries has lead to a mutation in the procedure of acquisition of the protection. Since the emergence of trade marks in the Antiquity and their development from the Middle Age, the ownership of a trade mark is no longer the result of the occupation of the sign like it used to be. As a matter of fact, the regime of the old law could be summarized by the adage “first come, first served”. Manufacturers, suppliers and merchants could choose any word or sign to distinguish their goods from those of competitors. In the same time, it appears relevant to specify that this sign was not picked up randomly because it had a function of attachment of the merchant to his corporation. The actual function of origin identified in the “Terrapin / Terranova” case is probably an evolution of the previous conception of the trade marks impacts.

The transition to the current system began in the second half of the XXth century. One by one, each individual state of the European Community adopted the protection of trade marks granted through the requirement of registration. This large transformation has the advantage of bringing more legal certainty, particularly by providing undisputed proves and establishing a database of precedents.

One of the first states which lead the way was France, by reforming the national trade mark law with legal provisions adopted the 31st December 1964. More precisely, the article 4 of the abovementioned law states that “La propriété de la marque s’acquiert par le premier dépôt, valablement effectué conformément aux dispositions de la présente loi et des décrets pris pour son application, qui déterminent les modalités et conditions dudit dépôt, ainsi que les actes ou paiements de taxes qui en perpétuent l’existence”.

Thirty years later, the English government followed by passing the Trade Mark Act in 1994, which in its article 2(1) states that “A registered trade mark is a property right

obtained by the registration of the trade mark under this Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act”.

The requirement of registration is also sanctioned by European provisions, such as the directives 89/104/EEC and 2008/95 which both define their scopes at article 1 by stating that “This Directive shall apply to every trade mark in respect of goods or services which is the subject of registration or of an application in a Member State for registration as an individual trade mark, a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux Office for Intellectual Property or of an international registration having effect in a Member State”.

Through this evolution, it is impossible to make an exception for trade mark families by avoiding this basic principle which must be seen as a pillar of trade mark law.

The principle of individual registration of each trade mark composing a series seems to be in accordance with the actual jurisprudential line led by the Bainbridge decision which held at its point 86 that “it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trade mark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former”. This quotation refers directly to the former statement developed above in which it is said that the separate registration of each trade mark of a family is justified by the fact that those marks have an individual business life different from one another. The ECJ considers that trade marks are not made to be substituted or exchanged. Each trade mark is attached to a good or service designating and individualizing it from competing ones. From this statement, it is possible to consider that trade mark rights are rights in rem.

Nonetheless, incoherence, resulting from the nature of the trade mark series, can be highlighted. Indeed, in the majority of cases, a trade mark family is usually composed of well known trade marks. However, according to the spirit of articles 6 bis of the Paris Convention and 16(2) of TRIPs, well known trade marks are not necessary registered, contrary to trade marks with a reputation.

This dichotomy was underlined and explained notably by the Advocate General JACOBS who expressed his own interpretation in his opinion on the “General Motors” case50. At the points 32 and 33 of his opinion, he specified that “The purpose of the protection afforded to well-known marks under those provisions [Article 6 bis of the Paris Convention and

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50 ECJ, 14th September 1999, General Motors Corporation v. Yplon SA., case, C-375/97, Opinion of Mr Advocate General JACOBS delivered on 26 November 1998 (pt. 32-33).
article 16(2) of TRIPs] appears to have been to provide special protection for well-known marks against exploitation in countries where they are not yet registered. The protection of well-known marks under the Paris Convention and TRIPs is accordingly an exceptional type of protection afforded even to unregistered marks. It would not be surprising therefore if the requirement of being well-known imposed a relatively high standard for a mark to benefit from such exceptional protection. There is no such consideration in the case of marks with a reputation“.

Thus, due to the fact that the trade marks composing a series are almost always well known or with reputation, the question arises whether it is necessary to apply for a registration while the intention of the owner of several marks is to constitute a series.

To fully consider this problem, it is necessary to bear in mind that the protection granted to well known trade marks without registration constitutes a derogatory mechanism. The abovementioned system of protection represents an infinitesimal proportion of protected trade marks. Therefore, this protection is regarded as a legal exception, while the protection established by registration constitutes the principle.

Besides, even incorporated in a series, each trade mark has its individual business life as well as its own impacts on the market. They will not affect the same customers. They will not be use in commerce in the same circumstances and each trade mark of a same family will generate profits and loss on its sign, identifiable from the others.

In addition, individual registration of the trade marks composing a series appears to be relevant regarding the requirement of coherence which is almost mandatory in business life in order for companies to adopt and develop strategic guidelines. Thus this separate registration takes part in a “genealogical” processes in which economic entities try to establish a link between old trade marks and new ones. In the consumption landscape, average consumers can be easily lost due to the immeasurable number of trade marks cohabiting on the market. In most cases, trade marks of a family are registered at the same time. Indeed, some will enjoy a longer lifetime than others. Who says longer presence in the market implies largest reputation. In the mean time, family taken as a social group is characterized by its special spirit. Usually, members of a same family support and help each other. This feature which applies to human and animal families can be transposed and adapted to trade mark ones. Thus, as in corporate and tax law with the “parent / subsidiary” system, a “daughter” mark which is new on the market may find support in its “parent” by using its notoriety. This switchable notoriety inside trade mark series is based on the existence of a common radical. If consumers had a good experience with a marked product or service, they will be encouraged to trust other
products or services showing through their signs a common element that can make them think of a possible business relationship between the abovementioned trade marks.

This is notably the strategy adopted by the company Apple which has developed customer loyalty around the distinctive denominator “I”, creating at the same time a double range effect on the trade marks and on the goods and services covering the same speciality.

Furthermore, another advantage of applying separately for registration consists in establishing a hierarchy between the trade marks. As it has been discussed below, a trade mark series is usually composed of signs more or less old and popular. But the legitimacy of a mark depends both of its lifetime on the market and of the quantitative and qualitative importance of its distribution.

Thus, few trade marks in a series can concentrate and generate the major part of the profits of a company, such as the mark “Big Mac” which in 2007 brought back 2,7 billions of dollars of revenues to Mac Donald (12 % of the global revenue) with 900 millions of sandwiches sold\(^\text{51}\).

Important trade marks with a strong economic potential and a large notoriety are considered as the spearhead of a family. The others marks composing the series naturally stand behind, trying to take advantage of its attractive power and in the same time to acquire their own success.

Due to their position of leader, the strongest brands of a family should enjoy privileges such as advertising and street marketing campaigns, or gondola heads in superstores. Those privileges have of course directs impacts on the famous trade marks, but they also have indirect repercussions on the other trade marks of the family. Establishment of a hierarchy between the brands of a series appears to be a way for the owner of the abovementioned series to advertise at a lower cost by using a mechanism of repercussion from the strongest marks on the other ones. Such a mechanism of advertising waterfall appears to be a way to achieve economies of scale.

Nonetheless, the particular and innovative structure of the concept of trade mark series requires to temper the obligation of individual registration to consider the significance of the common distinctive denominator which might open a right to a distinctive registration of this element.

§2 : To the sufficiency of an autonomous protection for the common distinctive element?

Since the beginning of this thesis, reference is made to a common distinctive element. This feature of trade mark families appears to be the keystone of the concept. But it also appears that the importance of this element is underestimated and consequently not considered at its fair value. This common distinctive element which makes the strength of a series suffers of a global treatment and so of a lack of recognition.

However, due to the importance and the distinctiveness resulting from the common denominator of a series, it can be imagined an autonomous system of protection dedicated solely to this feature. Indeed, such a denominator acts like a rallying cry for customers who are looking for a stable element in which they can put their trust.

The common distinctive denominator should be perceived as an indication of quality, as well as providing information on the origin of the goods and services. When a consumer faces several times trade marks with a very similar structure in which he can find the same distinctive element at the same place in each trade mark, he starts developing some automatisms and will instinctively be encouraged to trust goods and services sharing a substantial part of his favourite brands.

If for the consumer, the fact that several related marks belong to a same group led by a flagship one is synonymous of guaranty of origin and quality, then this common denominator to those brands should be regarded as a private indication of source, a private protected geographical indication.

Considering this point, it has been demonstrated that the distinctive element should fulfil some conditions to be effective on the market, conditions already identified by the ECJ, notably in the “PAM” case52.

In point 100 of the abovementioned case, European judges declared that the effectiveness and the strength of the denominator in a family are characterized by the fact that it must be "short and easily memorised". Indeed, it is hard to imagine a long denominator. Longer the common element is, the more it loses in intensity and relevance to the customer. That is why this average customer will shorten it only to maintain the substantial and memorisable part of the distinctive element. This tendency may be justified by the requirement of rapidity on which the actual society is based.

52 CFI, 22nd March 2007, Saint-Gobain Pam v. OHMI, case T-364/05.
Moreover, through the paragraph 51 the “PAM-PIM’S BABY-PROP” case which was held in 2006, the ECJ highlighted a second essential condition. Thus, for the European judges, it is important that the common distinctive denominator is “situated at the beginning of the mark applied for. The consumer generally pays greater attention to the beginning of a mark than to the end”\textsuperscript{53}. This factor appears to be determining in the process of constitution of a trade mark series. Customers need references to choose among the myriad of goods and services on the market. In this commercial jungle, a consumer has – on average – the choice between 40 000 to 80 000 branded items proposed in a superstore\textsuperscript{54}. The common denominator in a series can constitute one of these markers and can be seen by customers as the Arianne’s thread.

But this idea may be nuanced and subject to controversy regarding the diagram called "The Illusion of Choice"\textsuperscript{55}. According to this study, the majority of everyday consumption brands are in reality the emanation of ten multinational companies. Through this article, it has been tried to demonstrate and condemn the manipulation of the average consumer.

\textsuperscript{53} CFI, 7\textsuperscript{th} Spetember 2006, Meric v. OHMI, case T-133/05 (pt. 51).

\textsuperscript{54} Information report on “the evolution of the distribution “, French National Assembly, submitted on 11\textsuperscript{th} January 2000 - http://www.assemblee-nationale.fr/rap-info/i2072-1.asp

This reflexion can raise uncertainty about the relevance and the usefulness of the concept of trade mark series. If the market is dominated only by ten super companies, why the phenomenon of trade mark families increases?

Looking at the picture above, it is possible to notice that the represented trade marks only concern food and cosmetic products. Therefore, should it be concluded that the concept of trade mark series only applies to services and non-food products such as electronic ones or clothing? To this question, it is tempting to answer positively, especially after referring to the existing families on the market, i.e. Mac Donald, Apple and Citigroup (real estate and financial services). Without rushing to conclusions, it also might be added that the concept of umbrella marks is specific to food and cosmetic products, while the concept of trade mark family fits for services and non-food goods. The notoriety built around the common denominator, as much as the importance attached to the strategic position of this element, can constitute the reason why an autonomous protection for such denominators should be granted.

In addition, through the “MATRATZEN” case, the European judges may express their intention to recognize such a particular protection to the distinctive element shared by all the marks of a family. For this purpose, at the paragraph 33 of the abovementioned case, the judges focused on this element, stating that “Consequently, it must be held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it”.

By asserting the superiority of the common distinctive element on the other components of the trade marks of the family, the ECJ’s judges have implicitly pleaded for an evolution of the trade mark law. Thus, it is possible to imagine a mechanism of protection in which a proportion of use would be reintroduced. Such a mechanism would provide an extension of the article 15(2)(a) CTMR scope of application, nowadays conditioned to the requirement of non registration of the variation. This liberal approach would have the merit of bringing a modern vision to both the CTMR and the Paris Convention.

56 CFI, 16th April 2008, Citigroup and Citibank v. OHMI, case T-181/05.
57 CFI, 23rd October 2002, Matratzen Concord v. OHMI, case T-6/01.
The creation and development of the concept of trade mark series constitute an important mutation within trade mark law. It questions its relevance after the mutations of both the market and the business field. Thus, actual provisions of national and European trade mark law seem to have a delay time vis-à-vis the actual situation and some third party EU states. But the said concept does not solely impact structural mechanisms of trade mark law, it also has a major influence on competition law, influence which could be qualified as “external”.

**Chapter Two: The "external" implications**

As it has been discussed above, trade mark law appears to be strongly impacted by the development of the concept of trade mark series. The classical mechanism of registration seems to be no longer appropriate as it does not take into account the way families work. But beyond consequences the said concept may have on the formation of a series, it substantially influences competition law by being used by trade mark series’ owner as an argument of defence during an opposition procedure (Section Two). Moreover, it should be highlighted that the efficiency of the concept depends of numerous factors, which one of them is the size of the business owning the family. Thus, multinational companies have a structural advantage for the use of the concept (Section One)

**Section One: A concept profitable to companies holders of famous trade marks**

All the features detailed above, as much as the examples chosen to illustrate the relevance of the specific protection granted through the trade mark series, can be regarded as clues leading to the conclusion that a substantial part of trade mark families belong to large holdings, especially in the pharmaceutical and entertainment fields. Indeed, holding companies work as tree’s ramifications or tentacles of an octopus. The dynamic of those fields of activity requires a constant activity of research and development and is characterized by their diversity. Subsidiaries are attached to a mother company, not by a physical link but by a financial and economical one. Thus, such subsidiaries can be owners of trade marks which should be taken into account for the evaluation of the capital of the group. In the case of large companies, the division of subsidiaries makes sense, when in addition, the mother company is only a moral entity without real function except the one of creating a hierarchical link between itself and its
When several companies regrouped in a holding share a trade mark series, the level of control of the mother company can be regarded as having an impact on the strength of the series. Thus, higher the control is, stronger the family appears. On the contrary, a shared control between a couple of companies could be seen as a reason of a lack of influence of the series, and so of a loss of interest of the consumers for the series. In the commercial jungle of products and services, consumers seek for points of reference to be informed on the origin of goods, as much as to obtain guaranties on the quality of those products. The fact that several companies regrouped in a holding adopt a common commercial line with coherence and continuity between the trade marks due to the presence of a common distinctive element, is also a factor which will help the series to be stronger and offensive and easily distinguished from the brands of competitors.

To sum up, it is possible to consider that there is an intrinsic link between the level of control of subsidiaries in a holding and the strength of the series.

Nonetheless, another theory can be sustained according to which the level of control has absolutely no impact on the notoriety of the family. Thus, for trade mark law, a full or a partial control by the mother company of its subsidiaries is independent of the perception and of the craze of consumers for the series. This point of view highlights the dichotomy existing between the structure of a company or of a group of companies owning some trade marks and those trade marks themselves. Consumers do not make any association between the trade mark and the company. In consequences, the corporate organisation of a holding appears to be a complete different and independent universe from the exploitation of trade marks and their use in commerce. This point of view can find a justification in the internal organisation of these holdings. Due to the specificities of the abovementioned departments, the corporate service is not competent to solve questions about trade marks, and vice versa.

Between those two possible conceptions, the first one should retain the attention. Indeed, the principal function of the trade mark is to identify a good or a service from similar goods or services of competitors. Consequently, consumers are aware of the origin of the product or service they buy or use. If it is considered that there is an interdependent relationship between the notoriety of the series and the level of control in the holding, the consumer who trusts a branded product containing a common distinctive element which also appears to be a feature of the holding would be encouraged to consume goods or
services having close origin and common roots. This mutual influence has for consequences to create a virtuous circle or win-win process.

At the core of this process, mass medias are considered as the principal vector of information and advertisement, and also as a major actor in business strategy. Indeed, mass medias promote – at almost an equal proportion – the brands (through advertisement campaigns essentially) and the company and/or the holding (by economical press and news), the promotion of one leading to the promotion of the other. It is a mechanism of indirect advertisement.

In the same time, the strength of the family depends on the strategic marketing line adopted by the holding. Since trade marks should be considered as assets of companies, those economic entities have to adopt both attack and defence lines of actions vis-à-vis competitors in order to – inter alia – increase their attractive power on the market and in the meantime to build virtual protective walls so as to protect their assets against opposition procedures or civil claims for remedies. In fact, owners of families of brands have to balance their business approach between aggressive behaviour and defensive comportment through advertisement campaigns or large trials. Up to this statement, the “technological war” opposing Apple to Samsung should be put onto perspective. Indeed, even if the core of the battle does not concern directly trade marks, a question of design series can be highlighted. While claims and trials were based on patent grounds, the confrontation between those two global holdings was also motivated by a question of design and implied a likelihood of confusion. The victory of Apple and the fact that Samsung were sentenced to pay to Apple more than one billon of dollars should be regarded as a step in the war between those two giant companies. This battle between Goliath and Goliath will end solely by the attribution of a quasi monopoly on technological devices, and consequently by the removal of the market of the products of one company.

In the field of technological devices, more particularly smartphones and tablets, the likelihood of confusion between products is really high. Those devices look like each other. Nevertheless, consumers succeed at identifying Apple products from Samsung ones. The role of trade marks in this particular case is crucial. Due to the resemblance of these products, trade marks which respectively apply on them are regarded as one major element by customers that can help them to make a choice. Thus, is it still relevant to talk about the average consumer standard while the level of attention of customers is increasing?
The impact of the concept of trade mark series appears to be broader than it can be perceived and opens the debate on the trade mark design. It is possible to come to the short conclusion according to which the concepts of trade mark and design families might be treated equally, by applying the same principles and implications to one another.

Moreover, despite the eventual existence of a holding sharing a series, doubts about the origin of the good or service can arise in the mind of average consumers. They might think that the good is made by a company of a trusted group while it is produced by a competitor intending to take unfair advantage of the goodwill of the trade mark family. In such a situation, a prejudice is caused to both the trade marks of the family and the reputation of the companies member of the group. Such a mistaken association in the consumers’ mind has for consequences to create a likelihood of confusion in direct relation with both the family and the holding.

With series of brands, holdings can build and be protected behind a virtual perimeter of protection by joining the trade marks of all the subsidiaries to form a family.

The concept of trade mark series can also be perceived as a way to create a legal or at least a business and strategic link between the subsidiaries. The different entities in a group of companies are often independent from one another. In some cases, interferences appear between subsidiaries. When a trade mark family exists in the middle of those companies, it may oblige them to exchange information and to communicate to elaborate a common strategic marketing plan for instance.

Correlatively, it is possible to notice that small trade marks (taken from a media, marketing and economic point of view) become weaker, while brands of large companies win in strength. When a local trade mark shares a common element with a global one without being related to it, this small brand risks to face an opposition procedure a fortiori if this trade mark is posterior to the global one. In such a configuration, the owner of a series is able to ask the judge to record an encroachment of a similar trade mark of his, no matter if it concerns similar or different goods or services.

In the case where the small trade mark is anterior to the family, the owner of the family could be entitled to introduce an opposition procedure. To support its claim, the company which hold the series could use the notoriety of its family. To this purpose, customer surveys can be done to characterize the likelihood of confusion which exists in the
consumers’ mind. Objectively, the chances for the series to win in this configuration are not so strong.

When the situation is reversed, i.e. the small trade mark is posterior to the family, the hegemony of the series will literally destroy the small brand’s rights. The company or the holding owning the family has two cumulative defence arguments to reach its purpose. Firstly, the appellant will put the likelihood of confusion into perspective. In such a situation, considering the balance of power, the judge has no choice but to recognize the infringement of the defendant.

Secondly, the owner of the family is entitled to introduce a claim for unfair advantage, even if the defendant in the trial applied for the registration of its trade mark in good faith, i.e. ignoring the existence of the family or thinking he will not infringe on someone else rights.

One of the best example to support this demonstration is, without a doubt, the case of the news group Sky Broadcasting. This press holding had created several subsidiaries and had applied for worldwide registration for almost 80 trade marks, all of them sharing the distinctive element Sky. The registrations concerned goods and services related to the activity of press and information. In parallel, in France, a small company producing solar panels filed a registration for a trade mark containing the element Sky for a complete different class of products. Nonetheless, Sky Broadcasting considered that the brand of the small French company might enter into conflicts with the prior series of the news group, even though the two companies and the trade marks did not concern the same speciality. After negotiations, these companies came to an amiable solution. Under the pressure and the threat of an opposition procedure, the French company modified its mark and received compensations.

This example shows the supremacy of series on individual marks. It also illustrates the extension of the principle of speciality when a trade mark family is part of an opposition procedure. An enlargement in the perimeter of the principle of speciality might also lead to the depletion of the pool of marks. Large companies and large holdings owning a trade mark family in their assets might “reserve” a distinctive element, which corresponds to an implied exclusive attribution of a such an element. Such excesses might lead to a restriction on the use of some identified terms, without necessarily connexion with the speciality of the owner of the family. Competitors – direct and indirect – and companies whose activities are totally different from the designated owner might not be able to use those terms due to the strong likelihood of confusion and the unfair advantage that results from this use.
At the present time, the actual jurisprudence line refuses this interpretation of the concept and its consequences. The ECJ stated in this direction at the occasion of the Uni Case. However, after the Sky case, the actual context appears to be less clear and more difficult than it used to be.

The aura of a trade mark series could be regarded as the cement of a holding company, and also as an ultimate weapon to force small brands not to compete with strong ones. Thus, all trade marks do not play in the same playground. This statement takes all its relevance when it is challenged to the rules of competition law.

Section Two: Effects on Competition Law: a concept highlighting anti-competitive practices initiated by the owner of the third party trade mark

Trade mark rights can be regarded and qualified as providing *erga omnes* mechanisms of protection compared to the features of property law. Indeed, while traditional property law is based on the principle of perpetuity of ownership independently of the nature of the property (personal property or real property), the property in trade mark law is only limited to ten years, but is perpetually renewable. The time limit in the framework of this intellectual property field let the market not to be saturated by unused trade marks restraining third party’s rights by constituting an obstacle to the use in commerce of identical or similar signs. Despite this time variation, the trade mark property law obeys to the classical principles common to any property rights, i.e. the *usus*, the *fructus* and the *abusus*.

Besides, property rights on a trade mark are abstract and intangible. Contrary to a tangible property, trade marks rights are completely virtual. Their materialization goes through the procedure of registration, more particularly to the certificate delivered by the national office competent in trade marks, or by OHIM in case of a European procedure. However, nowadays, this statement is no longer relevant due to the electronic procedures and certificates.

Thus, because of this intangible feature, limits of the property rights on the mark are hardly determinable. The density and the diversity of trade marks, as well as their economic and social disparities, are additional factors motivating competitors to take unfair advantage of a brand and today of families.

Contrary to the opposition procedure, the purpose of a claim against someone taking unfair advantage of an existing trade mark is to ensure the protection of property rights
which belong to the owner of the prior trade mark. Legal actions for unfair competition and parasitism are classic civil procedures under which the plaintiff is entitled to claim for compensation resulting of the abused behaviour of a competitor.

Nonetheless, it is important to remind that both actions cannot be based on the same facts. The claim for unfair competition cannot be an excuse for the appellant – and in the context of this study for the owner of a trade mark series – to rebuild a monopoly around the family. While the opposition procedure should highlight a likelihood of confusion, the action in competition law should put into perspective that competitor had suffered a loss of profits and gains due to the exploitation of a third party brand using the same features of an existing trade mark series.

Thus, the legal procedure for unfair competition is autonomous vis-à-vis the opposition and the counterfeiting procedures. Because they are not based on the same argument and on the same legal basis, those actions are complementary and provide a better protection to the owner of trade marks. Even if the court dismisses the opposition claim of the plaintiff e.g. due to a lack of distinctiveness, the defendant could be condemned for taking unfair advantage of the mark of the appellant. This alternative procedure works as a safety belt ensuring a better and a stronger protection to trade marks.

The particularity of the concept of trade mark series is that, for the moment, it mainly concerns – without distinction – famous trade marks and trade marks with reputation. The family is built around a common distinctive element which becomes famous for every single average customer. So, for one product or service sold under a particular trade mark, a certain number of customers will begin a purchase process of the goods or services referring to a precise company and identifiable with the the common distinctive element. Due to this mechanism, the popularity of a trade mark increases exponentially. Nonetheless, this marketing butterfly effect has also perverse consequences. Trade marks with reputation work like a magnet, i.e. they have a strong attractive power. But the brand’s attraction has not exclusively positive consequences. Third parties, essentially competitors, would like to take advantage of this attraction. So, while they are facing a series, they will try to register a trade mark sufficiently close from the series, by incorporating the common distinctive element which constitute the family. Thus, if the competitor’s trade mark applies for goods and services of the same field as the ones of the series, the competitor’s *mala fide* will show that he intends to benefit of a likelihood of confusion to take unfair advantage of the notoriety of the series. In this case, the harmful intention of the competitor is presumed. Consumer will consequently unduly associate the
independent trade mark with the family, thinking that the isolated brand is part of the business ensemble.

Because of his conduct, the *mala fide* owner of the third party trade mark realizes economies of scale by taking unfair advantage of the reputation of the series without making any expense related to research and development or advertising for example.

This free rider comportment has for effects to violate the economic prerogatives of the owner of the family, and also to trouble public order by inducing consumers in error regarding the function of origin of trade marks. Such behaviour could have worst consequences. Indeed, the “infringer” may intend to harm the notoriety of the series by reducing its attractive power, or to destroy the image of the mark. Those impacts could result in an intentional distribution on the market of a poor quality product or service under a trade mark which can be easily associated by customers with the famous family. Marketing and strategic plans like these are hopefully really rare.

The action for parasitism could also be very useful when the third party trade mark is not registered and used in the same speciality as the ones composing the family. In that situation, even if the principle of speciality could not be set aside, the potential infringer could be sentenced on the ground of unfair competition. Such a solution is made to the evidence brought by the owner of the series of the *mala fide* behaviour of his competitor. When this wrong intention is proved, judges are free to condemn or not the competitor for having taken unfair advantage of an existing series. Thus, through this behaviour, the said competitor took unduly profit of the family’s reputation. Here, the key element is the intention to trouble and harm the competitor. The competitor’s bad faith is presumed when the parasitism claim is part of an opposition procedure. But this wrong intention could also be demonstrated in an independent unfair competition procedure. Nonetheless, it should be underlined that the principle of speciality prevails and the courts’ sanctions on this ground are fragile. Courts will be more inclined to set aside the principle of speciality when the claim concerns what could be called a “*super famous*” trade mark, i.e. a mark whose reputation is known by a large panel of average consumers.

The civil action offered to the claimant, and in the case of this study to the owner of the series, allows him to seek the liability of the plaintiff. This liability action find its roots in the article 5(1)(b) of the 2008 directive. Due to the bad faith of the defendant, the civil mechanism of liability is alleged, i.e. it is no longer necessary to demonstrate the

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existence of an infringement, a damage and a link between them. Indeed, the claimant solely needs to bring before court that the use of the infringing trade mark is not justified or that it may harm the former mark or series. The merit of such an action is to take into consideration the economical function of trade mark. A fortiori, it should be noticed that this mechanism of protection encroaches on the steps of civil law.

Due to the closeness between the concept of trade mark series and the principles of famous marks or marks with reputation, the application of the rule concerning such brands may be easily conceivable. Thus, the existence of a likelihood of confusion is not required, the demonstration of a likelihood of association is sufficient, which implies that the average consumer may wrongfully establish a link between a sign and a family of marks without economical connexion to one another.

What the owner of the series must put into perspective is the prejudice that may arise from the likelihood of association regardless of the good or bad faith of the third party. Due to the extensive interpretation of the ECJ decisions, and more particularly of both the L’Oreal v. Bellure\textsuperscript{59} judgement and the opinions of the General Attorney JOCOBS in the Adidas v. Fitnessworld\textsuperscript{60} case, it could be presumed that the main advantage of the sufficiency of a likelihood of association is that it can allow the said owner of the trade mark series to seek compensation alternatively for dilution, tarnishment or unfair advantage taken by a third party brand.

Based on a study of Professor Schechter\textsuperscript{61}, General Attorney JACOBS has brought definitions to those three concepts. Thus, from the points 39 to 43, he stated in his conclusions that:

“As regards detriment to the distinctive character of the 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 is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so.

\textsuperscript{59}CFI, 18\textsuperscript{th} June 2009, L’Oréal SA e.a v. Bellure NV e.a., case C-487/07.

\textsuperscript{60}CFI, 23\textsuperscript{rd} October 2003, Adidas-Salomon AG and Adidas Benelux BV v. Fitnessworld Trading Ltd., case C-408/01 ; Opinion of Advocate General JACOBS delivered 10\textsuperscript{th} July 2003.

As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

Just one of those three types of injury suffices for Article 5(2) of Directive 89/104 to apply.

It follows that an advantage taken by a third party of the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor.

Through these statements, A.G. JACOBS wanted to say that even if, in most cases, the three said actions are combined, it must be reminded that they are independent from each other. The demonstration by the owner of the series of a breach of his trade marks rights based on one of these concepts solely is sufficient for him to seek compensation.

The definitions generated by A.G. JACOBS are followed by a small “methodology” for judges of the ECJ. In that “how to proceed” description, A.G. JACOBS highlighted the points on which it must be focused on “In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark’s reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned. As regards the strength of the reputation and the degree of distinctive character of the mark, the Court has already held that, the stronger that mark’s distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. It is also
clear from the case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them”.

What is important to bear in mind after the demonstration of A.G. JACOBS is that the above statements which concern famous trade marks or trade marks with reputation seem to apply de facto to the concept of trade mark series. Indeed, due to the induced requirement of notoriety of the said concept and its direct consequence on the series’ strength, the flexible reasoning of the Court of Justice fits the mechanism of global protection of multiple brands sharing a common distinctive element. The confrontation of the most famous trade mark families – Apple and Mac Donald – to the abovementioned principles helps the demonstration.

The companies’ trade marks mentioned above are covered by their worldwide notoriety. Thus, any competitor who intends to register a trade mark sharing common visual, phonetic or conceptual features with the trade marks composing a family may be almost automatically exposed to an annulment of his trade mark by a judge seized of an opposition claim completed by a declaration of unfair competition. The judge might be influenced by the strength of Apple or Mac Donald’s trade mark series and will come to a solution in detriment of smaller competitors.

In some points, by granting such an extensive protection, judges encourage the monopoly or the oligopoly of certain companies which detain an “exclusive right” on a word, a sound, a prefix or suffix, a graphical or visual element shared by all the company’s brands and which constitute the cement of the series.

The common distinctive element could become a product on itself because it is easily conceivable for multinational companies to grant licence on this particular element and so to take benefits of such a commercial use. The hypothesis of a tolerance on the use of this denominator could also be conceived but the situation might be only hypothetical due to the research of profits and gains by any company, no matter its size.

In merger of the civil protection, it is necessary to mention a special mechanism provided by the article 5 §5 of the 2008 directive. Due to this provision, the owner of a family with reputation is able to introduce a restriction on the use of his trade marks – and by extension on the use of the common distinctive element in the case of a series – while the third party’s sign is not used as a trade mark, but the “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”. This transposition of this provision was not mandatory and only few Member States introduced it in their legislation.
At the dawn of the *Smart Notebook* and *CitiGate* decisions, companies show more and more attention to the concept of trade mark series. They do not hesitate anymore to adopt this notion which efficiency and benefits were demonstrated notably in India and in the United States. The lack of provisions within UE legal instruments is progressively filled by case-law on this topic.

Though this study, it may be observed that the concept of trade mark family is not a pure legal concept but interests and use economic, business, strategy and sociological notions, ideas and concepts. Trade mark series are consequently at the crossroad of all the activities of a company.

This reflexion on the concept, highlights the fact that the development of a series is a very long and expensive process involving a strong presence and activity on the market, facing consumers. The link between all the trade marks of a series is not always obvious, especially when they did not appear on the market at the same time. The development of a legal instrument would have for consequences to legitimize this practice, and to allow owners of trade mark families to capitalize on this mechanism.

Moreover, the strength of the concept is based on a flooding of the market by a variety of brands all related by a common distinctive element. The utility and relevance of the concept will grow with the introduction by the ICANN of Generic Top-Level Domain Names. By this new procedure, multinational companies will be able to register their trade marks as an domain names extension. Due to the cost of this registration ($185,000), this new option is almost exclusively reserved to worldwide companies.

Thus, such a registration procedure raises the question of the possible expansion of scope of the trade mark series' concept because of the conquest of the internet by the said concept. Indeed, by this opening, the question should be asked of whether or not domain names composed of an extension formed by a trade mark should enter into account in the formation of the trade mark series.
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- CFI, 18th December 2008, Torres v. OHIM, case T-287/06.
- ECJ, 18th June 2009, L’Oréal SA, Lancôme parfums et beauté & Cie SNC and Laboratoire Garnier & Cie v Bellure NV, Malaika Investments Ltd and Starion International Ltd., case C-487/07.
- ECJ, 16th June 2011, Union Investment Privatfonds GmbH v. OHMI, case C-317/10.
- CFI, IG Communications v. OHIM, Case T-301/09, case in progress.
- CFI, Smart Technologies v. OHIM, Case T-648/11, case in progress.

(ii) National decisions

French decisions


United States decisions

V. Laws

(i) European Provisions

(ii) National Provisions
- French Code of Intellectual Property
- French Civil Code
- French Code de Commerce
- UK Trade Mark Act 1994
- Indian Trademark Act 1999

VI. Electronic Data-bases
- Dalloz (French)
- Darts Ip (French)
- Le Doctrinal (French)
- Lextenso (French)
- Hipe Database (French)
- Jurisclasseur Database (French)
- Lamyline (French)
- Westlaw Database (Worldwide)
VII. Websites

(i) Institutional websites

http://www.wipo.int/portal/index.html.en
http://eur-lex.europa.eu/
http://curia.eu.int/
http://www.legifrance.gouv.fr/
http://www.legislation.gov.uk/ukpga
http://www.ipo.gov.uk

(ii) Frequently used websites

http://www.pmdm.fr/wp/
http://ipkitten.blogspot.fr/
http://morethanbranding.com/

(iii) Other websites (the accessibility of all the websites mentioned were verified the 4th September 2012)

www.apram.eu/docs/FLASHAPRAM165KINDER.pdf
title : FLASH APRAM CJUE, 24 mars 2011 – Ferrero SpA / OHMI
author : J. J. EVRARD
first release : 1st April 2011

http://abcnews.go.com/Business/story?id=3521002&page=1#.T9O3L78iBJM
title : Happy Birthday Big Mac
author : E. FRIEDMAN
first release : 24th August 2007

http://www.lefigaro.fr/economie/20070824.WWW000000695_le_big_mac_fete_ses_ans_de_mondialisation.html
title : Le Big Mac fête ses 40 ans de mondialisation
author : Unknown
first release : Unknown

http://www.lejdd.fr/Economie/Actualite/McDo-l-antidepresseur-80660/
title : McDo, l'antidépresseur?
author : A. BONDAIN
first release : 28th January 2009

title : 2012 BrandZ Top 100
author : Unknown
first release : Unknown

title : L'Illusion de la concurrence ? Dix groupes contrôlent l'essentiel de ce que vous achetez
author : P. HUBERT
first release : 26th May 2012
http://www.businessinsider.com/these-10-corporations-control-almost-everything-you-buy-2012-4
title: These 10 Corporations Control Almost Everything You Buy
author: A. LUTZ
first release: 25th April 2012

title: Series Trademark Applications
author: Unknown
first release: Friday, 4 February 2011

title: ECJ endorses the concept of trademark series … and rules on the prevalence of European provisions relating to the use requirement.
author: M. VON EINGESTELLT
first release: 20th September 2007

thesis: Series trade marks a consideration
author: T. MOUNT
first release: 11 October 2009

thesis: TPICE, affaire Bainbridge ou les risques et avantages des oppositions fondées sur une famille de marque
author: Fanny Véron
first release: 30th May 2006

http://droit-entreprises.lemondedudroit.fr/droit-a-entreprises/propriete-intellectuelle/71373-decheance-de-marque-usage-serieux-dune-famille-de-marques.html
thesis: Déchéance de marque : usage sérieux d’une famille de marques
author: LEGALNEWS
first release: 21st January 2011

title: L’appréciation de la similitude des signes en droit des marques
author: C. FAVREL & N. BONDOIS
first release: 18th April 2011

http://blog.dreyfus.fr/2010/03/le-glas-des-depots-de-variantes-a-t-il-sonne/
title: Le glas des dépôts de variantes a-t-il sonné ?
author: Lucile Verdun
first release: 11 March 2011

thesis: Changes to the UK Trade Mark rules and revised OHIM fees
author: J. JONES
first release: Unknown
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