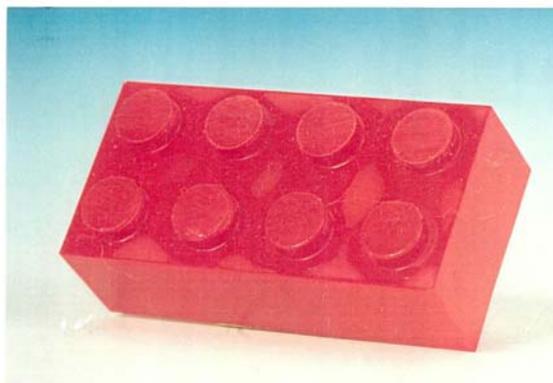
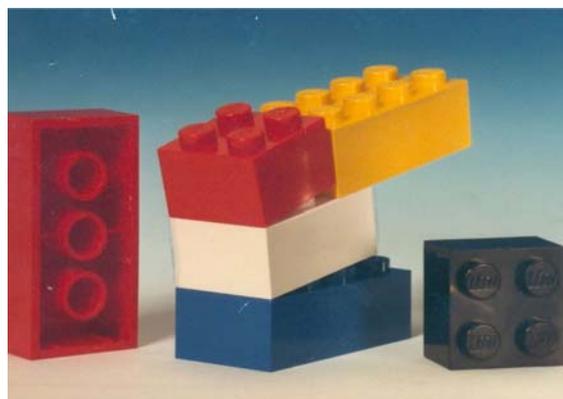
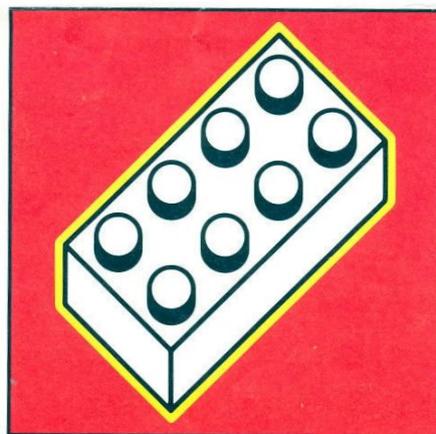


**Decision No. 15920/2005 formally issued on 19 May 2006**

**Case No. 21998/2001**

1. Reversal/Recourse
2. National procedures

PRECIS: The Administrative Court of First Instance of Athens has reversed a Trademark Committee decision and revoked the cancellation of the trademark registrations of several brick elements (device only marks) in the name of the LEGO Group based in Denmark. The cancellation petitions were filed by LEGO's great Canadian rival, RITVIK, against the LEGO trademarks solely consisting of the devices depicted in the following photos:



The court held that the marks in question, which did not contain any word elements whatsoever, are neither functional, nor common and have retained their distinguishing ability throughout their longstanding use in the Greek market.

### **LEGO bricks' cancellation revoked.**

The Administrative Court of First Instance of Athens revoked the Trademark Committee's decision to cancel the above trademark registrations. The related cancellation petitions were filed by Lego's Canadian rival, Ritvik, on several grounds, including non-use, and also non-admissibility grounds (which are ordinarily used for Oppositions but may also be included in certain cancellation petitions), such as lack of distinguishing ability, purely functional shape mandated by the nature of the product itself, commonly used design, etc.

Ritvik also made an unfair monopoly claim for the above reasons, asserting that the protection of such trademarks was sought by Lego in bad faith and only for the purpose of enjoying an unfair monopoly of what were alleged to be commonly used bricks, while Lego allegedly knew that said bricks were not subject to protection due to their lack of distinguishing character.

The Court dismissed all of RITVIK's non-use claims and allegations against LEGO and went into great detail in examining the merits of the case in question.

In doing so, the Court established some very useful guidelines in determining similar trademark disputes:

Firstly, by examining the spirit of the law and applying the relevant Trademark Law provisions to the facts of the dispute, it held that, when determining whether a trademark is filed in bad faith or not, what matters is to take into consideration the circumstances and applicable law in force at the time a trademark application is actually filed, and *not* the circumstances and applicable law in force at the time a subsequent cancellation petition is filed.

In light of the above, it considered that, in 1984, when the relevant trademark applications were filed, there was no question as to the admissibility of the trademark devices in question, as there was no dispute over the originality or distinctiveness thereof. As such,

RITVIK's allegation that the particular trademarks were filed in bad faith by LEGO, (by alleging that LEGO knew that said trademarks were inadmissible but nonetheless filed them) was deemed unsubstantiated based on the facts. This is because no oppositions or cancellations were ever filed against the particular trademarks by RITVIK or any other party with legitimate interest.

Interestingly enough, the Court also drew a distinction between on the one hand a bad-faith filing, which relates to the applicant's bad faith per se, and can be substantiated, inter alia, by proving that the applicant was aware of the fact that the trademark filed at the time would render him an unfair advantage, and on the other hand a filing which contravenes the principle of good faith, for the establishment of which no bad faith on the part of the applicant is required.

In fact, by reviewing several other related litigations initiated by LEGO the Court found that in reality it is LEGO's competitors that act in bad faith by continuously trying to copy the LEGO trademarks and LEGO is by no means trying to engage in any unfair monopoly, or act in bad faith, but rather its only aim is to protect its lawful rights.

The Court also dismissed the argument put forward by RITVIK that LEGO uses its above trademark devices in its packaging boxes and brochures along with the names LEGO and LEGO SYSTEM, and that this allegedly proved LEGO's own conviction that its trademark devices were unable to distinguish the LEGO products alone, without the presence of the LEGO name. Instead, the Court found that the particular manner of using the LEGO trademarks exhibits prudence on the part of LEGO, whose intention is to avoid any risk of confusion between its products and the copy products of its competitors, which have flooded the market and which are, as deemed appropriate, the subject-matter of relevant infringement litigations.

Lastly, the bad faith argument allegedly proven by the fact that LEGO filed the particular trademark applications six years after the lapse of its relevant patents was dismissed as irrelevant by the Court as the nature of a trademark right is sufficiently distinct to that of a patent right.

*Eleni Lappa*

*Dr Helen Papaconstantinou, John Filias & Associates, Athens*