

Protection of unregistered trademarks at European Union level

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Impact Paragraph

The purpose of this impact paragraph, according to the Explanatory Notes to the Maastricht University Doctoral Regulations (Annex 4) which entered into force on 1 February 2023 is to describe, in words and terms that someone not specialised in the field of study can understand, the scholarly impact of the results of the research. The scholarly impact is defined as “the short- and long-term contribution of the results of scholarly research to a shift in understanding and to advance science, method, theory and application within and across disciplines”. Where the research also has a social impact, defined as “the short- and long-term contribution of the results of scholarly research to changes in, or development of, societal sectors and to societal challenges”, it should also be described.

To make this assessment, the Regulations provide four questions as a guidance. Below I provide my response to each of them in order to outline the overall impact of this research.

1. (Research) What is the main objective of the research described in the thesis and what are the most important results and conclusions?

The main objective of the research is to analyse the current level of protection of unregistered trademarks in the European Union, and to examine whether a stronger harmonisation in connection to their protection could be achieved.

The research found that protection of unregistered trademarks, *per se*, is not harmonised at European Union level. Since their protection is not prohibited at national level either, the EU legal instruments only regulate their possible effect on registered rights. The research also shows that, historically, the protection of registered trademarks outweighed unregistered trademarks in importance because their increasing economic value and the development of cross-border commerce required means of protection that offer more legal certainty.

The research also revealed that in some European Union jurisdictions unregistered trademarks enjoy a higher level of protection. The experience of the Italian, Swedish, Danish and Finnish trademark protection systems show that the importance of unregistered trademarks should not be diminished, and they are still important in safeguarding the interests of trademark owners. For example, protection of unregistered trademarks could come to the aid of trademark owners that, for different reasons, delay to undergo any registration proceedings. They may also be useful to protect local businesses or different sub-brands.

This being said, when it comes to the protection of unregistered trademarks among the Member States of the European Union, different levels of protection among them could create unpredictability in the internal market. For this reason, a certain level of harmonised protection could be envisaged and could be taken into consideration by a future directive aiming to harmonise the trademark legislation among Member States.

With this in mind, I propose in this thesis that unregistered trademarks be harmonised at European Union level based on use standards that already have a precedent. Thus, a possible solution that I propose is imposing the “*European standard*” of trademark use among the Member States for the purpose of the opposability of unregistered trademarks, which is that of a use of “*more than mere local significance*”. This way, the Member States could benefit from European practice and set it as a benchmark for their own potential local practice. Additionally, the Italian trademark protection system, which allows owner of unregistered trademarks that are locally known to continue their use, is can also be taken into consideration for a possible harmonisation.

2. (Relevance) What is the (potential) contribution of the results from this research to scholarship, and, if applicable, to social sectors and social challenges?

The potential contribution of this research to scholarship consists of its findings regarding the experience of jurisdictions where unregistered trademarks enjoy a higher level of protection, and the possibility to use this experience in shaping a potential harmonisation of the protection of unregistered trademarks at European Union level.

The research reveals that although the importance of registered trademarks is undeniable, protection of unregistered trademarks is still present to various degrees in European Union Member States and a possible harmonisation could only strengthen the predictability of the level of protection on the internal market. Therefore, a potential contribution of this research is to bring additional arguments supporting such harmonisation in the perspective of a future reform of the European Union trademark protection system.

That said, the research may also set ground for further research in the field and more in-depth analysis that exceed the limitations of a doctoral thesis. For example, the findings of this research could bring the opportunity of a more detailed future analysis, made by a team of researchers, of the trademark protection system of each European Union jurisdiction that could support future efforts in shaping a potential proposal for harmonisation.

Regarding the contribution of the results of this research to social sectors and social challenges, the research is related to the protection of trademarks, which impacts directly the economic behaviour of market participants. As the research has shown, the value of trademarks is significant to the overall economic value of a business. Therefore, obtaining, preserving and enforcing trademark rights is almost indispensable to a business. In order to be successful in this endeavour, trademark owners should benefit from a certain level of predictability in order to shape their protection strategy. Thus, one of the potential contributions of this research is proposing a manner in which a “grey” area of trademark protection, of which trademark owners are not fully aware, could become clearer and even present opportunities, by fully understanding if protection of unregistered trademarks is suitable for their business.

3. (Target group) To whom are the research results interesting and/or relevant? And why?

One of the target groups of the results of this research consists of the members of the academic community who focus on intellectual property law in general, and industrial property of trademark protection law in particular. As mentioned, this thesis could represent a basis for much more research in connection with the protection of unregistered trademarks.

This research is also addressed to trademark attorneys who may find in this research relevant doctrine and case law that could assist them in their day-to-day work. More specifically, Chapter 5 offers an in-depth analysis of the applicability of Article 8(4) of the EU Trademark Regulation, which could offer guidance in assessing possible trademark conflicts.

The results of the research may also present interest for associations of trademark practitioners, such as the International Trademark Association (INTA) and the European Communities Trademark Association (ECTA), which lobby for amendments and reforms of trademark regulations around the world or strictly at European Union level.

4. (Activity) In what way can these target groups be involved in and informed about the research results, so that the knowledge gained can be used in the future?

The main means by which the results of this research can be made available to the target groups are its publication, subsequent academic writings that develop the findings of the research, and presentations in regional and international conferences of either an academic or a professional nature.