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Report Q168

in the name of the Argentinean Group
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Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 Acquiring a mark (if rights may be acquired by use according to national law)

No prior use of a mark "as a mark" is required by national law in order to acquire rights on the mark.

Under Argentine trademark law, property and exclusive use rights on a trademark are acquired through registration.

However, local courts have acknowledged rights on unregistered marks under certain conditions, such as having used the mark for a legitimate business for a reasonable time having thus created a clientele for such mark. Courts have even recently granted "injunctions" in defence of intensely used -though unregistered- trademarks.

1.2 Maintaining of a trademark registration (e.g. against an application for cancellation on grounds of non-use)

Use of a mark "as a mark" is required for maintaining a trademark registration.

As per national trademark law, trademarks may be renewed if used within the last five years prior to expiration either "in the marketing of a product, the rendering of a service or as part of the designation of an activity or business name".

At the same time, trademarks are vulnerable to cancellation actions on account of non-use, if unused within the last five years prior to the bringing of the cancellation action.

Published authors and Court precedents indicate that use should be serious, significant, and unequivocal. Use by an unauthorized party would normally not prevent cancellation for non use.

It should be noted that the criteria by which use "as a Mark" is accepted is flexible, as in re: "Baker Cummings Dermatologicals, Inc. vs. Laboratorios Felipe Bajer S.A." Division 2 of the Federal Court of Appeals (La Ley, 1995-D, page 618), where the Court ruled: *"In order to determine if a trademark was used, a flexible criteria should be applied, comprehensive of any act which has as a consequence that the distinctive sign appears in the market place and considering that the statute makes the concept of use and marketing as equivalents. The latter is meant to be understood with an extensive criteria, including commercial exchange acts and other applications of the product". In this precedent, Argentine Courts have validated preliminary activities as a valid use to avoid the cancellation of a mark ruling that "... the launching of a new product and a new trademark involve preliminary activities [i.e. clearance trademark searches, printing logos, designing packaging, catalogues] and if those activities are not accepted as a trademark use, the analysis as to whether they may be considered trademark use, would be extremely rigorous....In that connection the.... recognized effect of those preliminary acts before the marketing of products, of exhibitions prior to launching, advertising, distribution of free samples to test the product, rent or....,*

summing up the term "use" includes all manners by which a mark is made perceptible in the market..."

1.3 *Establishing infringement.*

In principle, use of a mark "as a mark" by a third party without consent of its legitimate owner constitutes trademark infringement. Argentine Trademark Law N° 22.362 uses broad infringement criteria. Article 31 subparagraph c) states that "use of a counterfeit or fraudulently imitated registered trademark or trade name without the owners consent" would amount to infringement.

On the basis of this provision, there may be instances where use of a mark not necessarily "as a Mark" would also constitute trademark infringement.

2. **Is there any definition of what is the use "as a mark" either in statute or case law?**

There is no specific definition of what is use "as a mark" in Argentine statutes. However, Art. 1 of Argentine trademark law, which gives examples of what may be registered as a trademark, refers to signs to "distinguish products and services" and which are capable of being "distinctive".

Case law has frequently defined a trademark as a distinctive sign used for identifying a product or service, distinguishing the same from others, as well as indicating source or origin of such good/service.

The law refers to use "in the marketing of a product, the rendering of a service or as part of the designation of an activity". In the same fashion Article 26 allows use of the mark as a trade name in order to defend a registration against a cancellation action.

3. **Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?**

There are some differences in assessing what use qualifies for acquisition, maintenance or infringement of rights. However, differences may lie not so much in the definition of the concept of "use as a mark" but on what uses not "as a mark" meet the standards for acquisition, maintenance or infringement of rights, respectively.

As stated in point 1.1. above, in principle, use of a mark "as a mark" is not necessary for the acquisition of rights thereon, which are acquired through registration. However, case law has frequently acknowledged rights to users of unregistered trademarks under certain conditions, as mentioned in point 1.1. above (use should be serious, significant, and unequivocal), which do require use of a mark "as a mark".

The maintenance requirement can be met with at least one further use (tradenname) which would not be considered to be "as a Mark". Courts further note that the trademark owner should have a "bona fide" intention of using the mark, in order to meet the user requirement. Courts have applied a flexible criteria as to what "sufficient use" of a mark is, when deciding on cancellation actions based on non-use or upon examining maintenance requirement of renewal applications. The Argentine Group believes that legitimate use on the Internet of a trademark - in relation to goods and services - in Argentina will be considered as "sufficient" use to maintain a trademark registration.

As to infringements, unauthorized uses of a mark on the Internet either "as a mark", as a domain name or otherwise, would be considered as infringing trademark rights and may be enjoined under trademark law, legal provisions on unfair competition or providing for the nullity of illicit or immoral acts. Courts have ruled that use as tradenames, copyrights, or advertising may constitute infringement.

Courts assessed that a registration of a domain name that included (apart from the words *www* and *.com.ar*) a third party mark, would be sufficient to find trademark infringement and grant injunctions.

In re "Heladerías Freddo S.A. vs. Spot Network", the Federal Judge of a Court of First instance ruled that *"...given that the plaintiff proved credible rights (trademark registration) to apply for precautionary measures, the requested measure should be granted in order to stop the defendant's unlawful use of the mark through Internet, as the domain name could only be used by the owner of intellectual property rights or by an authorized third party."*

There are several court precedents that upheld Heladerías Freddo's decision. The 2nd Division of the Federal Court of Appeals in re "Pugliese Francisco, Nicolas c/ Perez Carlos Enrique" ruled that *"...independently as to whether or not domain names can be considered equivalent to trademarks, the essence of the claim is the protection of a trademark registration which was being used by someone who is not its owner... [if the injunctive relief were not accepted], ...the plaintiff would be refrained from using its trademark through alternative means of selling its products."*

4. Is any of the following considered to be use "as a mark"

If necessary, please differentiate between acquisition, maintenance and infringement of marks

4.1 Use on the internet, as a metatag, in linking or framing

Such uses do not constitute use "as a mark", since in the case of metatags, the same are not visible to the public, and in the case of linking or framing they are used as a means to connect to other web sites or contents thereof.

Regarding maintenance the Argentine group believes that use as a metatag is not sufficient. Regarding linking and framing under certain circumstances they may be regarded as sufficient if such use is considered to be in the territory of Argentina (which presents jurisdictional problems not discussed in this question). An example could be that they qualify as good faith preparatory acts leading to subsequent use "as a mark"

Regarding infringement it should be noted that even if no court decisions have been passed in connection with conflicts between holders of trademarks and third parties making use thereof through metatags, deep linking or framing, in the opinion of the Argentine Group, cease of such uses could be successfully sought before the courts in defence of trademark rights, either alleging use of the mark without having owner's consent, dilution thereof, unfair competition, or trying to prevent such third parties from obtaining an unfair advantage from such use.

Based on court precedents regarding use of a mark in the Internet as a domain name as a comparable situation it is interesting to note that injunctions have been consistently granted by our courts in defence of trademarks registered as domain names by third parties having no legitimate interest in such names. Courts in these cases have ordered the temporary cease of use of the domain name by the registrant (alleged infringer), and the simultaneous temporary registration of such domain name and authorization for use thereof by plaintiff. In general such orders have been supported on rules of the Civil Code providing for the nullity of legal acts made to the prejudice of the rights of third parties, or prohibiting the abusive exercise of rights.

In re "Industrias Spar S.A. c. Faber SACEI", decision dated May 10, 2001, the First Instance Judge ruled that *"the trademark FABER applied to the Internet address and to the e-mail address would not be considered a trademark use"*. On appeal, The 1st Division of the Federal Court of Appeals did not give an opinion on the use of a trademark on the domain but drew a distinction between the use of the trademark on the domain name and the use of the trademark on the website. The court did not consider the last issue since the plaintiff submitted a copy without notarization of the use of the mark on the defendant's website.

On the other hand in re "Monsanto Company", decision of May 7, 2001, the 2nd Division of the Federal Court of Appeals ruled that *"the exclusive trademark rights granted by art. 4 of the Trademark Law N° 22.362 comprise the use of the trademark on the Internet."*

In the opinion of the Argentine group it is likely that most or all of such uses will be considered to infringe a trademark, even if not used "as a Mark" in the traditional sense, based on the broad criteria indicated under point 1.3. However, unless specific contacts with our territory occur and use is clearly "bona fide" such use may not be sufficient to maintain a registration.

4.2 *Use by fan clubs or supporters*

The use of a mark only as the "name" of a fan club -not in relation to goods and services- will, in the opinion of the Argentine Group, not be considered as use "as a mark" for the purpose of acquiring or maintaining trademark rights.

On the other hand, use of a mark by a fan club would not constitute infringement unless it is undertaken as a commercial activity which unfairly profits from the well known mark.

4.3 *Parody*

It is difficult to envision how someone may attempt to use a mark in parody for acquiring or maintaining rights over such trademarks. Use of a mark in parody will not, in the opinion of the Argentine group be regarded as sufficient to acquire or maintain trademark rights.

Use of a mark in a parody, whilst not constituting use "as a mark" could be considered as infringing owner's rights and thus would be objectionable, either as an unauthorized use of trademark or as diluting its distinctive character, or as an act of unfair competition or even as the obtention of an unfair advantage from the prestige of a third party's well-known or reputed trademark. However, a recent court of appeals decision on injunctive relief in re: *Japan Tobacco Inc. y otro c. Massalin Particulares* dated June 14, 2001 ruled that an advertising campaign by defendant using the plaintiff's mark as a parody of the plaintiff's use of English language in its advertising campaign should be allowed. The Court reasoned that the use at issue did not tarnish the image of the mark since it was humorous and did not adversely comment on the product or the origin thereof. The court added that the parody seemed truthful and not clearly mordant. The Argentine group believes that the question is not sufficiently settled but it seems that within certain limits parody would be allowed.

4.4 *Comparative advertising*

Use of a mark in comparative advertising is not considered as use "as a trademark".

It is difficult to envision how someone may attempt to use a mark in comparative advertising for acquiring or maintaining rights over such trademarks. The Argentine group believes such use would not be sufficient to acquire or maintain trademark rights.

Regarding infringement, it should be noted that the initial position of the courts of considering use of a mark in comparative advertising as unauthorized use of a trademark (thus constituting infringement of trademark rights), seems to be gradually changing to consider that the reference to, or quotation of the mark of a third party does not always constitute trademark infringement, and that provided that it is acknowledged that the such mark belongs to the other party, and that no disparaging or discrediting effect is sought, the use may be admitted. Of course, truthfulness and accurateness as to facts alleged when comparing trademarks is required. Any falsity renders use of the mark as unlawful.

5. **If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trademark or other laws (e.g. unfair competition and trade practice laws).**

Unconventional uses of a trademark are objectionable under national law, either under trademark law or under other legal provisions referred to unfair competition or providing for the nullity of unlawful acts - i.e. those detrimental to the rights of third parties.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

Use "as a mark" in the traditional sense is not required to establish infringement. Likewise well-known, famous, notorious or reputed trademarks used on dissimilar goods and services are protected in our country. Courts have consistently protected notorious trademarks (such as Lucky Strike, Christian Dior, Snoopy, among many others) by declaring the nullity of local registrations or applications filed by third parties even when no registration for the same class or the same goods or services was held by the legitimate owner of the famous trademark, or by enjoining use of such mark on dissimilar goods or services with the purpose of preventing likelihood of confusion as to the origin for consumers and denying an undue profit or unfair advantage for the local applicant or registrant.

Summary

There is no requisite of use in order to acquire trademarks in Argentina. Regarding infringement, although the law on the concept of use "as a mark" is not sufficiently explicit, it can be argued, based on precedent, that generally there is no limitation on how a mark should be used in order for such use to be considered infringement of a prior right. As to maintenance, it is likely that standards of use may be somewhat more stringent requiring 'bona fide' use.

Résumé

Il n'existe pas de conditions d'usage pour l'achat des marques en Argentine. En ce qui concerne des infractions, bien que la loi ne soit pas suffisamment explicite sur la notion d'usage comme marque, on pourrait dire que, sur la base des précédents, en général, il n'est pas des limitations sur la forme d'usage d'une marque pour considérer tel usage comme infraction d'un droit préalable. En ce qui concerne la conservation des marques, il est probable que les conditions standard d'usage sont un peu plus strict et que la bonne foi dans l'usage est aussi demandé.

Zusammenfassung

Es gibt keine besonderen Benutzungsbedingungen für den Erwerb von Warenzeichen in Argentinien. Hinsichtlich der Verletzung, obwohl der Begriff von Benutzung "wie eine Marke" im Gesetz nicht deutlich genug ist, könnte behauptet werden, gestützt auf Präzedenzfälle, dass im allgemeinen keine Beschränkung darauf besteht, wie eine Marke benutzt werden sollte, um diese Benutzung als Verletzung eines Vorrechtes zu betrachten. Hinsichtlich der Erhaltung der Marke ist es wohl möglich, dass Standardbedingungen über diese Benutzung ein wenig strenger sein könnten, wenn die "bona fide"-Klausel für die Markenbenutzung verwendet wird.

Report Q168

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Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights"

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 *Acquiring a mark (if rights may be acquired by use according to commercial law).*

The Trade Marks Act 1995 (Act) governs the registration and enforcement of trade marks in Australia.

It is assumed that "acquiring" in this question is a reference to acquiring registration of the mark.

The Act defines a trade mark as

"a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person."

Under Section 27 of the Act, as far as relevant for present purposes, a person may apply for the registration of a "trade mark" (as defined) in respect of goods and/or services if:

- a) the person claims to be the owner; and
- b) the person is using or intends to use the trade mark in relation to the goods and/or services.

Accordingly, there must be existing use of the mark or an intention to use the mark at the date of the application.

The Act further defines "use of a trade mark in relation to goods" and "use of a trade mark in relation to services" respectively as use of the trade mark upon or in physical or other relation to the goods or use of the trade mark in physical or other relation to the services.

In relation to use necessary to establish proprietorship the High Court of Australia¹ has held that the prior use required to establish the status of "proprietor of the mark" is public use in Australia of the mark as a trade mark, that is to say, a use of the mark in relation to goods for the purposes and so as to indicate a connection in the course of trade between the goods in respect of which the trade mark is used and that person".

Slight use which falls short of establishing a local reputation (in the case of a foreign applicant) will suffice.

¹ Phillip Morris –v- Morgate Tobacco 3 IPR 545

It would therefore appear from the foregoing and the definition of trade mark in the Act that acquiring the right to register a mark does involve existing use of a mark as a mark or intention to use the mark as a mark.

1.2 *Maintaining of a trade mark registration (for example against an application for cancellation on the grounds of non-use)*

Maintenance of a trade mark is dependent upon use. Under the Act there are provisions for the removal of a trade mark from the Register for non-use.

Faced with a non-use application the onus rests upon the registered proprietor of the mark to establish there has been use of the mark in the period ending 1 month before the filing of the non-use application.

The non-use application may be made on the basis that during the three years ending on the day which is one month before the date of the application there has been no use by the registered proprietor.

Secondly, a non-use application may be made on the basis that at the date of the filing of the trade mark the applicant for registration had no bona fide intention to use the mark and up to the period expiring one month before the date of the filing of the non-use application there had been no use of the trade mark.

In order to maintain the registration against a non-use application and rebut the application for removal of the mark the proprietor or applicant as the case may be bears the onus of establishing that there has been use as a "trade mark" as defined in the Act (see above) so that the mark has been used to distinguish the goods or services dealt with in the course of trade by the proprietor or applicant from goods or services dealt with by others.

1.3 *Establishing infringement*

The Act provides that a person infringes a registered trade mark if the person uses as a trade mark a sign that is substantially identical with or deceptively similar to the registered trade mark in relation to the subject goods or services.

The expression "uses as a trade mark" is thus embodied in the infringement section.

It is also embodied in the extended infringement provisions, (introduced in order to comply with the requirements of the TRIPS agreement), where the trade mark is used in relation to goods of the same description as or closely related services to the subject goods or services.

The words are also contained in the "well known marks" infringement provision.

It has been held that trade mark infringement consists in using the mark as indicating origin, again, having regard to the definition of trade mark contained in the Act. It has also been held that to determine whether the infringer's use of a mark was use as a trade mark, as distinct from mere descriptive use, the affects on potential buyers is to be considered. Thus, the Federal Court has held in the Kettle Chip case² that the word "kettle" (a registered mark of Kettle Chip Co) used on the packaging of a Pepsi Co product could be seen by consumers as being descriptive of the process by which thin potato chips achieved the qualities of crunchiness and strong flavouring and that the word "kettle" would be taken to mean the chips had been cooked in a vessel in which the liquid is boiled.

Accordingly, the position under the Act would seem to be that in the case of application, maintenance and infringement of a mark there must be use of the mark as a mark within the definition of "trade mark" as used in the Act.

² PepsiCo Australia Pty Limited –v- Kettle Chip Co Pty Limited (1996) 33 IPR 161

2. Is there any definition of what is use "as a mark" either in statute or case law?

There is no definition in the Act of what is use "as a mark".

However, the Federal Court of Australia has held that the use of a word constituting a trade mark will not amount to an infringement unless the word is use *as a trade mark*.

In a recent decision³ the Federal Court remarked that use as a trade mark involved the notion of a badge of origin and that this appeared from the definition in Section 17 of the Act.

In that case the court refused to find infringement of the trade mark "CHILL OUT" registered in class 25 for goods including t-shirts where the words "CHILL OUT" were embossed on a t-shirt of the alleged infringer.

The court found that these words were not used as a badge of the trade origin of the t-shirts or of their provenance; they were a mere exhortation to the reader to relax.

The court was assisted by dictionary definitions indicating that "chill out" was a colloquial usage meaning "relax, clam down; become less tense".

In other cases where the impugned mark was not of a descriptive character the court has examined the purpose and nature of the use and particularly the context.

Thus in the case of a television advertisement the court considered whether a trade mark purpose would have appeared to the television viewer.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

It would not appear that there is any difference.

4. Is any of the following considered to be use "as a mark"?

4.1 Use on the internet as a metatag, in linking or framing.

Metatags

Metatags are words hidden in the code of a website that act as a reference source to identify the content of that website for Internet search engines. It has become common for competitors to embed a rival company's trade mark as metatags. When a trade mark is used as a metatag, it issued in a way that is usually invisible to the human eye reading a web page but is visible to a search engine searching for that web page. In order to 'see' the metatag in most browsers one would select "view source" under menu.

Where the metatags are descriptive of the site's content, their use is not controversial. However, where traders embed competitor's and other well-known trade marks into the source code of their websites, without the consent of the owners of the marks, the question of trade mark infringement arises. The issue is whether or not the use of a trade mark as a metatag is the use of that trade mark "as a trade mark".

This issue has yet to be addressed by Australian courts but there are several US and UK cases in which the issue has been considered and which are likely to be persuasive in any Australian proceedings.

In *Playboy Enterprises-Inc –v- Calvin Designer Label et al⁴*, a federal judge in Virginia found Hong King based companies AsiaFocus International and Internet Promotions liable for trade mark infringement after they embedded the terms "Playboy" and "Playmate" within the codes of their websites. Playboy sued on a number of grounds, including that the use of the trade marks PLAYBOY and PLAYMATE as metatags constituted trade mark infringe-

³ Top Heavy –v- Killin 34 IPR 282

⁴ Civ No. C-97-3204 (NDCal, Sept 8, 1997)

ment and unfair competition, a false designation of origin and false representation. The Plaintiff also claimed that the defendant's use of metatags diluted its trade marks. The Plaintiff succeeded and was awarded \$3million. This case suggests that a metatag hidden within a web page can infringe a registered trade mark even though the mark is not visible to viewers of the page.

More recently, in *Brookfield Communications Inc –v- West Coast Entertainment Corp*⁵. The Ninth Circuit noted that "the few courts to consider whether the use of another's trade mark in one's metatags constitutes trade mark infringement have ruled in the affirmative". The court held that by including the word "MovieBuff" in the metatag to its website, the defendant had infringed the plaintiff's registered trade mark "MovieBuff".

In England the first metatag case was heard in May this year in *Road Tech Computer Systems Limited –v- Mandata (Management and Data Services) Limited*⁶. The decision is not particularly useful as a precedent in that the judgement was on an interlocutory application before a Master of the High Court. The Master held that there could be "no doubt" that the use made by the Defendant of the Claimant's trade mark (as a metatag) constituted infringement he also went on to hold that in the absence of any positive defence being advanced Judgement should follow. Nevertheless, the decision is one which is likely to be followed and does constitute therefore some persuasive authority on the point.

Analysis

Although trade mark legislation in the US and UK differs in a number of aspects from the *Trade Marks Act 1995*, it is considered possible that use of metatags may be an infringing act under the Australian legislation.

If a metatag operates to indicate the trade source or origin of goods or services rather than serving merely as a description then such use will probably be considered to be "use as a trade mark". The application of Australian principles would probably result in the same decisions in the *Brookfield, Playboy and Road Tech* cases mentioned above. In those cases, it has been argued by some that the words were being used to indicate, or draw a hit from, the reputation of the plaintiff, i.e. the origin of the name.⁷

However, without a clear decision from the Australian Courts this issue has yet to be settled. On the one hand it would no doubt be argued it is conceptionally dubious to contend that an invisibly used trade mark can constitute a "badge of origin". It would be said that the use of mark within a metatag by a search engine does not constitute use of that mark to identify goods or services. On the other hand however, the use of a competitors trade mark in a metatag could be said in the context of the internet to constitute trade mark infringement where its purpose fulfils the threshold requirements of Section 17 of the TMA the mark having been incorporated as a metatag to attract websurfers searching for competitors goods and services to their own website/pages.

Linking

The unauthorised use of a trade mark as a hyperlink may potentially constitute trade mark infringement. However, to date there has not been any litigation over this type of trade mark infringement. It has been suggested⁸ that a reasonable approach would be that if a trade mark is used on a web page as a hyperlink, but the context of use precludes the likelihood of confusion, then it is not an infringing use for the purposes of TMA. If the link is used as a sign which accurately and truthfully identifies the website location of the registered trade mark owner, then infringement is unlikely to arise. Infringement would be likely to arise

⁵ 174F.3d 1036 (1999) Ninth Circuit

⁶ (2000) (Ch.D.25th May 2000) (also Cited Lawtel 22 June 2000)

⁷ Gilbert & Tobin "Hidden Identifiers in Websites: Metatags and Intellectual Property" 5-5-98 st www.gtlaw.com.au

⁸ http://www.gtlaw.com.au/templates/categories/list_category_publications/jsp?catid=129&menuid=1
McCarthy, T "McCarthy on Trade Marks and Unfair Competition" at para 25.70

where the website owner used the hyperlink to indicate some connection with his or her own goods or services.

Framing

The most recent case on framing was in the US case of *The Washington Post –v- Total News Inc*⁹ (*Total News Case*) Total News operated a Website which offered access to news via a number of sources. When a user clicked on the appropriate icon, the trade mark or logo of one of the news sources, the user accessed the corresponding website. However, the website thus accessed would be surrounded by the "Total News" frame. The plaintiff alleged that the defendant's "framing" of its sites constituted misappropriation, trade mark dilution, trade mark infringement and unfair competition. However, the case settled almost immediately after it was filed and before any defences were lodged. Its value as a precedent is therefore limited.¹⁰

Should facts similar to the *Total News Case* arise in Australian Litigation one could well imagine that two positions would be argued in relation to the trade mark issues. A Respondent in such proceedings would no doubt wish to contend that the use being made of the mark was one that fell within one of the categories identified in Section 122 (1) of the TMA. Very probably sub-section (c) would be pressed into service as indicating that the trade mark was simply being used in good faith to indicate the intended purpose of the goods or services and nothing more. The difficulty however, which such a Respondent would have to contend with is that the framing of the page may well suggest that the Respondent is using the mark for the purpose of indicating a connection in the course of trade with the Applicant's goods or services. Such a use would be a use "as a trade mark" justifying a finding of infringement. As with metatags no clear guidance is presently available as to the likely approach to be taken by the Australian Courts. It is at least possible that so far as the issues of metatags linking and framing are concerned there will be cases which on their facts fall on one side or the other of the line demarking "use as a mark".

4.2 Use by fan clubs or supporters

To date there have not been any Australian trade mark infringement cases in relation to fan clubs/supporters websites.

However, there has been some discussion in the US on this issue. In the US, generally, fans may use a trade mark owner's marks on their sites as long as visitors to the site are not likely from the manner of use of the mark to believe that the owner approves, sponsors or has some other close connection to the site or its content.¹¹

Further, a hypertext link to the trade mark owner's 'official' site is likely to be permissible. However, when no 'official' site yet exists, fans can confuse visitors into thinking that their site is the 'official' site or that it is approved or sponsored by the trade mark owner.¹²

Infringement is even more likely to be found if there is an express or implied suggestion that the owner of the logo used as the link is a co-sponsor or is affiliated with the linking site.

The generally recognised rule would appear to be that using someone else's trade name, trade mark or protected logo as the icon for the hyperlink can constitute trade mark infringement, whilst the use of a trade mark or trade name as a mere part of the URL of a hyperlink, standing alone should be excused as a fair and descriptive use of the mark. There is however, as yet, no particularly compelling authority for this approach.

⁹ 97 Civ 1190(PKL) United States District Court, Southern District of New York

¹⁰ Macgregor, M "Restraint of Trade and Business Reputation Rights- Effective Protection Strategies for the Information Age" in The 5th Annual National Conference Intellectual Property- Protection, Enforcement & Commercialisation

¹¹ See, *Wendt –v- Host Int'l Inc.*, 25 Med. L. Rptr 2345 (9th Cir. 1997)

¹² Koster, E "Set Phasers on Stun: Handling Internet Fan Sites" *The Company Lawyer* vol 15(1) http://www.oppenheimer.com/intprop/news/fan_sites.shtml

4.3 Parody sites

To date, the use of commercial parodies in websites has not been examined in the Australian Courts. Again there has been litigation in the US relating to use of parodies and the protections afforded to owners in trade mark infringement and dilution suits.

Commercial parodies generally arise in two ways:¹³

- a) The first arises when the parodist attempts to 'free ride' off the name and goodwill of another company and uses the parody to sell its own products or services. For example, in the case of *Saks & Co –v- Hill*¹⁴ the defendant parodied the plaintiff's famous 'Saks Fifth Avenue' mark in its stores using the name 'Sack's Thrift Avenue'.
- b) The second kind of commercial parody is not intended to sell a product but make jokes at another company's expense.

The most recent authority on parody sites in the US is in the case of *PETA –v- Doughney*¹⁵ in that case, the court noted that a parody must "convey two simultaneous and contradictory messages: that is, the original, but also that it is not the original and is instead a parody"¹⁶. The case was essentially a domain name dispute which centred on whether Mr Doughney's website "PETA.ORG" was a parody site or not. The court held in the negative and Mr Doughney was forced to relinquish the domain name "PETA.ORG". Thus, he could not rely on The First Amendment (which protects free speech under the US Constitution)¹⁷ and fair use doctrines in trade mark law in the US which would operate to protect parody sites.

However, there do not appear to have been any cases that have examined the content of parody sites particularly in relation to trade mark issues.

The most recent case on a similar topic is *Bally Total Fitness Holding Corp –v- Faber*¹⁸ which related to a protest website developed by a user, Faber, which was devoted to consumer complaints and criticism of Bally Total Fitness. When a view visits Faber's site, Bally's distinctive trade mark appears with the word "Sucks" emblazoned upon it and below this, the site reads "Bally Total Fitness Complaints! Un-authorized".

The court rejected Bally's trade mark infringement claim. While the court found that Bally's Federally registered marks were valid and protectable, it also found that there was no consumer confusion created through Faber's use of the company's marks. The court found that no reasonable consumer would be confused about the source or sponsorship of Faber's site. In addition, the court rejected Bally's trade mark dilution claim because it found that Faber's use of Bally's trade mark was non-commercial in nature and did not dilute Bally's mark by lessening the capacity of the mark to identify and distinguish goods or services.¹⁹

The court held that Faber did not use Bally's mark to identify goods in commerce nor to sell his own services, and thus was not commercial.²⁰

¹³ Skoch, G "Commercial Trade Mark Parody: A Creative Device Worth Protecting" 9 Kan J L & Pub. Po'y 357

¹⁴ *Saks & Co –v- Hill* 843 F Supp 620 (SD Cal 1993), as cited in Skoch, G "Commercial Trade Mark Parody: A Creative Device Worth Protecting" 9 Kan J L & Pub. Po'y 357 at 360

¹⁵ (CA-00-1918)(4 Cir.23 August 2001) <http://laws.ip.findlaw.com/4th/001918p.html>

¹⁶ *Cliff notes, Inc –v- Bantam Doubleday Dell Publ Group, Inc* 886 F.2d 4909, 494 (2 Cir 1989)

¹⁷ Macgregor, M "Restraint of Trade and Business Reputation Rights- Effective Protection Strategies for the Information Age" in the 5th Annual National Conference Intellectual Property- Protection, Enforcement & Commercialisation.

¹⁸ 29F Supp 2d 1161 (CD Cal 1998)

¹⁹ Cisneros, O "Berkeley Technology Law Journal Annual Review of Law and Technology Intellectual Property- Trade Mark *Bally Total Fitness Holding Corp –v- Faber*" (2000) 15 Berkeley Tech LJ 229

²⁰ See note 24 at 241

Furthermore, the court also authorised the use by Faber of Bally's marks in his site's meta-tag as it was held that "prohibiting Faber from using Bally's name in the source code would effectively isolate him from all but the most savvy of internet users". Thus the fair-non commercial use of trade marks in metatags was recognised. This case affirms the First Amendment right of US consumers to criticise companies using their own marks in this new medium.

Analysis

From the above analysis, it appears that the use of another company's trade marks would be acceptable and would not constitute trade mark infringement provided that:

- there was no consumer confusion created through the use of the company's trade marks
- no reasonable consumer would be confused about the source or sponsorship of the parody website
- use of the trade mark is non-commercial in nature.

As noted above, there are two types of commercial parodies. It would appear that the first type of parody (where a competitor 'free rides' off another's trade mark) does have the potential to amount to trade mark infringement. However, the second kind (i.e. using parody to satirise, mock or make jokes at another company's expense) likely to be treated along similar lines to a "protest website" as in the *Bally Case* and is probably acceptable (at least from the trade marks standpoint) under US Law. It is doubtful whether the Australian Courts would take a different approach.

It should be noted that to an even greater extent than a 'protest website', parody is unlikely to result in public confusion, as the average viewer is not likely to believe that a parody site is either generated by the trade mark owner or appears with the trade mark owner's authorisation.

4.4 Comparative advertising

Comparative advertising is a form of advertising which involves an "implied or stated comparison between the advertiser's product and another product".²¹ It includes reference to a trade mark of which the advertiser is not the owner in a way which does not impute proprietorship in the mark to the advertiser for the purpose of comparing the goods or services of the advertiser to those of the owner of the mark.²²

SI22(1)(d) of the Trade Marks Act 1995 provides that a person does not infringe a registered trade mark when "the person uses the trade mark for the purposes of comparative advertising". However, there has not been any attempt to define comparative advertising or to impose a limit on the kinds of use which a comparative advertiser can make of another's mark.

Analysis

It is questionable whether in Australia the use of a trade mark for the purposes of comparative advertising is use of a trade mark "as a trade mark". The purpose of most comparative advertising is to identify a product or service of a competitor and then to claim that the comparative advertiser's own product or service is superior. The use of the trade mark in such cases is to identify that product or service of the owner of the trade mark and would be difficult to construe this as an 'infringing use'.²³

²¹ Sidoti, C "Comparative Advertising" (1996) 4 Competition and Consumer Journal 15

²² See Murphy, M "Legal Aspects of Comparative Advertising" (1997) 12 QUTLJ 41 at 53

²³ "Editorial" Australian Intellectual Property Journal Volume 7 August 1996 Number 2 at 125

Only when the trade mark is used to create a link to the comparative advertiser, is it being used "as a trade mark". On this analysis the scope of Section 122(1)(d) becomes of importance.

Thus, if the intention of the section is to permit a trade mark being 'used as a trade mark; in the context of comparative advertising then, some restrictions (perhaps modelled on the UK or US approaches) would be desirable to provide some protection to the owner of a trade mark which is used unfairly.

5. If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws).

Australian law does protect the public and traders against unconventional uses of trade marks. One aspect of this law is statutory (the Trade Practices Act) and the other arises under the Common Law (the tort of passing off, developed originally by the English courts and now adapted and refined by the Australian courts). The effect of these laws is to protect against trade mark use beyond the traditional indications of origin and identity. Whilst there is no broad law of unfair competition in Australia, the Courts have been willing and able to broadly apply the Trade Practice Act and the tort of passing off, such that Australian consumer and trade law is in step with the laws of major industrialised nations.

The Trade Practices Act, from a legislative perspective, is primarily intended to protect the public (in the trade mark arena this equates with consumers). It has, however, also evolved as a legal mechanism for protecting traders' interests. The Act includes a broad provision that prevents traders from engaging in "misleading or deceptive conduct" (or conduct that is "likely to mislead or deceive"), with the intent being that the activities of a trader should not mislead or deceive consumers (for example, into believing that one trader's use of a trade mark is authorised or approved by another). The Act has proven, since its inception in 1974, to be very powerful and broad reaching. It does not require business presence in Australia or even the proof of reputation but simply the establishment of misleading and deceptive conduct or the likelihood thereof. As such, the Australian Courts have readily been able to apply it to instances of trade mark use on the Internet, in parody and comparative advertising.

The Common Law tort of passing off, which is almost always litigated in conjunction with the Trade Practices Act, originally protected the interests of traders but has also developed into protection for the consumer. The original English Common Law tort has been developed by the Australian courts to a modern and relevant application that accommodates the changes in the way traders conduct business (including electronically and on the Internet). The law originally required that both traders had a business presence in Australia, and further required proof of a misrepresentation intended to injure the reputation or goodwill of another trader. Recent developments no longer require business presence or the proof of intention, but simply that of misrepresentation. As a common law action is usually run in conjunction with a breach of the Trade Practices Act, the establishment of misleading and deceptive conduct then establishes misrepresentation. Hence, in recent cases, the finding of passing off has followed automatically from a finding of misleading and deceptive conduct.

In summary, unconventional uses of trade marks, such as on the Internet, in parody and in comparative advertising may be objectionable and restrainable under Australian law.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

In summary, Australian Law protects trade marks which are "well-known", or have a reputation in Australia against use for dissimilar goods and services to some extent. A case by case analysis will be required. However, protection will be limited to situations where the use is likely to be taken as indicating a connection to the trade mark owner.

Discussion

In relation to the question, article 16.3 TRIPS provides:

"Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which trade mark is registered, provided that use of that trade mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use."

Australian law implements this obligation in a number of ways: (1) through the Trade Marks Act 1995 (Cth), (2) by statutory prohibition on unfair trade practices, and (3) by the common law of passing off.

Trade Marks Act

First, the Trade Marks Act 1995 (Cth) makes provision for the registration of defensive trade marks.²⁴ Section 185(1) requires a showing that, because of the extent of use of a trade mark for goods or services for which it is registered, its use in relation to other goods or services would be likely to be taken as indicating a connection to the trade mark owner.

To achieve registration as a defensive trade mark, it is not necessary for the owner to use or intended to use the trade mark on the "other" goods or services.²⁵ The registration is limited, however, to goods or services for which a likelihood of connection can be shown. The provision has not been used in practice to a very great extent because of the very stringent approach taken by the Trade Marks Office before registration will be accepted.

Secondly, section 120(3) provides:

A person infringes a registered trade mark if:

- a) the trade mark is well known in Australia; and*
- b) the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to:*
 - i) goods (**unrelated goods**) that are not of the same description as that of the goods in respect of which that trade mark is registered (**registered goods**) or are not closely related to services in respect of which the trade mark is registered (**registered services**); or*
 - ii) services (**unrelated services**) that are not of the same description as that of the registered services or are not closely related to the registered goods; and*
- c) because the trade mark is well known, the signs would be likely to be taken as indicating a connection between the unrelated goods or services and the registered owner of the trade mark; and*
- d) for that reason, the interests of the registered owner are likely to be adversely affected.*

(Use on goods or services which are the same or similar are covered by, respectively, sections 120(1) and 120(2).)

²⁴ Sections 184-189. Under the 1955 Act, such trade marks were registered in Part D.

²⁵ Section 185(2)

This requires the trade mark owner to satisfy seven conditions to be successful:

1. The owner must have a registered trade mark in Australia. This includes an international registration under the Madrid Protocol for which protection has been extended to Australia.²⁶
2. The trade mark must be well known in Australia.

Section 120(4) provides some further guidance on the concept of "well known" in Australia for these purposes:

*In deciding, for the purposes of paragraph (3)(a), whether a trade mark is **well known in Australia**, one must take account of the extent to which the trade mark is known within the relevant sector of the public, whether as a result of the promotion of the trade mark or for any other reason.*

Thus, it would appear that the criterion is that the trade mark is known in Australia" to the relevant section of the public. This could be as a result of promotion or other reasons. This standard does not appear to be as high as "famous" or "notorious". It is not clear, however, what standard is required since the provision has been considered on one case only to date and that case concerned the Coca Cola bottle shape.²⁷ The Working Party on whose recommendation this provision was introduced seem to have envisaged that the reputation should be sufficiently substantial that use on dissimilar goods or services should be prohibited.²⁸

3. The alleged infringer must use the sign "as a trade mark". See responses to questions 1 and 2 above.
4. The sign used must so nearly resemble the registered trade mark as to be likely to deceive or cause confusion.
5. The use must be on goods or services unrelated to those for which the trade mark is registered. Goods or services would be related to those covered by the registration if there was a realistic potential that the relevant public would regard them as being part of the same trade and so likely to emanate from the same source.²⁹
6. The use of the trade mark on the unrelated goods or services must be likely to be taken as indicating a connection with the owner of the registered mark because the trade mark is well known.
7. Because it is likely to be taken as indicating a connection, the interests of the owner of the registered trade mark are likely to be adversely affected.

While this provision appears in substance to comply with Australia's obligations under which 16.3 of TRIPS, requirement (6) above in particular can be an important limitation. The only case to consider the provision approached the matter as requiring the alleged infringement to misrepresent a trade connection with the trade mark owner, although this appears to include licence, sponsorship or other association.³⁰ It is arguable that Australian

²⁶ Trade Marks Regulations, reg 17A.39

²⁷ Coca Cola –v- All-Fect (1998) 43 IPR 47 AT 61 reversed on appeal on different grounds, (1999) 47 IPR 481, 498 at para 44.

²⁸ Recommended Changes to the Australian Trade Marks Legislation (July 1992), Recommendation 13C. Recommendation 13A distinguishes, however, between the reputation of well-known marks and other marks. The Discussion Paper had used the term "famous marks" instead of well known.

²⁹ See MID Sydney –v- Australian Tourism (1998) 42 IPR 561, 567-9.

³⁰ Coca-Cola –v- All-Fect above at first instance 43 IPR at 62-4

courts are less likely than US courts to draw a likelihood of connection where the use is for wholly unrelated goods or services. Each case, however, involves a weighing of the totality of circumstances including not just the reputation of the trade mark, but also what it is used for, how it is used, how the alleged infringer uses the mark, the goods or services for which the use is made and the sophistication of the relevant public.³¹

Thirdly, a trade mark which has required a reputation in Australia may provide the basis of an opposition to an application for registration where, because of that reputation, use in relation to the goods or services the subject of the application would be likely to deceive or cause confusion.³² The trade mark does not need to be registered in Australia to provide a basis for opposition under section 60.³³ It is feasible, therefore, that an application to register a mark for unrelated goods or services could be opposed where use for those goods or services would be likely to misrepresent an association or, possibly, give rise to cause for wonder.³⁴

Unfair trade practices and passing off

Commonwealth and state and territory statutes include a general prohibition on engaging in conduct in trade or commerce which is likely to mislead or deceive. The common law also provides a remedy against passing off. For present purposes, both types of remedy require three key aspects to be shown:

1. a reputation in a name or trade mark in Australia;³⁵
2. as a result, a likelihood that use of that or similar name by another would be likely to misrepresent an association with the owner of that representation; and
3. damage.³⁶

It is likely that the requirement of a risk of misrepresentation will be applied in similar fashion to the principles discussed above.³⁷

Proposals for harmonisation

Given the questions about whether or not "merely" registering a domain name is trade mark use or use in trade or commerce, and the prevalence of cybersquatting, we would support legislation along the lines of the Anti-Cybersquatting Protection Act. Dealing with cybersquatters imposes on companies heavy costs. While the UDRP can be an effective remedy, it does not carry sanctions like injunctions, damages and costs which it would seem are necessary to convince people that cybersquatting is not "just a lark".

Summary

It is apparent that the use of a trade mark as a mark is a sine qua non for the existence or enforcement of most trade mark rights in Australia. The right to apply for a trade mark depends upon existing use or intention to use the trade mark as a mark. Further, the rebuttal

³¹ Id citing *McIlhenney Co –v- Blue Yonder* (1997) 39 IPR 187 ("Tabasco" used for design of exhibition stands did not misrepresent trade association).

³² Trade Marks Act 1995 (Cth) section 60

³³ As noted, above, recommendation 13A of the Working Party suggest that there may be a difference between a trade mark having a reputation and one which is well known but the nature of that difference is not explained.

³⁴ See e.g. *Radio Corporation Pty Limited –v- Disney* (1937) 57 CLR 448 at 459 per Dixon J

³⁵ Reputation does not require use of the trade mark in Australia: *ConAgra –v- McCain* (1992) 23 IPR 193.

³⁶ Where there is a reputation and misrepresentation, damage will be presumed: *McIlhenney* (1997) 39 IPR 187 at 200

³⁷ *McIlhenney Co –v- Blue Yonder* (1997) 39 IPR 187

of a non-use application, and accordingly maintenance of the registration of a mark, involves proof of the use of the subject mark as a mark.

As far as infringement is concerned the requirement for use as a trade mark is embodied in the relevant statutory provisions creating the right to sue for infringement.

The question of whether more exotic uses of a mark, such as use as a metatag or as a hyperlink or in framing or by fan clubs or in parodying the mark, constitute infringing use is not settled. There is an absence of authority in Australia. The American cases provide opportunities for persuasive arguments that may be made either way as to whether these activities may constitute use as a trade mark. However, until there are local decisions, no conclusive view can be advanced.

Comparative advertising is not unlawful in Australia. It is possible that the use of a mark as a mark may still be protected by the relevant section in the Trade Marks Act and not constitute infringement.

Whilst there is no general law of unfair competition, non-conventional uses of marks (for example, use otherwise than as indications of origin) may be actionable under the common law of passing-off or under the statutory tort of false or misleading conduct contained in the Trade Practices Act.

Well-known or famous marks used on dissimilar (unrelated) goods or in respect of dissimilar services are protected under the Trade Marks Act. However, to establish infringement there must be proof that the signs alleged to infringe the well-known mark would be likely to be taken as indicating a connection in the course of trade between unrelated goods or services and the proprietor of the well-known mark.

Résumé

Il est apparent que l'usage de la marque "en tant que marque" est une condition "sine qua non" c'est-à-dire une condition légale au regard de l'existence, du maintien et de la contrefaçon des droits de la plupart des marques en Australie. Le droit d'enregistrement d'une marque dépend de l'usage existant ou l'intention d'utiliser la marque en tant que marque. De plus l'usage effectif de la marque n'est pas requis comme condition pour introduire un dépôt et en conséquence le maintien de l'enregistrement d'une marque implique la preuve de l'usage de la marque en tant que marque.

La condition expresse que l'usage soit un "usage de marque" en ce qui concerne la contrefaçon. est établi dans certaines juridictions, et ainsi crée le droit de poursuites légales contre le contrefacteur.

La question: que les usages de marques qui sont utilisées à des fins pouvant être décrites comme "non conventionnelles" comme noms de domaine ou liens ou comme meta-tags pour promouvoir un site web sur Internet; ou l'usage par des clubs de fans ou dans des parodies ou dans le cadre d'un autre site web, constituent-ils ou non des contrefaçons n'est pas encore tranchée. Il-y-a un vide de Législation en Australie. Les procès américains nous fournissent ainsi l'occasion de réfléchir à des arguments persuasifs qui peuvent être interprétés par les deux parties opposées quant à si ces activités constituent ou non un usage en tant que marque. Cependant tant qu'il n'y a pas de jurisprudence australienne bien établie on ne peut pas avancer de conclusion sur cette question.

La publicité comparative n'est pas illégale en Australie. Il est bien possible que l'usage d'une marque en tant que marque peut bien être protégée par la section en référenceaux marques dans le Code de Commerce ou Trade Practices Act et ne constitue aucunement une contrefaçon.

Tandis qu'il n'y a pas de Loi générale sur la concurrence déloyale, les usages "non-conventionnels" des marques (par exemple, l'usage sans indication de la source d'origine) peuvent être passives de poursuites légales dans le cadre de la loi commune de passing-off ou dans le cas de conduite illicite ou d'acte délictuel contenu dans le code de Commerce.

Des marques de "haute renommée" ou jouissant d'une réputation fameuse, qui sont utilisées pour des produits et services différents (non similaires à ceux de la marque) sont protégées par le code de Commerce. Cependant pour établir la contrefaçon on doit prouver que les signes incriminés qui contrefont la marque bien connue aurait entraîné de la confusion en indiquant une connection dans la vie des affaires entre les biens et les services différents et le propriétaire de la marque bien connue.

Zusammenfassung

Es ist ersichtlich, dass der Benutzung eines Markenzeichens als "Marke" ein sine qua non für die Existenz oder die Durchsetzung der meisten Markenzeichenrechte in Australien ist. Das Recht sich um ein Markenzeichen zu bewerben hängt von bestehendem Gebrauch oder der Absicht zur Benutzung eines Markenzeichens als "Marke" ab. Weitergehend schliesst die Zurückweisung eines Nicht - Benützung - Antrages, und demnach der Aufrechterhaltung der Registrierung einer Marke den Beweis der Benutzung der Marke als eine "Marke" ein.

Was Verstösse betrifft, sind die Bedingungen für die Benutzung als Markenzeichen in den relevanten gesetzlichen Verordnungen eingeschlossen und schaffen somit das Recht, gegen Verstösse zu klagen.

Die Frage ob die etwas exotischeren Benutzungsweisen einer Marke, wie die Benutzung als Metatag oder Hyperlink oder in "framing" oder durch fan clubs oder die Parodierung der "Marke", einen Benutzungsverstoss darstellen ist noch nicht geklärt. Da besteht ein Mangel an Autorität in Australien. Die Amerikanischen Fälle liefern Gelegenheiten für überzeugende Argumente sowohl dafür als auch dagegen ob diese Aktivitäten die Benutzung von Markennamen darstellen. Wie dem auch sei, solange es keine örtlichen Entscheidungen gibt, kann keine schlüssige Ansicht vorgebracht werden.

Vergleichende Werbung ist nicht ungesetzlich in Australien. Es ist möglich, dass der Gebrauch einer Marke als "Marke" noch durch einen relevanten Absatz im Trade Marks Act geschützt ist und keinen Verstoss darstellt.

Während es kein allgemeines Gesetz für unfairen (unlauteren) Wettbewerb gibt kann die unkonventionelle Benutzung von "Marken" (z.B. anderweitige Benutzung denn als Herkunftsangabe) unter dem common law of passing off (Täuschungsgesetz) oder unter dem gesetzlichen Delikt des falschen oder irreführenden Verhaltens (false or misleading Conduct) die im Trade Practices Act enthalten sind, klagbar sein.

Bekannte oder berühmte "Marken" die auf ungleichartigen oder unverwandten Gütern oder in Bezug auf ungleichartige Dienstleistungen benutzt werden, sind unter dem Trade Marks Act geschützt. Wie auch immer, um eine Übertretung nachzuweisen muss der Beweis vorliegen, dass die Zeichen, die angeblich auf die wohlbekannte Marke übergreifen als auf eine Verbindung im Handelsverlauf zwischen ungleichartigen Gütern oder Dienstleistungen und dem Besitzer der wohlbekannten "Marke" hinweisend verstanden werden könnten.

Rapport Q168

au nom du Groupe belge
par Louis VAN BUNNEN, prés., Antoine BRAUN, Brigitte DAUWE,
Isabelle GOES, Emmanuel CORNU et Bernard VAN REEPINGHEN

L'usage de la marque "en tant que marque" comme condition légale au regard de l'acquisition, du maintien et de la contrefaçon des droits

Préambule

Les réponses qui suivent se fondent sur le droit Benelux lequel a lui-même transposé et intégré l'ensemble de la directive européenne en ce compris les options facultatives.

1. Y a-t-il une nécessité d'utiliser la marque "en tant que marque" dans les cas suivants:

- a) pour acquérir le droit;
- b) pour le maintenir;
- c) pour agir en contrefaçon.

- a) En substance, en droit Benelux, ce n'est pas l'usage d'une marque en tant que marque, mais bien son dépôt qui est une condition de son acquisition (caractère attributif de droit du dépôt et non déclaratif).

Le simple usage, pourvu qu'il soit "fait de bonne foi" peut cependant permettre d'attaquer en nullité pour mauvaise foi le dépôt d'une marque identique ou ressemblante qui aurait été effectué par un tiers, en connaissance de cet usage (article 4, 6° a) LAM).

- b) L 'usage de la marque par son titulaire dans la vie des affaires est une condition du maintien du droit et est seul de nature à faire échec à une action en déchéance, laquelle est prévue, sauf juste motif: en cas de non-usage "normal" au Benelux pendant une période ininterrompue de cinq ans (article 5, 2° a) LBM).

La Cour Benelux, dans un arrêt Turmac (Rec. 1980/8] 23) a précisé que cet usage normal supposait que le signe en cause soit utilisé "... *hors de l'entreprise du titulaire de son licencié ou de la personne agissant en leur nom, et que cet usage se rapporte sans ambiguïté à un produit déterminé que l'usager vend ou offre en vente et qui par un tel usage se distingue des produits d'autrui*".

- c) L 'usage de la marque "en tant que marque" par un tiers est également une condition de l'action en contrefaçon au sens strict. En revanche, d'autres atteintes ne requièrent pas cette condition (cfr ci-après).

2. Y a-t-il une définition de l'usage "en tant que marque", dans la législation ou la jurisprudence?

La loi Benelux ne contient pas de définition de l'usage de la marque en tant que marque par le titulaire mais la Cour Benelux a précisé dans l'arrêt Turmac précité que cet usage "*dans la vie des affaires*" devait avoir un caractère externe "*hors de l'entreprise*" en vue de distinguer des produits ou des services (cfr ci-avant).

En revanche, en ce qui concerne l'usage de la marque par un tiers, la loi uniforme Benelux, article 13 A, alinéa 2 dispose ce qui suit: "*On entend par usage d'une marque ou d'un signe ressemblant, notamment:*

- a) *l'apposition du signe sur les produits ou leur conditionnement;*
- b) *l'offre, la mise dans le commerce ou la détention des produits à ces fins sous le signe;*
- c) *l'importation ou l'exportation des produits sous le signe;*
- d) *l'utilisation du signe dans les papiers d'affaires et la publicité; ..."*

La jurisprudence est venue préciser cette définition légale en déterminant ce qui n'est **pas** considéré comme un usage répréhensible d'une marque. Ainsi, par exemple:

- 1) L'usage qui ne tend pas à favoriser le commerce de ses propres biens ou services:

Dans son arrêt HAGENS du 29 juin 1982 (Jur. 1981, 82, p.40), la Cour de justice Benelux a dit pour droit que l'usage auquel le titulaire de la marque est en droit de s'opposer "doit s'entendre de l'usage de cette marque ou de ce signe par une personne concernant ses propres marchandises ou services pour en favoriser le commerce ou la prestation ou pour désigner sa propre entreprise".

N'utilise donc pas de la marque de façon répréhensible le transporteur de marchandises portant une marque contrefaisante, même s'il en est conscient. La Cour Benelux a toutefois précisé dans un arrêt ultérieur (*Daimler-Benz* du 20.12.1993, Rec. 1993, p. 67) qu'il y a emploi de la marque d'autrui au sens de l'article 13A lorsque, par la manière dont le revendeur emploie la marque dans une annonce, il existe réellement une possibilité de susciter dans l'esprit du public l'impression qu'il fait de la publicité en faveur de son entreprise comme telle, en suggérant une certaine qualité (appartenance à un réseau officiel de distribution).

- 2) L'usage de la marque à titre purement informatif:

La loi Benelux (art. 13 A, 6^{ème}) précise que le droit exclusif à la marque n'implique pas le droit de s'opposer à *l'usage par un tiers dans la vie des affaires.*

- *de son nom et de son adresse;*
- *d'indications relatives notamment à la provenance géographique (par ex.: "Bruxelles"), même s'il existe une marque "Banque de Bruxelles");*
- *de la marque lorsqu'elle est nécessaire pour indiquer la destination d'un produit, notamment en tant qu'accessoire ou pièce détachée;*

pour autant que cet usage soit fait conformément aux usages honnêtes en matière industrielle et commerciale).

La jurisprudence a précisé que, sous le bénéfice de cette disposition, est admis l'usage de la marque afin d'informer le public que l'annonceur répare et entretient les produits revêtus de cette marque, pourvu qu'il ne donne pas l'impression de l'existence d'un contrat de distribution avec le titulaire de la marque (C. Benelux, 25 sept. 2000; *BMW*, Ing. Cons. 2001, p.3; C.J.C.E., 23 fév. 1999, *BMW*, Ing. Cons., 1999, 311, obs. Cornu; C.J. Benelux, 20 déc. 1993; *Daimler Benz*; Ing. Cons. 1993, 349).

- 3) L'usage du signe qui n'est pas perçu comme une marque par le public concerné:

Il ne suffit pas de déposer une dénomination ou un signe pour en faire une marque, il faut encore que le signe soit apte à distinguer les produits du titulaire et à être **perçu comme une marque** par le public concerné, ce qui ne sera pas le cas de usage d'un nom dans une fonction exclusivement linguistique et publicitaire:

Ex.: "Dormir sur Epeda vous procure un bon repos" par rapport à la marque "Au bon repos".

Quid de l'usage, à titre d'enseigne ou de nom commercial?

L'usage à titre d'enseigne ou de nom commercial n'est en principe pas considéré comme un usage "en tant que marque".

Sera néanmoins considéré comme répréhensible l'usage d'un nom commercial identique à la marque, pour des produits ou services similaires, si cet usage de nom commercial est perçu par le public comme un usage de marque. Cette atteinte sera sanctionnée par une autre disposition de l'article 13, à savoir l'article 13 A.2 (actuellement 13 A,1,d) de la loi Bénélux (affaire OMNISPORT, Cour de justice Benelux. 7 novembre 1988, J.T. 1989, 194, obs. Antoine Braun, voy. aussi C.J. C.E., 20 décembre 1996, *Europabank*, Rec., 1996. p. 41).

Quid de l'usage d'un signe ressemblant à une marque déposée, à titre d'ornement et sans lui donner l'aspect d'une marque ?

La marque constituée par plusieurs bandes colorées ne sera pas considérée comme violée par un autre signe constitué de deux bandes colorées si celles-ci ne sont employées qu'à titre d'ornement et accompagnées d'une dénomination différente, écartant le risque de confusion (C.J.C.E., 22 juin 2000, *MARCA MODE / ADIDAS*, Ing. cons. 2000, 239). Néanmoins, il faudra tenir compte en droit Benelux de l'article 13 A d) qui prévoit que le titulaire peut s'opposer à "tout usage qui, dans la vie des affaires et sans juste motif serait fait d'une marque autrement que pour distinguer des produits, lorsque l'usage de ce signe tirerait indûment profit du caractère distinctif ou de la renommée de la marque ou leur porterait préjudice".

3. Y a-t-il une différence dans l'évaluation de l'usage "en tant que marque" entre l'acquisition, le maintien et la contrefaçon des droits?

Nous renvoyons, à ce sujet, à ce qui a été répondu à la première question.

4. Est-ce que l'un des faits suivants est considéré comme usage "en tant que marque":

4.1 L'usage sur Internet, comme "meta-tag", comme lien hypertexte ("linking") ou "framing"

L'usage sur Internet d'une marque déposée comme "metatag", c'est-à-dire comme mot clef dans la version HTML d'un site, qui n'est pas vu par le visiteur dudit site mais détecté uniquement par des moteurs de recherche, n'est pas un usage à titre de marque mais est répréhensible sur base de l'article 13A d précité, selon une décision néerlandaise (prés. arrond. Dordrecht. 9 février 1999, B.I.E., 1999, p.49, cité par Jean-Jo EVRARD et Philippe PETERS "La défense de la marque dans le Benelux", 2^{ème} éd., p.114; Pré. Com. Anvers. 16 mars 2000, confirmé par Anvers 9 oct. 2000, Auteurs et Média 2001, p. 285).

4.2 L'usage par des clubs de supporters

Pareil usage sera généralement admis étant donné qu'il n'a pas lieu, dans la vie des affaires, ni en vue d'assurer des débouchés aux produits ou services couverts par la marque.

Exceptionnellement, il peut y avoir une faute répréhensible suivant le droit commun ou sur base de l'article 13 A 1c) ou d) de la loi uniforme (cfr ci-après, réponse à la question 6).

4.3 L'usage parodique

En principe. l'usage d'un signe ressemblant dans une intention parodique, pour des produits identiques ou similaires est répréhensible, l'intention de parodie ne constituant pas un obstacle à une action en nullité du dépôt ou à une action en contrefaçon. Par exemple, la marque "Beteman", parodie de (C Batman, a été condamnée (civ. Brux. .11 mai 1993, Ing. cons. 1994, 108).

En pratique toutefois, dès lors que le juge constate que la marque parodiante ne peut prêter à confusion avec la marque parodiée, malgré certaines similitudes voulues, il n'y aura pas violation des droits et l'action en contrefaçon et en dommages-intérêts sera déclarée mal fondée.

On peut citer comme exemple la marque constituée par le titre de journal "Vers L'Avenir", imité par un petit journal électoral "L'Avenir vert". Dans cette espèce, il a été jugé que le risque d'association ou de rappel ne suffit pas, il faut qu'il y ait réellement possibilité de confusion, ce qui n'était pas le cas en l'espèce (cass., 5 avril 2001, J.L.M.B., 2001, p.1420, rejetant Je pourvoi contre l'arrêt de la cour d'appel de Liège du 6 octobre 1997, "Journal des procès" n° 336, p. 28).

En outre. L'imitation de marque ne sera pas considérée comme un usage à titre de marque et échappera à toute sanction s'il n'y a pas concurrence entre les parties, ni recherche de profit. Serait sans doute rejetée au Benelux comme elle l'a été en France, l'action de la société MICHELIN qui voulait faire cesser l'usage du signe "Bibendum" parodié par un syndicat d'employé de cette société (Riom, 15 octobre: 1994, D. 1995, J.p.428, note B. Edelman).

4.4 *La publicité comparative*

Il est maintenant admis en Belgique, en vertu d'une loi (LPC art. 23 bis, introduit par une loi modificative du 25 mai 1999) qu'est licite la publicité comparative, moyennant un certain nombre de conditions.

Pareille publicité est définie comme étant celle qui "identifie un concurrent ou des produits ou services offerts par un concurrent", ce qui signifie qu'est également licite l'usage d'une marque de produits ou de services concurrents, ainsi que des noms commerciaux et autres signes distinctifs de ce concurrent, pourvu que soient remplies un certain nombre de conditions:

- a) que cette publicité n'engendre pas "la confusion" entre les marques, noms commerciaux, autres signes distinctifs et les produits ou services de l'annonceur et ceux de son concurrent (art. 23 bis, 4^{ème});
- b) n'entraîne pas le "discrédit" ou le "dénigrement" des marques et nom commercial en cause (art. 23 bis, 5^{ème});
- c) ne tire pas "indûment profit de la notoriété" attachée à une marque ou à un nom commercial ou à d'autres signes distinctifs (art. 23 bis, 7^{ème});
- d) qu'elle ne présente pas un produit ou un service comme une "imitation" ou une "reproduction" d'un produit ou d'un Service portant la marque.

5. **Si, d'après le régime national du groupe, l'usage comme marque est confiné aux indications traditionnelles d'origine ou d'identification, des usages non conventionnels sont-ils néanmoins punissables de par la loi sur les marques ou d'autres lois (par exemple les lois sur la concurrence déloyale ou sur les pratiques du commerce)?**

La réponse à cette question se trouve dans l'art. 13 de la loi Benelux d'une part, le paragraphe 1 a) et b) vjse les actes de contrefaçon proprement dite, ces actes de contrefaçon étant également interdits par le droit pénal (belge, néerlandais et luxembourgeois); d'autre part, le paragraphe c) prévoit une protection élargie en faveur de la marque qui jouit d'une renommée à l'intérieur du territoire Benelux à des produits même non similaires à ceux

pour lesquels la marque est enregistrée, lorsque l'usage de ce signe tirerait indûment profit du caractère distinctif ou de la renommée de la marque ou leur porterait préjudice. Le paragraphe d) sanctionne tout usage d'une marque quelconque "autrement que pour distinguer des produits, lorsque l'usage de ceux-ci tirerait indûment profit du caractère distinctif ou de la renommée de la marque ou leur porterait préjudice".

En outre, l'an. 13A al. 1^{er} fait référence au «droit commun" en disposant que c'est "sans préjudice de l'application éventuelle du droit commun en matière de responsabilité civile..." que le droit exclusif à la marque permet au titulaire de s'opposer à l'usage de signes contrefaisants. Il ouvre ainsi d'autres possibilités d'action (en responsabilité ou en concurrence illicite).

6. Si l'usage "en tant que marque" dans le sens traditionnel est requis pour établir la contrefaçon, est-ce que les marques "de haute renommée", "célèbres", "notoires" ou "jouissant d'une réputation" utilisées sur des produits et services différents sont protégées?

L'art. 13.A.1 c) énonce en propres termes que le titulaire d'une marque peut s'opposer à "tout usage qui dans la vie des affaires et sans juste motif serait fait d'une marque qui jouit d'une renommée à l'intérieur du territoire Benelux ou d'un signe ressemblant pour des produits **non similaires** à ceux pour lesquels la marque est enregistrée, lorsque l'usage de ce signe tirerait indûment profit du caractère distinctif ou de la renommée de la marque ou leur porterait préjudice".

L'art. 13 A 1 d) réprime tout usage qui, dans la vie des affaires et sans juste motif, serait fait d'une marque ou d'un signe ressemblant "autrement que pour distinguer des produits lorsque l'usage de ce signe tirerait indûment profit du caractère distinctif ou de la renommée de la marque ou leur porterait préjudice".

La portée de ces dispositions protectrices est donc très large.

Report Q168

in the name of the Brazilian Group
by José Antonio B.L. FARIA CORREA, President, Esther M. FLESCHE, General Reporter,
Lélio D. SCHMIDT, Assistant Reporter, Luis Fernando RIBEIRO MATOS Jr., Chairperson -
Trademark Committee, Hélio FABBRI Jr., Vice Chairperson - Trademark Committee

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 *Acquiring a mark (if rights may be acquired by use according to national law)?*

Use is not a requirement for purpose of acquisition of rights. Exclusive rights in a mark derive from registration at the Brazilian Patent & Trademark Office.

Even though the mere use of an unregistered trademark does not entitle the user to the exclusive rights and to the various legal remedies available for the owner of a registration, **bona fide** users enjoy the following rights:

- a) the right of preference to obtain a registration. Such preference applies whenever the mark has been in use for at least 6 (six) months prior to the filing date of a third party's application for the same or similar mark, in an identical, similar or related class of activity;
- b) the right to invoke the rules on unfair competition so as to prevent competitors from using the mark, provided that such competitors are not vested with any registration for the disputed mark.

As an exception, Brazilian law specifically provides that **sports entities** shall enjoy exclusive rights in their marks without the need of a registration.

1.2 *Maintaining of a trade mark registration (e.g. against an application for cancellation on grounds of non-use)?*

Yes, the use of the registered mark is required in order to maintain the registration in force and avoid cancellation based on non-use upon request of third parties.

Case law and some decisions of the Brazilian Patent & Trademark Office consider that the mark is duly used if it corresponds to the trade name of the registration owner. In this situation, use as a trade name is accepted as evidence of use as a mark. If the mark is printed on invoices issued by the owner, it is also taken as enough evidence of the use as a mark.

In principle, the mark must be used as registered. Significant changes in the distinctiveness of the mark are not accepted as valid use. However, it does not mean that changes are not accepted at all. For instance, the modernization of the mark "HYARA" to "IARA" was accepted (in Portuguese, such words have the same sound).

1.3 *Establishing infringement?*

No. To establish the infringement, the owner of the mark does not need to show that it uses the mark. The exhibition of the mark registration is sufficient to support his rights. However, the lack of use might be used as defense or in a cancellation lawsuit.

If the mark is used by a **third party** in a purely descriptive way, such use is not considered infringement. No one, even the owner of the registration, can prevent third parties from using descriptive words **as long as not registered as a trademark without limitations**.

However, infringement can exist even when the mark is not used “as a mark”, but it is used, for instance, as a trade name or a domain name.

2. Is there any definition of what is use "as a mark" either in statute or case-law?

Section 123 of Brazilian IP Law does not contain detailed provisions on the manner of use . It just contains general definitions having regard to the type of mark concerned. We quote section 123 of the law:

Section 123. Under this law, it is considered:

- a) a product or service mark: the one used to distinguish a product or service from other identical, similar or related, with a different origin;
- b) a certification mark: the one used to affirm that a certain product or service is in conformity with some technical rules or specifications, especially regarding quality, nature, components and applied technology;
- c) a collective mark: the one used to identify products or services of the members of a certain entity”.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

Yes, the use of the mark is not required for the acquisition of rights, but necessary for the maintenance of rights. The use of the mark by the infringer is also necessary to support an infringement action.

As mentioned in topic 1.2, for the purpose of maintenance of rights, some changes in the use of the registered mark are acceptable, whenever they are made by the owner. However, if such changes are made by a third party, they will be considered infringement of rights.

4. Is any of the following considered to be use “as a mark”

4.1 Use on the Internet, as a metatag, in linking or framing

There exists no legal rule and no case law has so far developed on this issue. Doctrine is not unanimous regarding “metatag”, “linking” and “framing”, although links might be understood as a non-commercial citation, accepted by law. The analysis is made case by case.

Case law strongly considers that marks and domain names may conflict. The use as a domain name is understood as the use as a mark. If the distinctive formative element of the domain name is identical to or similar with a registered mark, the owner of the trade mark registration enjoys better rights.

Some commentators however sustain that such rule is not absolute: whenever the mark is not highly reputed and is not well-known, some identity, similarity or link in the activities is needed to establish infringement. Otherwise, the domain name owner could apply for a mark registration, which would not conflict with the non-competitor’s registered mark. Thus, no conflict would appear between the domain name and the non-competitor’s registered mark.

4.2 Use by fan clubs or supporters

Section 132 of Brazilian IP law establishes some exceptions, in which the trademark owner cannot prevent third parties from using its registered mark. Due to their nature of exception,

the cases described in such section do not accept analogy. Fan clubs or supporters are not expressly mentioned in section 123.

4.3 *Parody*

The analysis must be made case by case. Parodies are contemplated by copyright law (section 47). Section 132 of Brazilian IP Law rules in its item IV that the trademark owner cannot bar the use of his trademark in speech, scientific or literary works or any other publication, provided that there is no commercial connotation or harm to the trademark distinctiveness.

However, the trademark owner is entitled to protect the reputation of his registered trademark. Thus, if the parody is offensive, such aspect might be understood as a harm to the trademark distinctiveness, entitling the owner to legal remedies.

4.4 *Comparative advertising*

Yes, the citation of a third party's mark in a comparative advertising is considered use as a mark. As mentioned in AIPPI's introduction guidelines for question Q 168, comparative advertising is still a controversial issue. Since such issue was already focused in AIPPI's question Q 140, the Brazilian group **understands** that Q 168 only intended to discuss whether comparative advertising is considered use as a mark.

5. **If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws).**

Brazil protects trademarks not only because of their traditional functions, but also because of their publicity power to build goodwill. Thus, unconventional use of the trademark (for dissimilar goods and services, for instance) is objectionable, as it will be explained in topic 6 below.

6. **If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?**

Section 125 of Brazilian IP law establishes that reputed marks are protected in all classes of products and services. Thus, the protection encompasses even dissimilar goods and services, not produced or provided by the owner of the reputed trademark.

As a member of the Paris Convention and TRIPS(whose rules can be directly invoked by nationals or foreigners in Brazil), Brazil protects well-known trademarks, even for dissimilar goods and services, whenever there is a risk of association (section 16.3 of TRIPS).

Section 130 of Brazilian IP Law also enables the owner to protect the material integrity and reputation of his trademark, which can be applied whenever the trademark is used for a dissimilar but offensive good or service (for instance, the trademark of a fragrance used to identify a non-competitor's insecticide).

As well as stating the laws of their respective countries, the Groups are also invited, in respect of each of the questions above, to:

- **make any proposals for harmonisation; and**
- **offer any observations of interest on the topic above.**

We have so far not worked out any concrete **proposal** for harmonisation. However, we take the view that it is desirable to have international rules on links, metatags and frames.

Report Q168

in the name of the Bulgarian Group

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. According to the Bulgarian Law on Marks and Geographic Indications effective December 15, 1999 there is no requirement making the filing of trade mark application conditional on the use - real or intended of the mark applied for registration.
 - 1.1 The acquiring of a mark by its use only (without registration) is not possible now. The old Law on Trade Marks and Industrial Designs (not valid any more) incorporated the institute of "prior use". This possibility was denied by the new trade mark legislation that strictly conforms to the principle "first to file".
 - 1.2 The validity of the trade mark registration is conditional on its use. However the Bulgarian Patent Office does not require submitting proof of use in order to renew the registration. The mark is vulnerable to attack by an interested third party on grounds of non-use during a period of 5 years after the registration date of the trade mark (i.e. the date the mark was entered into the Trademark Register).
 - 1.3 There is no explicit requirement to prove use of the mark in order to be able to act against an alleged infringer. However the alleged infringer can defend himself by filing an invalidation action on grounds of non-use (provided the 5-year lawful term has expired).
2. The Law on Marks and Geographic Indications gives a legal definition of "use in the trade" which is the main feature of the use "as a mark" - such use is: putting the sign on the goods or on their packing; offering the goods bearing the mark for sale or putting these goods on the market or their storage to these purposes as well as offering or rendering services bearing the mark; the export and import of goods bearing the mark; using the mark in trade papers and in advertisements. The law is still new and there is no extensive court practice yet that could interpret and precise further the provisions.
3. The term "use as a mark" is not used as such by the Law. The legal term is "use in the trade" (or in the course of business activities). Along with the defined "use", an infringement of the mark is also: "affixing of the mark to a material to be used for labeling or packing, for business papers or for advertising of goods or services", as well as "manufacture of means specially intended for or adapted to reproduction of the mark, or possessing or storage of such means".
4. The Law on Marks and Geographic Indications does not mention the use on the Internet, as a metatag, in linking or framing; use by fan clubs or supporters; parody or comparative advertising as being use "as a mark" or valid use at all. The comparative advertising in particular cases is forbidden as unfair competition according to the Law on Protection of the Competition.
5. The unconventional uses of a mark are not mentioned at all by the trademark legislation. Any unauthorized use, which could be considered use under the Law on Marks and Geographic Indications is an infringement. If the unauthorized use is an act of unfair competition it could be objected as such.

6. The marks of renown are protected by the law not only for the identical goods and services but also in relation to goods or services which are not identical with or similar to those for which the mark is registered in the territory of Bulgaria and for which it is a mark of renown, where the use without due cause of the mark takes unfair advantage of, or is detrimental to the distinctive character or renown of the mark.

Report Q 168

in the name of the Canadian Group
by John BOCHNOVIC

**Use of a mark "as a mark" as a legal requirement in respect of acquisition,
maintenance and infringement of rights**

Introduction

Canadian trade-mark law is governed by a Federal statute, the *Trade-marks Act*, and Regulations made thereunder. The essential structure of the *Trade-marks Act* as it exists today dates from the early 1950s, and generally speaking, the statute has worked very well in providing broad and fluid protection for the developments of the last 50 years. In some respects it is a tribute to the foresight of those government officials and practitioners who collaboratively prepared the statutory law. Canada's law is deeply rooted in the principle of use of a trade-mark being required to support valid and enforceable trade-mark rights. Moreover, the use must be a commercial use in trade. It is evident that a long established requirement of this kind may have difficulty in adapting to the various kinds of activities which are now commonplace in the age of the Internet.

Questions:

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 Acquiring a mark (if rights may be acquired by use according to national law)

In order to acquire both a mark and the registration for a mark, use is required under Canadian law. Under Section 2 of the *Trade-marks Act*, a "trade-mark" is defined as being a mark that is

"used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others..."

Accordingly, one will not acquire a right in a mark unless that mark is being used in the manner prescribed in the definition.

Moreover, use in respect of goods and services is specifically defined under Section 4 of the *Trade-marks Act* in the following manner:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

4(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

Thus, not only must the mark be used in order for rights in a trade-mark to arise, but the use must be according to the definition, and this requires in essence, activity in the normal course of trade which is associated with the sale or performance of the goods or services, as the case may be.

In order to obtain a registration in Canada, and although Canadian application may be based on intention to use in Canada, an applicant will have to demonstrate that it has used the mark in either Canada or another country, before a Canadian registration will issue. If an applicant files on the basis of intention to use in Canada, the registration will not issue until the applicant provides a declaration confirming use in Canada. If the applicant relies on a foreign registration, the applicant must also include reference to use in a foreign country. The applicant does not need to prove that use, but the registration if obtained on this basis, will be open to challenge, and could be lost if the applicant does not commence use in Canada within three years of the Canadian registration.

1.2 *Maintaining of a trade mark registration (e.g. against an application for cancellation on grounds of non-use)*

Use in accordance with the definitions set forth above must be shown in order to maintain a trade-mark registration if it is challenged, either in a court proceeding or in administrative proceedings before the Trade-marks Office (under Section 45 of the *Trade-marks Act*).

1.3 *Establishing infringement*

Strictly speaking, it could be said that there is no strict requirement for using a mark in order that the mark could then be asserted against a third party alleged to be infringing the mark. In particular, if the mark is registered, it is possible that the registration could be successfully enforced even if the mark were not at that point in time in use in Canada by the owner or a licensee. Generally speaking however, enforcement of a trade-mark whether registered or not would as a practical matter require that the mark be in use in Canada. Certainly if the mark is not registered, an action at common law based on the trade-mark would normally need to rely on use of the mark and the reputation or goodwill attaching to it as a result of that use.

With respect to the activity of an alleged infringer, generally speaking, the infringer will need to be performing acts which would constitute a use of a mark as a mark in order for infringement to be established. This would normally require that the activity of the alleged infringer with respect to the allegedly infringing mark, be a kind of activity in the trade, which would normally be required to constitute "use". It can be seen that this will tend to limit the ability of a trade-mark owner to successfully enforce its trade-mark registration rights against activity which falls short of being trade-mark "use".

While there is no developed and identifiable "dilution" principle in Canadian trade-mark law, the owner of a registered trade-mark does have the right under Section 22 of the *Trade-marks Act* to prevent depreciation of the goodwill in its registered trade-mark by another person. This however, does require that the other person "use" the trade-mark and once again, the ability to rely on this provision has been circumscribed, depending upon the particular nature of the activity.

Finally the *Trade-marks Act* does provide under Section 7 for remedies against activities of another person which may fall short of being actual "use" of a trade-mark, but which are nonetheless objectionable. Such activities include passing-off and the use of false or misleading statements and descriptions.

2. **Is there any definition of what is use "as a mark" either in statute or case law?**

"Use" of a mark is defined by Section 4 of the *Trade-marks Act*. In addition, case law over the years has addressed different kinds of activities and factual situations.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

There is in essence no difference in the assessment of use "as a mark" as amongst the acquisition, maintenance and infringement of rights. This results from the well-established definition and requirement in the *Trade-marks Act*, as noted above (Sections 2 and 4 of the *Trade-marks Act*). Basically, all activity is evaluated against the definitional requirements.

As noted above, where infringement is concerned, activity which does not constitute use in accordance with the definitions may nonetheless be objectionable, even if it is not necessarily trade-mark infringement.

4. Is any of the following considered to be use "as a mark"

4.1 Use on the Internet, as a metatag, in linking or framing

In order for the use of a mark on the Internet as a metatag to constitute use for the purposes of acquiring or maintaining trade-mark rights in Canada, the use of it as a metatag would itself have to meet the definitional requirements of Section 4. In effect, it would in all likelihood have to be part of a commercial transaction relating to a sale (or leasing) of goods or, with respect to services, an offering or advertising of the services or a performance of the services. Thus, such use as a metatag could constitute use "as a mark" under Canadian requirements and be sufficient to support the acquisition and maintenance of trade-mark rights. However, it is important to note that this is unlikely to be supportable unless the use on the Internet is related directly to that activity which is required under Section 4 of the *Trade-marks Act*.

With respect to infringement, use of a mark as metatag, in order to constitute an infringing use, would need to be associated with activity which corresponds to the definitional requirements of Section 4 for use of a trade-mark. In a recent decision of a very high-level appellate court in Canada (the Court of Appeal for Ontario in *Pro-C Ltd. v. Computer City, Inc.* 55 O.R. (3d) 577), the Court confirmed that adherence to the traditional requirements of use set forth by Section 4 of the *Trade-marks Act* must be established in order to successfully object to a use of a mark on a web site where no sales are actually being made directly to Canada or in Canada.

4.2 Use by fan clubs or supporters

As explained with respect to Item 4.1, use by fan clubs or supporters, with respect to any acquisition, maintenance and infringement of marks, will be evaluated on the basis of the use requirement of Section 4 of the *Trade-marks Act*. Depending upon the specific activity, it is possible that this activity could constitute use of a mark as a mark under Section 4, but in general, it is not likely to constitute use, except in those situations where commercial sale of the product is taking place or advertising and/or performance of services is taking place.

4.3 Parody

In comparison to the activity under Items 4.1 and 4.2 above, it seems far less likely that activity which constitutes a parody could meet the definitional requirements under Section 4 of the *Trade-marks Act*, whether for acquisition, maintenance or infringement of marks. While the factual background of such cases must be carefully considered, there is case law in Canada and in one case it has been held that a trade union's parody of a well-known design trade-mark (the Michelin Tire Man logo or "Bibendum") did not constitute a use of the mark as a trade-mark.

4.4 Comparative advertising

It is possible that comparative advertising could constitute use of a mark as a mark in order to both support acquisition and maintenance of a trade-mark and in order to constitute infringing use of a trade-mark. This would very much depend on the factual background and the context in which the advertising appears, and as indicated above, would require reference back to the requirements of Section 4 of the *Trade-marks Act*. Much of the case law relating to comparative advertising has arisen from interlocutory injunction applications, and

there is very little case law resulting from considered trial decisions and from which instructive principles can be drawn. An analysis of comparative advertising would depend very much upon the extent to which (if any) the products and services were competitive, and the extent to which the information and respective trade-marks are clearly and fairly represented so as to properly inform the consumer of the different ownership of the respective marks.

In general, it would not seem that most comparative advertising would constitute the kind of activity required under Section 4 of the *Trade-marks Act* for use as a mark to support acquisition and maintenance of a trade-mark and registration therefor, or to constitute activity which is use as a mark so as to be an infringement.

5. If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws).

As noted above, it may be possible to object to any of the activity outlined in Items 4.1 to 4.4 on the basis of Section 7 of the *Trade-marks Act* or the common law action of passing-off (which is available also in the Province of Quebec, whose laws are largely governed by a Civil Code). The law of unfair competition in Canada is not well developed and unlike some countries, is not codified.

It is also important to recall that such remedies may support an application for an interlocutory injunction, where the focus is on the irreparable damage which may result to the trade-mark owner, rather than the legal right and its violation. As a result, there are factual situations in which an interlocutory injunction might be obtained on the basis of Section 7 or Section 22 of the *Trade-marks Act* or on the basis of a common law passing-off action.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

It has been well recognized in Canadian trade-mark law and in the *Trade-marks Act* for many decades that use of a mark on dissimilar goods or services is protected and moreover, the mark does not necessarily need to be well known, etc. However, the extent to which the mark is known and has been used is an important factor in extending the protection of the mark to dissimilar goods and services.

As well as stating the laws of their respective countries, the Groups are also invited, in respect of each of the questions above, to:

- **make any proposals for harmonisation; and**
- **offer any observations of interest on the topic above.**

No further comment.

Summary

Canadian trade-mark law is deeply rooted in the requirement for use of the mark. The definition of use of a mark is set forth in the *Trade-marks Act* (Section 4) and requires transfer of the property in or possession of goods in the normal course of trade, with the mark appearing on the goods or on packaging for the goods or in some other manner which associates it with the goods. Trade-mark use for services requires that the mark be used or displayed in the performance or advertising of the services. Canadian law requires that a mark be used as a mark in order to acquire rights to the mark, to maintain the registration of the mark, and to establish infringement. The assessment of this use as a mark does not in essence differ as amongst acquisition, maintenance and infringement of the right. Canadian trade-mark law has historically extended protection of trade-mark rights beyond the specific goods or services in the registration where this is appropriate, and in this re-

spect has historically offered a greater degree of protection for well-known or famous trade-marks. The relatively limited jurisprudence to date appears to be adopting a rather conservative and traditional approach to trade-mark use, based on the statutory requirements and the need for commercial activity with respect to goods or services required to establish that there has been use of a trade-mark.

Résumé

La loi sur les marques de commerce du Canada est profondément ancrée dans l'exigence relative à l'utilisation de la marque. L'utilisation de la marque de commerce est définie dans la *Loi sur les marques de commerce* (article 4). Une marque de commerce est réputée employée en liaison avec des marchandises si, lors du transfert de la propriété ou de la possession de ces marchandises, dans la pratique normale du commerce, elle est apposée sur les marchandises mêmes ou sur les colis dans lesquels ces marchandises sont distribuées, ou si elle est, de toute autre manière, liée aux marchandises. Une marque de commerce est réputée employée en liaison avec des services si elle est employée ou montrée dans l'exécution ou l'annonce de ces services. La loi canadienne exige qu'une marque soit utilisée comme une marque afin d'acquérir des droits à l'égard de la marque, de maintenir l'enregistrement de la marque et d'établir une violation à son égard. L'évaluation de l'emploi d'une marque ne diffère pas essentiellement qu'il s'agisse d'acquisition, de maintien et de la violation du droit. La *Loi sur les marques de commerce* du Canada a, par le passé, étendu la protection des droits relatifs aux marques de commerce au-delà des marchandises ou des services spécifiques dans l'enregistrement, le cas échéant, et, à cet égard, a historiquement offert un degré supérieur de protection aux marques de commerce bien connues ou célèbres. La jurisprudence relativement limitée jusqu'à présent semble adopter une approche plutôt prudente et traditionnelle à l'endroit de l'utilisation des marques de commerce, sur la base des exigences réglementaires et de la nécessité de l'activité commerciale en ce qui concerne les marchandises ou les services requis pour établir qu'il y a emploi d'une marque de commerce.

Zusammenfassung

Markenrecht in Kanada ist tief in der Voraussetzung für die Benutzung einer Marke verwurzelt. Der Begriff von Markenbenutzung ist ausführlich in dem kanadischen Markengesetz (Artikel 4) dargelegt und erfordert, dass - während der Übergabe von dem Eigentum oder dem Besitz dieser Waren im üblichen Handelsverkehr - die Marke auf den Waren selbst oder auf deren Packung erscheint oder in irgendeiner anderen Weise auf eine Verbindung mit der Marke hinweist. Die Benutzung einer Dienstmarke erfordert, dass die Marke bei der Leistung oder bei der Werbung dieser Dienste benutzt oder gezeigt wird. Kanadisches Recht fordert, dass eine Marke wie eine Marke benutzt wird, um Rechte an dieser Marke zu erwerben, die Eintragung der Marke aufrechtzuerhalten und um die Rechtsverletzung zu beweisen. Die Beurteilung über die Benutzung einer Marke unterscheidet sich im wesentlichen nicht von der Erwerbung, Aufrechterhaltung und Verletzung eines Rechtes. In der Vergangenheit hat das kanadische Markenrecht den Schutz über die spezifischen Waren und Dienstleistungen in der Eintragung hinaus erweitert, wo dies angemessen erschien, und demgemäß bekannten oder berühmten Marken einen breiteren Schutzzumfang geboten. Die bisherige relativ begrenzte Jurisprudenz scheint eher eine konservative und traditionelle Auffassung über die Benutzung einer Marke zu haben, die auf gesetzlich vorgeschriebenen Bedingungen und dem Bedarf an Handelsaktivitäten bezüglich Waren oder Dienstleistungen beruht, die zum Nachweis der Benutzung einer Marke erforderlich sind.

Chile
Chile
Chile

Report Q168

in the name of the Chilean Group
by Andrés ECHEVERRÍA

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark"?

In Chile there are no requirements of use of trademarks to have the right to apply or obtain its registration or renewal, nor to maintain a trademark in force.

In certain cases, however, there are rights that may be acquired by using the trademark "as a trademark".

Consequently, it is possible to successfully base an opposition and a cancellation action against a registered trademark, based in the circumstance that a certain mark that is being applied or is registered lacks the requirements of novelty or leads to error or deceit, due to its similarity with another unregistered mark that has been previously used in the market.

We are unaware of cases in which jurisprudence may have established that a certain use of a sign was not effected "as a trademark". It could exist in the case of conflicts between labeling elements and trademarks.

Under the former Chilean legislation, that required use of trademarks for the prescription of the cancellation action of a registration, the last jurisprudence that existed in respect of this issue which must be understood as subsisting for the effects of the interpretation of the concept "use as a trademark" within our juridical arraignment, required use in industry or commerce to be effective, continuous, in good faith and with the purpose of ownership.

In cases of penal infringements the situation is different, since the Law penalizes as infringement the simple use of a trademark that is identical or similar to a registered mark; deceit through the use of a registered trademark; advertising that uses or imitates a registered sign and the use of packages or containers with a registered mark that belongs to another party, even if said use is not customary by the infringer.

Use of a mark in the Internet, may only be considered use as trademark for administrative and civil purposes when directly leading to the advertising of the product or service it covers and in the supposition that it exists or will be introduced really and effectively in the immediate future in national commerce. The same occurs in the case of comparative advertising.

From the viewpoint of infringements, use in the Internet may be considered as infringement when it has commercial purposes and tends to promote, within the national territory, a product or service covered by a trademark registered in Chile.

Protection granted in Chile to trademarks that are "well known", "famous", "notorious" or "with reputation" is that the law prevents the registration of said marks in the name of third parties who are not their legitimate owners, but their legitimate owners must register them in Chile as a previous condition in order to prevent third parties' use of the marks in commerce.

Traduction française

1. Y a-t-il une nécessité d'utiliser la marque "en tant que marque"?

Au Chili il n'y a pas de conditions pour l'usage des marques, pour avoir droit à demander ou obtenir son enregistrement ou renouvellement, ni pour garder la vigueur d'une marque.

Par contre, dans certains cas, il y a des droits qui peuvent s'acquérir par l'usage d'une marque "comme marque".

En conséquence, il est possible de fonder avec succès une opposition et même une demande de nullité pour une marque déposée, se basant sur le fait qu'une marque déterminée qui est en train d'être demandée ou qui se trouve déposée, manque des conditions de nouveauté ou elle est inductive à erreur ou tromperie, de par sa similitude avec un autre signe préalablement utilisé sur le marché, qui n'a pas été enregistré.

On ne connaît pas de cas pour lesquels la jurisprudence se soit prononcée dans le sens que l'usage déterminé d'un signe ne soit pas "comme marque". Il pourrait exister le cas de conflit entre éléments de composition d'un texte et marques.

Sous l'ancienne législation chilienne, qui exigeait l'usage des marques pour que l'action de nullité d'un registre soit prescrite, la jurisprudence finale qui a existé sur ce point et qui doit s'entendre subsistante pour les effets de l'interprétation du concept usage comme marque dans le cadre de notre ordonnance juridique, demandait un usage effectif, continu, de bonne foi et avec l'esprit de maître dans l'industrie ou le commerce.

Dans le cas d'une infraction pénale la situation est différente, puisque la Loi punit comme infraction le simple usage d'une marque pareille ou semblable à une autre déjà déposée; la publicité qui utilise ou imite un signe déjà déposé et l'utilisation de récipients ou emballages avec une marque déposée d'autrui, même s'il n'existe pas une habitude dans l'usage de la part du transgresseur.

L'usage d'un signe dans Internet pourra seulement être considéré usage comme marque pour les objets administratifs et civils quant il sera dirigé directement à la publicité du produit ou service qu'il protège et en supposant que celui-ci existe ou qu'il aille être introduit réelle et effectivement dans un futur immédiat dans le commerce national. Il arrive de même dans le cas de la publicité comparative.

Du point de vue des infractions, il peut être considéré comme infracteur dans l'usage en Internet, quand il aura une fonction commerciale et avec une tendance à promouvoir, dans le territoire national, un produit ou service protégé par une marque déposée au Chili.

La protection qui est offerte au Chili aux marques "bien connues", "renommées", "notoires" ou "avec réputation" consiste à empêcher que ces marques soient déposées au nom de tiers qui ne soient pas ses légitimes titulaires ; mais ces légitimes titulaires doivent les déposer dans le pays comme condition préalable pour pouvoir empêcher que de tierces personnes les utilisent de façon commerciale.

Deutsche Übersetzung

1. Gibt es ein Erfordernis, das die Benutzung einer Marke "als Marke" verlangt?

In Chile gibt es keine Markengebrauchserfordernisse, um das Recht einer Eintragung oder einer Erneuerung einer Marke zu erbitten oder zu erhalten und man kann damit auch nicht auf ihrer Gültigkeit bestehen.

Immerhin kann man gegebenenfalls Rechte erwerben, um eine Marke "als Marke" zu benützen.

So ist es denn möglich, erfolgreiche Widersprüche zu begründen und auch die Ungültigkeit einer Schutzmarke zu verlangen, falls eine gewisse Marke die angemeldet wird oder eingetragen ist den Neuigkeitserfordernissen nicht entspricht oder weil sie wegen Ähnlichkeit oder anderen vorher am Markt bestehenden aber nicht früher eingetragenen Zeichen zu Irrtum oder Betrug führt.

Wir selbst kennen keinen Fall in welchem die Rechtsprechung ausgesagt hätte, dass ein gegebener Gebrauch eines Zeichens nicht "wie Marke" sei. Es mögen wohl solche Konflikte etwa zwischen Etiketten und Markenelementen vorhanden sein.

Nach vorjähriger Chilenischer Gesetzgebung, welche den Gebrauch der Marke verlangte um erlöschende Verjährung einer Eintragung ungültig zu erklären, und der letztmalige Rechtspruch in dieser Hinsicht, welchen man noch als gültig ansehen müsste und welcher in Auslegung des Gebrauchskonzeptes als Marke binnen unserer Gesetzordnung entspricht, verlangte einen tatsächlichen Gebrauch welcher stetig, glaublich und im Geist des Besitzers der Industrie vollstreckt wurde.

Im Fall einer strafbestimmten Verletzung ist die Situation eine andere, da das Gesetz die einfache Benützung einer gleichen oder ähnlichen schon eingetragenen Marke bestraft; sowie die Veruntreuung bei Gebrauch einer eingetragenen Marke; so wie die Bekanntmachung durch ein eingetragenes Zeichen oder die Gefässe oder Packung mit fremder eingetragener Marke, wäre auch deren Gebrauch nicht gewöhnlich.

Der Gebrauch eines Internet Zeichens, wird nur als Markenzeichengebrauch angesehen im Fall von Verwaltungs- und Zivil-Gegenständen, wenn das Zeichen genau auf die Bekanntmachung eines Produktes oder Service (Dienstleistung) die es schützt hinweist und dieses schon existiert oder in kurz zukünftlicher Zeit wirklich im inländischen Handel eingeführt wird. Dasselbe gilt im Fall vergleichartiger Bekanntmachung.

In Hinsicht auf Verletzungen wird jemand als Internetübertreter angesehen wenn er auf einer Handelstelle arbeitet und im Inland ein eingetragenes Produkt oder Service fördern will.

Den Schutz welchen Chile den "gut bekannten", "berühmten", "öffentlich bejahten" oder "beachteten" Marken anbieten kann besteht darin dass das Gesetz verbietet jene Marken, auf Nahmen dritter Personen einzutragen; aber jene rechtmässigen Inhaber müssen die Marken im Land im Voraus eingetragen haben, um zu verhindern, dass Dritte sie kommerziell benützen.

Report Q168

in the name of the Czech Group

**Use of a mark "as a mark" as a legal requirement in respect of acquisition,
maintenance and infringement of rights**

A ground for cancellation of a trade mark is its non-use for at least five years prior to the initiation of the cancellation proceeding and its proprietor failed to present cogent reasons for its non-use. Its use in the last three months prior to the filing a request for cancellation is considered as insufficient. Use of a trade mark by a third party based on an agreement is considered to be a proper use. It is also considered to be a proper use if the trade mark is used in a form not substantially different from the registered form.

Report Q168

in the name of the Danish Group
by Claus HYLLINGE and Nicolai LINDGREEN

**Use of a mark "as a mark" as a legal requirement in respect of acquisition,
maintenance and infringement of rights**

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 *Acquiring a mark (if rights may be acquired by use according to national law);*

Yes.

1.2 *Maintaining of a trade mark registration (e.g. against an application for cancellation on grounds of non-use); or*

Yes.

1.3 *Establishing infringement*

Yes.

2. Is there any definition of what is use "as a mark" either in statute or case law?

There is no statutory definition of use "as a mark" in Danish trademark law.

However, Section 3 of the Danish Trademarks Act provides that a trademark right may be acquired through "commercial use" of the mark. Section 4(3) further provides that "commercial use" includes, but is not limited to, affixing the mark to goods or their packaging, offering goods or services for sale using the mark, marketing or storing them with the purpose of offering them for sale, importing or exporting goods using the mark, or using the mark on business papers or in advertising.

The Trademarks Act does not contain specific definitions of the nature of trademark use required for acquisition, maintenance and infringement of rights. However, in respect of maintenance, it is emphasized in Section 25 that the mark must have been "genuinely" used in order to be upheld under the user requirement.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

As stated above, the Trademarks Act does not distinguish specifically between the nature of use required in respect of acquisition, maintenance and infringement.

In case law, it has been established that as regards acquisition, it is a condition that use of the mark has taken place externally, ie outside the proprietor's own business or organisation. There is no specific requirement as to the extent and duration of the use. The nature of use establishing infringement corresponds with the requirement for use necessary for establishing a trademark right.

Regarding maintenance, a recent decision concerning the trademark HOME (UfR 2001.2094 SH) indicates that the courts are inclined to uphold a broader specification of goods than that for which use has, strictly speaking, been proven, at least in respect of well-

known marks. As the user requirement is new in Danish law, it is too early to say whether a real difference will occur.

4. Is any of the following considered to be use "as a mark"

4.1 Use on the internet, as a metatag, in linking or framing

Use of a trademark on the internet as a metatag, in linking and in framing is considered trademark use under Danish trademark law, at least in relation to infringement. In general, use on the internet can establish trademark rights and can be relied upon in cancellation matters, provided that goods have been available on the Danish market.

4.2 Use by fan clubs or supporters

The use by fan clubs or supporters of a mark as the name of the fan club or supporter group will not normally amount to use as a mark. However, depending on the circumstances such use may be a violation of other rules, including the Marketing Practices Act.

4.3 Parody

Trademark parody which takes place in connection with the marketing of goods or services, is trademark use under Danish trademark law.

4.4 Comparative advertising

If necessary, please differentiate between acquisition, maintenance and infringement of marks.

In relation to infringement, comparative advertising using the trademarks of a competitor is trademark use under Danish law, but may be lawful under the rules regulating this form of marketing (Section 2a of the Marketing Practices Act). Use of a mark in comparative advertising cannot, however, form the basis of acquisition or maintenance of trademark rights.

5. If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws).

Not applicable.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

Not applicable.

Summary

There is no statutory definition of use "as a mark" in Danish trademark law, and case law has not provided a clear definition. Under Danish law, trademark use necessary for acquiring, maintaining or infringing a trademark right is normally not confined to use on goods or their packaging, and untraditional uses, including use on the internet may amount to use as a mark sufficient to acquire, maintain or infringe a trademark right.

Résumé

Il n'y a aucune définition légale de l'usage "en tant que marque" selon la loi sur les marques de fabrique et de commerce, et aucune définition univoque n'est développée dans la jurisprudence.

Selon la loi Danoise, l'usage de la marque, l'établissement de la marque et la contrefaçon de la marque ne sont pas généralement limités à l'usage de la marque sur la marchandise ou de l'emballage de celle-ci. L'usage non conventionnel, l'usage sur l'Internet inclus, sera suffisant pour éta-

blir, former la base de et l'usage de la marque, d'établissement de la marque, d'entraîner une contrefaçon de la marque.

Zusammenfassung

Es gibt keine gesetzmäßige Definition von der Benutzung "als Marke" im dänischen Warenzeichengesetz, und durch Rechtsprechung ist keine eindeutige Definition entwickelt worden.

Nach dänischem Gesetz ist die Warenzeichenbenutzung, Warenzeichenstiftung und Warenzeichenverletzung in der Regel auf die Benutzung der Marke auf der Ware oder deren Verpackung nicht beschränkt. Unkonventionelle Benutzungsformen, einschließlich der Benutzung im Internet, könnten als Benutzung "als Marke" genügend für die Stiftung, Aufrechterhaltung und Verletzung eines Warenzeichenrechtes beurteilt werden.

Report Q168

in the name of the Egyptian Group by
Hamdy GABER, Nadia HAROUN, Magda SAAD

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

Introduction

In accordance with the provisions of the Egyptian Trade Mark Act 57/1939 article 3:-

"The person registering a trade mark is presumed to be the sole owner of such trade mark. A person having registered a trade mark who has made uninterrupted use of such mark for a period of five years from the date of its registration shall, in the absence of any admitted claim, be considered the exclusive proprietor of such a mark"

From such provision we realize the importance of use of a trademark. However such use of a mark can be sustained by registration, while the registration per se of a mark does not establish or confirm use.

The answers to Question Q168 will be based on the above provisions:

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 Acquiring a mark if rights may be acquired by use according to national law)

According to the presently applied Egyptian Law, acquiring a mark is achieved by registration and use of such trademark (article 3). Prior use, in case of litigation, is taken into consideration to prove the right in the mark.

1.2 Maintaining of a trademark registration (e.g. against an application for cancellation on grounds of non-use)

Though proof of use is not a prerequisite for the renewal procedure yet maintaining a trademark registration requires the use of such mark. In accordance with the provisions of the law, if such trademark registration is not in use for **5** consecutive years, the court may order the removal thereof from the register on application of any party interested, in accordance with Article **22** of the said Egyptian act Trademark stipulating:

"The court may order the removal of a mark from the register on application of any party interested, on proof that no use has been made of the mark during five consecutive years, unless failure to use the marks can be justified by the proprietor".

1.3 Establishing infringement

For establishing infringement, both registration and use of a mark are required, in order to have sound grounds for initiating an infringement action against a third party.

2. Is there any definition of what is use "as a mark" either in statute or case law?

The National law does not have a specific definition for use "as a mark", it applies what is mentioned in this respect in the Paris Convention.

However, use "as a mark" is always referred to in the traditional sense i.e. on the product or paper work relating to the service.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

As indicated above, use as a mark is referred to in the traditional sense, therefore, there is no difference in the assessment of use "as a mark" between the acquisition maintenance and infringement of rights, bearing in mind that the value of the mark is taken into consideration. Besides, all other procedures taken by the proprietor to prevent dilution of his trademark are also related to the assessment of use "as a mark".

Assessment of use in court, in case there is a cancellation action against a registered trademark on the grounds of non-use requires providing proof of said use e.g. vouchers, brochures, ads in the local newspapers, or any other official channels.

4. Is any of the following considered to be use "as a mark"

4.1 *Use on the internet, as a metatag, in linking or framing*

4.2 *Use by fan clubs or supporters*

4.3 *Parody; and*

Neither of the first 3 points constitutes a valid use for protecting a trademark against any opposition raised by a third party. In addition, there are no court decisions issued regarding same, and the law has not specify such cases yet.

4.4 *Comparative advertising.*

It is strictly forbidden by the Egyptian law (civil or criminal).

5. If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trademark or other laws (e.g. unfair competition or trade practice laws).

Use of a mark according to the presently applied trademark law in Egypt is confined to traditional indications of origin or identity.

To prove unconventional uses in an infringement act, one has to refer to other laws (Civil, Commercial, Paris Convention, TRIPS agreement as soon as applied).

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

The well-known marks are protected under article 6 bis of the Paris Convention and the TRIPS agreement. The Egyptian Trade Mark Act does not include a provision relating to the protection of well-known marks. However, the draft of the new trademark law, which is presently debated in Parliament, does include such clause in accordance with the TRIPS agreement.

The Paris Convention, to which Egypt is a country member, only addresses the protection of well-known marks when the recently filed mark relates to same or similar goods.

However, there are rare cases where it was decided to reject the registration of a mark filed in respect of goods which are completely dissimilar to those covered by the well-known mark. The said decisions are either based on the risk of association or distortion of the image of the mark. The owners of the well-known mark must prove that they have a legitimate right in stopping the use of the same mark in respect of dissimilar goods.

On the other hand, according to article **5** of the aforementioned Trade Marks Act, the marks which are likely to deceive the consumers are irregistrable, and this article is very broad as to include the grounds for rejecting an application for the registration of a mark which is identical to a well-known mark and filed in respect of different goods.

Conclusion

Egypt is presently revising IP laws and a new law is expected to be enacted in the near future. Such law will comprise new provisions that are compatible with the TRIPS agreement regarding plant varieties and utility models etc.

However, such law does not include provision relating to the electronic commerce. The Egyptian Group expressed readiness, to the authorities, to cooperate in drafting a new electronic commerce law.

Regarding the use "as a mark", it is suggested to bring about a harmonization of the definition of use "as a mark" in its broader sense; in order to include use on the internet and other similar modern uses.

Summary

Registration of a mark should be followed by use. Failure to use the mark for five consecutive years renders it vulnerable to attack in accordance with the provisions of the Egyptian Trademark Law no. **57/1939** Use of a mark is referred to in the traditional sense i.e. as applied or fixed on the products or the paperwork with regard to goods and/or services.

Use on the internet, by fan clubs or supporters or as parody does not constitute a valid use of a mark.

The well-known, famous, notorious or reputed marks are protected under the provisions of the Paris Convention.

Report Q168

in the name of the Finnish Group
Marja TOMMILA (Chairman), Maria CARLSSON (Secretary), Kukka ANTILA,
Petteri HÄKKÄNEN, Merja KOMULAINEN, Mia PAKARINEN, Jaana PELTOLA,
Jan SANDSTRÖM, R. Kenneth WREDE and Peter ÅKERLUND

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 Acquiring a mark

According to Sections 1 and 2 of the Trademark Act (10 January 1964/7, as amended), the right to a trademark may be acquired either by registration or by establishment through use. A trademark shall be regarded as established if it has become generally known in the relevant business or consumer circles in Finland as a symbol specific to its proprietor's goods or services. Use of a trademark "as a mark" for the purpose of acquiring trademark rights through establishment is thus required. No use "as a mark" is required to obtain trademark rights to distinctive marks through registration.

Trademark rights can normally be obtained for non-distinctive marks only through establishment. According to Section 13 of the Trademark Act, a right to a non-distinctive trademark may be obtained by registration if it can be proved that the trademark has acquired secondary meaning through extensive use.

1.2 Maintaining of a trade mark registration

According to Section 26 of the Trademark Act, the registration of a trademark can be revoked at the request of a third party if the mark has not been used during the last five years after the registration of the mark, or if the use thereafter has been suspended during an uninterrupted period of five years, and the proprietor is unable to give a proper reason therefor. The use of a trademark with the proprietor's consent, for instance by an affiliated company or licensee, is considered equal to use by the proprietor.

According to the third Subsection of Section 26 of the Trademark Act, the trademark has to be used in connection with all the registered goods, otherwise the trademark rights will be revoked in respect of the goods in connection with which the mark has not been used.

In Finnish case law and doctrine it has been considered that in order to maintain a trademark registration, actual use "as a mark" must have taken place in the scale of the commercial activity pursued by the proprietor of the trademark. Preparation for use, for instance the printing of packaging material and preliminary marketing research, has in case law not been considered sufficient in order to constitute actual use, where the preparations have not been directed to the general public (Helsinki Court of Appeal, decision S91/1000 of 18 March 1992 "BOSS").

1.3 Establishing infringement

The exclusive right to a trademark is defined in Section 4 of the Trademark Act, according to which in the course of trade, only the proprietor of a mark (or another party with the proprietor's consent) may use an identical or confusingly similar symbol for identical or similar goods or services, on the goods themselves or their packaging, in advertising or in com-

mercial documents, or in any other way, including orally. The provision applies regardless of whether the goods are offered for sale or intended to be offered for sale in Finland or abroad, or of whether they are imported for commercial use, preservation, storage, or transport to a third country.

Use of a trademark “as a mark” is thus required in order for the use to constitute infringement of an identical or similar mark. There is, however, no requirement that the earlier registered mark must have been used “as a mark” in order for the proprietor to be able to submit infringement claims against the use of an identical or confusingly similar mark.

2. Is there any definition of what is use “as a mark” either in statute or case law?

Regarding definitions in statute law, please see Sections 1.1 – 1.3 above. In addition to those Sections it should be mentioned that use “as a mark” is defined in Section 1 of the Trademark Act as use of a mark in the course of trade to distinguish goods or services from those of others. Non-commercial use is thus not considered to be use “as a mark”.

The Group has not been able to find any comprehensive definitions of use “as a mark” in case law, but only definitions of what does or does not constitute use “as a mark” under certain specific circumstances. A case-by-case interpretation of what is to be considered use “as a mark” must therefore be made according to the individual circumstances of the case, and the evidence of use must be weighed in an overall assessment. The cases found indicate, however, what kind of evidence can be used to prove use “as a mark”. Different kinds of evidence have been admitted by the Patent Office and the courts quite liberally. For instance printed matter, affidavits of use, commercials and use on the Internet have been admitted as evidence of use “as a mark”.

3. Is there any difference in the assessment of use “as a mark” between the acquisition, maintenance and infringement of rights?

Use “as a mark” is, according to the opinion of the Group, in principle assessed according to the same criteria in all cases. The required intensity and quality of the use does, however, differ between acquisition, maintenance and infringement of rights.

In respect of the acquiring of trademark rights through establishment the required intensity of use “as a mark” is the most extensive. In respect of maintenance, use “as a mark” by the proprietor or with his consent must have taken place in relation to the normal scale of commercial activity pursued by the proprietor of the trademark. In respect of infringement it is sufficient that the goods are intended to be offered for sale.

4. Is any of the following considered to be use “as a mark”:

4.1 Use on the internet, as a metatag, in linking or framing

General issues

Use on the Internet alone, or combined with other kinds of use, can under certain circumstances be considered to be use “as a mark” for the purpose of establishment or maintenance of marks.

In case of an infringement related to use on the Internet, the rules of Finnish trademark law are applied as in any other case of infringement.

According to the Trademark Act, any commercial use of a trademark identical or confusingly similar to another’s trademark for identical or similar goods or services, is prohibited. Use as a metatag, in linking or framing is thus not excluded from the consideration of whether there has been use “as a mark”.

Use as a metatag

The question of whether or not use as a metatag can be considered to be use “as a mark” in Finland is unsettled.

There is one recent decision of the Market Court (1999:015 of 1 November 1999 “VIA-GRENE”), in which the use of metatags was considered to constitute unfair trade practice. The defendant had used the plaintiff’s registered trademark and tradename VIAGRA in plain text on its site and as metatags and keywords leading to the site. The Market Court gave a ruling based on the Unfair Trade Practices Act (22 December 1978/1061, as amended), in which the Market Court *i.a.* prohibited the defendant from using the marks in connection with the site.

The Group considers that the commercial use of a competitor’s trademark as a metatag may also constitute trademark infringement under certain circumstances.

Use in linking or framing

The question of whether or not linking or framing can constitute use “as a mark” in Finland is unsettled. There is no case law on the subject.

Trademark infringement through linking and framing can be prohibited under the Unfair Trade Practices Act if the use is misleading or takes unfair advantage of the goodwill of another’s trademark. However, in most cases linking or framing may be considered informative use, which is allowed under the Unfair Trade Practices Act.

4.2 *Use by fan clubs or supporters*

Use by fan clubs or supporters can, together with other kinds of use (interpreted on a case-by-case basis), be considered to be use “as a mark” for the acquiring of trademark rights through establishment. There is no case law on the subject.

Use by fan clubs or supporters cannot constitute use “as a mark” for the maintenance of a mark unless it is a question of an official fan club managed by the trademark proprietor. The criterion, according to which use for the purposes of maintaining of a trademark registration must be undertaken by the trademark proprietor or with his express consent, applies here as well.

As commercial use is a criterion for trademark infringement, use by private fan clubs or supporters does not usually constitute trademark infringement. If, however, the fan club expands to merchandising by e.g. printing T-shirts in order to gain profit from this activity, such activity might constitute trademark infringement, usually provided that the trademark is reputed or well known or that the goods and services provided are the same or similar to those of the trademark proprietor.

4.3 *Parody*

Even parodying use of a trademark can, together with other kinds of use (interpreted on a case-by-case basis), be considered to be use “as a mark” for the acquiring of trademark rights through establishment. For the maintenance of marks the use should be undertaken by the proprietor or with his express consent in order for it to be considered use “as a mark”. There is no case law on the subject.

As commercial use is a criterion for trademark infringement, non-commercial parodies cannot constitute infringement (for instance shows, cabarets etc.). Commercial use of a trademark by competitors may probably be seen as use “as a mark” and prohibited as trademark infringement provided that the goods or services are similar or that the trademark is reputed or well known. There is, however, no case law on the subject. Parodying use can also be prohibited as unfair trade practice under the Unfair Trade Practices Act if the use is misleading or takes unfair advantage of the goodwill of another’s trademark.

4.4 *Comparative advertising*

Comparative advertising can, together with other kinds of use (interpreted on a case-by-case basis), be considered to be use “as a mark” for the acquiring of trademark rights through establishment. For the maintenance of marks the use should be undertaken by the

proprietor or with his express consent in order for it to be considered use "as a mark". There is no case law on the subject.

The use of another's trademark in comparative advertising has in case law normally not been considered infringing when the trademark has been used for identification or information purposes. The criteria for when comparative advertising is allowed in general have recently been taken into the Consumer Protection Act (20 January 1978/38, as amended).

Comparative advertising which is misleading or which takes unfair advantage of the goodwill of another's trademark can be prohibited as unfair trade practice under the Unfair Trade Practices Act or the Consumer Protection Act.

5. If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws

As can be read from the above, the concept of use "as a mark" has been interpreted broadly in Finland. Unconventional use may thus fall under the Trademark Act when the infringed trademark is registered or established and the trademark is used by a competitor in the course of trade.

Unconventional use can, however, also be considered objectionable as unfair trade practice under the Unfair Trade Practices Act, providing that the use is misleading or that it takes unfair advantage of the goodwill of another's trademark. According to Section 1 of the Unfair Trade Practices Act, a practice that is in contradiction with fair trade practice or otherwise unfair towards other tradesmen is forbidden in trade. According to Section 2 of the Unfair Trade Practices Act forbidden in trade is also a) an untruthful or misleading statement concerning one's own or another's trade which is likely to have an influence on the demand or supply of a commodity or to injure the trade of another; and b) a statement that is improper with regard to its contents or manner or form of presentation and which is likely to injure the trade of another.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

According to Section 6, Subsection 2 of the Trademark Act, confusing similarity can be referred to regardless of the similarity of goods in favour of a trademark which is reputed in Finland, if the use of the symbol of another without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.

Summary

The Group has not been able to find any comprehensive definitions of use "as a mark" in case law, but only definitions of what does or does not constitute use "as a mark" under certain specific circumstances. A case-by-case interpretation of what is to be considered use "as a mark" must therefore be made according to the individual circumstances of the case.

The Group is of the opinion that the concept of use "as a mark" has been interpreted broadly in Finland. Different kinds of evidence has been admitted by the Patent Office and the courts quite liberally. For instance printed matter, affidavits of use, commercials and use on the Internet has been admitted as evidence of use "as a mark".

Use "as a mark" is, according to the opinion of the Group, in principle assessed according to the same criteria irrespective of whether the question is of acquisition, maintenance or infringement of rights. The required intensity and quality of the use may, however, differ.

In respect of acquisition by establishment the required intensity of use "as a mark" is the most extensive. In respect of maintenance, use "as a mark" by the proprietor or with his consent must have

taken place in relation to the normal scale of commercial activity pursued by the proprietor of the trademark. In respect of infringement it is sufficient that the goods are intended to be offered for sale.

Unconventional use may fall under the Trademark Act when the infringed trademark is registered or established and the trademark is used by a competitor in the course of trade.

The Group has especially noted the following:

- Use on the internet alone, or combined with other kinds of use, can under certain circumstances be considered to be use "as a mark" for the purpose of establishment or maintenance of marks.
- In case of an infringement related to use on the Internet, the rules of Finnish trademark law are applied as in any other case of infringement.
- The Group considers that the commercial use of a competitor's trademark as a metatag may constitute trademark infringement under certain circumstances.
- Trademark infringement through linking and framing can be prohibited under the Unfair Trade Practices Act if the use is misleading or takes unfair advantage of the goodwill of another's trademark. However, in most cases linking or framing may be considered informative use, which is allowed under the Unfair Trade Practices Act.
- As commercial use is a criterion for trademark infringement, use by private fan clubs or supporters does not usually constitute trademark infringement. If, however, the fan club expands to merchandising, such activity might constitute trademark infringement.

Résumé

Le groupe n'a pas pu trouver une définition définitive de l'usage de marque "en tant que marque" dans la jurisprudence, mais seulement des définitions de ce que constitue ou ne constitue pas un usage "en tant que marque" dans certaines circonstances spécifiques. Ainsi, une interprétation au cas par cas de l'usage "en tant que marque" doit être faite selon les circonstances particulières de chaque situation.

Le groupe est d'avis que la notion de l'usage de marque "en tant que marque" a été interprétée de façon extensive. Différents types d'évidences ont été acceptés de façon assez ample par l'office des brevets et les tribunaux. Par exemple, les oeuvres imprimées, les affirmations d'usage (écrites), les annonces publicitaires et l'usage sur l'Internet ont été admises comme des évidences d'usage "en tant que marque".

Pour le groupe, l'usage "en tant que marque" est en principe décelé selon les mêmes critères sans différence entre l'acquisition, le maintien et la contrefaçon de droits. Cependant, l'intensité et la qualité exigés pour l'usage peut varier.

En ce qui concerne l'acquisition par utilisation de la marque, l'intensité exigée pour l'usage "en tant que marque" est la plus ample. En ce qui concerne le maintien de l'usage "en tant que marque" par la propriétaire ou avec son autorisation, une condition est que l'usage aie eu lieu dans le cadre de l'activité commerciale ordinaire réalisée par la propriétaire de la marque. En ce qui concerne la contrefaçon, il est suffisant que les marchandises soient destinées à être vendues.

La loi des marques peut être appliquée dans des cas d'usage non-conventionnel, quand la marque contrefaite est enregistrée ou établie et la marque est utilisée par un concurrent dans le cadre de son activité.

Le groupe particulièrement note comme il suit:

- L'usage seul sur Internet, ou combiné avec d'autres modes d'usage, peut sous certaines conditions être considéré comme un usage "en tant que marque" qui a pour objet établir ou maintenir des marques.

- En cas de contrefaçon concernant l'usage sur Internet, la législation finlandaise de marques est appliquée de façon identique qu'aux autres cas de contrefaçon.
- Le groupe considère que l'usage commercial de la marque d'un concurrent comme un metatag peut être constitutif de contrefaçon sous certaines conditions.
- La contrefaçon de marque à travers les *links* et les *frames* peut être interdite sous la Loi des pratiques déloyales si l'usage peut tromper ou profiter de façon injuste de la clientèle d'une autre marque. Nonobstant, dans la plupart des cas, les *links* et les *frames* sont considérés comme d'usage purement informatif, ce qui est permis sous la Loi des pratiques déloyales.
- Étant donné que l'usage commercial est une des conditions pour qu'il existe contrefaçon, l'usage par des clubs privés de fans ou des supporters ne constitue pas un acte de contrefaçon de marque. Ceci dit, si le club de fans entreprend une activités commerciale comme le *merchandising*, cette activité peut être constitutive d'un acte de contrefaçon.

Zusammenfassung

Die Gruppe konnte für die Rechtspraxis keine umfassenden Definitionen für eine „warenzeichenartige“ Benutzung finden, sondern nur definieren, was unter gewissen spezifischen Umständen eine „warenzeichenartige“ Benutzung darstellt und was nicht. Daher muss in jedem Einzelfall gesondert beurteilt werden, was unter den bestimmten Umständen des betreffenden Falles als „warenzeichenartige“ Benutzung anzusehen ist.

Nach Auffassung der Gruppe wird der Begriff der „warenzeichenartigen“ Benutzung in Finnland breit interpretiert. Das finnische Patentamt und die finnischen Gerichte stehen verschiedenen diesbezüglichen Nachweisen recht liberal gegenüber. So sind als Nachweise für eine „warenzeichenartige“ Benutzung z.B. Drucksachen, eidesstattliche Erklärungen von stattgefunden Benutzungen, Werbungen sowie eine Benutzung im Internet anerkannt worden.

Eine „warenzeichenartige“ Benutzung wird nach Ansicht der Gruppe im Prinzip nach denselben Kriterien beurteilt, handelt es sich denn um Einbürgerung, Aufrechterhaltung oder Verletzung von Rechten. Die Intensität und Qualität der Benutzung kann jedoch unterschiedlich sein.

Für die durch Einbürgerung erzielten Rechte wird die umfassendste Intensität einer „warenzeichenartigen“ Benutzung gefordert. Für die Aufrechterhaltung einer registrierten Marke muss eine „warenzeichenartige“ Benutzung durch den Inhaber, oder mit seiner Zustimmung im Verhältnis zum normalen Umfang der kommerziellen Aktivität des Inhabers des Warenzeichens stattgefunden haben. Für Verletzungen genügt die Absicht, die Waren für den Verkauf anzubieten.

Eine unkonventionelle Benutzung kann unter dem Warenzeichengesetz fallen, wenn das verletzte Warenzeichen registriert worden ist oder sich eingebürgert hat und das Warenzeichen von einem Konkurrenten gewerblich benutzt worden ist.

Die Gruppe hat insbesondere folgendes festgestellt:

- Eine Benutzung im Internet allein, oder zusammen mit Benutzungen anderer Art, kann unter gewissen Umständen als eine „warenzeichenartige“ Benutzung zum Zweck einer Einbürgerung oder Aufrechterhaltung des Schutzrechts angesehen werden.
- Im Fall einer infolge einer Benutzung im Internet erfolgten Verletzung werden die Bestimmungen der finnischen Warenzeichengesetzgebung in der gleichen Weise wie in jedem anderen Verletzungsfall angewandt.
- Die Gruppe ist der Ansicht, dass die kommerzielle Benutzung eines Warenzeichens eines Konkurrenten in Form eines Metatags unter gewissen Umständen eine Warenzeichenverletzung darstellen kann.
- Eine in Form von linking und framing im Internet erfolgte Verletzung kann nach dem Gesetz über unlauteres Verhalten im Gewerbe verboten werden, falls die Benutzung irreführend ist oder einen unlauteren Missbrauch des Geschäftswertes eines Warenzeichens eines anderen darstellt. In den meisten Fällen werden linking und framing jedoch als eine

informative Benutzung angesehen, die nach dem Gesetz über unlauteres Verhalten im Gewerbe zugelassen ist.

- Während eine kommerzielle Benutzung ein Kriterium für die Verletzung eines Warenzeichens darstellt, wird eine Benutzung durch private Funkclubs oder private Anhänger in der Regel nicht als eine Warenzeichenverletzung angesehen. Falls der Funkclub jedoch seine Tätigkeit auf Handel erweitert, könnte eine solche Aktivität eine Warenzeichenverletzung darstellen.

Rapport Q168

au nom du Groupe français
par Grégoire TRIET, Président. Michel ABELLO, Yves BIZOLLON, Delphine Brunet STOCLET,
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L'usage de la marque "en tant que marque" comme condition légale au regard de l'acquisition, du maintien et de la contrefaçon des droits

Position de la question

Le développement des échanges sur Internet a vu apparaître de nombreuses techniques destinées à augmenter la capacité des sites à attirer les visites des internautes.

Parmi ces techniques, on distingue notamment le "linking" qui, par l'existence de liens hypertextes, permet de passer d'un site à un autre, le "framing" qui permet d'insérer dans une fenêtre ("frame") ouverte dans la page d'un site, la page d'un autre site, ou encore les "meta-tag" ou mots-clés insérés dans les codes-sources des sites dans le but de se faire référencer par les moteurs de recherche.

Ces procédés propres au web, et la plupart du temps indispensables à la communication, sont porteurs de risques juridiques.

En effet, les marques sont les premières utilisées à titre de "link", de "framing" ou de "meta-tag" et se pose donc la question de la qualification de ces usages, notamment lorsqu'ils ne sont pas autorisés.

Ces nouveaux usages bouleversent les fonctions traditionnelles connues de la marque d'indication d'origine ou d'identification.

Comment doivent-ils être analysés au regard des conditions classiques d'usage de la marque en tant que marque, qui sont exigées aux différents stades de l'acquisition du droit sur la marque, de son maintien pour éviter la déchéance ou de la contrefaçon?

C'est l'objet de la présente question qui nous demande également de réfléchir à l'application de ces critères à l'usage de la marque par des clubs de fans ou de supporters, à titre de parodie ou dans la publicité comparative.

1. Y a-t-il une nécessité d'utiliser la marque "en tant que marque" dans les cas suivants:

1.1 l'acquisition d'une marque (si, d'après la loi nationale, des droits peuvent être acquis par l'usage);

- a) Sous l'empire de la loi de 1857 qui n'est plus en vigueur depuis le 1^{er} août 1965, il était possible d'acquérir des droits de marque par l'usage. En effet, s'il était nécessaire de déposer la marque pour être opposable aux tiers, ce dépôt n'était que déclaratif et l'usage était générateur de droit, à la condition qu'il s'agisse d'un usage à titre de marque, c'est-à-dire pour identifier et distinguer un produit ou service.
- b) Aujourd'hui, le droit français ne connaît plus l'acquisition du droit de marque par l'usage.

L'article L.712.1 du code de la propriété intellectuelle dispose que *"la propriété de la marque s'acquiert par l'enregistrement"*.

Il n'y a donc pas nécessité d'utiliser la marque en tant que marque pour acquérir des droits sur cette marque.

- c) L'usage est toutefois pris en compte par le droit français pour conférer un caractère distinctif à une marque qui en aurait été dépourvue lors de son enregistrement (article L.711-2 in fine du code précité), sauf dans le cas des signes constitués exclusivement par la forme imposée par la nature ou la fonction du produit, ou conférant à ce dernier sa valeur substantielle.

Aucune définition de la notion d'usage n'est donnée par la loi. La jurisprudence a eu l'occasion de préciser que le signe devait avoir été utilisé à titre de marque et non, par exemple, comme titre d'un ouvrage fut-il publié depuis près de 30 ans. (Paris, 7 mars 1995 - Tout Lyon Annuaire PIBD n° 588 - 15/05/1995).

- d) Enfin, sans que cela constitue un mode d'acquisition d'une marque en France, le droit français combinant l'article 6 bis de la Convention d'Union de Paris, l'article L.713-5 et l'article L.714-4 du code de la propriété intellectuelle et l'article 16.3 des accords ADPIC attribue un effet en France à l'usage de la marque notoire (qui n'est pas une marque déposée et/enregistrée contrairement à la marque de renommée). Ainsi la protection de la marque notoire est-elle une exception à la règle selon laquelle l'enregistrement est seul constitutif de droit.

1.2 *le maintien d'un enregistrement de marque (par exemple contre une action en déchéance pour non-usage)*

a) *Renouvellement*

Le droit français dispose que *"l'enregistrement produit ses effets à compter de la date de dépôt de la demande pour une période de 10 ans indéfiniment renouvelable"* (article L.712-1 du code précité).

Les conditions du renouvellement, énoncées aux articles L.712-9 et R.712.24 et R.712-25 du code précité, ne prévoient pas la nécessité de rapporter la preuve de l'usage de la marque au cours de la période écoulée comme c'est le cas dans certains pays (Etats-Unis notamment).

b) *Déchéance*

En revanche, d'une façon plus générale, la loi française impose l'usage sérieux de la marque *"pour les produits et services visés dans l'enregistrement"* pendant une période ininterrompue de cinq ans pour échapper à la perte du droit sur la marque que constitue la déchéance des droits de son propriétaire.

La loi exige un "usage sérieux" mais cette notion n'est pas définie.

La jurisprudence paraît plutôt définir la notion d'usage par référence aux fonctions traditionnelles de la marque:

"Il est constant que la marque sert à identifier le produit ou le service auprès de la clientèle et qu'un usage du signe à un titre autre que celui attaché à la fonction de la marque ne peut être retenu comme constituant un usage sérieux à titre de marque" (Paris, 15 janvier 1999, PIBD 1999 n° 674 III 172).

Ou encore:

"il ne saurait y avoir exploitation d'une marque que si le signe déposé comme tel remplit sa fonction qui est de distinguer des produits"

*offerts en vente soit qu'il soit **apposé** sur eux soit que tout au moins il accompagne la mise à disposition du public dans des conditions **ne laissant aucun doute sur ladite fonction**". (Paris, 25 mai 1989, PIBD n° 466-III-599).*

A contrario, une utilisation seulement à titre d'enseigne ou de nom commercial, c'est-à-dire pas en relation avec les produits ou services, est insuffisante.

On précisera enfin que, dans le cadre de la procédure française d'opposition, le titulaire de la demande d'enregistrement contesté peut *"inviter l'opposant à produire des pièces propres à établir que la déchéance de ses droits pour défaut d'exploitation n'est pas encourue"* (Article R.712-17).

Toutefois, l'INPI n'examine pas la réalité de cet usage.

Au contraire, l'OHMI (sur la base de l'article 43(2) et (3) du Règlement n° 40/94 et de l'article 22 (2) du Règlement n° 2868/95) se livre à une analyse rigoureuse des preuves d'usage qui lui sont communiquées pour chacun des produits et services et rejette l'opposition si elle est basée sur une marque non exploitée depuis plus de cinq ans (décision n° 118/2000 du 28/01/2000). L'OHMI se réfère à la fonction traditionnelle de la marque de désignation des produits et services.

c) *Tolérance*

Enfin, l'article L 716-5 du Code de la Propriété Intellectuelle dispose qu'est *"irrecevable toute action en contrefaçon d'une marque postérieure enregistrée dont l'usage a été toléré pendant cinq ans à moins que son dépôt n'ait été effectué de mauvaise foi. Toutefois, l'irrecevabilité est limitée aux seuls produits et services pour lesquels l'usage a été toléré"*.

Cette disposition permet à la marque seconde qui n'était pas disponible au moment de son dépôt, d'acquérir une validité.

L'usage exigé dans ce cas constitue également un usage en tant que marque.

1.3 *La condition pour qu'il y ait contrefaçon*

La contrefaçon est définie en France de façon très générale par *"l'atteinte portée aux droits du propriétaire de la marque"* (article L.716-1).

a) *Pas de définition légale de l'usage*

La loi fait référence à la notion d'usage lorsqu'elle énumère les violations des interdictions constitutives de la contrefaçon.

Ainsi, tout d'abord, l'article L.713-2 utilise par deux fois le terme "usage":

"Sont interdits, sauf autorisation du propriétaire:

- a) *la reproduction, **l'usage** ou l'apposition **d'une marque**, même avec l'adjonction de mots tels que: "formule, façon, système, imitation, genre, méthode", ainsi que **l'usage d'une marque reproduite** pour des produits ou services identiques à ceux désignés dans l'enregistrement."*

L'article L.713-3 relatif, d'une part à la reproduction de la marque pour des produits et services similaires de la marque et, d'autre part, à l'imitation, est formulé façon tout à fait comparable puisque sont interdits:

- "a) *La reproduction, l'usage, ou l'apposition d'une marque, ainsi que l'usage d'une marque reproduite, pour des produits ou services similaires à ceux désignés dans l'enregistrement;*
- b) *L'imitation d'une marque et l'usage d'une marque imitée, pour des produits ou services identiques ou similaires à ceux désignés dans l'enregistrement."*

La loi française ne définit pas l'usage. Elle n'a notamment pas transposé littéralement l'article 5 de la Directive n° 89-104 du 21 décembre 1988 qui caractérisait de façon plus précise la notion d'usage par référence à la vie des affaires.

"Art. 5 - Droits conférés par la marque

- 1. *La marque enregistrée confère à son titulaire un droit exclusif. Le titulaire est habilité à interdire à tout tiers, en l'absence de son consentement, de faire usage, dans la vie des affaires:*
 - a) *d'un signe identique à la marque pour des produits et services identiques à ceux pour lesquels celle-ci est enregistrée;*
 - b) *d'un signe pour lequel, en raison de son identité ou de sa similitude avec la marque et en raison de l'identité ou de la similitude des produits ou des services couverts par la marque et le signe, il existe, dans l'esprit du public, un risque de confusion qui comprend le risque d'association entre le signe et la marque".*

Quant à la marque de renommée, la loi française diffère de la Directive dans les mêmes conditions que celles vues plus haut pour la contrefaçon. Alors que la Directive prévoit que le titulaire de la marque de renommée est habilité à interdire à tout tiers, en l'absence de son consentement "*de faire usage dans la vie des affaires*" de sa marque de renommée (Directive précitée article 5-2), l'article français, qui ne reprend d'ailleurs pas le terme "usage" mais lui préfère celui d'emploi, ne le qualifie pas mieux.

b) *Une conception jurisprudentielle extensive de la notion d'usage*

En l'absence de référence à la vie des affaires, la jurisprudence française traditionnelle sanctionne de façon très large l'usage d'une marque contrefaite, sans exiger que celle-ci soit utilisée en tant que marque. Cette attitude est la conséquence de la conception française du caractère absolu du droit de marque.

C'est ainsi que la jurisprudence française traditionnelle considère que le simple dépôt de marque, même si celle-ci n'a jamais été exploitée, constitue un acte de contrefaçon.

L'usage peut être écrit ou oral.

L'usage de la marque à titre de nom commercial ou d'enseigne constitue également un usage interdit. Pour autant, cet usage n'est pas assimilé juridiquement à un usage "*à titre de marque*".

De la même façon, la reproduction d'une marque dans un dictionnaire ou dans un article de journal, c'est-à-dire dans un contexte non commercial, est susceptible d'entraîner une condamnation, lorsque son emploi est générique (exemple: "*un jean de type 501*" Paris 1^{er} juillet 1998 - PIBD 662.III.486 et à propos d'un article intitulé "*Le caddie est responsable de 7.000 accidents par an*" TGI Paris 29 octobre 1997 - PIBD 1998 n° 648.III.119.Caddie)

Dans ces cas particuliers, la responsabilité de l'auteur de l'article ou de la définition pourrait être recherchée, non pas sur le terrain de la contrefaçon, mais sur celui de la responsabilité civile pure dans la mesure où son article ou sa définition risque d'entraîner la dégénérescence de la marque. Cependant, le groupe français a jusqu'à présent considéré que la contrefaçon était plus appropriée car elle dispensait le titulaire de la marque de démontrer la faute.

En revanche, la loi française permet l'usage d'une marque comme référence nécessaire pour indiquer la destination d'un produit ou service (art. 713-6 du CPI). Ce principe a été récemment appliqué au nom de domaine "jeboycottedanone.com" (TGI Paris 3° ch. 1° s. 4 juillet 2001).

Par ailleurs, un important mouvement jurisprudentiel décide que n'est pas considéré comme un usage à titre de marque l'usage d'un mot déposé à titre de marque lorsque ce mot est employé dans son sens courant: *"le droit des marques pour étendu qu'il soit, ne saurait cependant conduire à prohiber l'usage normal par des tiers de mots du langage courant"* (Versailles 13 juillet 1994 et Cassation - 26 novembre 1996 Philip Morris/Action).

2. Y a-t-il une définition de l'usage "en tant que marque", dans la législation ou la jurisprudence?

La loi française ne définit pas l'usage en tant que marque.

La jurisprudence utilise fréquemment cette expression, la plupart du temps pour évoquer les fonctions traditionnelles de la marque.

On peut par exemple citer la décision suivante de la Cour d'appel de Paris:

"Il ne saurait y avoir exploitation d'une marque que si le signe déposé comme tel remplit sa fonction qui est de distinguer des produits offerts en vente soit qu'il soit apposé sur eux soit que tout au moins il accompagne la mise à disposition du public dans des conditions ne laissant aucun doute sur ladite fonction" (Paris, 25 mai 1989; BIBD 1989 n° 466 III 599).

Ainsi, l'usage "en tant que marque", s'il n'exige pas nécessairement que la marque soit reproduite sur le produit lui-même implique cependant qu'il soit employé pour présenter ou accompagner l'offre ou la vente de ce produit ou service.

Il en va ainsi par exemple des actes de publicité pour les produits ou services.

3. Y a-t-il une différence dans l'évaluation de l'usage "en tant que marque" entre l'acquisition, le maintien et la contrefaçon des droits?

La notion d'usage en tant que marque n'étant pas prise en compte pour l'acquisition des droits, nous nous contenterons d'examiner les différences susceptibles d'exister entre le maintien et la contrefaçon des droits.

a) *Evaluation de l'usage "en tant que marque" pour le maintien des droits*

Il ressort de l'examen de la jurisprudence française que l'usage requis pour qu'un titulaire de marque puisse conserver ses droits sur son titre combine les trois éléments suivants:

- la marque doit avoir été utilisée effectivement pour chacun des produits et services visés à l'enregistrement; la notion de similarité utilisée en matière de contrefaçon ne s'applique pas en matière de déchéance;
- cet usage doit avoir été sérieux et la jurisprudence examine la matérialité et la réalité de l'utilisation invoquée; l'article 12.1 de la Directive admet que le

commencement d'usage ou les préparatifs pour le commencement prouvés avant la demande en déchéance peuvent constituer des actes d'usage.

- ledit usage doit être intervenu "à titre de marque", la jurisprudence faisant référence à la fonction traditionnelle de la marque (voir jurisprudence précitée 1.2).

b) *Evaluation de l'usage "en tant que marque" pour la contrefaçon de droits*

Comme on l'a vu plus haut (supra 1.3), la jurisprudence française appréhende de façon très extensive la notion d'usage lorsqu'elle aborde la question de la contrefaçon.

Deux différences apparaissent avec la notion d'usage abordée sous l'angle du maintien des droits:

- la notion d'usage sérieux n'est pas prise en compte pour caractériser la contrefaçon; un acte unique, isolé, suffit;
- l'usage ne doit pas nécessairement avoir eu lieu "en tant que marque", ainsi que le démontre la jurisprudence relative aux articles de journaux et aux dictionnaires. Un usage à titre d'enseigne ou de dénomination sociale est également pris en compte.

4. Est-ce que l'un des faits suivants est considéré comme usage "en tant que marque"

4.1 *l'usage sur Internet, comme "meta-tag", comme lien hypertexte ("linking") ou "framing"*

4.1.1 **Meta-tag**

a) *Définitions*

Un site Internet peut être interrogé soit directement en composant son adresse lorsque celle-ci est connue, soit par l'utilisation d'annuaires thématiques, également appelés portails, ou de moteurs de recherches. Dans la pratique, ces moteurs de recherche jouent un rôle essentiel. Techniquement, ces derniers sont des robots qui effectuent leurs recherches par mots-clés. Les internautes les interrogent en indiquant un ou plusieurs termes en rapport avec le sujet qui les intéresse.

Le succès d'une entreprise présente sur Internet dépend donc de la qualité des informations qu'elle intègre dans ses pages web pour lui permettre d'obtenir un référencement optimum par le plus grand nombre de moteurs de recherches et de générer ainsi vers son site du trafic.

Ce référencement est notamment obtenu par les meta-tags ou meta-name.

Un meta-tag est une donnée, ou un ensemble de mots-clés, invisibles pour le public, insérés dans le contenu d'une page web du titulaire du site, c'est-à-dire dans son code source, permettant le référencement automatique du site pour les utilisateurs. En général, le titulaire d'un site utilise comme mots-clés non seulement ses propres marques, mais aussi tout un vocabulaire rappelant l'univers de son activité.

Certains n'hésitent pas à utiliser comme mots-clés des marques appartenant à des tiers.

Lorsqu'une requête est adressée au moteur de recherche, celui-ci va faire référence au site du titulaire de la marque, mais aussi au site tiers reproduisant la marque en tant que meta-tag dans son code source.

b) *Un tel usage constitue-t-il un usage à titre de marque?*

α **Maintien des droits**

La loi française ne répond pas à cette question.

Dans la mesure où le meta-tag est invisible pour le consommateur, le groupe français est d'avis qu'il ne peut, seul, permettre de maintenir les droits sur la marque.

β La contrefaçon

Sans répondre explicitement à la question, la jurisprudence a sanctionné, au titre de la contrefaçon de marque, l'usage du signe à titre de meta-tag. On peut citer ainsi un jugement récent de la 3^{ème} Chambre du Tribunal de grande instance de Paris:

"● Sur la contrefaçon par meta-tags reproduisant les marques de la société Levi Strauss & Co.:

Attendu que pour améliorer la lisibilité de son site, la société Discom utilise des "meta-tags" constituant la reproduction ou l'imitation des marques appartenant à la société Levi Strauss & Co. tels que: "Levi's", "Lewis", "501", "505", "551", "525", "515", "595";

Attendu que ces "meta-tags" sont des mots-clés invisibles, intégrés par le concepteur du site dans ses pages web, et qui sont explorés par les moteurs de recherche, afin de leur permettre de procéder à l'indexation des sites;

Que lorsqu'un internaute effectue une recherche sur un moteur en tapant le mot clé "LEVI'S", le moteur de recherche le connectera automatiquement sur le site "levisdiscount" ou "lewisdiscount" dont les pages contiennent de nombreux meta-tags "LEVI'S";

Attendu que l'utilisation sous cette forme des termes "LEVI'S" et du nombre "501" non autorisée par la société LEVI STRAUSS & CO. constituent la contrefaçon desdites marques protégées au sens de l'article L.713.2 du Code de la propriété intellectuelle;" (TGI Paris, 3^o ch. 1^o s. 27 septembre 2000, Levi Strauss/Discom).

Un autre jugement du Tribunal de grande instance de Paris a jugé dans le même sens en précisant:

"Attendu que le fait d'utiliser ces marques à titre de mots-clés sur sa page source pour faire en sorte que tout internaute consultant le réseau Internet et effectuant une recherche à partir de ces mots se voit nécessairement proposer le site de la société SFR implique que cette reprise des marques Itinérés ou Mobicarte permet l'accès à un site Internet et donc sa désignation;

[...]

Attendu qu'aucune considération relative à l'informatique, la téléphonie ou la télématique ne justifie l'usage de ces vocables par la société SFR; qu'aucune nécessité technique n'impose de faire figurer ceux-ci à titre de mots-clés; que les marques Itinérés ou Mobicarte ne sont en aucun cas devenues descriptives ou génériques;" (TGI Paris, 3^o ch. 3^o s., 16/11/1999 France Telecom/SFR).

c) Le groupe français considère que l'utilisation de marques tierces à titre de meta-tag doit pouvoir être poursuivie selon les critères habituels de la contrefaçon.

Tout usage non autorisé de la marque doit par principe constituer un acte de contrefaçon.

Par exception sont licites, l'usage d'un terme dans son sens courant, fut-il déposé à titre de marque, l'usage par le distributeur de la marque des produits qu'il vend et, en application de la règle de spécialité, l'usage d'une marque non notoire pour des produits et services ni identiques, ni similaires, à ceux couverts par la marque.

La première et la dernière exceptions sont bien évidemment applicables aux meta-tags. La deuxième, relative à la libre utilisation que le distributeur d'un produit peut faire de la marque apposée sur le produit est plus discutable.

En effet, contrairement à l'utilisation de la marque dans la publicité, qui est admise en jurisprudence, le meta-tag n'est pas directement visible par le consommateur.

Par ailleurs, compte tenu de la spécificité du réseau Internet, il est probable que sera plus largement prise en compte pour échapper à la contrefaçon l'absence de caractère commercial ou l'utilisation de la marque à des fins d'information.

4.1.2 Les liens hypertextes ("linking")

a) Définitions

Les liens hypertextes permettent de naviguer ou de surfer d'un document à un autre. Pour cela, il suffit de cliquer sur le lien. Cette technique diffère fondamentalement du meta-tag puisque, d'une part, le lien est visible (généralement le signe utilisé à titre de lien est d'une couleur différente de celle de l'ensemble du texte, ou réagit différemment lorsque la flèche de la souris se positionne dessus) et, d'autre part, il suppose une démarche volontaire de l'internaute qui ne clique sur le lien que s'il est intéressé.

Il existe principalement deux catégories de liens:

- le lien hypertexte simple
- le lien hypertexte en profondeur.

Le lien hypertexte simple relie une page quelconque d'un site à la page d'accueil d'un autre site. La visibilité du transfert sur le deuxième site est donc totale.

Le lien hypertexte en profondeur, en revanche, entraîne l'internaute vers une page secondaire du deuxième site sans passer par la page d'accueil.

b) De tels usages constituent-ils un usage à titre de marque?

La loi française ne répond pas non plus à cette question.

α Maintien des droits

Le groupe français distingue selon que le lien est autorisé ou non par le titulaire de la marque.

S'il est autorisé, le groupe est d'avis que cette utilisation peut permettre de maintenir les droits sur la marque à la condition que cette utilisation réponde à la définition classique d'usage sérieux à titre de marque pour désigner une offre réelle de produits ou services.

Dans le cas contraire, le groupe français considère que l'usage non autorisé ne permet pas au titulaire de maintenir ses droits.

β La contrefaçon

La jurisprudence, sans répondre positivement à la question, a sanctionné au titre de la contrefaçon de marque l'usage du signe à titre de lien. Le Tribunal de grande instance de Paris vient en effet de juger:

*"Attendu que la société Keljob reproduit sur son site, qui sélectionne selon certains critères des offres provenant d'autres sites, la marque Cadrem-ploi;
[...]"*

Attendu qu'en reproduisant ainsi sans autorisation, dans le cadre de son service de sélection d'offres d'emploi, la marque dont la société Cadremploi est titulaire, la société Keljob commet des actes de contrefaçon prohibés par l'article L.713-3 du Code de la Propriété Intellectuelle;

Que cette exploitation est bien effectuée à des fins commerciales, et non dans le seul but désintéressé d'informer l'utilisateur;

Que la société Keljob tire ainsi profit de la réputation de sérieux de la marque Cadremploi;

[...]

qu'elle ne se borne pas à citer la marque comme elle pourrait l'être dans un guide, mais l'utilise dans le cadre d'une activité de recensement et de sélection d'offres d'emploi directement concurrente de celle exercée par la demanderesse, et couverte par l'enregistrement de la marque invoquée". (TGI Paris, 3^o ch. 1^o s. 5 septembre 2001 - Cadremploi/Keljob).

La distinction qui semble être opérée par le Tribunal est la suivante:

- le lien hypertexte permettant la reproduction d'une marque tierce est constitutif de contrefaçon lorsqu'il participe d'un objectif commercial;
- ce même lien hypertexte ne serait pas illicite lorsqu'il serait mis en place dans le seul but d'informer l'utilisateur.

On mentionnera que plusieurs décisions rendues en référé ont refusé d'entrer en voie de condamnation en considérant que les principes de fonctionnement d'Internet impliquaient nécessairement que des liens hypertextes et intersites puissent être effectués librement, en particulier lorsque ce lien aboutit sur la page d'accueil du deuxième site. (Tribunal de Commerce de Nanterre, 8 novembre 2000, Stepstone/Ofir).

Le point d'arrivée du lien hypertexte paraît avoir une certaine importance. Ainsi la décision Cadremploi précitée n'a pas suivi le demandeur sur le terrain connexe de la concurrence déloyale au motif que le site auquel le lien permettait d'aboutir était clairement identifiable:

"Attendu qu'en l'espèce l'utilisateur [du lien hypertexte] est averti par une page écran intermédiaire qu'il est mis en relation avec le site Cadremploi, qui est clairement identifié;

Qu'il se retrouve ensuite sur le site Cadremploi sur lequel il peut poursuivre sa navigation si bon lui semble;

[...]

Qu'il n'existe aucun risque de confusion dans l'esprit de l'utilisateur entre les deux sites".

c) En conclusion, le groupe français est d'avis que l'usage à titre de lien hypertexte d'une marque tierce est répréhensible notamment lorsque:

- le lien utilisant la marque tierce s'inscrit dans la vie des affaires;
- le lien porte atteinte à la marque tierce.

4.1.3 "Framing"

a) Le "framing" consiste à insérer dans l'un des cadres d'un site une page d'un deuxième site.

Ainsi, les informations d'un deuxième site sont en quelque sorte intégrées dans un premier.

Cette pratique est une variante de l'insertion par lien déjà étudiée. Toutefois, en l'espèce, une page entière d'un deuxième site apparaît dans une fenêtre du premier site en dehors du cadre normal. L'utilisateur verra sur son écran une portion du site second intégrée dans le site premier, sans qu'il puisse réaliser qu'il s'agit de deux sites distincts.

b) Un tel usage constitue-t-il un usage à titre de marque?

Là encore, la loi française ne répond pas à la question.

c) A la connaissance du groupe français, la jurisprudence ne s'est pas penchée sur la question.

Les mêmes conditions que celles examinées pour les liens hypertextes devraient toutefois être appliquées.

4.2 *L'usage par des clubs de "fans" ou de supporters*

L'usage d'une marque par un club de fans ou de supporters ne fait l'objet d'aucune disposition dans la Loi et n'a pas, à la connaissance du groupe français, donné lieu à des décisions en France.

α **maintien des droits**

Si l'usage de la marque par un club de fans ou de supporters est autorisé par le titulaire de la marque, et si celle-ci est effectivement utilisée pour désigner les produits et services visés à l'enregistrement, le groupe français est d'avis que cet usage peut permettre le maintien des droits du titulaire.

β **La contrefaçon**

Le groupe français est d'avis que l'usage de la marque par des clubs de fans ou de supporters devrait pouvoir échapper à la qualification d'usage à titre de marque répréhensible notamment lorsque, au minimum, les deux conditions suivantes sont réunies:

- la marque est utilisée en dehors de la vie des affaires,
- et l'usage est limité à une référence nécessaire au club, à la personne ou au produit (film, etc ...) auquel est consacré le site.

4.3 *La parodie*

Contrairement au droit d'auteur, qui connaît l'exception de parodie, reconnue à l'art L.122-5-4 du Code de la propriété intellectuelle, la loi française relative aux marques l'ignore. La solution est logique. En effet, la parodie trouve plus facilement vocation à s'appliquer à une œuvre de l'esprit qu'à une marque.

La jurisprudence dominante refuse d'admettre cette exception de parodie en matière de marque.

Toutefois, le groupe français est d'avis que l'exception de parodie pourrait être opposée au droit de marque lorsque, notamment:

- l'usage a lieu en dehors de la vie des affaires,
- l'usage n'est pas constitutif d'un abus,
- l'intention de l'utilisateur est effectivement humoristique.

4.4 *La publicité comparative*

- a) La publicité comparative a été admise en France par l'article 10 de la Loi du 18 janvier 1992 codifiée ensuite aux articles L.121-8 à L.121-14 du Code de la Consommation.

Une directive européenne d'harmonisation est ensuite intervenue le 6 octobre 1997.

La France vient tout juste de transposer les termes de cette Directive en droit interne par une Ordonnance du 23 août 2001, modifiant les dispositions du Code de la Consommation.

L'article L.121-9 modifié du Code de la Consommation dispose dorénavant:

"La publicité comparative ne peut:

1° Tirer indûment profit de la notoriété attachée à une marque de fabrique, de commerce ou de service, à un nom commercial, à d'autres signes distinctifs d'un concurrent ou à l'appellation d'origine ainsi qu'à l'indication géographique protégée d'un produit concurrent;

2° Entraîner le discrédit ou le dénigrement des marques, noms commerciaux, autres signes distinctifs, biens, services, activité ou situation d'un concurrent;

3° Engendrer de confusion entre l'annonceur et un concurrent ou entre les marques, noms commerciaux, autres signes distinctifs, biens ou services de l'annonceur et ceux d'un concurrent;

4° Présenter des biens ou des services comme une imitation ou une reproduction d'un bien ou d'un service bénéficiant d'une marque ou d'un nom commercial protégé".

Le nouveau texte apparaît donc plus protecteur des intérêts du propriétaire de la marque par rapport à l'ancien texte qui exigeait que la comparaison n'est pas *"pour objet principal de tirer avantage de la notoriété attachée à une marque"*.

- b) L'article L.121-14 du Code de la Consommation, sur les sanctions applicables, renvoie directement, outre à l'article 1382 du Code Civil, aux sanctions pénales prévues en cas de contrefaçon de marque par les articles L.716-9 et L.716-12 du Code de la Propriété Intellectuelle.

De l'article L.121-9, il résulte que ne sont pas seulement visés les usages en tant que marque mais toute atteinte susceptible d'être portée aux différents signes distinctifs du concurrent.

5. Si, d'après le régime national du groupe, l'usage comme marque est confiné aux indications traditionnelles d'origine ou d'identification, des usages non conventionnels sont-ils néanmoins punissables de par la loi sur les marques ou d'autres lois (par exemple les lois sur la concurrence déloyale ou sur les pratiques du commerce)?

5.1 Comme on l'a vu plus haut, le droit français ne se limite pas à une sanction de l'usage d'une marque "à titre de marque", confiné aux indications traditionnelles d'origine ou d'identification.

C'est notamment le cas lorsque sont sanctionnés:

- l'utilisation illicite d'une marque dans un article du journal, une définition de dictionnaire, un meta-tag;
- une imitation dans un site Internet appelant à boycotter une marque, dès lors qu'aucune exception ne peut être invoquée;
- un simple dépôt de marque, sans aucun usage;
- l'usage d'une marque à titre d'enseigne ou de nom commercial.

5.2 *Cette approche extensive de la notion d'usage de la marque constitutif de contrefaçon n'exclut pas le recours à d'autres notions juridiques.*

Ainsi, la jurisprudence a eu l'occasion de sanctionner l'utilisation non autorisée des informations contenues dans un site sur le terrain de la protection des bases de données (jugement Cadremploi précité page 13).

Par ailleurs, les principes relatifs à la concurrence déloyale restent pleinement applicables pour faire sanctionner les atteintes qui ne relèvent pas du droit des marques.

6. **Si l'usage "en tant que marque" dans le sens traditionnel est requis pour établir la contrefaçon, est-ce que les marques "de haute renommée", "célèbres", "notoires" ou "jouissant d'une réputation" utilisées sur des produits et services différents sont protégées?**

Comme on l'a vu, l'usage "en tant que marque" n'est pas nécessaire pour établir la contrefaçon.

Le champ de protection de la marque notoire et de renommée est plus large que celui des seuls produits ou services identiques ou similaires (sans pour autant être illimité) pour lesquels la marque non notoire est protégée.

Au-delà de cette différence de champ de protection, la matérialité de l'emploi injustifié de la marque notoire et de renommée n'est pas appréhendée de façon différente de celle de l'usage de la marque non notoire.

Il convient toutefois de souligner que le texte français relatif aux marques notoires et de renommée n'utilise pas le terme "usage" mais celui d'emploi.

Cette différence de vocabulaire a eu un impact redoutable et au demeurant critiquable sur l'appréciation de l'atteinte à la marque notoire, la jurisprudence française ayant récemment décidé que seule la reproduction à l'identique de la marque notoire serait illicite, mais pas son imitation (Olymprix Cass. Com. 29 juin 1999 - Dalloz 24 février 2000 p. 186; Paris, 1^o ch. aud. sol. 8 novembre 2000 JCP 2001, n^o 5, p. 228).

Le groupe français est d'avis que la notion d'emploi d'une marque notoire et de renommée ne devrait pas différer de celle d'usage utilisée pour les marques non notoires. En d'autres termes, l'emploi injustifié d'une marque notoire et de renommée devrait permettre de réprimer tant sa reproduction que son imitation.

Résumé

1. **Y a-t-il une nécessité d'utiliser la marque "en tant que marque" dans les cas suivants:**

1.1 *L'acquisition d'une marque (si, d'après la loi nationale, des droits peuvent être acquis par l'usage);*

- Le droit français ne connaît plus l'acquisition du droit de marque par l'usage. L'article L.712.1 du code de la propriété intellectuelle dispose que "*la propriété de la marque s'acquiert par l'enregistrement*". Il n'y a donc pas nécessité d'utiliser la marque en tant que marque pour acquérir des droits sur cette marque.
- Par exception, l'usage est pris en compte pour conférer un caractère distinctif à une marque qui en aurait été dépourvue lors de son enregistrement et pour attribuer un effet en France à une marque notoire.

1.2 *Le maintien d'un enregistrement de marque (par exemple contre une action en déchéance pour non-usage)*

- Au moment du renouvellement de la marque, l'usage n'est pas pris en compte.
- En revanche, la loi française impose au propriétaire de la marque un usage sérieux de la marque "*pour les produits et services visés dans l'enregistrement*" pendant une période ininterrompue de cinq ans pour échapper à la perte du droit sur la marque.

La jurisprudence paraît plutôt définir la notion d'usage par référence aux fonctions traditionnelles de la marque. Une utilisation à titre d'enseigne ou de nom commercial est insuffisante.

- Enfin, le titulaire d'une marque ne peut agir en contrefaçon à l'encontre d'une marque postérieure dont il a été toléré l'usage pendant cinq ans, à moins que le deuxième dépôt n'ait été effectué de mauvaise foi. L'action est limitée aux seuls produits et services pour lesquels l'usage a été toléré. L'usage exigé dans ce cas constitue également un usage en tant que marque.

1.3 La condition pour qu'il y ait contrefaçon

- La contrefaçon est définie de façon très générale par "l'atteinte portée aux droits du propriétaire de la marque". La loi fait référence à la notion "d'usage" lorsqu'elle énumère les violations des interdictions constitutives de la contrefaçon.
- La jurisprudence sanctionne de façon très large l'usage d'une marque contrefaite, sans exiger que celle-ci soit utilisée en tant que marque.

Ainsi, le simple dépôt de marque, même si celle-ci n'a jamais été exploitée, constitue un acte de contrefaçon. L'usage peut être écrit ou oral. L'usage de la marque à titre de nom commercial ou d'enseigne constitue également un usage interdit.

La reproduction d'une marque dans un dictionnaire ou dans un article de journal, c'est-à-dire dans un contexte non commercial, est susceptible d'entraîner une condamnation, lorsque son emploi est générique.

En revanche, la loi française permet l'usage d'une marque comme référence nécessaire pour indiquer la destination d'un produit ou service. De même, l'usage d'un mot déposé à titre de marque est licite lorsque ce mot est employé dans son sens courant.

2. Y a-t-il une définition de l'usage "en tant que marque", dans la législation ou la jurisprudence?

La loi française ne définit pas l'usage en tant que marque. La jurisprudence utilise fréquemment cette expression, la plupart du temps pour évoquer les fonctions traditionnelles de la marque. L'usage "*en tant que marque*", s'il n'exige pas nécessairement que la marque soit reproduite sur le produit lui-même implique cependant qu'il soit employé pour présenter ou accompagner l'offre ou la vente de ce produit ou service.

3. Y a-t-il une différence dans l'évaluation de l'usage "en tant que marque" entre l'acquisition, le maintien et la contrefaçon des droits?

La notion d'usage en tant que marque n'étant pas prise en compte pour l'acquisition des droits, nous nous contenterons d'examiner les différences susceptibles d'exister entre le maintien et la contrefaçon des droits.

• Evaluation de l'usage "en tant que marque" pour le maintien des droits

L'usage requis pour qu'un titulaire de marque puisse conserver ses droits sur son titre suppose que la marque ait été utilisée effectivement pour chacun des produits et services visés à l'enregistrement, que cet usage soit sérieux, et qu'il soit intervenu "à titre de marque", la jurisprudence faisant référence à la fonction traditionnelle de la marque.

- **Evaluation de l'usage "en tant que marque" pour la contrefaçon de droits**

Comme on l'a vu plus haut (supra 1.3), la jurisprudence française appréhende de façon très extensive la notion d'usage lorsqu'elle aborde la question de la contrefaçon. Deux différences apparaissent avec la notion d'usage abordée sous l'angle du maintien des droits:

- la notion d'usage sérieux n'est pas prise en compte pour caractériser la contrefaçon; un acte unique, isolé, suffit;
- l'usage ne doit pas nécessairement avoir eu lieu "en tant que marque";

4. Est-ce que l'un des faits suivants est considéré comme usage "en tant que marque":

4.1 *L'usage sur Internet, comme "meta-tag", comme lien hypertexte ("linking") ou "framing"*

4.1.1 ***L'usage à titre de meta-tag constitue-t-il un usage à titre de marque?***

- α **Maintien des droits.** La loi française ne répond pas à cette question. Dans la mesure où le meta-tag est invisible pour le consommateur, le groupe français est d'avis qu'il ne peut, seul, permettre de maintenir les droits sur la marque.
- β **La contrefaçon.** La jurisprudence a sanctionné, au titre de la contrefaçon de marque, l'usage du signe à titre de meta-tag.

Le groupe français considère que l'utilisation de marques tierces à titre de meta-tag doit pouvoir être poursuivie selon les critères habituels de la contrefaçon.

4.1.2 ***L'usage à titre de lien hypertexte ("linking") constitue-t-il un usage à titre de marque?***

La loi française ne répond pas non plus à cette question.

- α **Maintien des droits.** Le groupe français distingue selon que le lien est autorisé ou non par le titulaire de la marque. S'il est autorisé, le groupe est d'avis que cette utilisation peut permettre de maintenir les droits sur la marque à la condition que cette utilisation réponde à la définition classique d'usage sérieux à titre de marque pour désigner une offre réelle de produits ou services. Dans le cas contraire, le groupe français considère que l'usage non autorisé ne permet pas au titulaire de maintenir ses droits.
- β **La contrefaçon.** La jurisprudence a sanctionné au titre de la contrefaçon de marque l'usage du signe à titre de lien hypertexte.

Le groupe français est d'avis que l'usage à titre de lien hypertexte d'une marque tierce est répréhensible notamment lorsque le lien utilisant la marque tierce s'inscrit dans la vie des affaires et/ou le lien porte atteinte à la marque tierce.

4.1.3 ***L'usage à titre de "framing" constitue-t-il un usage à titre de marque?***

La loi française ne répond pas à la question et la jurisprudence ne s'est pas penchée sur la question. Les mêmes conditions que celles examinées pour les liens hypertextes devraient toutefois être appliquées.

4.2 *L'usage par des clubs de "fans" ou de supporters*

L'usage d'une marque par un club de fans ou de supporters ne fait l'objet d'aucune disposition dans la Loi et n'a pas donné lieu à des décisions en France.

- α **Maintien des droits.** Si l'usage de la marque par un club de fans ou de supporters est autorisé par le titulaire de la marque, et si celle-ci est effectivement utilisée pour désigner les produits et services visés à l'enregistrement,

le groupe français est d'avis que cet usage peut permettre le maintien des droits du titulaire.

- β **La contrefaçon.** Le groupe français est d'avis que l'usage de la marque par des clubs de fans ou de supporters devrait pouvoir échapper à la qualification d'usage à titre de marque répréhensible notamment lorsque, au minimum, les deux conditions suivantes sont réunies: la marque est utilisée en dehors de la vie des affaires, et l'usage est limité à une référence nécessaire au club, à la personne ou au produit (film, etc ...) auquel est consacré le site.

4.3 *La parodie*

Contrairement au droit d'auteur, qui connaît l'exception de parodie, la loi française relative aux marques l'ignore. La jurisprudence dominante refuse d'admettre cette exception de parodie en matière de marque.

Toutefois, le groupe français est d'avis que l'exception de parodie pourrait être opposée au droit de marque lorsque, notamment:

- l'usage a lieu en dehors de la vie des affaires,
- l'usage n'est pas constitutif d'un abus,
- l'intention de l'utilisateur est effectivement humoristique.

4.4 *La publicité comparative*

Selon une directive européenne d'harmonisation du 6 octobre 1997 et une Ordonnance du 23 août 2001, la publicité comparative ne peut tirer indûment profit de la notoriété attachée à une marque, entraîner le discrédit ou le dénigrement des marques ou engendrer de confusion au détriment d'une marque tierce.

Ne sont pas seulement visés les usages en tant que marque mais toute atteinte susceptible d'être portée aux différents signes distinctifs du concurrent.

5. **Si, d'après le régime national du groupe, l'usage comme marque est confiné aux indications traditionnelles d'origine ou d'identification, des usages non conventionnels sont-ils néanmoins punissables de par la loi sur les marques ou d'autres lois (par exemple les lois sur la concurrence déloyale ou sur les pratiques du commerce)?**

L'approche française extensive de la notion d'usage de la marque constitutif de contrefaçon n'exclut pas le recours à d'autres notions juridiques. Notamment, les principes relatifs à la concurrence déloyale restent pleinement applicables pour faire sanctionner les atteintes qui ne relèvent pas du droit des marques.

6. **Si l'usage "en tant que marque" dans le sens traditionnel est requis pour établir la contrefaçon, est-ce que les marques "de haute renommée", "célèbres", "notoires" ou "jouissant d'une réputation" utilisées sur des produits et services différents sont protégées?**

Comme on l'a vu, l'usage "en tant que marque" n'est pas nécessaire pour établir la contrefaçon.

Le champ de protection de la marque notoire et de renommée est plus large que celui des seuls produits ou services identiques ou similaires pour lesquels la marque non notoire est protégée. Cependant, la matérialité de l'emploi injustifié de la marque notoire et de renommée n'est pas appréhendée de façon différente de celle de l'usage de la marque non notoire.

Le groupe français est d'avis que la notion d'emploi d'une marque notoire et de renommée ne devrait pas différer de celle d'usage utilisée pour les marques non notoires. En d'autres

termes, l'emploi injustifié d'une marque notoire et de renommée devrait permettre de réprimer tant sa reproduction que son imitation.

Summary

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 *Acquiring a mark (if rights may be acquired by use according to national law)*

- French Law no longer recognises the acquisition of trademark rights by use. Article L.712.1 of the Intellectual Property Code states that "*ownership of the trademark is acquired by registration*". There is therefore no longer the need to use a trademark as a mark in order to acquire the rights to this mark.
- Exceptionally, use is taken into account to confer a distinctive character on a trademark which was devoid of one on registration or to recognize an effect in France of a notorious trademark.

1.2 *Maintaining a trademark registration (e.g. against an application for cancellation on grounds of non-use)*

- When the trademark is renewed, use is not taken into account.
- On the other hand, French law requires the owner of the trademark to make genuine use of it "*for the products and services defined in the registration*" for an uninterrupted period of five years, in order to avoid the loss of rights to the trademark.

Case law prefers to define the concept of use by referring to the traditional functions of a trademark. Use as a shop sign or corporate name is insufficient for this.

- Finally, the holder of a trademark cannot take action on infringement against a later trademark, the use of which has been tolerated for five years, unless the second registration was performed in bad faith. Action is limited only to the products and services for which use was tolerated. The use required in this case is also use as a mark.

1.3 *Establishing infringement*

- Infringement is broadly defined as "injury to the trademark owner's rights". The law refers to the concept of "use" when it lists violations of prohibitions constituting infringement.
- Case law broadly punishes the use of an infringed trademark, without requiring it to be used as a mark.

Therefore, simply registering a trademark, even if it has never been used, is an act of infringement. Its use can be written or oral. Use of a trademark as a corporate name or shop sign is also prohibited.

Reproduction of a trademark in a dictionary or press article, i.e. in a non-commercial context, is liable to lead to conviction when it is used generically.

On the other hand, French law allows a trademark to be used as a necessary reference to indicate the purpose of a product or service. In the same way, the use of a word registered as a trademark is licit when this word is used in its normal sense.

2. Is there any definition of what is use "as a mark" either in statute or case law?

French law does not define use as a mark. Case law frequently uses this expression, usually in terms of the traditional functions of the trademark. Use "*as a mark*", although it does

not necessarily require the trademark to be reproduced on the product itself, nevertheless implies that it must be used to present or accompany the offer or sale of this product or service.

3. **Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?**

The concept of use as a mark is not taken into account for the acquisition of rights, so we shall simply examine the differences likely to exist between maintaining and infringing rights.

- **Assessment of use "as a mark" for maintenance of rights**

The required use for a trademark owner to maintain its right to the trademark assumes that the mark has been used for each of the products and services defined on registration, that this use has been genuine and applied "as a mark", i.e. case law referring to the traditional function of the trademark.

- **Assessment of use "as a mark" for infringement of rights**

As was noted above (supra 1.3), French case law gives a very broad understanding of the concept of use when it deals with the question of infringement. Two differences can be noted with the concept of use approached from the maintenance of rights angle:

- The condition of genuine use is not taken into account for characterizing infringement; a single, isolated act is enough;
- Use need not imply use "as a mark";

4. **Are any of the following considered to be uses "as a mark"**

4.1 *Use on the internet, as a metatag, in linking or framing*

4.1.1 ***Is use as a metatag considered to be use as a mark?***

- α **Maintenance of rights.** French law does not address this question. In so far as the metatag is invisible to consumers, the French group feels that this alone cannot be used to maintain the rights to a mark.
- β **Infringement.** Case law has punished the use of a sign as a metatag as a trademark infringement.

The French group considers that using third party trademarks as metatags must be sued under the standard criteria for infringement.

4.1.2 ***Is use for linking considered to be use as a mark?***

French law does not address this question either.

- α **Maintenance of rights.** The French group makes a distinction between whether or not the link is authorized by the holder of the trademark. If it is authorized, the group feels that this use should maintain the rights to the trademark so long as it meets the standard definition of genuine use as a mark to designate a real offer of products or services. Otherwise, the French group feels that unauthorized use does not allow the holder to maintain its rights.
- β **Infringement.** Case law has penalized use of the trademark as a hypertext link under the heading of infringement.

The French group feels that use of a third party trademark in this type of linking is condemnable, particularly when the link using the third party link is part of business activity and/or the link is injurious to the third party trademark.

4.1.3 Is use for framing considered to be use as a mark?

French law does not address this question and case law has not considered the matter. The same conditions as those examined for hypertext links should be applied however.

4.2 Use by fan clubs or supporters

The use of a trademark by a fan club or supporters is not provided for in the Law and has not given rise to decisions rendered in France.

α **Maintenance of rights.** If use of the trademark by a fan or supporters club is authorized by the holder of the trademark, and it is used to designate the products and services defined in registration, the French group feels that this use should maintain the holder's rights.

β **Infringement.** The French group feels that use of the trademark by fan or supporters clubs should not be qualified as condemnable, particularly when at least the following two conditions are met: the mark is used outside business activities and is limited to a necessary reference to the club, person or product (film, etc ...) to which the site is devoted.

4.3 Parody

Unlike copyright which permits the exception of parody, French law concerning trademarks does not take it into consideration. Case law largely refuses to accept this exception of parody with respect to trademarks.

However, the French group feels that the exception of parody could be defended against trademark rights, particularly when:

- it is used outside business activity;
- its use is not abusive;
- the user's intention is really humorous.

4.4 Comparative advertising

According to the European harmonization directive of 6 October 1997 and to the French Order of 23 August 2001, comparative advertising cannot benefit from a trademark's reputation, lead to discredit or denigration of a trademark or lead to confusion to the detriment of a third party trademark.

This does not only target use as a mark but any injury likely to be suffered by the various distinctive competing signs.

5. If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws)?

The broad French approach to the concept of the trademark use generating infringement does not exclude recourse to other legal concepts, particularly principles relative to unfair competition which remain fully applicable to penalize injury which cannot be judged by trademark law.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

As we have seen, use "as a mark" is not necessary to establish infringement.

The field of protection of a notorious or a well-known trademark is broader than the one for identical or similar products or services for which the trademark, which is not notorious, is protected. However, the question of unjustified use of a notorious or well-known trademark is not treated differently from that of a trademark which is not notorious.

The French group feels that assessment of the use of a notorious or well-known trademark should not differ from that applied to trademarks which are not notorious. In other words, unjustified use of a notorious or well-known trademark should be enough to repress both its reproduction and its imitation.

Zusammenfassung

1. Gibt es ein Erfordernis, das die Benutzung einer Marke "als Marke" verlangt

1.1 Um eine Marke zu erwerben (falls Rechte durch Benutzung gemäss dem nationalen Recht erworben werden können)

- Das französische Recht kennt den Erwerb des Markenrechtes durch Benutzung nicht mehr. Artikel L.712.1 des Gesetzes über geistiges Eigentum bestimmt, dass *"das Eigentum an einer Marke durch die Eintragung erworben wird"*. Es ist daher nicht erforderlich, die Marke als Marke zu benutzen, um Rechte an dieser Marke zu erwerben.
- In Ausnahmefällen wird die Benutzung berücksichtigt, um einer Marke ein Unterscheidungsmerkmal zu verleihen, das dies bei seiner Eintragung nicht gehabt hätte, und um einer notorischen Marke in Frankreich Wirkung zu verleihen.

1.2 Um eine Markenregistrierung aufrechtzuerhalten (d.h. gegen einen Antrag auf Löschung wegen Nichtbenutzung)

- Zum Zeitpunkt der Erneuerung der Marke wird die Benutzung nicht berücksichtigt.
- Jedoch verlangt das französische Recht vom Eigentümer einer Marke eine ernsthafte Benutzung der Marke *"für die bei der Eintragung angegebenen Produkte und Dienstleistungen"* während eines ununterbrochenen Zeitraumes von fünf Jahren, um dem Verlust der Rechte an der Marke zu entgehen.

Das Fallrecht scheint den Begriff der Benutzung eher in Bezug auf die traditionellen Funktionen der Marke zu definieren. Eine Benutzung als Firmenzeichen oder Firmenname ist unzureichend.

- Schliesslich kann der Inhaber einer Marke nicht gegen eine später eingetragene Marke Klage erheben, deren Benutzung er fünf Jahre lang geduldet hat, es sei denn, dass die zweite Anmeldung böswillig erfolgt ist. Die Klage ist auf die Produkte und Dienstleistungen beschränkt, für die die Benutzung toleriert worden ist. Die in diesem Fall geforderte Benutzung stellt auch eine Benutzung als Marke dar.

1.3 Um eine Verletzung zu begründen?

- Die Verletzung von Rechten wird sehr allgemein als "Verstoss gegen die Rechte des Eigentümers der Marke" definiert. Das Gesetz bezieht sich auf den Begriff der "Benutzung" bei der Aufzählung derjenigen Verstösse, die eine Verletzung von Rechten begründen.

- Das Fallrecht sanktioniert in einem sehr weiten Sinn die Benutzung einer gefälschten Marke, ohne zu fordern, dass diese als Marke benutzt wird.

So stellt die einfache Anmeldung einer Marke, auch wenn diese nie benutzt worden ist, eine Fälschungshandlung dar. Die Benutzung kann schriftlich oder mündlich erfolgen. Die Benutzung der Marke als Firmennamen oder Firmenzeichen stellt ebenfalls eine verbotene Benutzung dar.

Der Nachdruck einer Marke in einem Lexikon oder Zeitungsartikel, d. h. in einem nicht kaufmännischen Kontext, kann eine Verurteilung nach sich ziehen, wenn sie dem Allgemeingebrauch zukommt.

Jedoch erlaubt das französische Recht die Benutzung einer Marke als notwendige Referenz, um die Bestimmung eines Produktes oder einer Dienstleistung anzugeben. Desgleichen ist die Benutzung einer als Marke eingetragenen Bezeichnung statthaft, wenn diese Bezeichnung in ihrer geläufigen Bedeutung benutzt wird.

2. **Gibt es eine Definition dessen, was die Benutzung "als Marke" ist, entweder im Gesetzesrecht oder im Fallrecht?**

Das französische Gesetz definiert die Benutzung als Marke nicht. Das Fallrecht benutzt diesen Begriff häufig, meist um die traditionellen Funktionen der Marke anzusprechen. Die Benutzung "*als Marke*", wenn sie auch nicht notwendigerweise erfordert, dass die Marke auf dem Produkt selbst reproduziert wird, impliziert jedoch, dass es benutzt wird, um das Angebot oder den Verkauf dieses Produktes oder dieser Dienstleistung zu präsentieren oder zu begleiten.

3. **Gibt es einen Unterschied in der Beurteilung der Benutzung "als Marke" zwischen dem Erwerb, der Aufrechterhaltung und der Verletzung von Rechten?**

Da der Begriff der Benutzung als Marke beim Erwerb der Rechte keine Berücksichtigung findet, begnügen wir uns damit, die Unterschiede zu untersuchen, die zwischen der Aufrechterhaltung und der Verletzung der Markenrechte bestehen können.

• **Beurteilung der Benutzung "als Marke" für die Aufrechterhaltung der Rechte**

Die erforderliche Benutzung, damit der Inhaber einer Marke Rechte an seinen Urkunden bewahren kann, setzt voraus, dass die Marke tatsächlich für jedes der bei der Anmeldung angegebenen Produkte und Dienstleistungen benutzt worden ist, dass diese Benutzung ernsthaft ist und dass sie "als Marke" erfolgt ist, wobei Das Fallrecht auf die traditionelle Funktion der Marke verweist.

• **Beurteilung der Benutzung "als Marke" bei der Verletzung von Rechten**

Wie wir bereits weiter oben gesehen haben (Punkt 1.3), erfasst das französische Fallrecht den Begriff der Benutzung sehr extensiv, wenn es die Frage der Verletzung von Rechten behandelt. Zwei Unterschiede tauchen zum Begriff der Benutzung unter dem Gesichtspunkt der Aufrechterhaltung von Rechten auf:

- der Begriff der seriösen Benutzung wird nicht berücksichtigt, um die Verletzung von Rechten zu charakterisieren; eine einmalige, isolierte Handlung ist ausreichend;
- die Benutzung muss nicht notwendigerweise "als Marke" erfolgt sein;

4. **Wird eine der folgenden Nutzungsformen als Benutzung "als Marke" beurteilt:**

4.1 *Benutzung im Internet, als Metagag, in "linking" oder "framing"*

4.1.1 **Stellt die Benutzung als Metatag eine Benutzung als Marke dar?**

- α **Aufrechterhaltung der Rechte.** Das französische Recht beantwortet diese Frage nicht. So lange das Metatag für den Verbraucher unsichtbar ist, ist die französische Gruppe der Ansicht, dass es allein nicht erlauben kann, die Rechte an der Marke aufrechtzuerhalten.
- β **Die Verletzung von Rechten.** Das Fallrecht hat die Benutzung des Zeichens als Metatag als Verletzung der Markenrechte sanktioniert.

Die französische Gruppe meint, dass die Benutzung von Drittmarken als Metatag nach den gewöhnlichen Kriterien der Fälschung verfolgt werden können muss.

4.1.2 Stellt die Benutzung als Hypertext-Verbindung ("linking") eine Benutzung als Marke dar?

Das französische Recht beantwortet auch diese Frage nicht.

- α **Aufrechterhaltung der Rechte.** Die französische Gruppe unterscheidet danach, ob die Verbindung von dem Eigentümer der Marke genehmigt ist oder nicht. Wenn sie genehmigt ist, ist die Gruppe der Auffassung, dass diese Benutzung ermöglichen kann, die Rechte an der Marke unter der Bedingung aufrechtzuerhalten, dass diese Benutzung der klassischen Definition der seriösen Benutzung als Marke entspricht, um ein reales Angebot an Produkten oder Dienstleistungen zu bezeichnen. Im gegenteiligen Fall ist die französische Gruppe der Ansicht, dass die nicht genehmigte Benutzung dem Eigentümer nicht erlaubt, seine Rechte aufrechtzuerhalten.
- β **Die Verletzung der Rechte.** Das Fallrecht hat die Benutzung des Zeichens als Hypertext-Verbindung als Fälschung einer Marke sanktioniert.

Die französische Gruppe ist der Meinung, dass die Benutzung einer Drittmarke als Hypertext-Verbindung insbesondere dann strafbar ist, wenn die Verbindung, die die Drittmarken benutzt, Teil des Geschäftslebens ist und/oder die Verbindung, die die Drittmarken schädigt.

4.1.3 Stellt die Benutzung als "framing" eine Benutzung als Marke dar?

Das französische Recht beantwortet diese Frage nicht, und das Fallrecht hat sich nicht mit der Frage auseinandergesetzt. Es sollten jedoch die gleichen Bedingungen wie die in Hinblick auf die Hypertext-Verbindungen untersuchten angewendet werden.

4.2 Benutzung durch Fan-Clubs oder Anhänger

Die Benutzung einer Marke durch einen Fanclub ist nicht Gegenstand irgendeiner gesetzlichen Bestimmung und hat in Frankreich keinen Anlass zu gerichtlichen Entscheidungen gegeben.

- α **Aufrechterhaltung der Rechte.** Wenn die Benutzung der Marke durch einen Fanclub von dem Inhaber der Marke genehmigt ist, und wenn diese tatsächlich benutzt wird, um Produkte und Dienstleistungen zu bezeichnen, die bei der Eintragung angegeben wurden, so ist die französische Gruppe der Ansicht, dass diese Benutzung die Aufrechterhaltung der Rechte des Inhabers ermöglichen kann.
- β **Die Verletzung der Rechte.** Die französische Gruppe ist der Meinung, dass die Benutzung der Marke durch Fanclubs von der Einstufung als strafbare Benutzung als Marke ausgenommen werden können müsste, insbesondere dann, wenn mindestens die folgenden zwei Bedingungen erfüllt sind: die Marke wird ausserhalb des Geschäftslebens benutzt, und die Benutzung ist auf eine für den Club, die Person oder das Produkt (Film, etc. ...) notwendige Referenz beschränkt, der die Website gewidmet ist.

4.3 *Parodien*

Im Gegensatz zum Urheberrecht, das die Ausnahme der Parodie kennt, kennt das französische Markengesetz diese nicht. Das dominierende Fallrecht weigert sich, diese Ausnahme der Parodie bezüglich der Marken zuzulassen.

Jedoch ist die französische Gruppe der Meinung, dass die Ausnahme der Parodie der Markenrecht entgegengestellt werden könnte, insbesondere wenn

- die Benutzung ausserhalb des Geschäftslebens erfolgt,
- die Benutzung keinen Missbrauch begründet,
- die Absicht des Benutzers tatsächlich humoristischer Art ist.

4.4 *Vergleichende Werbung?*

Nach einer europäischen Richtlinie über die Harmonisierung vom 6. Oktober 1997 und einer Verordnung vom 23. August 2001 darf die vergleichende Werbung nicht unberechtigt Profit aus dem mit einer Marke verbundenen Bekanntheitsgrad schlagen, den Verruf oder die Verunglimpfung der Marke nach sich ziehen oder zur Verwechslung zum Nachteil einer Drittmarke führen .

Es ist nicht nur die Benutzung als Marke, sondern jede Schädigung gemeint, die an den verschiedenen Erkennungszeichen des Konkurrenten verursacht werden kann.

5. **Wenn im nationalen Recht der Gruppen die Benutzung als Marke auf die traditionellen Angaben der Herkunft oder Identität beschränkt ist, sind unkonventionelle Benutzungsformen gestützt auf Markenrecht oder andere Gesetze (z.B. unlauterer Wettbewerb oder Handelsrecht) trotzdem klagbar?**

Der extensive französische Ansatz zum Begriff der Benutzung der Marke, die eine begründet, schliesst den Rückgriff auf andere juristische Begriffe nicht aus. Insbesondere bleiben die Prinzipien bezüglich des unlauteren Wettbewerbs unbeschränkt anwendbar, um die Schädigungen zu sanktionieren, die nicht dem Markenrecht unterliegen.

6. **Wenn die Benutzung "als Marke" im traditionellen Sinn notwendig ist, um eine Verletzung nachzuweisen, sind "bekannte", "berühmte", "notorische" oder "angesehene" Marken, die für unähnliche Waren oder Dienstleistungen benutzt werden, geschützt?**

Wie wir bereits gesehen haben, ist die Benutzung "als Marke" nicht notwendig, um die Verletzung von Rechten zu begründen.

Der Bereich des Schutzes einer notorischen Marke mit gutem Ruf ist weiter als derjenige der identischen oder ähnlichen Produkte oder Dienstleistungen, für die die notorische Marke geschützt ist. Jedoch wird der Sachverhalt der ungerechtfertigten Benutzung einer notorischen Marke mit gutem Ruf nicht anders gehandhabt als derjenige der Benutzung einer nicht notorischen Marke.

Die französische Gruppe ist der Meinung, dass der Begriff der Benutzung einer notorischen Marke von gutem Ruf sich nicht von demjenigen der Benutzung unterscheiden dürfte, der für eine notorische Marke verwendet wird. Mit anderen Worten, die ungerechtfertigte Benutzung einer notorischen Marke mit gutem Ruf sollte es ermöglichen können, sowohl ihre Reproduktion als auch ihre Imitation zu ahnden.

Bericht Q168

im Namen der Deutschen Landesgruppe
von Franz HACKER*

Benützung einer Marke "als Marke" als rechtliche Voraussetzung bezüglich Erwerb, Aufrechterhaltung und Verletzung der Rechte

Vorbemerkung

Das geltende deutsche MarkenG, durch das u.a. die Vorgaben der europäischen Markenrechts-Richtlinie vom 21.12.1988 (im folgenden: MarkenRL) in nationales Recht umgesetzt wurden, ist seit 1.1.1995, somit seit annähernd sieben Jahren, in Kraft. In vielen zentralen Bereichen des reformierten und (teil-)harmonisierten Markenrechts kann bereits auf eine gesicherte höchstrichterliche Rechtsprechung zurückgegriffen werden. Dies gilt jedoch nicht uneingeschränkt. Insbesondere zu dem in der Frage Q168 angesprochenen Begriff der Benutzung als Voraussetzung für den Erwerb, die Aufrechterhaltung und die Verletzung von Marken liegen bisher nur ganz vereinzelte höchstrichterliche Entscheidungen vor. Deshalb bestimmen die nicht immer einheitliche Spruchpraxis der Instanzgerichte und die Äußerungen im Schrifttum das zum Teil sehr vielfältige Meinungsbild. Dabei geht der Streit häufig darum, in welchem Umfang Grundsätze, die unter der Geltung des früheren Rechts¹ als gesicherte Erkenntnis gelten konnten, auch bei der Auslegung und Anwendung des MarkenG zu beachten sind.

Vor diesem Hintergrund kann der vorliegende Bericht nicht für sich in Anspruch nehmen, die in Deutschland geltende Rechtslage nach Art eines festgefügt Kanons darzustellen. Vielmehr kann es weitgehend nur darum gehen, trotz der aus Raumgründen gebotenen Vereinfachung und Zusammenfassung ein möglichst zutreffendes Bild des gegenwärtigen Diskussionsstandes nachzuzeichnen. Darüber hinaus soll außerhalb des vorgegebenen Fragenkatalogs in einem zusätzlichen Abschnitt 3a. versucht werden, die Debatte in einigen Punkten weiterzuführen.

1. Die Benutzung einer Marke "als Marke" als Voraussetzung für den Erwerb, die Aufrechterhaltung und die Verletzung von Rechten

1.1 Schutzrechtserwerb

a) Nicht registrierte Marken

Neben dem Erwerb des Markenschutzes durch Registrierung kennt das deutsche Recht seit langem auch den Schutz nicht registrierter Marken.² Die MarkenRL befaßt sich nur mit registrierten bzw. zur Registrierung angemeldeten Marken, hat es den Mitgliedstaaten aber ausdrücklich freigestellt, durch Benutzung erworbene

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¹ Bis zum 31. Dezember 1994 galt in Deutschland das Warenzeichengesetz von 1936 (WZG) i.d.F. vom 2. Januar 1968, das in wesentlichen Teilen auf das Gesetz zum Schutz der Warenbezeichnungen vom 12. Mai 1894 zurückging.

² Bereits im 19. Jahrhundert war in einigen deutschen Staaten der Schutz nicht registrierter Marken anerkannt. Das erste für ganz Deutschland geltende MarkenschutzG von 1874 sah demgegenüber nur den Schutz registrierter Marken vor. Erst das WZG von 1894 (vgl. o. Fußn. 1) hat den Schutz nichtregistrierter Marken in Form des sog. Ausstattungsschutzes wieder eingeführt (§ 15 WZG 1894, später § 25 WZG).

Marken nach Maßgabe des nationalen Rechts weiterhin zu schützen.³ Von dieser Möglichkeit ist in Deutschland in § 4 Nr. 2 MarkenG Gebrauch gemacht worden. Nach dieser Vorschrift entsteht der Markenschutz durch Benutzung eines Zeichens im geschäftlichen Verkehr, soweit das Zeichen innerhalb beteiligter Verkehrskreise „als Marke“ Verkehrsgeltung erworben hat. Die Benutzung allein genügt somit nicht.

Nach dem Wortlaut des Gesetzes ist die Formulierung „als Marke“ auf die Verkehrsgeltung, nicht auf die Benutzung bezogen. Die Verkehrsgeltung ist jedoch nur die tatsächliche Folge einer gesteigerten Benutzung des Zeichens. Insoweit setzt eine Verkehrsgeltung „als Marke“ zwingend eine Benutzung „als Marke“ voraus.

b) Registermarken

Auch bei Marken, die im Wege der Registereintragung geschützt werden sollen (§ 4 Nr. 1 MarkenG), kann die Frage einer Benutzung als Marke Bedeutung erlangen. Die Eintragung setzt zwar grundsätzlich keine vorgängige Benutzung voraus. Anders verhält es sich aber, wenn der angemeldeten Marke ein absolutes Schutzhindernis nach § 8 Abs. 2 Nr. 1 bis 3 MarkenG (fehlende Unterscheidungskraft, beschreibende Angabe, üblich gewordene Bezeichnung)⁴ entgegensteht. Für diesen Fall sieht § 8 Abs. 3 MarkenG in Umsetzung von Art. 3 Abs. 3 Satz 1 MarkenRL vor, daß eine Eintragung gleichwohl erfolgen kann, wenn die Marke sich infolge ihrer Benutzung für die Waren oder Dienstleistungen, für die sie angemeldet worden ist, in den beteiligten Verkehrskreisen durchgesetzt hat. Insoweit wird hier ebenso wie im Rahmen des § 4 Nr. 2 MarkenG eine Benutzung „als Marke“ vorausgesetzt.⁵

1.2 Aufrechterhaltung des Schutzes

a) Nicht registrierte Marken

Nicht registrierte Marken verlieren ihren Schutz – quasi spiegelbildlich zu ihrer Entstehung – mit dem Verlust der Verkehrsgeltung „als Marke“. Das ist nicht gesetzlich geregelt, aber allgemein anerkannt.⁶ Der Verlust der Verkehrsgeltung tritt meist nicht zeitgleich mit der Beendigung der Benutzung ein, folgt ihr aber in der Regel alsbald nach. Die Aufrechterhaltung des Schutzes setzt insoweit ebenso wie die Schutzbegründung eine Benutzung „als Marke“ voraus.

b) Registermarken

aa) Marken, die im Wege der Verkehrsdurchsetzung eingetragen worden sind:

Ist eine Marke nach § 8 Abs. 3 MarkenG aufgrund ihrer Durchsetzung im Verkehr in das Register eingetragen worden, so finden im weiteren die allgemeinen Vorschriften für registrierte Marken Anwendung. Der nachträgliche Verlust der Verkehrsdurchsetzung läßt daher – anders als bei nicht eingetragenen Marken – den Fortbestand der Marke unberührt. Die Marke unterliegt lediglich den Vorschriften des Benutzungszwangs (s. bb)).

bb) Benutzungszwang:

³ Vgl. den 4. Erwägungsgrund. Dabei handelt es sich nicht nur, was der Wortlaut („erworbene Marken“) nahelegen könnte, um einen Bestandsschutz; vielmehr ist auch der Schutz neuer Marken kraft Benutzung möglich, s. auch Art. 16 Abs. 1 Satz 3 TRIPS-Übereinkommen.

⁴ Vgl. Art. 3 Abs. 1 lit. b, c und d MarkenRL

⁵ Im früheren Recht ist dies deutlicher zum Ausdruck gekommen. Nach § 4 Abs. 3 WZG war es erforderlich, daß sich das angemeldete Zeichen im Verkehr „als Kennzeichen“ der Waren des Anmelders durchgesetzt hat. Mit der Neuformulierung des Verkehrsdurchsetzungstatbestandes in § 8 Abs. 3 MarkenG war indessen keine sachliche Änderung gegenüber § 4 Abs. 3 WZG beabsichtigt.

⁶ Althammer/Klaka, Markengesetz, 6. Aufl. (2000), § 4 Rn. 44; Ingerl/Rohnke, Markengesetz (1998), § 4 Rn. 20; Fezer, Markenrecht, 3. Aufl. (2001), § 4 Rn. 214, jeweils m.w.N.

In Übereinstimmung mit Art. 10 bis 12 MarkenRL sieht das MarkenG vor, daß aus einer Marke keine Rechte geltend gemacht werden können (§§ 25, 43, 55 Abs. 3 MarkenG) bzw. die Marke wegen Verfalls der Löschung unterliegt (§ 49 Abs. 1 MarkenG), wenn sie nicht innerhalb bestimmter – je nach Verfahrensart unterschiedlich zu berechnender – Fünfjahreszeiträume nach Maßgabe des § 26 MarkenG rechtserhaltend benutzt worden ist. Das Gesetz – wie auch die MarkenRL – verlangt insoweit nicht wörtlich eine Benutzung „als Marke“. Die Bundesregierung ist davon aber in der Begründung zum Entwurf des MarkenG ausgegangen.⁷

1.3 Markenverletzung

Die Frage, ob der Verletzungstatbestand die Benutzung des angegriffenen Zeichens „als Marke“ voraussetzt, wird in Deutschland unter dem Stichwort des „markenmäßigen Gebrauchs“ diskutiert. Diese besondere Terminologie ist historisch dadurch zu erklären, daß im früheren Recht (§ 16 WZG) bestimmte Benutzungshandlungen Dritter vom Schutzbereich der Marke ausgenommen waren (insoweit vergleichbar § 23 MarkenG bzw. Art. 6 MarkenRL), dies aber nur, sofern bei den privilegierten Handlungen nicht ein „warenzeichenmäßiger Gebrauch“ vorlag. Daraus und aus der dominierenden Herkunftsfunktion der Marke hatte man nahezu einhellig geschlossen, daß nur die warenzeichenmäßige (markenmäßige) Benutzung einer Marke markenrechtliche Ansprüche auslöste.⁸ Markenmäßiger Gebrauch in diesem Sinne wurde angenommen, wenn eine Bezeichnung zur Kennzeichnung einer Ware oder in Beziehung auf eine Ware in einer Weise verwendet wird, daß der Durchschnittsbetrachter annehmen kann, die Bezeichnung diene zur Unterscheidung der so gekennzeichneten Ware von gleichen oder gleichartigen Waren anderer Herkunft.⁹ Diese Voraussetzungen wurden im allgemeinen großzügig bejaht.¹⁰ Insbesondere sollte in dem Gebrauch einer Bezeichnung als Firma in der Regel zugleich eine zumindest mittelbare Herkunftskennzeichnung der unter der Firma vertriebenen Waren liegen.¹¹ Darüber hinaus wurde bei der Anbringung fremder Marken auf den eigenen Waren ein zeichenmäßiger Gebrauch sogar *vermutet*.¹²

Ob diese Grundsätze unter der Geltung des MarkenG weiterhin anzuwenden sind, ist Gegenstand einer lebhaften Kontroverse. Das MarkenG regelt die Frage nicht explizit. § 14 Abs. 2 Nr. 1 bis 3 MarkenG fordert, soweit hier von Interesse, in Übereinstimmung mit Art. 5 Abs. 1 Satz 2 und Abs. 2 MarkenRL lediglich die Benutzung des angegriffenen Zeichens im geschäftlichen Verkehr. Auch die Regierungsbegründung zum MarkenG verhält sich nicht eindeutig hierzu. In der Regierungsbegründung zum Entwurf eines Gesetzes zur vergleichenden Werbung¹³, mit dem die Richtlinie 97/55/EG umgesetzt wurde, ist allerdings ausdrücklich ausgeführt, daß das MarkenG nur den kennzeichenmäßigen Gebrauch von Marken erfasse.¹⁴

⁷ Begründung zum Entwurf des MarkenG (§ 26), Bl. f. PMZ 1994, Sonderheft, S. 77

⁸ Vgl. statt aller Baumbach/Hefermehl, Warenzeichenrecht, 12. Aufl. 1985, § 15 Rn. 22 m.w.N.; a.A. Heydt, GRUR 1976, 7 ff.; ders., GRUR 1971, 253 ff. (Anm. zu BGH GRUR 1971, 251 – Oldtimer); ders., Mitt. 1969, 319 ff.; ihm folgend Fezer, GRUR 1977, 616, 618 (Anm. zu BGH GRUR 1977, 614 – Gebäudefassade).

⁹ Z.B. BGH GRUR 1985, 41, 43 – REHAB; GRUR 1961, 280, 281 – Tosca; GRUR 1960, 126 – Sternbild; GRUR 1955, 484, 485 – Luxor/Luxus; GRUR 1953, 175, 176 – Kabel-Kennzeichnung.

¹⁰ Vgl. BGH GRUR 1998, 830, 834 – Les-Paul-Gitarren; GRUR 1995, 57, 60 – Markenverunglimpfung II (Nivea) m.w.N.

¹¹ Z.B. BGH GRUR 1977, 789, 790 – Tina-Spezialversand; GRUR 1975, 257 – Buddelei; GRUR 1954, 123, 124 – NSU-Fox/Auto-Fox; Baumbach/Hefermehl, aaO (Fußn. 8), § 15 Rn. 27 m.w.N.

¹² BGH GRUR 1998, 830, 834 – Les-Paul-Gitarren; GRUR 1995, 57, 60 – Markeverunglimpfung II (Nivea); GRUR 1961, 280, 281 – Tosca.

¹³ Abgedruckt in WRP 2000, 555; s. dazu auch unten 4.4.

¹⁴ AaO S. 557.

Die höchstrichterliche Rechtsprechung ist zunächst in einigen obiter dicta vom Erfordernis eines kennzeichenmäßigen Gebrauchs im traditionellen Sinne ausgegangen¹⁵, hat die Frage aber in späteren Entscheidungen offen gelassen, teils weil ein markenmäßiger Gebrauch jedenfalls vorlag¹⁶, teils weil angenommen worden war, die beanstandete Verwendung sei nach § 23 MarkenG (Art. 6 MarkenRL) von markenrechtlichen Ansprüchen freigestellt.¹⁷ Die Rechtsprechung der Instanzgerichte verlangt hingegen, soweit sie die Frage nicht ebenfalls dahingestellt sein läßt¹⁸, ganz überwiegend, daß das angegriffene Zeichen markenmäßig im traditionellen, auf die Herkunftsfunktion bezogenen Sinne benutzt worden ist.¹⁹ Das OLG Düsseldorf indessen hat hierzu den Europäischen Gerichtshof um eine Vorabentscheidung ersucht.²⁰ Der Beklagte des Ausgangsverfahrens hatte Dritten Edelsteine mit einem „Spirit-Sun-Schliff“ angeboten. Der Begriff „SPIRIT SUN“ war für den Kläger als Marke für Edelsteine eingetragen. Aus dem Verkaufsgespräch war jedoch nach den Feststellungen des Gerichts zweifelsfrei hervorgegangen, daß es sich bei den angebotenen Steinen nicht um solche aus der Produktion des Klägers, sondern des Beklagten handelte.

Im Schrifttum ist die Frage umstritten wie kaum eine andere. Einigkeit besteht lediglich darin, daß jedenfalls in den Fällen von einer rechtsverletzenden Benutzung auszugehen ist, in denen ein Zeichen im herkömmlichen Sinne markenmäßig, d.h. zur betrieblichen Herkunftsindividualisierung von Waren und Dienstleistungen verwendet wird. Im übrigen lassen sich im wesentlichen zwei große Meinungsgruppen feststellen. Die eine Auffassung will den Tatbestand der rechtsverletzenden Benutzung wie im alten Recht auf markenmäßige Benutzungshandlungen beschränken und beruft sich hierfür vor allem auf Art. 5 Abs. 5 MarkenRL.²¹ Nach dieser Vorschrift bleibt es den Mitgliedstaaten unbenommen, Bestimmungen über den Schutz der Marke gegenüber der Verwendung eines Zeichens zu anderen Zwecken als der Unterscheidung von Waren und Dienstleistungen vorzusehen. Hierin wird ein eindeutiger Hinweis darauf gesehen, daß der Benutzungsbegriff in Art. 5 Abs. 1 und 2 MarkenRL nicht jedwede Benutzung erfaßt, sondern nur eine Benutzung zur Unterscheidung von Waren und Dienstleistungen eines Unternehmens von solchen anderer Unternehmen, somit allein eine markenmäßige Benutzung.

Die Gegenmeinung²² erachtet jede Benutzung als rechtsverletzend. Einziges Korrektiv dieses weiten Benutzungsbegriffs soll § 23 MarkenG sein, der in Umsetzung des Art. 6 MarkenRL bestimmte Handlungen von markenrechtlichen Ansprüchen freistellt, sofern diese Handlungen nicht im Einzelfall gegen die guten Sitten verstoßen. Zur Begründung wird auf den Wortlaut des Art. 5 Abs. 1 und 2 MarkenRL bzw. des § 14 Abs. 2 MarkenG

¹⁵ BGH GRUR 1996, 68, 70 – COTTON LINE; GRUR 1995, 354, 358 – Rügenwalder Teewurst II.

¹⁶ BGH GRUR 1998, 834, 835 – Les-Paul-Gitarren.

¹⁷ BGH GRUR 1998, 697, 699 – VENUS MULTI.

¹⁸ Z.B. LG Düsseldorf GRUR 1998, 159, 161 – EPSON; LG München I CR 1997, 540, 541 – Freundin.de.

¹⁹ Z.B. OLG Dresden NJW 2001, 615, 616 – Johann Sebastian Bach; LG Hamburg CR 2000, 392, 394 – keyword buys; OLG Hamburg WRP 1997, 106, 108, 110 – Gucci; WRP 1996, 572, 576; KG GRUR 1997, 295, 296 – Alles wird Teurer; OLG München Mitt. 1996, 174, 175 – FAT-TIRE; vgl. auch OLG München MMR 1999, 547 – Buecher.de/Amazon.de (zum Firmenrecht).

²⁰ OLG Düsseldorf WRP 2000, 316 – SPIRIT SUN.

²¹ Schultze/Schwenn, WRP 1997, 536, 538; v. Schultz, GRUR 1997, 408, 409; Keller, GRUR 1996, 607 ff.; Piper, GRUR 1996, 429, 434; Sack, GRUR 1995, 81, 93 ff.; v. Gamm, GRUR 1994, 775, 780; ders., WRP 1993, 793, 798; Ernst-Moll, GRUR 1993, 8, 17; Kunz-Hallstein, GRUR Int. 1990, 747, 757;

²² Althammer/Klaka, aaO (o. Fußn. 6), § 14 Rn. 66 f.; Ingerl/Rohnke, aaO (o. Fußn. 6), § 14 Rn. 53 ff.; Nägele, Die rechtsverletzende Benutzung im Markenrecht (1999), passim; Nordemann, NJW 1997, 1891, 1893; Nordemann, Wettbewerbs- und Markenrecht, 8. Aufl., Rn. 430g; Kur, CR 1996, 590, 592; Starck, GRUR 1996, 688, 690 ff.; Fezer, GRUR 1996, 566 ff.; ders., aaO (o. Fußn. 6) § 14 Rn. 39; Meyer, GRUR Int. 1996, 592, 602; Meister, WRP 1995, 366, 369; Krüger, GRUR 1995, 527, 529; Schmieder, NJW 1994, 1241, 1244; Ingerl/Rohnke, NJW 1994, 1247, 1252; Schertz, Merchandising, Rn. 197 ff.

verwiesen, wo lediglich eine Benutzung im geschäftlichen Verkehr gefordert ist. Daneben wird auf die speziell erwähnten Benutzungstatbestände des Art. 5 Abs. 3 lit. b und d MarkenRL/§ 14 Abs. 3 Nr. 2 und 5 MarkenG hingewiesen, die mit dem bloßen Besitz rechtsverletzend gekennzeichneten Waren und mit der Benutzung rechtsverletzender Zeichen in der (auch mündlichen) Werbung Handlungen erfassen, die nach herkömmlichem Verständnis nicht als markenmäßig qualifiziert werden konnten. Als weiteres Argument wird angeführt, daß die Herkunftsfunktion nicht mehr die allein geschützte Funktion der Marke darstelle.

Neben den geschilderten beiden Grundauffassungen bestehen noch verschiedene vermittelnde Meinungen, die das Kriterium der markenmäßigen Benutzung nur bei bestimmten Verletzungstatbeständen nicht mehr anwenden wollen, etwa im Rahmen des Identitätsschutzes (Art. 5 Abs. 1 Satz 2 lit. a MarkenRL/§ 14 Abs. 2 Nr. 1 MarkenG)²³ oder des Schutzes der bekannten Marke nach Art. 5 Abs. 2 MarkenRL/§ 14 Abs. 2 Nr. 3 MarkenG.²⁴

Die „BMW/Deenik“-Entscheidung des Europäischen Gerichtshofes²⁵ konnte bisher nicht zu einer Beilegung des Meinungsstreits beitragen. Beide großen Meinungsgruppen sehen sich durch dieses Urteil in ihren Auffassungen bestätigt.²⁶ Insofern ist es zu begrüßen, daß das OLG Düsseldorf die Streitfrage erneut dem Europäischen Gerichtshof zur Entscheidung vorgelegt hat.²⁷

2. Definitionen des Begriffes der Benutzung "als Marke"

- a) Der Begriff „als Marke“ wird im geltenden deutschen Recht, wie zu 1. ausgeführt, nur im Zusammenhang mit dem Schutzrechtserwerb bei nicht registrierten Marken (§ 4 Nr. 2 MarkenG) verwendet. Eine gesetzliche Definition fehlt. Hinzuweisen ist aber auf den allgemeinen Markenbegriff in § 3 Abs. 1 MarkenG. Danach handelt es sich bei der Marke um ein Zeichen zur Unterscheidung von Waren und Dienstleistungen eines Unternehmens von solchen anderer Unternehmen (vgl. Art. 2 MarkenRL). Hieraus läßt sich entnehmen, daß der Markenschutz nach § 4 Nr. 2 MarkenG die Benutzung (und Verkehrsgeltung) des betreffenden Zeichens zur Unterscheidung von Waren und Dienstleistungen ihrer betrieblichen Herkunft nach voraussetzt. Gleiches gilt für den Fall der Verkehrsdurchsetzung (§ 8 Abs. 3 MarkenG).
- b) Als Voraussetzung für die Aufrechterhaltung der Marke im Rahmen des Benutzungszwangs wird eine Benutzung „als Marke“ explizit nur in der Regierungsbegründung zum Entwurf des MarkenG gefordert (s.o. zu 1.2) und näher im Sinne einer *funktionsgerechten Verwendung der Marke* erläutert.²⁸ Dies bedeute nicht notwendig, daß die Marke (sofern es sich um eine Warenmarke handelt) auf den Waren angebracht worden sein müsse. Vielmehr könne auch, je nach den Umständen, eine Benutzung auf Geschäftspapieren, in Katalogen oder insbesondere in der Werbung ausreichen. Die Regierungsbegründung fordert in diesem Zusammenhang eine Abkehr von der früheren strengen Rechtsprechung, die im Grundsatz eine Benutzung auf der Ware verlangt hat. Dafür bestehe, so heißt es weiter, nach dem harmonisierten Recht keine Grundlage mehr.

²³ v. Gamm, GRUR 1994, 775, 780; ders., WRP 1993, 793, 797; hiergegen Keller, GRUR 1996, 607, 610 Fußn. 40.

²⁴ Kraft, GRUR 1991, 339, 342; ausf. hierzu unten 3a.

²⁵ EuGH GRUR Int. 1999, 438 – BMW/Deenik.

²⁶ Vgl. einerseits OLG Dresden NJW 2001, 615, 616 – Johann Sebastian Bach, andererseits Althammer/Klaka, aaO (o. Fußn. 6), § 14 Rn. 67; Fezer, aaO (o. Fußn. 6), § 14 Rn. 30c.

²⁷ Vgl. o. Fußn. 20; kritisch hierzu Fezer, aaO Rn. 30d.

²⁸ AaO (o. Fußn. 7).

Teile der instanzgerichtlichen Rechtsprechung²⁹ und des Schrifttums³⁰ sind dem – u.a. unter Hinweis auf die Multifunktionalität der Marke – gefolgt. Ein bloß gedanklicher Bezug zu den betreffenden Waren und Dienstleistungen wird insoweit für ausreichend erachtet.³¹

Demgegenüber hat der Bundesgerichtshof in seiner ersten Entscheidung zum Benutzungszwang nach neuem Recht eine im Sinne der traditionellen Herkunftsfunktion kennzeichenmäßige Benutzung verlangt.³² Neuere höchstrichterliche Entscheidungen zu dieser Frage liegen noch nicht vor. Ob damit im Regelfall zwingend eine körperliche Anbringung der Marke auf der Ware verlangt ist³³, war im konkreten Fall nicht zu entscheiden, dürfte aber jedenfalls dann zu bejahen sein, wenn eine derartige Markenverwendung nach den jeweils branchenbezogenen Gegebenheiten und der Art der verwendeten Marke die verkehrsübliche Form einer Markenbenutzung darstellt.³⁴

- c) Zum Begriff des warenzeichen- bzw. markenmäßigen Gebrauchs als Voraussetzung einer Markenverletzung wurde in der Rechtsprechung die bereits oben zu 1.3 angeführte Definition entwickelt, wonach es darauf ankommt, ob das angegriffene Zeichen zur Kennzeichnung einer Ware oder in Beziehung auf eine Ware (oder Dienstleistung) in einer Weise verwendet wurde, daß der Durchschnittsbetrachter annehmen kann, die Bezeichnung diene zur Unterscheidung der Waren von gleichen oder gleichartigen Waren anderer Herkunft. Für das geltende Recht kann eine Weitergeltung dieser Begriffsbestimmung nur im Rahmen des oben 1.3 skizzierten Meinungsspektrums angenommen werden. Höchststrichterliche Äußerungen hierzu fehlen.

3. Unterschiede in der Beurteilung der Benutzung "als Marke" im Hinblick auf den Erwerb, die Aufrechterhaltung und die Verletzung von Rechten

Im deutschen Recht ist seit langem scharf differenziert worden insbesondere zwischen rechtsverletzender und rechtserhaltender Benutzung. Der Benutzungsbegriff im Sinne des Benutzungszwangs wurde als *eigenständiger Begriff* aufgefaßt.³⁵ Zwar waren sowohl die rechtsverletzende wie die rechtserhaltende Benutzung im Hinblick auf die traditionelle Herkunftsfunktion zu beurteilen; im einen wie im anderen Fall kam es also darauf an, ob der Verkehr die Marke bzw. das angegriffene Zeichen als Herkunftshinweis verstand. Trotzdem gelangte man zu unterschiedlichen Ergebnissen, weil der Begriff der markenmäßigen Benutzung im Sinne des Verletzungstatbestandes *sehr weit*, der Begriff der markenmäßigen Benutzung im Sinne des Benutzungszwangs dagegen eher *restriktiv* ausgelegt wurde. So waren viele Handlungen denkbar, die zwar eine Markenverletzung darstellten, für eine rechtserhaltende Benutzung aber nicht ausreichten. Ein Beispiel dafür war die firmenmäßige Benutzung eines Zeichens. Sie wurde zwar als rechtsverletzend qualifiziert, weil in der Bezeichnung eines Unternehmens regelmäßig zugleich eine herkunftskennzeichnende Bezeichnung der von dem Unternehmen vertriebenen Produkte liege (mittelbar zeichenmäßiger Gebrauch). Für eine rechtserhaltende Benutzung genügte dagegen ein bloß firmenmäßiger Gebrauch nicht. Umgekehrt konnte es aber auch

²⁹ OLG München Mitt. 1997, 30, 34 – aliseo.

³⁰ Fezer, aaO (o. Fußn. 6), § 26 Rn. 8 und 30; Ingerl/Rohnke, aaO (o. Fußn. 6), § 26 Rn. 18.

³¹ So insb. Fezer, aaO.

³² BGH GRUR 1995, 583, 584 – MONTANA (von Fezer, aaO (o. Fußn. 6), § 26 Rn. 30 irrtümlich als Entscheidung zum alten WZG eingeordnet); ebenso Starck, GRUR 1996, 688, 691.

³³ So die ganz h.M. zum früheren Recht, vgl. statt aller Baumbach/Hefermehl, aaO (o. Fußn. 8), § 5 Rn. 21.

³⁴ Vgl. BGH GRUR 1996, 267, 268 – AQUA (zwar zum WZG, aber unter Bezugnahme auf die schon zum MarkenG ergangene MONTANA-Entscheidung (Fußn. 32)); ebenso OLG München WRP 1996, 128, 130 – THE BEATLES; BPatG GRUR 1998, 1032, 1033 – MAPAX/MAPAG; GRUR 1996, 981, 982 – ESTAVITAL; ähnlich Althammer/Ströbele, aaO (o. Fußn. 6), § 26 Rn. 10.

³⁵ Statt aller: Baumbach/Hefermehl, aaO (o. Fußn. 8), § 5 Rn. 20 m.w.N.

Handlungen geben, die zwar eine rechtserhaltende, aber keine rechtsverletzende Benutzung darstellten, z.B. bestimmte innerbetriebliche Gebrauchsformen.

Von der h.M. wird die Unterscheidung zwischen rechtserhaltender und rechtsverletzender Benutzung auch für das geltende Recht vorgenommen³⁶, wobei aber im einzelnen Unterschiede bestehen, die letztlich mit den Auseinandersetzungen um den Begriff des kennzeichenmäßigen Gebrauchs zusammenhängen.³⁷

3a. Bemerkungen zu 1. bis 3.

- a) Ob und inwieweit der Gebrauch eines Zeichens „als Marke“ Voraussetzung für den Erwerb und die Aufrechterhaltung bzw. für das Vorliegen einer Markenverletzung ist, und was im einzelnen unter einem Gebrauch „als Marke“ zu verstehen ist, hängt sehr eng mit der grundsätzlichen Frage zusammen, welche rechtlich geschützten Funktionen der Marke zugewiesen werden. Unbestritten ist die traditionelle Herkunftsfunktion auch im geltenden Recht eine der geschützten Funktionen. Das ergibt sich sowohl aus dem 10. Erwägungsgrund zur MarkenRL, der die Herkunftsfunktion besonders hervorhebt, als auch aus der Definition der Marke als eines Zeichens zur Unterscheidung von Waren und Dienstleistungen *eines Unternehmens* von solchen *anderer Unternehmen* (Art. 2 MarkenRL/§ 3 Abs. 1 MarkenG).³⁸ Ob darüber hinaus auch alle anderen denkbaren (und auch wandelbaren) „ökonomischen“ Funktionen der Marke, insbesondere ihre Qualitäts- und Werbefunktion, umfassend und mit gleichem Gewicht wie die Herkunftsfunktion zu berücksichtigen sind – wie im Sinne eines Paradigmenwechsels gegenüber dem früheren Recht sowohl in der Regierungsbegründung zum MarkenG³⁹ als auch von gewichtigen Stimmen im Schrifttum⁴⁰ vertreten wird –, erscheint in dieser Allgemeinheit zweifelhaft. Sicher feststellen läßt sich jedenfalls, daß es eine Marke ohne Herkunftsfunktion nicht geben kann; das folgt unmittelbar aus Art. 2 MarkenRL/§ 3 Abs. 1 MarkenG, wo die Eignung zur herkunftsindividualisierenden Unterscheidung von Waren und Dienstleistungen *zwingend* vorausgesetzt ist. Alle sonst denkbaren Funktionen dagegen können im Einzelfall zwar vorliegen, von Rechts wegen ist dies aber *nicht zwingend* erforderlich, um überhaupt von einer Marke sprechen zu können. Allein die Herkunftsfunktion ist obligatorisch mit dem Begriff der Marke vorgegeben; alle anderen Funktionen sind fakultativ.⁴¹ Insofern läßt sich auch unter dem harmonisierten Recht von der Herkunftsfunktion als der Grundfunktion der Marke sprechen, wie dies der 10. Erwägungsgrund zur MarkenRL zutreffend zum Ausdruck bringt.

Im übrigen wird die Frage nach der rechtlich geschützten Funktion einer Marke nicht für jede Marke gleich beantwortet werden können. In den weitaus häufigsten Fällen entsteht der Markenschutz durch Eintragung in das Register, was – abgesehen vom Fall der Verkehrsdurchsetzung – eine Benutzung nicht voraussetzt. Einer solchen noch unbenutzten Registermarke kann nun zwar eine Herkunftsfunktion im Sinne einer nach der bloßen Registerlage gegebenen Eignung zur herkunftsindividualisierenden Unterscheidung der im Verzeichnis der Waren und Dienstleistungen beanspruchten Waren und Dienstleistungen von solchen anderer Unternehmen zugemessen werden.⁴² Eine darüber hinausgehende Qualitäts-,

³⁶ Vgl. Althammer/Klaka, aaO (o. Fußn. 6), § 14 Rn. 66; Althammer/Ströbele, aaO (o. Fußn. 6), § 26 Rn. 9; Fezer, aaO (o. Fußn. 6), § 14 Rn. 70 und § 26 Rn. 4; a.A. Ingerl/Rohnke, aaO (o. Fußn. 6), § 26 Rn. 19, die für einen weitgehenden Gleichlauf beider Benutzungsbegriffe eintreten.

³⁷ Insoweit auch für den Benutzungszwang ablehnend Fezer, aaO (o. Fußn. 6), § 26 Rn. 4.

³⁸ Sehr deutlich in diesem Sinne auch EuGH, Urt. v. 4.10.2001, Rs. C-517/99 Rn. 22 und 24 – Bravo.

³⁹ AaO (o. Fußn. 7), S. 66 und besonders S. 76.

⁴⁰ Fezer, aaO (o. Fußn. 6), Einleitung Rn. 35; ihm folgend Hubmann/Götting, Gewerblicher Rechtsschutz, 6. Aufl., S. 258; vgl. auch Kunz-Hallstein, in: FS DPA – 100 Jahre Marken – Amt, S. 147 ff.; Tilmann, ZHR 158 (1994), 371 ff.; Kiethe/Gröschke, WRP 1998, 541 ff.

⁴¹ Vgl. Sambuc, FS Hertin, S. 439, 443.

⁴² Ob dies der Fall ist, ist Gegenstand der Prüfung im Eintragungsverfahren.

Werbe- oder sonstige Kommunikationsfunktion kann ihr aber als bloßem Registerrecht (noch) nicht zukommen.⁴³ Diese zusätzlichen Funktionen kann eine Marke erst durch tatsächliche Ingebrauchnahme und eine gewisse Bekanntheit im Markt erwerben. Erst wenn und soweit dies geschehen ist, kann die Frage gestellt werden, ob diese zusätzlichen, erworbenen Funktionen auch rechtlich geschützt sind. Dem läßt sich nicht entgegenhalten, daß bereits der Registermarke als Formalrecht eine wenigstens latente Qualitäts-, Werbe- oder sonstige Kommunikationsfunktion innewohne. Das Markenrecht kann immer nur real vorhandene, zumindest nach der Registerlage vorliegende, nicht aber bloß latente Funktionen schützen.⁴⁴

b) Hiervon ausgehend ergibt sich folgendes:

aa) Zum Schutzrechtserwerb

Kraft Benutzung und Verkehrsgeltung geschützte Marken (§ 4 Nr. 2 MarkenG) genießen den gleichen Schutz wie registrierte Marken. Daher muß für die nichtregistrierte genauso wie für die registrierte Marke gelten, daß ihr eine Herkunftsfunktion zukommt, und zwar, da es um einen Schutzrechtserwerb durch tatsächliche Benutzung und Verkehrsgeltung geht, eine tatsächliche Herkunftsfunktion. Die für die Schutzentstehung erforderliche Benutzung und Verkehrsgeltung „als Marke“ ist daher *allein* im Hinblick auf die erforderliche tatsächliche Herkunftsfunktion im Einzelfall näher zu konkretisieren.⁴⁵

bb) Zur Aufrechterhaltung des Schutzes

Soweit für die Aufrechterhaltung des Markenschutzes eine Benutzung erforderlich ist, geht es um den grundsätzlichen Bestand der Marke, somit um ihren Fortbestand als herkunftsindividualisierende Kennzeichnung. Die Aufrechterhaltung einer etwa zusätzlich erworbenen Qualitäts-, Werbe- oder sonstigen Kommunikationsfunktion ist nicht Gegenstand des Benutzungszwangs. Der Benutzungsbegriff kann daher auch insoweit nur im Hinblick auf die Herkunftsfunktion interpretiert werden. Die Rechtsprechung hat daher zu Recht am Erfordernis eines kennzeichenmäßigen Gebrauchs im Sinne der traditionellen Herkunftsfunktion festgehalten.

cc) Zur Markenverletzung

Das deutsche Recht hat in § 14 Abs. 2 Nr. 1 und 2 MarkenG die obligatorischen Vorgaben des Art. 5 Abs. 1 Satz 2 lit. a und b MarkenRL umgesetzt. Danach genießt die Marke Identitätsschutz und Schutz gegenüber Verwechslungsgefahr. Darüber hinaus ist in § 14 Abs. 2 Nr. 3 MarkenG von der Option des Art. 5 Abs. 2 MarkenRL Gebrauch gemacht worden. Im Inland bekannte Marken genießen danach Schutz auch gegenüber Benutzungshandlungen im Bereich unähnlicher Waren, sofern mit der Benutzung eine Verwässerungsgefahr oder eine Rufausbeutung bzw. -schädigung einhergeht.

Der Identitätsschutz und der Schutz gegen Verwechslungsgefahr kommt gleichermaßen benutzten wie unbenutzten, bekannten und unbekanntem Marken zugute. Da, wie unter a) dargelegt, eine unbenutzte Marke keine andere als eine formal nach der Registerlage gegebene Herkunftsfunktion aufweisen kann, ist im Rahmen des § 14 Abs. 2 Nr. 1 und 2 MarkenG mit der bislang vorliegenden instanzgerichtlichen Rechtsprechung grundsätzlich am Erfordernis eines

⁴³ Ähnlich Sambuc, WRP 2000, 985, 988; Althammer/Ströbele, aaO (0. Fußn. 6), § 9 Rn. 42; vgl. auch BGH GRUR 1999, 158, 160 – GARIBALDI.

⁴⁴ A.A. Fezer, WRP 2000, 1 ff., der bereits eine latente Herkunftsfunktion genügen lassen will; hiergegen zutreffend Kur, MarkenR 2000, 1, 5; Sambuc, WRP 2000, 985, 988 f.; Ströbele, GRUR 2001, 658, 664.

⁴⁵ Dasselbe ergibt sich, wie oben zu 3. dargelegt, aus einer Zusammenschau der §§ 4 Nr. 2, 8 Abs. 3 mit dem allgemeinen Markenbegriff des § 3 Abs. 1 MarkenG.

markenmäßigen Gebrauchs im traditionellen, auf die Herkunftsfunktion bezogenen Sinne festzuhalten, wobei im Interesse eines effektiven Schutzes auch der unbenutzten Marke von einem weiten Begriffsverständnis auszugehen ist.

Dasselbe ergibt sich aus dem Begriff der Verwechslungsgefahr, der nach der Rechtsprechung des Europäischen Gerichtshofes allein im Hinblick auf die Herkunftsfunktion auszulegen ist.⁴⁶ Dies gilt gleichermaßen im Hinblick auf die Gefahr eines gedanklichen Inverbindungbringens, bei der es sich nur um eine besondere Spielart der Verwechslungsgefahr handelt.⁴⁷ Es wäre nicht sinnvoll, unter diesen Voraussetzungen den Benutzungsbegriff von der Herkunftsfunktion abzukoppeln.

Aus anderer Warte wird diese Sichtweise noch einmal durch die „BMW/Deenik“-Entscheidung des Europäischen Gerichtshofes⁴⁸ bestätigt. In dieser Entscheidung ist der besonderen Regelung des Art. 5 Abs. 5 MarkenRL über die Verwendung einer Marke zu anderen Zwecken als der Unterscheidung von Waren und Dienstleistungen entnommen worden, daß der Benutzungsbegriff im übrigen nur die Benutzung zur Unterscheidung von Waren und Dienstleistungen erfaßt⁴⁹, somit die markenmäßige Benutzung im traditionellen, auf die Herkunftsfunktion bezogenen Sinne.⁵⁰

Das Erfordernis eines markenmäßigen Gebrauchs dürfte für eine sinnvolle Begrenzung des Markenschutzes auch unverzichtbar sein. § 23 MarkenG (Art. 6 MarkenRL) kann für sich allein den insoweit gebotenen Ausgleich mit den Interessen Dritter nicht leisten. Insbesondere erscheint es nicht zutreffend, jede bloß nennende, d.h. nicht markenmäßige Benutzung einer fremden Marke unter § 23 Nr. 2 MarkenG (Art. 6 Abs. 1 lit. b MarkenRL) zu subsumieren.

Anders verhält es sich dagegen beim Sonderschutz der bekannten Marke gemäß § 14 Abs. 2 Nr. 3 MarkenG/Art. 5 Abs. 2 MarkenRL. Bekannte Marken haben über ihre ursprüngliche Herkunftsfunktion hinaus weitere Funktionen hinzu erworben. Sie lassen sich über ihre bloße Verwendung als Individualisierungszeichen hinaus wirtschaftlich verwerten. Diese zusätzlich hinzu gewonnenen Funktionen werden durch § 14 Abs. 2 Nr. 3 MarkenG über die traditionelle Herkunftsfunktion hinaus selbständig – also nicht nur, wie früher, in den Grenzen der Herkunftsfunktion⁵¹ – rechtlich geschützt. Dem ist durch einen entsprechend weiten Benutzungsbegriff Rechnung zu tragen, der *grundsätzlich jede* Benutzung der Marke für die Produkte Dritter erfaßt.⁵²

Im Schrifttum ist die Auffassung vertreten worden, daß der Benutzungsbegriff für die verschiedenen Verletzungstatbestände nur einheitlich ausgelegt werden könne.⁵³ Begründet wird dies mit fließenden Übergängen der Tatbestände und daraus resultierenden Abgrenzungsschwierigkeiten. Das trifft jedoch nicht zu. Das einzige Abgrenzungsmerkmal zwischen dem Schutz gegen Verwechslungsgefahr und dem Sonderschutz der bekannten Marke ist die Ähnlichkeit bzw. Unähnlichkeit der Waren/Dienstleistungen, für die das angegriffene Zeichen verwendet wird. Diese Frage muß aber ohnehin in *jedem* Verletzungsfall geklärt werden.

⁴⁶ EuGH GRUR 1998, 922, 924 Rn. 26 ff. – Canon; ebenso EuGH, Urt. v. 4.10.2001, Rs. C-517/99, Rn. 22 und 24 – Bravo.

⁴⁷ EuGH GRUR 1998, 387, 389 – Springende Raubkatze; GRUR Int. 2000, 899, 900 – Marca/Adidas.

⁴⁸ EuGH GRUR Int. 1999, 438 – BMW/Deenik.

⁴⁹ AaO Rn. 38 – BMW/Deenik.

⁵⁰ A.A. Fezer, aaO (o. Fußn. 6), § 14 Rn. 30c; Althammer/Klaka, aaO (o. Fußn. 6), § 14 Rn. 67.

⁵¹ Vgl. BGHZ 60, 185, 193 f. – Cinzano.

⁵² Ähnlich schon Kraft, GRUR 1991, 339, 342.

⁵³ Fezer, aaO (o. Fußn. 6), § 14 Rn. 29; ders., GRUR 1996, 566, 567 f.; Ingerl/Rohnke, aaO (o. Fußn. 6), § 14 Rn. 46.

Auch die MarkenRL steht einem differenzierten Verständnis des Benutzungsbegriffs nicht entgegen. Zwar könnte man dem Gesamtzusammenhang des Art. 5 MarkenRL möglicherweise entnehmen, daß der Benutzungsbegriff auch im Rahmen des Sonderschutzes der bekannten Marke (Art. 5 Abs. 2 MarkenRL) im Gegenschluß zu Art. 5 Abs. 5 MarkenRL, somit im traditionellen Sinne auszulegen ist. Dieser Auffassung ist offensichtlich auch der Europäische Gerichtshof.⁵⁴ Dabei darf aber nicht übersehen werden, daß es sich bei Art. 5 Abs. 2 MarkenRL nur um eine *fakultative Vorschrift*, nicht um eine obligatorische Vorgabe handelt. Die Mitgliedstaaten können diese Vorschrift umsetzen, müssen dies aber nicht tun, können sie also auch *anders als vorgegeben* umsetzen.⁵⁵ Insoweit kann dann aber Art. 5 Abs. 5 MarkenRL keine bindende Vorgabe für die Auslegung des Art. 5 Abs. 2 MarkenRL bzw. des entsprechenden nationalen Rechts entnommen werden. Im übrigen schließt es Art. 5 Abs. 5 MarkenRL nicht aus, daß die Mitgliedstaaten den dort vorgesehenen Schutz im Wege des Markenrechts gewähren.

4. Einzelne problematische Benutzungformen

Bevor im folgenden zu einzelnen unter dem Aspekt des Benutzungsbegriffs besonders problematischen Fallgruppen berichtet wird, ist darauf hinzuweisen, daß die Entscheidung markenrechtlicher Sachverhalte in besonderem Maß von den Umständen des Einzelfalles abhängt. Nur mit diesem Vorbehalt lassen sich einige generelle Aussagen treffen.

4.1 Markenrechtlich relevante Benutzungformen im Internet

Vorbemerkung: International-privatrechtliche Aspekte

Der Erwerb, die Aufrechterhaltung und die Verletzung einer Marke setzen stets *inländische* Benutzungshandlungen voraus. Gesetzlich geregelt ist dies für den Benutzungszwang (§ 26 Abs. 1 MarkenG; vgl. auch Art. 10 Abs. 1 MarkenRL). Im übrigen ergibt es sich aus dem im Immaterialgüterrecht allgemein geltenden Schutzlandprinzip.⁵⁶

Probleme bereitet im vorliegenden Zusammenhang insbesondere die Frage, unter welchen Voraussetzungen die Benutzung von Zeichen im weltweit zugänglichen Internet eine Benutzungs-, insbesondere Verletzungshandlung nach Maßgabe des innerstaatlichen Rechts darstellen kann. Hierzu hat das Standing Committee on the Law of Trade marks, Industrial Designs and Geographical Indications der WIPO in seinen Empfehlungen vom 16.3.2001 Handreichungen gegeben.⁵⁷ Diese Vorschläge sind im deutschen Schrifttum insgesamt positiv aufgenommen worden und erscheinen, vor allem was das Kriterium des „commercial effect“ als international-privatrechtlichen Anknüpfungstatbestand angeht, grundsätzlich angemessen.⁵⁸ Es ist vorgeschlagen worden, das Problem im Rahmen des in § 14 Abs. 2 MarkenG enthaltenen Tatbestandsmerkmals der Benutzung *im geschäftlichen Verkehr* zu behandeln.⁵⁹

Eine gesetzliche Regelung dieses Fragenkreises fehlt in Deutschland ebenso wie einschlägige höchstrichterliche Rechtsprechung. Hinzuweisen ist aber auf eine Entscheidung des BPatG, wonach eine rechtserhaltende Benutzung im Inland

⁵⁴ Vgl. EuGH GRUR Int. 1999, 438, 441 Rn. 38 – BMW/Deenik.

⁵⁵ Vgl. zur beschränkten Harmonisierungswirkung bloß fakultativer Richtlinienbestimmungen BPatG GRUR 2001, 744, 746 – S100; unklar Rößler, GRUR 1994, 559, 561, 568.

⁵⁶ Vgl. die im Anhang der Richtlinie 2000/31/EG über den elektronischen Geschäftsverkehr vorgesehene Ausnahme vom Herkunftslandprinzip des Art. 3 Abs. 1 und 2 dieser Richtlinie. Für das Urheberrecht findet sich eine ausdrückliche Normierung des Schutzlandprinzips in Art. 5 Abs. 2 Satz 2 RBÜ.
⁵⁷ Art. 10 Abs. 1 MarkenRL in WRP 2001, 833 ff.

⁵⁸ Vgl. Bettinger, WRP 2001, 789 ff.; Kur, WRP 2000, 935, 937 ff; s. des weiteren Bettinger/Thum, GRUR Int. 1999, 659, 670 ff; zu verwandten Fragestellungen im Urheberrecht s. Schack, MMR 2000, 59 ff.

⁵⁹ Kur, WRP 2000, 935, 937.

angenommen werden kann, wenn eine Internetwerbung (auch) in deutscher Sprache gehalten ist und die Produktion der beworbenen Waren im Inland erfolgt.⁶⁰

Die nachfolgenden Ausführungen gehen davon aus, daß es sich um inländische Sachverhalte handelt.

a) *Benutzung einer Marke „als Marke“ durch Verwendung im Internet*

Die Benutzung von Marken im Internet und deren Rechtsfolgen richten sich grundsätzlich nach den allgemeinen, oben 1. bis 3. dargestellten Regeln. Es ist bislang nicht ersichtlich, daß für die Lösung der insoweit auftretenden Probleme völlig neue Ansätze gefunden werden müßten. Das schließt es nicht aus, daß in Einzelfällen die mit dem Internet verbundenen technischen Möglichkeiten der Nutzung von Kennzeichen eine Anpassung der herkömmlichen Instrumentarien erfordern⁶¹

aa) Schutzrechtserwerb

Ein Schutzrechtserwerb nach §§ 4 Nr. 2, 8 Abs. 3 MarkenG aufgrund einer Zeichenbenutzung im Internet ist nach den insoweit allgemein geltenden Kriterien möglich. Voraussetzung ist also, daß das Zeichen „als Marke“, d.h. als Herkunftshinweis für bestimmte Waren oder Dienstleistungen benutzt wird. Der allgemeine Gebrauch eines Zeichens z.B. als Domainname wird insoweit nicht für ausreichend erachtet.⁶² Durch den Gebrauch als Domainname kann eine geschützte geschäftliche Bezeichnung (§ 5 MarkenG) oder ein Namensrecht (§ 12 BGB) entstehen. Für den Schutz als Marke aber ist darüber hinaus ein konkreter Produktbezug der Benutzung und – darauf aufbauend – der Verkehrsgeltung unabdingbar. Ob hierfür ein bloß „virtueller Produktbezug“ ausreicht⁶³, erscheint zweifelhaft. Eine Privilegierung der Internet-Benutzung ist nicht gerechtfertigt. Im Regelfall wird man deshalb fordern müssen, daß die körperliche Verbindung von Marke und Ware im Internet bildlich dargestellt sein muß. Entsprechendes gilt im Rahmen des Verkehrsdurchsetzungstatbestandes (§ 8 Abs. 3 MarkenG).

bb) Rechtserhaltende Benutzung

Daß die Werbung für Waren und Dienstleistungen im Internet eine rechtserhaltende Benutzung darstellen kann, ist in der instanzgerichtlichen Rechtsprechung – wenn auch nur in einem obiter dictum – bereits anerkannt worden. Als Voraussetzung wurde postuliert, daß eine hinreichende Beziehung zwischen der jeweiligen Ware und der Marke erkennbar wird und die Werbung auf eine tatsächlich beabsichtigte Lieferung der beworbenen Produkte bezogen ist.⁶⁴ Für eine hinreichende Beziehung zwischen Marke und Ware wird dabei im Regelfall – korrespondierend zur Schutzentstehung – zu fordern sein, daß die Marke auf der Ware in der Darstellung im Internet erkennbar ist.

Die Verwendung einer Marke als Domainname wird nach diesen Grundsätzen für sich allein die Annahme einer rechtserhaltenden Benutzung regelmäßig nicht rechtfertigen.⁶⁵ Anders kann es aber bei Dienstleistungen liegen, wenn die Dienstleistung direkt über das Internet unter dem betreffenden Domainnamen erbracht wird.⁶⁶

cc) Markenverletzung

⁶⁰ BPatG Bl. f. PMZ 2001, 24, 25 – Vision; zum Inlandsbezug bei Verletzungshandlungen s. LG Hamburg CR 2000, 392, 393 – keyword buys.

⁶¹ In diesem Sinne auch Herberger, NJW 2000, 2082 ff.

⁶² Fezer, aaO (o. Fußn. 6), § 3 Rn. 309.

⁶³ So Fezer, aaO Rn. 310.

⁶⁴ BPatG Bl. f. PMZ 2001, 24, 25 – Vision.

⁶⁵ Fezer, aaO (o. Fußn. 6), § 3 Rn. 322.

⁶⁶ Fezer, aaO.

In der Rechtsprechung der Instanzgerichte – höchstrichterliche Entscheidungen liegen auch hierzu bislang nicht vor – ist besonders häufig erörtert worden, ob die Verwendung eines mit einer Marke (oder einem sonstigen geschützten Kennzeichen oder Namen) identischen oder verwechslungsfähigen Domainnamens eine Marken- (bzw. sonstige Kennzeichen- oder Namens-) Verletzung darstellt. Sofern man – wie nahezu einhellig die bisher vorliegende Rechtsprechung der Instanzgerichte⁶⁷ - am Erfordernis eines marken- bzw. sonst kennzeichenmäßigen Gebrauchs festhält, kommt es insoweit darauf an, ob man dem Domainnamen nur die technische Funktion einer Rechneradresse oder darüber hinaus auch eine kennzeichenmäßige Funktion zumißt. In Rechtsprechung und Schrifttum wird eine (auch) kennzeichnende Funktion von Domainnamen fast einhellig bejaht, weil zur Bildung von Domainnamen sehr häufig identifizierende Kennzeichen wie Marken, Firmen, Werktitel oder Namen verwendet werden, so daß der Verkehr von einer kennzeichnenden Funktion entsprechend gebildeter Domainnamen ausgehe.⁶⁸ Dies bedeutet, daß Waren und Dienstleistungen, die unter einem Domainnamen im Internet angeboten oder vertrieben werden, durch den Domainnamen im Regelfall zumindest mittelbar ihrer betrieblichen Herkunft nach gekennzeichnet werden, so daß zumeist eine markenrechtlich relevante Benutzungshandlung vorliegen wird.⁶⁹

Verneint wurde indessen ein kennzeichenmäßiger Gebrauch, wenn die Domain keinen eigenen Inhalt hat, sondern lediglich eine Weiterleitung an die eigentliche Homepage des Unternehmens erfolgt.⁷⁰ Ebenfalls verneint wurde eine Benutzungshandlung der Vergabestelle im Hinblick auf die bei ihr registrierten Domainnamen.⁷¹

b) *Verwendung fremder Marken als Metatags*

Nicht selten werden fremde Marken als Metatags in den Quellcode von Websites aufgenommen. Auf diese Weise sollen Suchmaschinen dazu veranlaßt werden, bei Eingabe der Marke durch den Internet-Nutzer die betreffende Homepage (sogar bevorzugt) in der Trefferliste mit anzuzeigen. Ob ein derartiger Gebrauch fremder

⁶⁷ S. dazu oben 1.3.

⁶⁸ KG GRUR-RR 2001, 180 – CHECK IN/checkin.com; OLG Hamburg GRUR-RR 2001, 126, 129 f. – Intershop; OLG Frankfurt GRUR-RR 2001, 5 – mediafacts.de; OLG Hamburg CR 2001, 552 – buecher1001.de; LG München I CR 2001, 416 – BMW; OLG Köln GRUR 2000, 798, 799 – alsdorf.de; OLG München GRUR 2000, 519, 520 – rollsroyce.de; OLG Hamburg MMR 2000, 544, 545 – kulturwerbung.de; OLG München MMR 2000, 277 – Intershopping.com; OLG Rostock NJWE-WettbR 2000, 161 – mueritz-online; OLG München GRUR 2000, 518, 519 – buecherde.com; OLG München MMR 1999, 547 – Buecher.de/Amazon.de; OLG Köln CR 1999, 385 – herzogenrath.de; OLG München CR 1999, 382 – shell.de; OLG München CR 1998, 556, 557 – freundin.de; LG Düsseldorf GRUR 1998, 159, 161 – EPSON; LG Hamburg CR 1998, 47, 48 – eltern.de; LG Frankfurt/Main NJW-RR 1998, 974; OLG Hamm NJW-RR 1998, 909, 910 – krupp.de; KG NJW 1997, 3321, 3322; LG Ansbach NJW 1997, 2688 – ansbach.de; LG Braunschweig NJW 1997, 2687 – braunschweig.de; LG Mannheim GRUR 1997, 377, 378 = NJW 1996, 2736, 2737 – heidelberg.de; ebenso Althammer/Klaka, aaO (o. Fußn. 6), § 15 Rn. 31; Ingerl/Rohnke, aaO (o. Fußn. 6), § 14 R. 65; Fezer, aaO (o. Fußn. 6), § 3 Rn. 329; Reinhart, WRP 2001, 13, 14; Joller, MarkenR 2000, 341, 343; Wiebe, CR 1998, 157, 158; Bettinger, GRUR Int. 1997, 402, 409; Nordemann, NJW 1997, 1891, 1892 (unter dem Aspekt der Schutzfähigkeit von Domainnamen); Bücking, NJW 1997, 1886, 1887; Kur, CR 1996, 590, 591; dies., CR 1996, 325, 327; Freitag, MA 1996, 495, 496; ders., in: Kröger/Gimmy (Hrsg.), Handbuch des Internetrechts, S. 346 f.; vgl. auch Hoffmann, Die Entwicklung des Internetrechts, in: NJW 2001, Beilage zu Heft 14, S. 16 f.; a.A. lediglich die frühen Entscheidungen LG Köln NJW-RR 1998, 976 – pulheim.de; GRUR 1997, 377 – huerth.de; BB 1997, 1121 – kerpen.de - m. abl. Anm. Zahrrnt; offen gelassen von OLG Frankfurt WRP 2000, 645, 646 – weideglueck.de; LG München I CR 1997, 540, 541 – Freundin.de.

⁶⁹ Zu weiteren Benutzungshandlungen s. Fezer, aaO (o. Fußn. 6), § 3 Rn. 324.

⁷⁰ OLG München MMR 1999, 547 – Buecher.de/Amazon.de.

⁷¹ BGH NJW 2001, 3265, 3266 – ambiente.de; OLG Dresden WRP 2001, 706, 708 – Kurt-Biedenkopf.de.

Marken eine markenrechtlich relevante Benutzungshandlung darstellt, ist streitig. Die bisher vorliegende Rechtsprechung der Instanzgerichte bejaht dies uneingeschränkt, gibt hierfür aber keine nähere Begründung.⁷² Auch das Schrifttum geht überwiegend davon aus, daß das Metatagging eine Benutzungshandlung im Sinne der markenrechtliche Verletzungstatbestände darstellt.⁷³ Im einzelnen bestehen hier aber viele Unterschiede. Teils wird der Benutzungscharakter nur für den Fall bejaht, daß ein markenmäßiger Gebrauch im herkömmlichen Sinne nicht erforderlich ist⁷⁴, teils wird er bejaht, weil der Begriff der markenmäßigen Benutzung „multifunktional“ weit auszulegen sei⁷⁵, teils deswegen, weil das Metatagging jedenfalls eine Benutzungshandlung im Sinne der „BMW/Deenik“-Entscheidung des Europäischen Gerichtshofes darstelle.⁷⁶ Demgegenüber wird vor allem eingewendet, daß der Gebrauch einer Marke als Metatag für den Internet-Nutzer nicht sichtbar in Erscheinung tritt; insoweit liege nicht nur kein markenmäßiger Gebrauch, sondern überhaupt keine Benutzung der fremden Marke vor.⁷⁷

Ob und unter welchen Voraussetzungen das Metatagging unter dem Gesichtspunkt des § 23 MarkenG (Art. 6 MarkenRL) oder im Hinblick auf eine Erschöpfung des Markenrechts gerechtfertigt sein kann⁷⁸, ist bisher nicht Gegenstand gerichtlicher Entscheidungen gewesen.

Mit einer dem Metatagging ähnlichen Problematik hatte sich das LG Hamburg zu befassen. Die Beklagte, eine online-Parfümerie, hatte mit der Zweitbeklagten, der Betreiberin einer Suchmaschine, eine entgeltliche Abrede dahingehend getroffen, daß bei der Eingabe bestimmter Kosmetikmarken durch Internet-Nutzer ein Werbebanner der Beklagten auf dem Bildschirm erschien, während die Trefferliste erstellt wurde. Auf dem Werbebanner selbst erschienen die betreffenden Marken nicht. Das LG Hamburg hat in dieser Verwendung fremder Kosmetikmarken keinen markenmäßigen Gebrauch im traditionellen, auf die Herkunftsfunktion bezogenen Sinne gesehen⁷⁹ und lediglich eine wettbewerbswidrige Rufausbeutung (auch durch den Suchmaschinen-Betreiber) angenommen.

c) *Verwendung fremder Marken und verwechslungsfähiger Zeichen im Rahmen von Links*

Die Verlinkung von Websites unter Nennung fremder Marken wird im Schrifttum für grundsätzlich zulässig erachtet. Dies wird jedoch weder mit einer entsprechenden Auslegung des Benutzungsbegriffs noch unter Heranziehung der Freistellungstatbestände der §§ 23, 24 MarkenG (Art. 6 und 7 MarkenRL) begründet, sondern teilweise mit einer vermuteten Zustimmung der betroffenen Markeninhaber⁸⁰, teilweise mit einem allgemeinen Werberecht als Schranke des Kennzeichenrechts.⁸¹

Eine ganze Serie gerichtlicher Verfahren betraf Links auf Websites, von denen aus die Software „FTP-Explorer“ des amerikanischen Softwareherstellers FTPX heruntergeladen werden konnte. Hiergegen wandte sich jeweils die Inhaberin der Software-Marke „Explorer“. Soweit nicht eine Verwechslungsgefahr zwischen dem

⁷² OLG München WRP 2000, 775, 778 – Hanseatic; LG Frankfurt/Main CR 2000, 462, 463; LG Hamburg CR 2000, 121 m. zust. Anm. Ernst; LG Mannheim CR 1998, 306 f. – ARWIS.

⁷³ Ohne nähere Begründung Fezer, aaO (o. Fußn. 6), § 3 Rn. 342; Freitag, in: Kröger/Gimmy (Hrsg.), Handbuch des Internetrechts, S. 357; Koch, NJW-CoR 1998, 45, 47.

⁷⁴ Viefhues, MMR 1999, 336, 339.

⁷⁵ Menke, WRP 1999, 982, 984 ff.; vgl. hierzu auch Fezer, aaO (o. Fußn. 6), § 14 Rn. 48 f.

⁷⁶ Kur, CR 2000, 448, 451 f.

⁷⁷ Kotthoff, K&R 1999, 157, 159 f.; ablehnend auch Schmidt-Bogatzky, GRUR 2000, 959, 961 f.

⁷⁸ Vgl. hierzu österrOGH ÖBl. 2001, 126.

⁷⁹ LG Hamburg CR 2000, 392, 394 – keyword buys; insoweit abl. Schmidt-Bogatzky, GRUR 2000, 959, 960 f.

⁸⁰ Hoeren, WRP 1997, 993, 995.

⁸¹ Fezer, aaO (o. Fußn. 6), § 3 Rn. 338.

Zeichen „FTP-Explorer“ und der Marke „Explorer“ verneint wurde⁸², haben die Gerichte angenommen, daß das Setzen des Links eine kennzeichenmäßige Verwendung des verletzenden Zeichens „FTP-Explorer“ darstelle.⁸³

d) *Framing*

Die markenrechtliche Beurteilung des Framing war bislang, soweit ersichtlich, noch nicht Gegenstand gerichtlicher Entscheidungen. Die Gefahr von Kennzeichenverletzungen dürfte hier aber grundsätzlich höher einzustufen sein als bei dem bloßen Setzen von Links.

4.2 *Verwendung fremder Marken durch Fan-Clubs*

Der Gebrauch fremder Marken durch Fan-Clubs usw. wird sich häufig außerhalb des geschäftlichen Verkehrs abspielen und bereits deshalb kaum Anhaltspunkte für ein markenrechtliches Vorgehen bieten.⁸⁴ Anders liegt es dagegen bei der Verwendung von Marken als schmückende Ausstattung von Fan-Artikeln, Werbegeschenken etc.

Unter dem früheren Recht schieden bei einer nur ornamentalen Verwendung fremder Marken zeichenrechtliche Ansprüche regelmäßig aus, teils unter dem Gesichtspunkt des fehlenden markenmäßigen Gebrauchs⁸⁵, teils wegen fehlender Warengleichartigkeit.⁸⁶ Insoweit kamen nur wettbewerbsrechtliche Ansprüche in Betracht.⁸⁷

Unter dem geltenden Recht erscheint eine andere Betrachtungsweise geboten. Auch wenn man – mit der hier bevorzugten Auffassung⁸⁸ – jedenfalls in den Fällen des Identitätsschutzes und bei der Beurteilung der Verwechslungsgefahr an dem Erfordernis eines markenmäßigen Gebrauchs festhält, werden markenrechtliche Ansprüche hieran in der Regel nicht scheitern. Wer z.B. eine fremde Bekleidungsmarke dekorativ auf ein T-Shirt aufdruckt, benutzt diese Marke ohne weiteres markenmäßig in dem weiten Sinne, wie es im Interesse eines effektiven Markenschutzes anzunehmen geboten ist.⁸⁹ Soweit eine ornamentale Verwendung der fremden Marke auf unähnlichen Waren erfolgt, werden meist die Voraussetzungen des § 14 Abs. 2 Nr. 3 MarkenG erfüllt sein, denn praktisch sind es allein bekannte Marken und deren besonderes Flair, welches Dritte zu einer Ausbeutung in Form von ornamentalen Verwendungen verleitet. Markenmäßiger Gebrauch ist insoweit nach der hier bevorzugten Auffassung nicht erforderlich.

Eine praktisch relevante Schutzlücke wird sich nur in den seltenen Fällen ergeben, in denen eine (bekannte) Marke im Warenidentitäts- oder –ähnlichkeitsbereich benutzt wird, so daß insoweit die Voraussetzungen des Sonderschutzes der bekannten Marke nach § 14 Abs. 2 Nr. 3 MarkenG nicht erfüllt sind, und andererseits Ansprüche aus § 14 Abs. 2 Nr. 1 und 2 MarkenG wegen eindeutig fehlenden markenmäßigen Gebrauchs ausscheiden. So kann es etwa bei der Verwendung mehrerer bekannter Marken nebeneinander als Dekor liegen.⁹⁰ Da auch in diesen Fällen das vom Markeninhaber geschaffene Image ungerechtfertigt ausgebeutet wird, muß man entweder mit einer entsprechenden

⁸² OLG Braunschweig MMR 2001, 608, 610.

⁸³ OLG Hamm, MMR 2001, 611 – FTP-Explorer; LG Braunschweig NJWE-WettbR 2000, 298, 299; LG München I MMR 2000, 566, 568; anders für den Betreiber einer Suchmaschine LG München I NJW-RR 2001, 550.

⁸⁴ Vgl. Fezer, aaO (o. Fußn. 6), § 3 Rn. 328.

⁸⁵ Z.B. BGH GRUR 1994, 635, 636 – Pulloverbeschriftungen; GRUR 1960, 126, 128 – Sternbild; OLG München GRUR 1991, 218 – Wiesenausschnitt.

⁸⁶ Vgl. OLG München GRUR Int. 1981, 180, 183 – John Player.

⁸⁷ Vgl. BGH GRUR 1994, 635, 636 – Pulloverbeschriftungen.

⁸⁸ Vgl. oben Abschnitt 3a.

⁸⁹ Ebenso Kur, MarkenR 2001, 137, 143.

⁹⁰ Vgl. BGH GRUR 1994, 635 – Pulloverbeschriftungen; s. hierzu auch Kur, MarkenR 2001, 137, 143 Fußn. 44; vgl. auch OLG Dresden NJW 2001, 615, 616 – Johann Sebastian Bach.

Anwendung des § 14 Abs. 2 Nr. 3 MarkenG helfen oder wettbewerbsrechtliche Ansprüche in Betracht ziehen.⁹¹

Hinzuweisen ist noch auf eine Entscheidung des OLG München, in der eine rechtserhaltende Benutzung durch die dekorative Verwendung einer Marke auf Fan-Artikeln verneint wurde.⁹²

4.3 Markenparodien

Unter der Geltung des WZG ist ausführlich erörtert worden, ob in der parodistischen Verfremdung einer Marke noch ein zeichenmäßiger Gebrauch „als Marke“ zu sehen ist. Die Rechtsprechung stand dem zunächst eher ablehnend gegenüber.⁹³ Dabei ist allerdings nicht zu verkennen, daß die einschlägigen höchstrichterlichen Urteile⁹⁴ nicht von dem für das Wettbewerbs- und Markenrecht, sondern von dem für das bürgerliche Deliktsrecht zuständigen Senat des Bundesgerichtshofes erlassen wurden. In späteren Fällen hat der Marken- und Wettbewerbssenat des Bundesgerichtshofes einen zeichenmäßigen Gebrauch großzügig bejaht. Ein solcher sollte jedenfalls dann vorliegen, wenn im Verkehr der Eindruck entstehen könne, der Markeninhaber selbst stehe hinter der Parodie.⁹⁵

Wie die Fälle der Markenparodie bzw. der parodistischen Verunglimpfung im geltenden Recht einzuordnen sind, war noch nicht Gegenstand der höchstrichterlichen Rechtsprechung. Das Kammergericht hat – im Hinblick auf den von ihm für erforderlich gehaltenen markenmäßigen Gebrauch – markenrechtliche Ansprüche in einem Fall verneint, in dem die sehr bekannte Hauptmarke eines deutschen Telekommunikationsunternehmens in kritisch verballhornter Form als Postkartenaufdruck verwendet worden war.⁹⁶

Die Vorschläge in der Literatur hängen im wesentlichen davon ab, ob markenmäßiger Gebrauch im Rahmen der Verletzungstatbestände für erforderlich gehalten wird. Soweit dies der Fall ist, wird der rechtliche Ansatz schwerpunktmäßig im allgemeinen Recht des unlauteren Wettbewerbs gesehen.⁹⁷ Die Gegenmeinung stellt hingegen im Hinblick auf die mit der Markenparodie verbundene Ruf- bzw. Aufmerksamkeitsausbeutung auf den Sonderschutz der bekannten Marke (§ 14 Abs. 2 Nr. 3 MarkenG) ab.⁹⁸

Nach der hier bevorzugten Auffassung kommt es im Warenidentitäts- oder -ähnlichkeitsbereich (§ 14 Abs. 2 Nr. 1 und 2 MarkenG) auf das Vorliegen eines markenmäßigen Gebrauchs an. Dieser wird sich jedoch – bei der gebotenen großzügigen Betrachtungsweise – meist bejahen lassen. Dafür spricht schon eine tatsächliche Vermutung.⁹⁹ Wer eine fremde Marke parodiert, um unter dem verfremdeten Zeichen seine eigenen, identischen oder ähnlichen Waren abzusetzen, der legt es regelmäßig (zumindest auch) auf eine Herkunftsverwirrung an. Das Gros der Fälle betrifft indessen eine Verwendung der Parodie für unähnliche Waren. Markenmäßiger Gebrauch ist insoweit nicht erforderlich. Meist werden auch die weiteren Voraussetzungen des § 14 Abs. 2 Nr. 3

⁹¹ Vgl. zur entsprechenden Anwendung des § 14 Abs. 2 Nr. 3 MarkenG/Art. 5 Abs. 2 MarkenRL BGH GRUR 2000, 875 – Davidoff (Vorlage an den EuGH).

⁹² OLG München WRP 1996, 128, 130 – THE BEATLES.

⁹³ OLG Frankfurt GRUR 1982, 319, 320 – Lusthansa; BGH GRUR 1984, 684, 685 – Mordoro; BGH GRUR 1986, 759, 760 – BMW m. abl. Anm. Bollack/Friehe.

⁹⁴ S. vor. Fußn.

⁹⁵ BGH GRUR 1995, 57, 60 – Markenverunglimpfung II (Nivea); GRUR 1994, 808, 809 – Markenverunglimpfung I (Mars); vgl. auch OLG Hamburg GRUR 1992, 58 – adihash; abl. zur Annahme eines zeichenmäßigen Gebrauchs in den genannten BGH-Fällen Götting, JZ 1995, 206, 207; vgl. auch Deutsch, GRUR 1995, 319 ff.

⁹⁶ KG GRUR 1997, 295, 296 – Alles wird Teurer.

⁹⁷ Vgl. Schultze/Schwenn, WRP 1997, 536, 539.

⁹⁸ Vgl. Ingerl/Rohnke, aaO (o. Fußn. 6), § 14 Rn. 98 f.; Althammer/Klaka, aaO (o. Fußn. 6), § 14 Rn. 68; Fezer, aaO (o. Fußn. 6), § 14 Rn. 436.

⁹⁹ Vgl. BGH GRUR 1995, 57, 60 – Markenverunglimpfung II (Nivea).

MarkenG, insbesondere die Ausnutzung der Wertschätzung einer bekannten Marke, vorliegen, so daß die Parodie grundsätzlich markenrechtlich abgewehrt werden kann.

Zu beachten ist aber, daß insbesondere in den Fällen der Markenparodie der verfassungsrechtliche Schutz der Meinungsfreiheit (Art. 5 GG) größere Bedeutung erlangen kann. Darauf hat – in anderem rechtlichen Zusammenhang – auch der Bundesgerichtshof hingewiesen.¹⁰⁰ Gerade die bekannte Marke ist nicht nur ein ausschließlich dem Markeninhaber zugeordnetes Absatz- und Marketinginstrument, sondern Teil des gesellschaftlichen und kulturellen Kommunikationsprozesses. Insoweit hat sie sich auch öffentlicher Kritik zu stellen.¹⁰¹ Daß die Auseinandersetzung mit einer bekannten Marke, soweit markenrechtlich von Interesse, im geschäftlichen Verkehr und gegebenenfalls zu eigenen Absatzzwecken stattfindet, steht einer Berücksichtigung der verfassungsrechtlich verbürgten Meinungsfreiheit nicht entgegen.¹⁰² Das in § 14 Abs. 2 Nr. 3 MarkenG/Art. 5 Abs. 2 MarkenRL enthaltene Tatbestandsmerkmal „ohne rechtfertigenden Grund in unlauterer Weise“ eröffnet den nötigen Spielraum für die gebotene Berücksichtigung grundrechtlicher Belange.¹⁰³

4.4 Vergleichende Werbung

Die markenrechtliche Einordnung der Verwendung fremder Marken im Rahmen vergleichender Werbung war ebenfalls noch nicht Gegenstand höchstrichterlicher Rechtsprechung. Dementsprechend beherrscht auch hier ein stark differenziertes Meinungsspektrum das Bild. Die Regierungsbegründungen zum MarkenG¹⁰⁴ und zum Entwurf eines Gesetzes über vergleichende Werbung¹⁰⁵ sowie Teile des Schrifttums¹⁰⁶ gehen davon aus, daß der Gebrauch einer fremden Marke in der vergleichenden Werbung von vornherein nicht unter einen der Markenverletzungstatbestände fällt, weil der Gebrauch insoweit nicht für *eigene* Waren und Dienstleistungen des Benutzers erfolgt. Dem hat sich auch das OLG München angeschlossen.¹⁰⁷ Andere vertreten demgegenüber die Auffassung, daß solche Benutzungshandlungen grundsätzlich den Verletzungstatbestand erfüllen, jedoch unter den Voraussetzungen der Richtlinie 97/55/EG¹⁰⁸ von der markenrechtlichen Haftung freigestellt sind. Insoweit wird teilweise angenommen, die Freistellung erfolge über § 23 Nr. 2 MarkenG (Art. 6 Abs. 1 lit. b MarkenRL).¹⁰⁹ Andererseits ist vorgeschlagen worden, in solchen Fällen den Erschöpfungstatbestand anzuwenden.¹¹⁰

Der Unterschied zwischen den geschilderten Grundauffassungen besteht darin, daß die letztere im Falle einer wettbewerbsrechtlich unzulässigen vergleichenden Werbung neben wettbewerbsrechtlichen Ansprüchen auch konkurrierende markenrechtliche Ansprüche annehmen kann¹¹¹, während dies nach der in der Regierungsbegründung vertretenen Ansicht nicht möglich ist.¹¹²

¹⁰⁰ BGH GRUR 1984, 684, 685 ff. – Mordoro (betreffend die Verfremdung der bekannten Zigarettenmarke „Marlboro“ in einem Nichtraucher-Kalender); vgl. auch Fezer, aaO (o. Fußn. 6), § 14 Rn. 429 und 436.

¹⁰¹ Vgl. Götting, JZ 1995, 206, 207.

¹⁰² Vgl. BVerfG GRUR 2001, 170 – Schockwerbung (Benetton); s. hierzu auch Kur, MarkenR 2001, 137, 139 Fußn. 22.

¹⁰³ Vgl. Kur, MarkenR 2001, 137, 139.

¹⁰⁴ AaO (o. Fußn. 7), S. 69.

¹⁰⁵ WRP 2000, 555, 557.

¹⁰⁶ Ingerl/Rohnke, aaO (o. Fußn. 6), § 14 Rn. 89; ebenso wohl Köhler/Piper, UWG, 2. Aufl. (2001), § 2 Rn. 49.

¹⁰⁷ OLG München WRP 2001, 820, 828 – Duft-Vergleichslisten.

¹⁰⁸ ABI. EG Nr. L 290 S. 18 v. 23.10.1997; in Deutschland umgesetzt durch §§ 2 und 3 Satz 2 UWG.

¹⁰⁹ Fezer, aaO (o. Fußn. 6), § 14 Rn. 496 und § 23 Rn. 49; Althammer/Klaka, aaO (o. Fußn. 6), § 14 Rn. 94.

¹¹⁰ Kur, MarkenR 2001, 137, 142.

¹¹¹ Vgl. Fezer, aaO (o. Fußn. 6), § 14 Rn. 496 a.E.

¹¹² Vgl. OLG München WRP 2001, 820, 828 – Duft-Vergleichslisten.

Einen Ansatzpunkt zur Lösung dieser Frage bietet möglicherweise der 15. Erwägungsgrund zur Richtlinie 97/55/EG. Danach stellt eine Benutzung von Marken eines Mitbewerbers keine Verletzung dar, wenn sie unter Beachtung der in der Richtlinie aufgestellten Bedingungen erfolgt. Das könnte den Gegenschluß nahelegen, daß eine nicht den Erfordernissen der Richtlinie entsprechende vergleichende Werbung eine Verletzungshandlung darstellt. Zwingend erscheint ein solcher Gegenschluß nicht. Zieht man ihn aber, so wäre insoweit die markenrechtliche Verortung der Freistellung einer zulässigen vergleichenden Werbung zu klären. Die bisher hierzu gemachten Vorschläge (§§ 23 Nr. 2, 24 MarkenG/Art. 6 und 7 MarkenRL) erscheinen nicht überzeugend, da sie den Wortlaut und Zweck der betreffenden Vorschriften stark strapazieren. Denkbar wäre aber, den Freistellungstatbestand unmittelbar in dem genannten 15. Erwägungsgrund der Richtlinie 97/55/EG zu sehen.¹¹³

5. Ergänzende Anwendung der Vorschriften gegen den unlauteren Wettbewerb

Wie der vorstehende Bericht gezeigt hat, kann die Marke auch gegenüber unkonventionellen Benutzungshandlungen in der Regel erfolgreich mit den Instrumentarien des Markenrechts verteidigt werden. Soweit dies der Fall ist, scheiden nach der Rechtsprechung des Bundesgerichtshofes konkurrierende wettbewerbsrechtliche Ansprüche aus.¹¹⁴ Ein Rückgriff auf das allgemeine Unlauterkeitsrecht und ebenso auf das bürgerliche Recht¹¹⁵ ist nur bei Sachverhalten möglich, die vom MarkenG nicht erfaßt werden.¹¹⁶ Etwas anderes müßte allerdings im Fall der wettbewerbsrechtlich unzulässigen vergleichenden Werbung gelten, wenn man darin zugleich eine Markenverletzung erblickt.¹¹⁷ Noch nicht abschließend geklärt ist des weiteren der Schutz der bekannten Marke im Warenidentitäts- oder –ähnlichkeitsbereich. Insoweit kommt sowohl eine markenrechtliche Lösung über eine entsprechende Anwendung des § 14 Abs. 2 Nr. 3 MarkenG/Art. 5 Abs. 2 MarkenRL als auch eine wettbewerbsrechtliche Lösung in Betracht.¹¹⁸

6. Markenmäßiger Gebrauch im traditionellen Sinne und Sonderschutz bekannter Marken im Bereich unähnlicher Waren

Wie ausführlich erörtert, hat das MarkenG von der Option des Art. 5 Abs. 2 MarkenRL Gebrauch gemacht und sieht in § 14 Abs. 2 Nr. 3 einen Sonderschutz im Inland bekannter Marken im Warenunähnlichkeitsbereich gegenüber verwässernden und rufausbeutenden oder –schädigenden Benutzungen vor. Im übrigen ist darauf hinzuweisen, daß der Sonderschutz der bekannten Marke nicht zwingend ein Korrektiv zu dem Erfordernis des markenmäßigen Gebrauchs im traditionellen Sinne darstellt. Es erscheint immerhin möglich, auch im Rahmen dieses Sonderschutzes einen markenmäßigen Gebrauch zu fordern. Nach der hier bevorzugten Auffassung wäre dies allerdings nicht sachgerecht.

Zusammenfassung

Mit dem seit 1.1.1995 in Kraft befindlichen MarkenG wurden u.a. die Vorgaben der Richtlinie 89/104/EWG vom 21.12.1988 in nationales Recht umgesetzt. In Übereinstimmung mit Art. 5 Abs. 2 MarkenRL ist neben dem Schutz gegen Verwechslungsgefahr ein besonderer Schutz im Inland bekannter Marken gegenüber Verwässerungsgefahr und gegenüber rufausbeutenden oder –schädigenden Handlungen außerhalb des Warenähnlichkeitsbereichs vorgesehen.

¹¹³ Der genannte Erwägungsgrund hätte insoweit gegenüber der MarkenRL rechtsändernde Qualität. Die rechtsändernde Qualität von Erwägungsgründen ist aber auch schon anderweit anerkannt worden, vgl. den 17. Erwägungsgrund zur Verordnung (EG) Nr. 1610/96 über die Schaffung eines ergänzenden Schutzzertifikats für Pflanzenschutzmittel, ABI. EG Nr. L 198 v. 8.8.1996, S. 30.

¹¹⁴ Grundlegend BGH GRUR 1999, 161, 162 – MAC Dog; bestätigt in BGH WRP 2001, 1193, 1194 – Tagesreport; WRP 2001, 1188, 1189 – Tagesschau.

¹¹⁵ Vgl. hierzu BGH GRUR 1998, 696, 697 – Rolex-Uhr mit Diamanten.

¹¹⁶ A.A. insb. Fezer, aaO (o. Fußn. 6), § 2 Rn. 2 ff. Er tritt für eine uneingeschränkte Anspruchskonkurrenz ein.

¹¹⁷ S. oben 4.4.

¹¹⁸ Vgl. hierzu die Vorlage BGH GRUR 2000, 875 – Davidoff.

Ob und inwieweit eine Benutzung der Marke „als Marke“ Voraussetzung für den Erwerb, die Aufrechterhaltung und die Verletzung von Rechten ist, ist für die Rechtslage unter dem MarkenG erst punktuell höchststrichterlich geklärt und im übrigen Gegenstand einer lebhaften Kontroverse.

Für die Entstehung von Marken außerhalb des Markenregisters verlangt das MarkenG neben der Benutzung im geschäftlichen Verkehr, daß das Zeichen „als Marke“ Verkehrsgeltung erworben hat. Dies setzt eine Benutzung „als Marke“ im traditionellen, auf die Herkunftsfunktion bezogenen Sinne voraus. Im Rahmen des Benutzungszwangs ist ebenfalls eine Benutzung „als Marke“ erforderlich. Auch insoweit zeichnet sich in der Rechtsprechung die Tendenz ab, den Benutzungsbegriff im traditionellen Sinne zu verstehen.

Der Begriff der rechtsverletzenden Benutzung ist im deutschen Recht seit langem eigenständig ausgelegt worden. Davon ist auch unter dem geltenden Recht auszugehen. Umstritten ist dagegen, ob die rechtsverletzende Benutzung – wie im früheren Recht – eine Benutzung des angegriffenen Zeichens „als Marke“ voraussetzt. Dies dürfte im Hinblick auf den Identitätsschutz und den Schutz gegen Verwechslungsgefahr in Übereinstimmung mit der Auffassung der Bundesregierung zu bejahen sein. Der besondere markenrechtliche Schutz bekannter Marken außerhalb des Warenähnlichkeitsbereichs sollte jedoch gegenüber jedweder Verwendung gewährt werden.

Die Verwendung einer fremden Marke als Internet-Domainname wird ganz überwiegend ebenso als markenrechtlich relevante Benutzungshandlung beurteilt wie die Verwendung als Metatag. Dagegen wird der Gebrauch fremder Marken im Rahmen von Links als grundsätzlich zulässig angesehen. Rechtsprechung und Literatur zur markenrechtlichen Beurteilung des Framing liegen derzeit noch nicht vor.

Der Einsatz fremder Marken als Dekoration auf Fan-Artikeln usw. wird überwiegend als rechtsverletzend qualifiziert. Das gleiche gilt für Markenparodien. Ob der Gebrauch fremder Marken im Rahmen vergleichender Werbung eine relevante Benutzungshandlung darstellt, ist demgegenüber umstritten. Die Bundesregierung hat dies jedoch mehrfach verneint.

Der Rückgriff auf das Recht gegen den unlauteren Wettbewerb kommt nach der Rechtsprechung des Bundesgerichtshofes nur für Sachverhalte in Betracht, die im MarkenG keine Regelung gefunden haben. Die meisten Fälle einer unkonventionellen Verwendung fremder Marken werden sich jedoch mit dem Instrumentarium des Markenrechts lösen lassen.

Summary

With the Trade Mark Act, in force as from 1 January 1995, the requirements of Directive 89/104/EEC of 21 December 1988 were introduced into national law. In agreement with Art. 5 paragraph 2 of the Trade Marks Directive, in addition to the protection against a risk of confusion, special protection against a risk of dilution and against acts taking unfair advantage of or being detrimental to the repute of a trade mark is granted beyond the scope of similarity of goods to trade marks having a reputation in the country.

If and to what extent the use of a trade mark "as a mark" is a prerequisite for obtaining, maintaining and infringing rights, is determined by the courts under the new Trade Mark Act only in individual cases and is the subject of intense controversies in other cases.

The Trade Mark Act requires the sign to have obtained a recognition "as a mark" in trade, in addition to the use in trade, for the acquisition of a trade mark right outside the trade mark register. This implies use "as a mark" in the traditional sense as an indication of origin. Use "as a mark" is also necessary with respect to the legal onus of use. In this respect, too, a tendency to interpret the term "use" of the trade mark in its traditional sense is emerging in the jurisdiction.

The term of infringing use has been interpreted independently by German law for a long period of time. This may also be assumed under present law. However, it remains controversial whether infringing use presupposes - as under former law - the use of the infringing sign "as a mark". This

should be affirmed in respect to the protection of identity and the protection against the risk of confusion in agreement with the opinion of the German Federal Government. However, the special trade mark protection conferred even outside the scope of similar goods to marks having a reputation, should be granted with respect to any kind of use.

The use of a trade mark owned by a third party as an Internet domain name is predominantly regarded as an act of use relevant with respect to trade mark law, just as the use as a metatag. On the other hand, the use of a trade mark in connection with hyperlinks is generally considered to be admissible. Jurisdiction and legal writing on the assessment of framing under trade mark law are not yet available.

The use of trade marks owned by third parties as decoration on fan articles and the like is predominantly qualified as infringing trade mark rights. The same applies to trade mark parodies. However, it remains controversial whether the use of a trade mark owned by a third party in connection with comparative advertising is a relevant form of use. The German Federal Government has repeatedly denied this.

According to the jurisdiction of the Federal Supreme Court, the application of the law on unfair competition is only admissible for cases not contemplated by the Trade Mark Act. Most cases of unconventional use of trade marks may, however, be solved by applying the provisions of the Trade Mark Act.

Résumé

La Loi de Marques, en vigueur depuis le 1 janvier 1995, a introduit, entre autres, les dispositions de la Directive 89/104/CEE du 21 décembre 1988 dans le droit national. En conformité avec l'article 5 paragraphe 2 de la Directive sur les Marques, outre la protection contre le risque de confusion, une protection spéciale de marques jouissant d'une renommée dans le pays contre la dilution et contre des actes tirant indûment profit de leur renommée ou leur portant préjudice, est prévue hors du domaine de similitude des produits.

La question si et dans quelle mesure l'usage d'une marque "en tant que marque" est une condition de l'obtention, le maintien et la violation de droits, n'a été résolue pour la Loi de Marques par la jurisprudence que pour des cas isolés et constitue, pour les cas restants, le sujet d'une controverse intense.

Pour l'obtention de marques hors du registre des marques, la Loi de Marques exige, en plus de l'usage dans le commerce, que le signe soit reconnu "en tant que marque". Ceci présuppose un usage "en tant que marque" dans le sens traditionnel relatif à l'indication de l'origine. Dans le cadre d'obligation d'usage, là aussi, un usage "en tant que marque" est requis. En ce sens aussi, on entrevoit une tendance dans la jurisprudence à comprendre le terme d'usage dans le sens traditionnel.

Le terme d'un usage violant un droit a été, depuis longtemps, interprété d'une manière indépendante par la jurisprudence allemande. Il faut supposer que cette pratique continuera sous la loi actuelle. Par contre, la question si un usage violant un droit - comme selon la législation antérieure - présuppose un usage du signe "en tant que marque", est controversée. En vue de la protection contre l'usage d'un signe identique et de la protection contre le risque de confusion, en conformité avec l'opinion du Gouvernement Fédéral, on y répondrait à l'affirmative. La protection de marque conférée hors du domaine de similitude des produits aux marques jouissant de renommée, devrait être garantie par rapport à un usage quelconque.

L'usage d'une marque d'un tiers comme nom d'un domaine internet, de même que l'emploi comme *metatag*, se considère, dans la majorité des cas, comme un acte d'usage pertinent par rapport au droit de marques. Par contre, l'usage de marques de tiers dans le cadre de liens hypertexte (hyperlink) se considère généralement comme admissible. A ce jour, il n'existe pas encore de jurisprudence ni de littérature sur l'évaluation du cadrage (*framing*) par rapport au droit de marques.

L'emploi de marques de tiers comme décoration sur des articles pour des admirateurs (*fans*) se qualifie, dans la majorité des cas, comme une violation de droits. Le même vaut pour les parodies de marques. Par contre, la question si l'usage de marques de tiers dans le cadre de la publicité comparative constitue un acte d'usage pertinent, est controversée. Néanmoins, le Gouvernement y a répondu négativement à maintes reprises.

Selon la jurisprudence de la Cour suprême, le droit relatif à la concurrence déloyale est applicable seulement aux cas qui ne sont pas réglés par la Loi de Marques. Nonobstant, la majorité des cas d'usages non conventionnels de marques de tiers pourront être résolus au moyen des provisions de la Loi de Marques.

Report Q168

in the name of the Hungarian Group
by Dr. Zoltán TAKÁCS (Chair), Dr. Tamás GÖDÖLLE, Dr. Natalie NÁTHON,
Dr. Ádám SZENTPÉTERI, Dr. Éva SZIGETI and Dr. Dóra TAMÁS

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

In reply to the Guidelines for Question 168, the Hungarian Group would like to report and express its opinion as follows.

I. Answers to the Questions

1. Is there any requirement for use of a mark "as a mark" for the purpose of

1.1 Acquiring a mark (if rights may be acquired by use according to national law)

Hungary has the system of acquiring trademark rights through registration. Prior use or intent to use is not required for registration.

1.2 Maintaining of a trademark registration (e.g. against an application for cancellation on grounds of non-use)

In order to be maintained, registered trademarks shall be genuinely used in Hungary. The acceptability of the use - with respect to the volume, quality and the manner of it - is decided on a case-by-case basis. Using the mark to the goods or their packaging, placing goods with the mark on the market, offering them for sale, stocking them for the purpose of placing the goods on the market, providing or offering services under the mark, importing or exporting goods bearing the mark are manners of use which use to be considered in cancellation procedures initiated on the ground of lack of use. It is still a matter of dispute whether the mere use of the trademark on business papers or in advertising would be regarded as genuine use according to the present Trademark Act of 1997 which entered into force on July 1, 1997.

1.3 Establishing infringement

According to the Hungarian Trademark Act, all manners of commercial use mentioned under 1.2., including use on business papers and in advertising without the consent of the owner, would constitute trademark infringement.

2. Is there any definition of what is use "as a mark" either in statute or case law?

There is no definition in the Hungarian Trademark Act of 1997 as to what is considered to be use "as a mark". There is a non-exhaustive list of the manners of use as mentioned under 1.2.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

For acquisition, no use is required. Concerning maintenance and infringement of rights, there is a difference. Namely, what will deem to be sufficient with respect to maintenance will constitute infringement, provided that the mark is used without the consent of the owner. However, not all acts of use may qualify as "genuine use". One single act of use may be sufficient to commit an infringement; while for maintenance purposes the scope,

manner and volume of the actual use will be taken into consideration in determining whether to qualify as "genuine use". In addition, characteristics of the concerned goods and services will be also of relevance in that respect.

4. Is any of the following considered to be use "as a mark"

4.1 *Use on the internet, as a metatag, in linking or framing:*

4.2 *Use by fan clubs of supporters:*

4.3 *Parody, and*

4.4 *Comparative advertising.*

Hungary does not have any law adopted to directly address these questions, but, in general, a differentiation can be made as to whether these questions are examined regarding the maintenance or infringement of rights. Probably, certain ways of use that will constitute trademark infringement will not be deemed sufficient to maintain a mark. Any of the above unconventional uses without the consent of the owner and with commercial purpose might lead to infringement even if the use is sporadic, while the same will not suffice the purpose of safeguarding the registration. We are not aware of any case law in this respect yet. Most disputes over the issues of points 4.1. - 4.4. are settled well before proceedings commence at court, and even less get to a final judgment. Inevitably, there will not only be continuation or increase of disputes arising out of these issues, but a fairly tailored approach will need to be made to the question of fair use, or limitations on trademark protection. These unconventional uses might be objectionable under laws other than the trademark law, to which there is a reference under point 5.

5. If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trademark or other laws (e.g. unfair competition or trade practice laws).

Legislation that might be applicable to the cases of unconventional uses includes the Act on the Prohibition of Unfair Competition and Restrictive Market Practices, the Act on Economic Advertising Activity, and the Civil Code in general. In the Hungarian Unfair Competition Act, there is a general clause that prohibits any conduct of economic activities in an unfair manner, particularly in a manner that violates or jeopardizes lawful interests of competitors and consumers, or in a way, which is in conflict with the requirements of business ethics. Under the Act on Economic Advertising Activity conditions for lawful comparative advertising are provided, whereby it is laid down that in such case no claims can be raised on the basis of trademark infringement, provided that the use of the competitor's trademark occurs in accordance with the purpose of the advertising and the use of that trademark is indispensable for the comparison and it is not excessive. The Civil Code provides for protection of goodwill of any natural or legal person. Provided that any of the unconventional uses qualify as harmful to one's goodwill, such provisions may be invoked as a remedy.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

Hungary has been a Member State to both multilateral conventions, which deal with the protection of famous and well-known marks, namely the Paris Convention for the Protection of Industrial Property and the Agreement on Trade Related Aspects of Intellectual Property Rights. Hungary gives special protection to "reputed" trademarks, as outlined in the Trademark Act, which has been in the line with the international efforts to provide special protection to famous trademarks being particularly vulnerable to abuse due to their notoriety. It is a relative ground for refusal and for cancellation if a mark that has later priority and has been applied for or registered for different goods or services is identical or similar to an earlier trademark having reached good reputation on the domestic market, provided that the use of such later trademark is detrimental to the distinctive nature or good reputation of the earlier one, or take unfair advantage of such. An unauthorized use of such a reputed trademark for dissimilar goods or services may constitute infringement. No definition is available as to what makes a trademark "famous", "well-known" or "reputed" in Hungary,

which means that the appreciation of such a question is left either to the Hungarian Patent Office or the competent court.

II. The Opinion of the Group

Disputes and questions regarding the above issues seem likely to continue, if not increase, because of the great importance of trademarks in the market economy today, and the growing globalization of business. It also seems immature for the Hungarian Group to propose any specific solution. There is little doubt that for instance metatags have become very effective marketing instruments, routing people searching on the Net routed onto a site intended for such a purpose. In case someone chooses a trademark of another as a metatag, the very first question that will arising will concern the extent to which such a conduct should be allowed. It is desirable to set up as a rule of thumb that such an unconventional use with a commercial character should not be allowed, where either clear association with the concerned mark can be detected or the unconventional use would be detrimental to the reputation of the concerned mark. The same can well be correct regarding the parody issue, and comparative advertisement also. To the best of our knowledge, in some other jurisdictions there were different approaches to this question between the respective courts of the country. The Hungarian Group is, in principle, in favor of finding an approach which will not be too broad, but not too restrictive as well. The Hungarian Group also welcomes and expects applicable solutions out of ongoing international efforts aimed to achieve more certainty and clarity of the protection of well-known and famous marks.

Summary

The Hungarian Trademark Act does not provide for special rules regarding the use of a mark "as a mark" pertaining acquisition, maintenance and infringement of trademark rights.

While for acquiring trademark rights prior use or intent to use is not a requirement, there is a distinction in the assessment of use between maintenance and infringement of rights. One single act of use may qualify as an infringing activity, for maintaining trademark rights the scope, manner and volume of the actual use will be taken into account.

Hungary has not adopted any law directly addressing issues of unconventional uses of trademarks, however, it should be emphasized that laws other than the trademark law might become applicable when seeking for a remedy.

The Hungarian Group supports ongoing international efforts undertaken in regard achieving more certainty and clarity of the protection of well-known and famous marks.

Résumé

La loi hongroise sur les marques ne contient pas de règles spéciales concernant l'usage de la marque "en tant que marque".

Tandis que l'usage et l'intention de l'usage ne sont pas des conditions impératives de l'acquisition des droits, l'appréciation du maintien et celle de la contrefaçon sont différentes. La contrefaçon peut être commise par une seule action, mais en jugeant le maintien des droits, le genre et la dimension de l'usage sont aussi pris en considération.

En Hongrie, aucune loi en vigueur ne règle l'usage non conventionnel des marques. Malgré ce fait, le groupe hongrois est de l'avis qu'outre la loi sur les marques, les provisions d'autres lois peuvent être appliquées au cours de la procédure judiciaire.

Le groupe hongrois soutient les efforts internationaux visant la protection spéciale des marques notoires et réputées.

Zusammenfassung

Das Ungarische Markengesetz enthält keine spezielle Verfügungen, die die Frage der Benutzung einer Marke "als Marke" - regeln würden.

Während bezüglich des Erwerbs der Markenrechte weder die Benutzung noch die Absicht der Benutzung eine obligatorische Bedingung darstellen, zeigen sich bei der Beurteilung der Frage der Aufrechterhaltung und Verletzung Unterschiede. Als Verletzung kann eine einzige Handlung betrachtet werden, bezüglich der Aufrechterhaltung der Rechte werden aber auch die Art und Umfang der Benutzung geprüft.

In Ungarn gibt es kein geltendes Gesetz, das die unkonventionelle Benutzung regeln würde.

Trotz diesem Umstand hält die Ungarische Gruppe es für nötig zu betonen, dass bei der Anwendung von Rechtsmitteln nicht nur die Bestimmungen des Markengesetzes sondern auch diejenigen von anderen Gesetzen herangezogen werden können.

Die Ungarische Gruppe unterstützt die internationalen Anstrengungen zur Sicherung des speziellen Schutzes der bekannten und berühmten Marken.

Report Q168

in the name of the Irish Group

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights.

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 *Acquiring a Mark (if rights may be acquired by use according to National Law)*

There is no actual requirement of actual usage to secure registration under Irish law and therefore registration/proprietorship can be obtained based on an intention to use a Trade Mark. Section 37 (2) of the Irish Trade Marks Act, 1996 states that "*the Application shall state that the Trade Mark is being used, by or with the consent of the Applicant, in relation to the goods or services specified in the Application, or that the Applicant has a bona fide intention that it should be so used*".

1.2 *Maintaining of a Trade Mark Registration (example - against an application for cancellation on grounds of non-use)*

Revocation of a Trade Mark Registration is dealt with under Section 51 of the Irish Trade Marks Act, 1996. In order to maintain a Trade Mark Registration against an application for cancellation on the grounds of non-use, the requirement is for "*genuine use*" according to Section 51 (1)(a). It is suggested that the use must be "*as a Trade Mark*" i.e. so as to indicate origin. Although the definition of use under this Section has not been set out by the Irish Courts as of yet, it is likely to be interpreted as "a bona fide" use, meaning substantial and genuine use of the Mark adjudged by ordinary commercial standards.

1.3 *Establishing Infringement*

The infringement provisions under the Irish Trade Mark Act, 1996 required use in the course of trade. It follows therefore, that an examination of the nature of the "use" is required. There is however, no express requirement for use of a Mark "*as a Mark*" within Section 14 of the Act. The issue as to whether non-trade mark usage is embraced under Section 14 will have to be determined by the Irish Courts. This issue was addressed under the old legislation in the Gallagher (Dublin) Limited v The Health Education Bureau (1982 ILRM 240). In this case, Costello J. found infringement by use on printed matter by virtue of a registration in respect of tobacco products. The defendant used the identical Trade Mark on an imitation cigarette packet containing printed matter used as an aid to stop smoking. This was held to be use in relation to cigarettes and thus an infringement. In conclusion, it is arguable that there is not always a requirement for the use of a Mark "*as a Mark*" for the purposes of establishing infringement.

2. Is there any definition of what is use "as a mark" either in statute or case law?

There is no definition of what use "*as a Mark*" is, in statute. In addition, there has been no decision within the Irish Courts on this issue since the new Act was introduced in 1996.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

See Questions 1.1, 1.2 and 1.3.

4. Is any of the following considered to be use "as a mark"

4.1 Use on the Internet, as a metatag, in linking or framing

Use on the Internet can be considered as use "*as a Mark*". Once more, we would point out that there are no Irish decisions in relation to this issue, however, it is likely that we would apply the principles set out in the U.K. For the purpose of infringement, the United Kingdom requires use of the sign in the course of trade. Furthermore, we would point out that use of Trade Marks in metatags, does constitute use of a sign, for the purposes of infringement within the U.K.

4.2 Use by fan clubs or supporters

In answering this question, we assume that the above question relates to merchandising use generally. In this regard, we would point out that there is no direct reference to merchandising use within our legislation nor has there been any decisions by the Irish Courts in relation to this matter. We would point out however, that there is nothing to suggest that substantial merchandising use would not be sufficient to maintain a registration.

We are aware that the U.K Courts have recently indicated that merchandising use does not constitute use "*as a Mark*" however, no such indication has been given by the Irish Courts.

4.3/4.4 Parody and comparative advertising

Section 14 (6) establishes that it is permissible to engage in comparative advertising by use of another persons registered Trade Mark for the purpose of identifying the goods or services of the proprietor of the registered Trade Mark or their licensee. However, such use must be in accordance with honest practices, industrial or commercial matters and should not, without due cause, take unfair advantage of, or be detrimental to the distinctive character or reputation of the Trade Mark. When assessing whether parody and comparative are advertising can be considered to be use, "*as a Mark*", we must point out that this matter has not to-date been tested by the Irish Courts.

5. If, under the groups national regime, "use as a mark" is confined to the traditional indications of origin or identity, or unconventional uses nevertheless objectionable under Trade Mark or other laws (e.g. unfair competition or trade practice laws).

Following the introduction of new legislation in 1996, "*use as a Mark*" is no longer confined to the traditional indications of origin or identity within this jurisdiction. The new legislation is quite broad, and in this regard, should cover not only traditional "origin" cases but also more unconventional cases for example, in relation to parody and comparative advertising.

6. If "use as a mark" in the traditional sense is required to establish infringement, our "well-known", "famous", "notorious", or "reputed" marks used on dissimilar goods and services protected?

Section 14 (3) addresses the issue of "*well-known*" Trade Marks. Section 14 (3) states that "*a person should infringe a registered Trade Mark if that person uses in the course of trade, a sign which (a) is identical with or similar to the Trade Mark, and (b) is used in relation to goods or services which are not similar to those for which the Trade Mark is registered, where the Trade Mark has a reputation in the state and use of the sign, being without due cause, takes unfair advantage of or is detrimental to, the distinctive character or the reputation of the Trade Mark*". It is clear from this provision, that "*well known*" Trade Marks which are used on dissimilar goods and services, are protected under the Irish Trade Mark Act, 1996 for the purposes of infringement. We would also point out that a similar provision exists under Section 10 (3) in relation to the acquisition of a Trade Mark registration.

Summary

The definition of use in the new Irish Trade Mark Act following the EU Harmonisation Directive is still in its infancy and remains to be interpreted by both the ECJ and Irish National Courts. How-

ever, it would appear to be the position that use is no longer simply to be equated with the traditional concept of Trade Mark use.

Report Q168

in the name of the Israeli Group

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

We are giving hereunder our reply to the questions concerning Q168. The enumeration is as indicated in the guidelines.

1.1 *Use is not required to obtain or maintain registration. However non-use may be grounded for cancellation of a mark.*

The definition of "trade mark" as given in Section 1 of the Trademark Ordinance reads as follows:

"trade mark" means a mark used, or intended to be used, by a person in relation to goods he manufactures or deals in;"

This means that when an application is filed there must not be "use" but intention of "use" is sufficient.

1.2 *Section 41 of the Ordinance reads as follows:*

- a) Without prejudice to the generality of the provisions of sections 38 to 40, application of the cancellation of the registration of a trademark may be made by any person interested on the ground that there was no bona fide intention to use the trademark in connection with the goods for which it is registered and that there has been in fact no bona fide use of the trademark in connection with those goods, or that there has not been any such use during the three years preceding the application for cancellation.
- b) *The provision of subsection (a) shall not apply where it is proved that the non-use is due to special circumstances in the trade and not to any intention not to use, or to abandon, the mark in respect of the said goods.*
- c) *For the purpose of this section, there shall be deemed not to have been bona fide use of the trademark in the event of any of the following:*
 - 1) *use of the trademark in Israel in advertising only, whether in the local press or in foreign newspapers reaching Israel, unless there are special circumstances which, in the Court or the Registrar, justify the non-use of the mark on goods manufactured or sold in Israel;*
 - 2) *cancellation of an authorisation to use the mark, given to a manufacturer in Israel under section 50, unless the authorisation is cancelled following an infringement of conditions or because the person who gave the authorisation intends himself to manufacture the goods for which the mark is to be used or to grant the authorisation to another manufacturer in Israel.*
- d) Not relevant
- e) Not relevant
- f) In this paragraph the "use" with trademark including -
 - 1) The use of a registered trademark by its owners or by a registered user as stated in paragraph 50, in a different form from the listing in the regis-

- ter in details which do not change the distinguishing characters of the mark as registered;
- 2) Use by a registered user as stated in paragraph 50, under the condition that this use is made under the supervision of the trademark owner.

The section clearly indicate that, unless there are special circumstances, use of the mark is required.

1.3 Use of a mark may be considered infringement even if the mark is not used as a mark

The definition of infringement is given in Section 1 of the amended Ordinance reading as follows:

"infringement" means the use by a person not entitled thereto -

- 1) *of a registered trade mark, or of a mark resembling such a trade mark, in relation to goods in respect of which the trade mark is registered, or to goods of the same description;*
- 2) *of a registered trade mark in advertising goods of the class in respect of which the mark is registered or goods of the same description;*
- 3) *In a well known Trademark even if it is not a registered Trademark, or in a mark that resembles it as far as misleading in the matter of goods for which the mark is well known or in the matter of goods of the same definition.*
- 4) *In a well known Trademark, that is a registered Trademark, or in a mark that resembles it, for the matter of goods that are not of the same definition, as long as that the use points to the bond between the said goods and the proprietor of the registered mark, and the proprietor of the registered mark may be injured as a result from the said usage.*

We should like to state that this section was amended in order to give a broader protection to a "well-known mark" even if it is not registered.

The leading Decision in this respect was issued by the Supreme Court regarding the trademark "BACARDI". "BACARDI" is a very well-known Mark in Class 32 for alcoholic beverages, in particular for rum. There was filed an Application for "BAKARDI" in Class 25 for clothing. The Supreme Court decided that "BACARDI" in Class 32 is a very well-known Mark and even though the goods are not of the same kind and nature, they decided not to accept the Application for "BAKARDI" in Class 25.

2.
 - a) As regards **statute**, please refer to 1.1 above.
 - b) There are no case Law at this point dealing directly with the specific question, it is the group's opinion that if the matter will be come up the court will give the term "use" the widest possible interpretation, as the court has done in similar cases
3. Use in cancellation or infringement proceedings will be given broader interpretation.
 - a) **Acquisition** - please refer to 1.2 above.
 - b) **Maintenance** - the Renewal Fee can be paid even if the mark is not being used. However, please take into consideration the requirements of Section 41 of the law (see above).
 - c) No **proof** has to be filed that a mark is used when the Maintenance Fee is being paid. However, the payment will most probably not be considered as use.
- 4.1 Use on the internet would most likely considered as use if the use is in a commercial manner, namely not just a web site.
- 4.2 Use by fan clubs will not be considered as use unless with a special recorded permission.

- 4.3 Will most likely not be considered as use by the owner however considered Fair use.
- 4.4 As above currently in debate.
5. There may be considered passing off, unjustified enrichment, unfair competition and similar objections.
6. The protection of well-known marks is broader.
7. a) Please refer to section 11(13) and 11(14) as follows:

11(13)

Said paragraph was recently amended. As there is no official translation to said amendment, we would like to advise you that said paragraph refers to the point of well-known trade marks, i.e. trade mark which is identical or resembles as to deceive to a well-know trade mark, even if said trade mark is not registered, for the goods for which the well-known trade mark is known, or for the goods from the same kind.

11(14)

Said paragraph was recently amended. As there is no official translation to said amendment, we would like to advise you that said paragraph refers to the point of well-known trade marks, i.e. trade mark which is identical or resembles as to deceive to a well-know trade mark, which is a registered trade mark, and this also for goods not from the same kind, if in the requested mark for registration is to point to a relation between the goods for the requested mark and the trade mark owner, and the trade mark owner may be damaged as a result of the use of the requested mark.

- b) Please refer to the Bakardi decision mentioned above.

Report Q168

in the name of the Italian Group
by Vincenzo JANDOLI, Giovanni PELLEGRINO, Giorgio Ena VIGEVANI

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any definition of "use as a mark" either in the statute law or case-law?

In order to find a definition of use "as a mark" in the statute law it is necessary to take into consideration articles 1, 1 bis and 15 Trademarks Law.

Article 1, which concerns the contents of the trademark right, states that only the trademark owner (or his licensee) should be allowed to:

- affix his own mark on his goods or packaging;
- offer his goods, market them or keep them in order to market them;
- offer or deliver services marked with the sign;
- import or export goods marked with the sign;
- use the mark in advertising material or mail.

The trademark owner or licensee has the exclusive right to use the mark or a similar mark for identical or similar goods or services. Therefore it seems to be clear that "use as a mark" must be made in relation to goods or services or advertising as well.

Yet, article 1 bis specifies that the descriptive use is not to be regarded as use "as a mark".

Furthermore, article 15 Law on Trademarks allows a trademark to be transferred without the firm, or a trademark to be licensed to several licensees. The rule is important because it confirms that the mark is not confined to the traditional indications of origin or identity. It recognises the further function of trademarks as a means to generate goodwill by way of the associations it may create in the mind of the public.

Consequently it has to be pointed out that a trademark has also the function of collector of information.

On this regard, the Court of Naples has recently affirmed that the Law on Trademarks recognizes the function of the trademark as a collector of information to the public.¹

In the quoted decision the Judge stated that: *the trademark has now assumed an autonomous value which is independent of the products or services which it represents [...] The trademark is the "expression" (instrument of communication) which encloses and communicates values, knowledge, quality, which are partly independent of the "meaning" (the product or service); this – as a result – has an economic value and in result of the new laws, also a juridical value of its own.*

Furthermore, the Supreme Court stated that when a sign is very suggestive and attractive it is enforceable even though no risk of confusion is involved.²

¹ Court of Naples, November 5, 1998 (Benkiser / Henkel), in *European Trade Mark Reports* 1999, 614.

2. Requirements for the use of a mark "as a mark" for the purposes of

2.1 *Acquiring a mark*

According to article 2571 of the Italian Civil Code and article 9 and 17.1 b) Law on Trademarks, a mark may be acquired by use, even if it has not been registered. The rule is consistent with article 6-bis of the Paris Convention.

In the absence of registration, trademarks are named to be "de facto" marks.

Anyway, it is important to consider that the use grants to the user a right which is sometimes weaker than the right rising from registration.

The differences between a registered and a "de facto" mark are the following:

1. a registered trademark is enforceable by the mere fact of registration, whilst a "de facto" trade mark is enforceable on the condition that the proof of intensive use is given.
2. a registered trademark enables his owner to exclude anyone from using an identical or similar sign in relation to identical or similar goods or services (or even in relation to different goods or services in case of well-known trademarks). A "de facto" trademark enjoys the same protection only when the mark is known at national level. If the trademark has been used on a local basis, the owner of the trademark is allowed to continue using the same sign but he can not exclude third parties from registering it and, consequently, using it, even in the same place where the "de facto" mark is used.³
3. Finally, it has to be pointed out that traditionally "de facto" trademarks have been enforced throughout unfair competition rules. Recent decisions, however, stated that unfair competition rules and trademark rules are both applicable.⁴

With regard to the requirements for use it has to be said that, virtually, no specific requirement in order to acquire a mark is provided by law. According to article 9 and 17.1 b) Law on Trademarks, the trademark right should rise from use independently of whether, owing to the use, the mark has got a reputation or not. Court's decisions, anyway, state that the use to acquire a "de facto" mark have to be such as to make the sign known by the interested consumers⁵.

The trademark's scope of protection is different, however, depending on the extent of the mark's reputation.⁶

2.2 *Maintaining of a trademark registration*

Although use is not necessary for acquiring trademark rights, it is relevant in maintaining the mark protection.

² Supreme Court 25.8.1998, n. 8409, Camel case.

³ Yet, Courts have stated that, in this case, according to article 11 Law on Trademarks, the owner of the registered mark should use it in a non-confusing way.

⁴ See Supreme Court March, 27 1998, n. 3236.

⁵ See, for instance, Court of Udine, may 31, 1993.

⁶ Indeed, according to article 9 Law on Trademarks, it is possible to identify three different cases:

- a) use which does not imply reputation;
- b) use which implies reputation on a local basis; in both these two cases the trademark owner does not have the right to object to the registration and use of an identical trade mark for identical goods. He is only allowed to continue using the mark within the limits of the previous use.
- c) use which implies reputation; in this case the mark's owner has an exclusive right.

Indeed, according to article 41 Law on Trademarks, a trademark expires when, because of the use, it becomes generic or deceptive.

On the other hand, a registered trademark, which is invalid due to the lack of distinctiveness, may not be declared void if it has got a secondary meaning (article 47 bis Law on Trademarks).

Moreover, article 42 Law on Trademarks requires that a trademark, even though registered, has to be used to maintain the rights relating to that mark. Indeed, it expires due to continued non-use for five years. But the rule specifies that the trademark may not be cancelled if use has been resumed before an application for cancellation has been filed.⁷ Furthermore, the cancellation may not be granted if:

- a) the sign is used by a third party with the owner's permission;
- b) non-use is due to a justifiable reason;
- c) the mark is used in a modified shape which does not change its distinctiveness;
- d) for the same goods the owner of the trademark - which has not been used - has filed and used another mark, similar to the first one.⁸

The statute law does not define the nature and amount of use necessary to avoid the trademark's cancellation.

Anyway, the case-law stated that, in order to maintain a trademark, use may be a local use and does not necessarily have to be continuous. Yet it must be an effective use, serious and genuine. It has been stated in case law that the use has to be suitable for giving the proof - after having considered all factual circumstances - of the trademark owner's presence on the market.

The distribution of goods free of charge, as well as use in advertising, also fulfils the conditions of required use.

2.3 *Establishing infringement*

A registered trademark may be enforced independently of whether it has been used or not, unless lapsed because of non use.

Anyway, this does not mean that use is not relevant at all.

On the contrary, the trademark's scope of protection becomes larger - and the owner may prevent third parties from using the same or a similar mark for dissimilar goods - when the mark, due to the use, has a reputation and this reputation would be damaged by the use of such sign by third parties, or if third parties would derive undue benefit from such use.

Unless the trademark has a reputation, a likelihood of confusion is necessary in order to establish infringement. According to article 1 Law on Trademarks, the use of an identical mark for identical goods or services can anyhow be prevented. In this case the likelihood of confusion is presumed.

Yet, the use of an identical or similar mark for identical or similar goods can be prevented only in case that such use gives cause for the likelihood of confusion or association.

It is not strictly necessary for the use by the alleged infringer to be an "indication of origin" use, in order to establish infringement.

⁷ Bona fide is not required, but if the five years are expired and the trademark owner is aware of the fact that an application for cancellation is to be filed, use may be taken into consideration in order to avoid the cancellation only if it has been resumed three months before the application's filing.

⁸ Article 42 d) recognises the "defensive trademark". Yet, the case law states that the rule has to be strictly interpreted in order not to jeopardize the non-use rule. The signs must be very close, either literally or with regard to their meaning (Court of Turin, 14.6.2000, Volkswagen / Fiat).

This may be deduced from statute law, as said above, and, according to that, Courts have stated that:

- a) Descriptive use - which basically is not an "indication of origin" use - is infringing not only when such use results in a likelihood of confusion regarding the origin, but also if it is not objectively necessary in order to indicate the destination of the product (Supreme Court 10.1.2000, n. 144, Fiat / Isam).
- b) The use of football teams marks on picture-cards is an infringement of trademark rights when such use, which is on the other hand clearly a descriptive use, is not necessary for linking the player to the team, because this function is performed by the shirt worn by the player (Court of Milan, 4.7.1998, Soc. Milan / Soc. Topps)

Consequently, it can be said that the Italian case-law does not necessarily require that the use has to be a "trademark use" in the traditional sense in order to establish infringement.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

See above

4. Is any of the following considered to be use "as a mark"

4.1 Use on Internet, as a metatag, in linking or framing.

Generally use on internet is considered to be use as a mark. It has also been stated that anyone has the exclusive right to use his own trademark in internet as a domain name (Court of Valdagno, 27.5.1998).

Recent Court's decisions, have anyway stated that the use of a sign as a domain name, in principle, is not a distinctive use (Court of Florence, ordinanza 29.5.2000).

It has been anyway pointed out that, although a trademark and a domain name are different, the use of a trademark as a domain name by third parties may be prevented under Unfair Competition Law when such use is in a likelihood of confusion (Court of Naples, Empoli's section, Blaupunkt case, November 2000).

4.2 Use by fan clubs or supporters

If marked products are merchandised, such use should be considered "use as a mark" and infringing use, unless it is allowed by the owner.

This may be deduced by a Supreme Court's decision, where it has been recognised that a trademark, when very attractive, has further functions in addition to the "indication of origin" function.⁹

Yet, in the past it has been stated that a trademark can be used by third parties, also in the marketing of products, provided that there is at least a slight differentiation which allows to avoid that the product at issue is attributed to and/or associated with the trademark owner.¹⁰

Furthermore, infringement may be established also in other cases, when the trademark is used by taking advantage from the indication of origin of the infringed trademark. The principle is anyway not always applicable.

4.3 Parody

It is not considered "use as a mark", but it may be considered a denigratory act under Unfair Competition Law.

⁹ Supreme Court 25.8.1998, n. 8409, Camel case.

¹⁰ Court of Milan, 28 November 1994, Inter case.

4.4 *Comparative advertising*

It may not be regarded as use "as a mark" as long as comparative advertising is admitted. On the contrary the use of the sign may fall under article 2043 Civil Code (which forbids to cause third parties undue damages) or Unfair Competition Law.

5. See above.

Résumé

Au fin de l'application de l'article 1 de la loi italienne sur les marques, concernant les droits attribués au titulaire de la marque, il faut d'abord établir ce qu'on entend par "*l'utilisation comme une marque*". La première signification peut être reconnue par rapport aux biens et aux services qui sont indiqués avec la marque.

L'existence de fonctions de la marque différents de l'indication d'origine (par exemple le rôle de collecteur de clientèle) est confirmée par l'article 15 de la loi citée, qui prévoit la possibilité de céder la marque sans l'entreprise, ou la possibilité de la concéder en licence à une pluralité de bénéficiaires. La nécessité du risque de confusion a donc été surmontée.

La marque "de facto", en fait la marque utilisée qui n'a pas été enregistrée, est ça même protégée. Mais cette protection est plus faible que celle attribuée a les marques enregistrées.

L'utilisation de la marque peut être la cause de sa décadence, lors que elle la fait devenir descriptive ou générique. Au contraire, si la marque a acquis une "secondary meaning" par rapport a sa utilisation, elle ne peut pas être frappée de nullité. La marque doit aussi être utilisée (ça peut être aussi une utilisation au niveau local ou pas continue) pour maintenir sa validité; en fait, si elle n'est pas utilisée pendant cinq ans, elle peut être frappée de nullité.

En théorie, la contrefaçon de la marque est indépendante de sa utilisation. De toutes façons, l'utilisation de la marque devient importante lors que la marque a acquis une considérable renommée. En cas contraire, il faut toujours démontrer le risque de confusion.

On peut donc affirmer que le juges italiens ne considèrent pas nécessaire la démonstration de l'utilisation de la marque dans le sens traditionnel. En fait aujourd'hui on considère utilisée aussi la marque reproduite dans internet, dans les fan clubs, dans la parodie ou dans les messages comparatives.

Report Q168

in the name of the Japanese Group

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 Acquiring a mark (if rights may be acquired by use according to national law)

Under the Japanese Trademark Law, use of a mark is not a prerequisite for registration of the mark, in principle. Although in view of the language of the relevant statute, an intention of using the trademark to be applied for is a requirement for registration (Art.3, Para.1 of the Trademark Law), practically this provision is hardly be invoked. Before the revision of the Bank Act, banks were prohibited from manufacturing or selling any goods. Accordingly, because there is no possibility of banks using any trademark, no trademark registration was granted in any bank's name. However, regarding containers as three dimensional trademarks, the Patent Office has established a practice by which it rejects a registration under said provision of Trademark Law, if it considers that the trademark cannot be used as a source identifier, even though such practice does not seem to meet the proper interpretation of this provision.

As an exception, even a trademark that is not inherently distinctive would become registrable if you can establish distinctiveness acquired through use (Art.3, Para.2 of the Trademark Law). In order to objectively show that the trademark has been recognized as a sign identifying a specific source of goods, practically it is necessary to establish that the trademark, which must be identical to the trademark applied for in substance, has extensively been used by evidence such as advertising materials. While the Japanese Patent Office and courts examine this requirement very strictly, no criterion concerning the length of use is provided. Under the Japanese Law, there is neither an established law in common law countries where use of the trademark for five to ten years is recognized, nor, a provision like Section 2 (f) of the U.S. Trademark Act (which regards the exclusive use of a trademark for five years as prima facie evidence of acquired distinctiveness). The Japanese trademark system might be improved if continued use of the mark for five or ten years would be deemed as a prima facie standard for granting acquired distinctiveness in view of the experience in common law countries, with exception of the case that an establishment of secondary meaning of a mark could be positively admitted through continued use for less than five years.

1.2 Maintaining of a trade mark registration (e.g. against an application for cancellation on grounds of non-use)

The requirement to submit evidence showing the continued use of a registered trademark for renewal was abolished at the time of Japan's accession to the Trademark Law Treaty (TLT).

In order to defend a trademark registration from being cancelled by a cancellation action based on non-use, the trademark owner has to establish use of the registered trademark within the three years preceding the filing of the cancellation action. A cancellation trial based on non-use is a system to cancel a registration of a trademark which has not earned any goodwill yet. In view of the spirit of this system, logically use of a mark by which the user's goodwill would not be recognized, in other words, use of mark in a manner which

does not permit it to function as a source identifier, should not be considered "use" of the mark.

Under actual practice, however, it is not usual for it to be asked whether or not the use by the trademark registrant or its licensee is use of a "real trademark" which is capable of distinguishing goods, and the defendant's use would tend to be easily acknowledged as "use" even if it only formally falls under the definition of use (discussed below).

However, in some complicated cases such as those appealed from the Trial/Appeal Board of the Patent Office to the Tokyo High Court, the substance of the use of the trademark could be examined seriously. In the Japanese law, there is no provision like "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark," as is in the U.S. Trademark Act.

Under the current trademark law, an advertisement showing a trademark in connection with certain goods falls under "use" independently, according to the definition of use of a mark. Therefore, even only an advertisement for goods bearing a trademark without any actual manufacture or sale of the goods could be interpreted as "use" of the trademark. This appears to be improper in theory.

Further, in case a registered trademark consisting of the three letters "ABX" is used as a model sign of goods but, at the same time, it actually functions as a source identifier, practically the registration would not be cancelled.

1.3 *Establishing infringement*

As to "use" concerning a trademark infringement, not only whether the defendant's use falls under the definition of "use" discussed below but also whether such use is use substantially as a trademark in a proper sense (a source identifier) will be examined. In actuality, there are a considerable number of precedents where the defendants' use was found not to be "use as a trademark" and as a result, the infringement was denied. This would become an issue in an infringement action, if the defendant argues that its use is not use as a trademark.

Meanwhile, under the Japanese law, it is not necessary for a plaintiff in a trademark infringement suit to establish use of his registered trademark. Even if the plaintiff has never used his registered trademark as far as it stands in force on the Trademark Registers, he can enjoin the infringer's use on the basis of an unused registered trademark and also can sometimes demand damages corresponding to the amount of royalties to be paid under the normal circumstances (although there was a decision by a district court, which denied such damages sought by a trademark holder who had never used his trademark).

If such non-use continues for three years, however, the trademark registration would become vulnerable to a cancellation action.

In this connection, there has been criticism directed against the current law which allows a trademark registrant to enforce his trademark which has merely been registered without any goodwill.

2. **Is there any definition of what is use "as a mark" either in statute or case law?**

First, Art. 2, Para. 1 of the Japanese Trademark Law provides the definition of the physical attributes of "mark" as follows, whereas it does not define the functional attributes of "mark":

- 2.(1) *"Trademark" in this Law means characters, signs, three-dimensional shapes or any combination thereof, or any combination thereof with colors (hereinafter referred to as a "mark"):*
 - (i) *which are used in respect of goods by a person who produces, certifies or assigns such goods in the course of trade;*

- (ii) *which are used in respect of services by a person who provides or certifies such services in the course of trade (other than as in (i) above).*

Next, Art. 2, Paragraphs 3 and 4 of the Trademark Law provides a detailed definition of "use of a mark" as follows:

- (3) *"Use" with respect to a mark in this Law means any of the following acts:*
 - (i) *acts of applying the mark on the goods or their packaging;*
 - (ii) *acts of assigning, delivering, displaying for the purpose of assignment or delivery, or importing, the goods on which or on the packaging of which a mark has been applied;*
 - (iii) *acts of applying a mark to articles for use by persons to whom the services are provided (including articles assigned or leased -hereinafter the same) when providing services;*
 - (iv) *acts of providing services by use of articles to which a mark has been applied for use by persons to whom the services are provided when providing services;*
 - (v) *acts of displaying, for the purpose of providing services, articles to which a mark has been applied and supplied for use in the provision of services (including articles for use by persons to whom the services are provided when providing services - hereinafter the same);*
 - (vi) *acts of applying a mark to articles related to the provision of such services belonging to persons to whom the services are provided when providing services;*
 - (vii) *acts of displaying or distributing advertisements relating to the goods or services, price lists or business papers with respect to the goods or articles on which a mark has been applied.*
- (4) *Acts of applying a mark to goods or other articles to which a mark is applied as prescribed in the preceding subsection shall include acts of having goods or their packaging, articles that are supplied for use in the provision of services and advertisements relating to goods or services shaped into a mark.*

However, none of the terms used in the above definitions is defined in the Act, and furthermore, the traditionally established interpretation of the terms appears to be becoming slightly altered in conformity with the development of trading environment.

For instance, whether or not "a use of trademark" is always required in the form of traditional way or not is vague. Although traditionally "goods" have been interpreted as being a "tangible substance which can be an object of trade in commerce," the Morisawa typeface case decided by the Tokyo High Court on December 24, 1993, as well as the change of practice by the Patent Office, under which "computer programs" are accepted as an identification of goods in a trademark application, have clarified that even an intangible object can be "goods," and thus the traditional interpretation is being altered.

Also concerning "services," the current court judgements still exclude "retail services" from the category of "services" under the interpretation that "services" must be those for which money is independently paid, not services which are an auxiliary of goods. In view of the international trend, however, it appears likely that the Law or Regulation will be changed before long. In fact, this matter is now being discussed seriously.

Meanwhile, according to the definition of "mark" under the Trademark Law, marks are only those which can be sensed visually and the definition of "use" absolutely requires that a trademark be "attached" physically to something. Therefore, under the Japanese law, presentation of a mark by a voice in a radio advertisement or the like would not fall under "use" of a mark.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

As mentioned above, while regarding the use to maintain a trademark registration, relatively formal use, i.e., use which comes formally under the definition of use of Art. 2 of the Trademark Law, would be considered sufficient, in the case of an infringement suit, not only whether the defendant's use falls under the definition of use but also whether the defendant's mark has been used actually as a sign distinguishing goods could be examined.

In this regard, one might feel that the above difference results from the difference in the manner of interpretation of "use of mark" by an administrative agency, which is practically required to keep the balance of public interests in deciding whether the registered trademark may be allowed to maintain or not and that by a judicial organization, which is required to justify the balance of conflicting parties, because the former (a cancellation action based on non-use) is examined by the Patent Office (the administrative agency) and the latter (an infringement suit) by a court. However, since the examination in the Patent Office is rather conducted ex-officio in writing, whereas that by a court is conducted in the manner of party to party principle and in oral hearings where the actual use in question is thoroughly examined, the above difference appears to result from the volume of evidence to be produced, the difference in the level of seriousness and stance of the challenge-defense by the parties and the like, rather than because of a difference in interpretation of law.

4. Is any of the following considered to be use "as a mark"

4.1 Use on the internet, as a metatag, in linking or framing

There is no statute or case law concerning such use.

However, since a trademark written in a metatag is not visible, and this is not "use of mark" in view of the aforementioned definition, it appears that the writing in a metatag itself would not become the subject under the Trademark Law.

Nevertheless, the result of writing the trademark in a metatag may be considered illegal, such as an unfair act under the Unfair Competition Prevention Law, infringement of a copyright, defamation of character or the like, and in such a case, one could take a legal action against it as the case may be.

4.2 Use by fan clubs or supporters

This manner of use does not meet the requirement under the statutory definition of "mark" that a user must be "one who manufactures, sells, etc. goods as business." Therefore, this type of use does not come under "use" which constitutes a trademark infringement.

Since even this type of use may cause dilution of the capacity of a famous mark and/or the mark to become generic, some legislation against it would be necessary.

Particularly, it is necessary to control any false representation about the mark, such as to control comparative advertisings.

Regarding the matter of making a trademark generic, the following provision in Section 10 of the Community Trademark Regulation is worth referring to:

Article 10

[Reproduction of Community trade marks in dictionaries]

If the reproduction of a Community trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work shall, at the request of the proprietor of the Community trade mark, ensure that the reproduction of the trade mark at the latest in the next edition of the publication is accompanied by an indication that it is a registered trade mark.

4.3 Parody

Whether or not a certain mark is used as a parody would have no legal implication under the Japanese law. That is, irrespective of whether it is a parody or not, if the trademark actually used is viewed as identical to the registered trademark, it would constitute a trademark infringement.

Yet, even a parody could eventually constitute an unfair act or the like depending on the actual manner of use, as above discussed about use in metatags, especially in the case that the trademark is a well-known mark, a parodic use of the same should be undoubtedly considered as an unfair competitive act in most cases.

4.4 Comparative advertising

While it is difficult to imagine that a question of "use" of a trademark would be raised in connection with a comparative advertising, the question here is whether the defendant's act comes under the announcement or circulation of a falsehood under Art. 2, Para. 1, Item 14 of the Unfair Competition Prevention Law or an unfair trade act under Art. 4 of The Law against Unjustifiable Premiums and Misleading Representations.

Unfair Competition Prevention Act

Sec.2 (1)(xiv)

The act of notifying or circulating a falsehood detrimental to the business credit of another person in a competitive relationship.

The Act against Unjustifiable Premiums and Misleading Representations

Sec. 4 [Prohibition of misleading representations]

No entrepreneur shall make such representation as provided for in any one of the following paragraphs in connection with transactions regarding a commodity or service which he supplies:

- (i) *Any representation by which the quality, standard or any other matter relating to the substance of a commodity or service will be misunderstood by consumers in general to be much better than the actual one or than that of other entrepreneurs who are in competitive relationship with the entrepreneur concerned, and thereby which is found likely to induce customers unjustly and to impede fair competition;*
- (ii) *Any representation by which price or any other terms of transaction of a commodity or service will be misunderstood by consumers in general to be much more favorable to the consumer than the actual one or than those of other entrepreneurs who are in competitive relationship with the entrepreneur concerned, and thereby which is found likely to induce customers unjustly and to impede fair competition; or*
- (iii) *In addition to those stipulated in the preceding two paragraphs, any representation by which any matter relating to transactions as to a commodity or service is likely to be misunderstood by consumers in general and which is designated by the Fair Trade Commission as such, finding it likely to induce customers unjustly and to impede fair competition.*

In addition, interpretation or legislation which might include the matter of 4.2, 4.3, 4.4 above under the category of trademark infringement would run the risk of making the substance of a trademark infringement vague, and they should be discussed separately.

5. **If, under the Group's national regime, use as a mark is confined to the traditional indications of original or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws).**

As aforementioned in this report, in Japan, the traditional interpretation of trademark use, which is to identify the source or quality of goods or services, has been still maintained in principle, with exception of special case, that is use of a trademark for software. However, Unfair Competition Prevention Law will be applicable and useful for prohibiting such an unfair use of other's trademark that is deemed as new type of trademark use.

6. **If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?**

When any well-known or famous trademark is applied for registration or is already registered by a person other than the true owner thereof, it shall be rejected or cancelled with a positive provision stipulated in the Trademark Law. A well-known or famous trademark is also reasonably protected under the Unfair Protection Prevention Law indeed, in accordance with the degree of its recognized reputation in the market, from any unauthorized use of the same or similar trademark not only for the same or similar goods or services but also for dissimilar goods or services.

We, Japanese Group, are offering the following two proposes to be studied in respect of Question 168:

1. **Proposal in relation to "Use of a Mark 'As a Mark' "**

It is anticipated that the answers to the Question 168 would show the difference of the definition or interpretation of the legal concept of "Use of a trademark" among nations, respecting, but, fundamentally, it is quite natural because a trademark right has been protected by each national law. Meanwhile such difference originated from each independent national law has gradually been decreased as the results of recent effort toward international harmonization of national trademark laws in accordance with the expansion of international business activities. Currently, the harmonization has been limited on the aspect of procedural matters, such as application forms or the like.

But for those who are in charge of international business it is desirable to have fundamental trademark matters harmonized for smooth and swift international trade. The growth of trade through the Internet must facilitate this desire. Accordingly, taking this opportunity Japanese Group would propose to discuss the necessity or feasibility of harmonization on the definition of "the use of trademark", which we believe is one of the most essential points in the trademark protection system. Practically it would be necessary to resolve to the points listed below as early as possible. For the information, in Japan recently it has been discussed how the definition of trademark use should be cleared in the Trademark Law, in order to compliance with the natural expansion of the "e-commerce".

- Feasibility of a cancellation of trademark registration for non-use-Is any use of trademark on Internet (even a taken use) able to avoid a non-use cancellation action?
- For consideration of an infringement-What mode of use on Internet be interpreted as infringing trademark use?
- Proof of trademark use through Internet to be evaluated as established famousness.
- In the trademark use through Internet evaluated as the basis of trademark right under a national law (especially in a common law country)?

2. **Observations of interest on the topic above**

We often notice the cases where other person's trademark is used as a reference, without any authorization in market, for example:

- 1) For parody, other person's trademark is referred to without consent.
- 2) For comparative advertising, other person's trademark is referred to.
- 3) In case of marketing the parts or components to be assembled to other's finished product, the trademark of other person's finished goods is used as a reference.
- 4) In case of marketing computer software, other person's trademark for compatible computer hardware is used without consent.
- 5) In case of marketing finished products (e.g. suits), other person's trademark is respect of their material (e.g. cloth for the suit) is referred to.
- 6) As a decay, other person's trademark is used as a reference.

It is useful to discuss more specifically about the criteria to determine acceptable references of other person's trademark and unacceptable reference taking into account of various marketing circumstances.

Summary

Under the Japanese Trademark Law, in principle, the use of a mark is not a requirement for its registration. However, as an exceptional case, it is required to prove acquisition of a secondary meaning (i.e. acquired distinctiveness) as a result of the continuous use of a mark that originally lacks a distinctive feature.

While, it is necessary to use a trademark in order to maintain the trademark registration, but a trademark that has not been used for three consecutive years or longer will be revoked when a trial for cancellation of trademark registration is instituted against it and such non-use is affirmed.

In determining a trademark infringement, a use of the registered trademark is not specifically required as long as the plaintiff's trademark is validly registered on the Trademark Register. With respect to a use of the defendant's mark, it will be surely argued whether the defendant's mark is used as a trademark or not. There is a some difference between the decision on the use in a case of a trial for cancellation for non-use and in case of an infringement law suit, because the former system is to keep the balance of public interests and the latter one is to deal with the individual conflict between the parties.

A provision of the Japanese Trademark Law defines "the use of a trademark", and an advertisement is recognized as one mode of the trademark use. However, interpretation of the use has been improved in compliance with the development of trading environment.

There is no special provision regarding a use of a trademark on the Internet, therefore, a definition of the conventional use of a trademark would apply thereto, in principle. As for the use in metatag, any unauthorized use of trademark might be prohibited by the Unfair Competition Prevention Law (hereinafter referred to as the UCP Law) depending on the situation.

As to such use of a trademark as in a Parody or by a fan club, or unauthorized use of a trademark by a person other than the owner of registered trademark in a comparative advertisement or the like, the Trademark Law will be applicable to some cases and the UCP Law will be applicable to some cases depending on the manner of the use, and indeed there are some case where neither Laws will be applicable.

Résumé

Conformément au droit des marques japonais, l'usage d'une marque n'est, en principe, pas nécessaire à son enregistrement. Toutefois, à titre exceptionnel, il est nécessaire de prouver l'acquisition d'une signification secondaire (c'est-à-dire d'un caractère distinctif acquis) découlant de l'usage continu d'une marque qui, à l'origine, n'a pas de caractère distinctif.

Alors qu'il est nécessaire d'utiliser une marque commerciale afin de conserver son enregistrement, le défaut d'usage d'une marque commerciale pendant trois années consécutives ou plus conduira à sa révocation si une action en déchéance de marque commerciale invoquée à son encontre confirme le défaut d'usage.

Lorsque l'on étudie s'il y a contrefaçon de marque, un usage de la marque n'est pas spécifiquement nécessaire si l'enregistrement de la marque de la demanderesse auprès du registre des marques est valide. En ce qui concerne l'usage de la marque de la défenderesse, l'usage ou le défaut d'usage en tant que marque commerciale de la marque de la défenderesse sera sans aucun doute examiné. La décision concernant l'usage est dans une certaine mesure différente si elle est prise dans le cadre d'une action en déchéance pour défaut d'usage ou si elle est prise dans le cadre de poursuites en contrefaçon, dans la mesure où le premier de ces systèmes consiste à maintenir l'équilibre des intérêts généraux alors que le second consiste à régler un litige particulier entre les parties.

Une disposition du droit des marques japonais définissant "l'usage d'une marque" reconnaît qu'une publicité constitue un mode d'utilisation de la marque. Toutefois, l'interprétation de l'usage s'est améliorée au fur et à mesure du développement du milieu commercial.

Dans la mesure où il n'existe pas de disposition spécifique concernant l'usage d'une marque sur Internet, on lui appliquerait, en principe, une définition de l'usage traditionnel d'une marque. Quant à l'usage sous forme de balises méta, toute utilisation non autorisée d'une marque commerciale pourrait être interdite par le droit de protection contre la concurrence déloyale (appelé ci-dessous le droit de PCD) en fonction de la situation.

Quant à l'utilisation d'une marque telle que dans une parodie ou dans un fan club, ou l'utilisation non autorisée d'une marque commerciale par une personne autre que le propriétaire d'une marque déposée dans le cadre d'une publicité comparative ou similaire, on pourra appliquer le droit des marques dans certains cas et le droit de PCD dans d'autres, en fonction de la forme d'utilisation, et il existe en effet certains cas dans lesquels ni l'un ni l'autre ne seront applicables.

En l'occurrence, le droit des marques japonais continue d'être conçu d'une façon telle qu'il adopte l'interprétation de l'usage d'une marque conformément au concept traditionnel, mais une telle interprétation s'est progressivement améliorée au fur et à mesure du développement du milieu commercial. Une marque notoire ou célèbre est protégée de façon efficace et totale par le droit des marques japonais ainsi que le droit de PCD.

Zusammenfassung

Der Gebrauch eine Marke ist im Prinzip nach dem Japanischen Markengesetz nicht Voraussetzung für eine Eintragung. Es ist jedoch im Ausnahmefall nötig, den Erwerb einer zweiten Bedeutung (d.h. erworbene Unterscheidungskraft) aufgrund des stetigen Gebrauchs einer Marke, die ursprünglich kein unterscheidungskräftiges Merkmal aufwies, nachzuweisen.

Es ist notwendig, eine Marke zu benutzen, um die Eintragung aufrechtzuerhalten. Eine Marke, die für drei aufeinanderfolgende Jahren oder länger nicht benutzt wurde, wird für ungültig erklärt, wenn ein Gericht zur Aufhebung einer Markeneintragung angerufen und eine mangelnde Benutzung bestätigt wird.

Für die Feststellung einer Markenverletzung ist die Benutzung der eingetragenen Marke nicht spezifisch notwendig, solange die Marke des Klägers in dem Markenregister rechtsgültig eingetragen ist. Bezüglich der Benutzung des Zeichens durch den Beklagten wird sicherlich in Frage gestellt, ob das Zeichen des Beklagten markenmässig benutzt wird oder nicht. Es bestehen jedoch Unterschiede zwischen der Entscheidung bezüglich der Benutzung im Fall eines Gerichtsverfahrens zur Löschung aufgrund Nichtbenutzung und im Falle eines Gerichtsverfahrens wegen Verletzung, da das erste Verfahren dazu dient, das öffentliche Interesse zu berücksichtigen und das letztere den individuellen Konflikt zwischen den Parteien betrifft.

Eine Regelung des Japanischen Markengesetzes definiert "den Gebrauch einer Marke", und Werbung wird als eine Form der Benutzung der Marke angesehen. Die Auslegung der Benutzung wurde jedoch entsprechend der Entwicklung des Handelsumfelds verbessert.

Es gibt keine spezielle Regelung bezüglich der Benutzung einer Marke im Internet. Die Definition des üblichen Gebrauchs einer Marke würde daher prinzipiell auf diesen Fall angewendet. Bei einer Benutzung im META-TAG kann jegliche unbefugte Benutzung der Marke aufgrund des Gesetzes gegen unfairen Wettbewerb (nachfolgend als UCP-Gesetz) abhängig von der Situation verboten werden.

Bezüglich der Benutzung einer Marke, beispielsweise in einer Parodie oder durch einen Fanclub oder die unbefugte Benutzung einer Marke durch einen anderen als den Eigentümer der eingetragenen Marke in einer vergleichenden Werbung oder dergleichen, finden in einigen Fällen das Markengesetz oder UCP-Gesetz abhängig von der Art der Benutzung Anwendung. In einigen Fällen ist sogar keines dieser Gesetze anwendbar.

Ausserdem ist das Japanische Markengesetz immer noch so angelegt, dass es eine Interpretation der Benutzung einer Marke gemäss dem traditionellen Konzept annimmt. Eine solche Interpretation wurde entsprechend der Entwicklung des Handlungsfeldes verbessert. Sehr bekannte oder weltbekannte Marken sind unter dem Japanischen Markengesetz und dem UCP-Gesetz effektiv und umfassend geschützt.

Report Q168

by Armins PETERSONS, Lauma BUKA

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 Acquiring a mark

Exclusive rights to a trademark may be ensured only by registration of the trademark – either with the Patent Office of the Republic of Latvia or by International registration done pursuant to the provisions which are in force in Latvia concerning the International registration. (Republic of Latvia Law on Trademarks and Indications of Geographical Origin, 1999, further in the text – LLT/99). Only well-known marks enjoy more liberal regulations and in fact are protected without registration. LLT/99, Article 4(5).

1.2 Maintaining of a trademark registration

According to the provisions of LLT/99, Article 23, the owner has to commence the actual use of the trademark in Latvia in connection with the goods or services with respect to which it has been registered. As to this, the actual use of a trademark shall be construed as the use of the trademark (also in a form differing in individual, non-essential elements) on goods and their packaging, on any documentation accompanying the goods, in the advertising of the goods or services, or in relation to other business activities in connection with the relevant goods or services. Altogether, the actual use shall be construed as the use of a trademark in the course of trade, with the purpose of gaining and maintaining a certain market position for the respective goods or services, as well as on goods or their packaging in Latvia solely for export purposes.

1.3 Establishing infringement

Pursuant to the regulations of LLT/99, the requirements for establishing of infringement are the following: use (affixing, attachment) of the infringing trademark on the goods or on the packaging thereof; offering the goods, or putting them on the market or stocking them for these purposes; providing services or offering them; importing or exporting the goods and using the trademark on business papers and in advertising. However, also as infringement is related an illicit use of the trademark intended for purposes other than distinguishing goods or services (marking of goods, indication of the origin of the goods or services), if it is **proven** that the use of such sign in the absence of appropriate justification gives the impression of connection with this trademark, or takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trademark.

2. Is there any definition of what is use "as a mark" either in statute or case law?

There is no precise and distinguished definition, however according to the LLT/99, Article 4 and Article 23 the following activities are understood as the use of the mark:

- use (affixing, attachment) of trademark on the goods or on the packaging thereof;
- offering the goods, or putting them on the market or stocking them for these purposes;
- providing services or offering them under the said trademark;

- importing or exporting the goods and using the trademark on business papers and in advertising
- use in relation to other business activities in connection with the relevant goods or services.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

In general, there is no particular difference (apart from the fact that trademark rights can be acquired solely by registration in Latvia), but it must be admitted that for explanation of the sense of "use as a mark", more peculiar restrictions and various interpretations are characteristic in procedure of establishing infringement of trademark rights rather than maintenance of trademark rights. This is largely dependant on the national court and The Board of Appeal.

4. Is any of the following considered to be "use as a mark"?

In general - according to the Latvian laws, the explanation of "use as a mark" does not go beyond the traditional sense, i.e. indication of origin or identity; however the assessment of unconventional uses is closely linked to each individual case. For more clearance, it should also be admitted that Latvia lacks any precedent (and thus also legal practice) in relation to points 4.1. and 4.2., therefore the assumptions mentioned below are mostly theoretical.

4.1 Use on the internet, as a metatag, in linking or framing

As regards maintenance of trademark rights, according to the LLT/99, Article 23, all of the above uses are disregarded to be "use as a mark", but sometimes they can be perceived as advertising, which in general is related to traditional forms of trademark use. As concerns infringement – they are also not considered to constitute trademark infringement, unless they are possible to be attributed as "illicit use of the trademark intended for purposes other than distinguishing goods or services (marking of goods, indication of the origin of the goods or services), if it is proven that the use of such sign in the absence of appropriate justification takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trademark" (LLT, Article 4(9)).

4.2 Use by fan clubs or supporters

In the case of maintenance of trademark rights – in general, this does not differ a lot from the situation discussed in 4.1. and the same relates also to trademark infringement issues, therefore please see 4.1.

4.3 Parody

This, under no circumstances can be related as valid use for the purposes of maintenance of trademark rights, because, parody, according to the provisions of LLT/99, Article 23(4), can never "be construed as the use of a trademark in the course of trade, with the purpose of gaining and maintaining a certain market position for the respective goods or services". However, despite the evasive definition in the LLT/99, Article 4(9), which can be attributed to the case of parody: "illicit use of the trademark intended for purposes other than distinguishing goods or services (marking of goods, indication of the origin of the goods or services), if it is proven that the use of such sign in the absence of appropriate justification takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trademark", this is considered clear trademark infringement.

4.4 Comparative advertising

Akin to parody (discussed in 4.3.), this is also not a valid ground for the maintenance of trademark rights, however in relation to infringement of rights, it is considered as use "as a mark" and can be restricted under the regulations of LLT/99, Article 4(9), which prohibits "illicit use of the trademark intended for purposes other than distinguishing goods or services (marking of goods, indication of the origin of the goods or services), if it is proven that the use of such sign in the absence of appropriate justification takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trademark".

Moreover, comparative advertising (as well as parody to some extent) is regulated also by Advertising Law (further in the text – AL) and Competition Law (further in the text – CL).

5. Are unconventional uses objectionable under trademark or other laws?

If unconventional uses serve for a commercial purpose, they are heavily restricted by the provisions regarding unfair competition under the CL. According to the regulations of CL, unfair competition is prohibited and "unfair competition may also occur as: the dissemination of false, incomplete or distorted information regarding another market player or its employees, as well as, in respect of the goods produced or sold by such a market player, the economic significance, quality, form of production, characteristics, quantity, usefulness, prices, their information and another provisions, which may cause losses to this market player". (CL, Article 22(3)). There are especially strict regulations regarding the comparative advertising under the AL. Provisions of AL object to the unconventional trademark use in the form of comparative advertising, if it: "creates confusion between the advertiser and competitor, or between the advertiser and the company, trade mark, brand names or other distinguishing marks, goods or services of a competitor, if it defames a competitor, or the name (firm name), trade marks, brand names or other distinguishing marks, goods, services or operations, or personal characteristics and the like of a competitor and if it unfairly uses the name (firm name), trade mark, brand name or other distinguishing marks of a competitor or the reputation of the designation of origin of a competing good." (AL, Article 9(3)).

6. Are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

First, in Latvia only "well-known" marks are identified, others are considered to be variations of "well-known" marks and there are no particular regulations regarding any of them, except "well-known" marks. However, yes, LLT/99 clearly states, that "the owner of a trademark, that is well-known in Latvia, is entitled to prevent the use, in the course of trade, of any sign which constitutes a reproduction, an imitation, a translation or a transliteration, liable to create confusion, of the well-known trademark, in relation to goods or services, that are identical or similar to those covered by the well-known trademark. The owner of a trademark, that is well-known in Latvia, is entitled to prevent the use, in the course of trade, of any sign which constitutes a reproduction, an imitation, a translation or a transliteration, of the well-known trademark, also in relation to goods or services, that are not similar to those covered by the well-known trademark, provided that consumers may perceive the use of such a sign as indicating a connection between these goods or services and the owner of the well-known trademark, and provided that such use may be detrimental to the interests of the owner of the well-known trademark."(LLT/99, Article 4(7)).

Summary

In general, Latvian trademark law confines use "as a mark" to the traditional indications of origin and identity, however some of the unconventional uses are still disputable in relation to trademark maintenance and infringement issues. Such unconventional uses as parody and comparative advertising are also regulated by Competition law and Advertising law.

As Latvian trademark practice lacks notable precedents in relation to unconventional use of trademarks, it should be emphasized that those questions have not been seriously raised in Latvia and consequently - considerations on the discussed unconventional uses are mostly theoretical.

In relation to well-known marks, the protection is broader and those marks are protected also to dissimilar goods and services than those registered. This, undoubtedly, has a certain impact on the possibility of unconventional uses.

Rapport Q168

au nom du groupe luxembourgeois
par Nicolas DECKER, Avocat à la Cour

L'usage de la marque "en tant que marque" comme condition légale au regard de l'acquisition, du maintien et de la contrefaçon des droits

Remarque introductive

Le droit des marques est régi au Grand-Duché de Luxembourg par la loi uniforme Benelux sur les marques entrée en vigueur le 1^{er} janvier 1971, désignée ci-après "LUB".

Aux termes de l'article 13 A.2. LUB on entend par usage d'une marque ou d'un signe ressemblant, notamment:

- a) *l'apposition du signe sur les produits ou sur leur conditionnement;*
- b) *l'offre, la mise dans le commerce ou la détention des produits à ces fins sous le signe;*
- c) *l'importation ou l'exportation des produits sous le signe;*
- d) *l'utilisation du signe dans les papiers d'affaires et la publicité.*

1. Y a-t-il une nécessité d'utiliser la marque "en tant que marque" dans les cas suivants:

1.1. L'acquisition d'une marque

Pour acquérir une marque aucun usage de cette marque n'est exigé.

1.2. Maintien d'un enregistrement de marque

Le titulaire d'une marque peut être déclaré déchu du droit à la marque s'il n'y a eu, sans juste motif, aucun usage normal de la marque sur le territoire Benelux pour les produits pour lesquels la marque est enregistrée, pendant une période ininterrompue de cinq années (Art 5, sous 2 a) LUB).

Cet usage doit être normal ou sérieux.

Ainsi la pratique des "token-sales", qui ne poursuit que le but de maintenir le droit à la marque, est prohibée.

A noter que l'usage de la marque Benelux ne doit pas couvrir la totalité du territoire Benelux. (cf. Evrard et Peters, La défense de la marque dans le Benelux, 2^{ème} édition, n° 197)

La preuve du non-usage incombe en principe à la partie qui l'invoque. Conformément aux dispositions de l'article 5, sous 2 a) LUB le tribunal peut mettre, en tout ou en partie, le fardeau de la preuve de l'usage à charge du titulaire de la marque.

1.3 La condition pour qu'il y ait contrefaçon

Le titulaire d'une marque, dont il n'est pas fait un usage normal, ne peut agir en contrefaçon sur base de cette marque. En tous cas il se verra opposer une demande reconventionnelle en déchéance de la marque sur base de l'article 5, sous 2 a) LUB.

2. Y a-t-il une définition de l'usage "en tant que marque" dans la législation ou la jurisprudence?

D'après la loi uniforme Benelux l'usage d'une marque doit être normal.

Ce critère a été défini comme suit par la jurisprudence:

"Pour savoir si l'usage (...) peut être considéré comme un usage normal, il faut prendre en considération, dans leurs rapports mutuels, tous les faits et circonstances propres à la cause, tels que: la nature, l'étendue, la fréquence, la régularité et la durée de l'usage, la nature du produit, la nature et la dimension de l'entreprise; il est déterminant qu'il se dégage de l'ensemble de ces circonstances, compte tenu de ce qui passe pour usuel et commercialement justifié dans le secteur des affaires concerné, que l'usage a pour objet de créer ou de conserver un débouché pour les produits marqués et qu'il ne vise pas au seul maintien du droit à la marque."

(Cour de Justice Benelux 27.01.1981, Jur. 1980-1981, p. 23, Arrêt Turmac; cf. également: Cour de Justice Benelux 18.11.1998, Jur. 1988, p. 61, Arrêt Philip Morris)

3. Y a-t-il une différence dans l'évaluation de l'usage "en tant que marque" entre l'acquisition, le maintien et la contrefaçon des droits?

Le critère d'usage normal d'une marque est appliqué de manière identique tant lors de l'examen du maintien d'un droit que lors de l'examen du délit de contrefaçon.

4. Est-ce que l'un des points suivants est considéré comme usage "en tant que marque"?

4.1 L'usage sur Internet comme metatag, comme "linking" ou "framing"

Conformément à l'article 13 A 1 sous c) LUB le titulaire de la marque peut s'opposer à:

"tout usage qui, dans la vie des affaires et sans juste motif, serait fait d'une marque qui jouit d'une renommée à l'intérieur du territoire Benelux ou d'un signe ressemblant pour des produits non similaires à ceux pour lesquels la marque est enregistrée, lorsque l'usage de ce signe tirerait indûment profit du caractère distinctif ou de la renommée de la marque ou leur porterait préjudice".

L'usage d'une marque sur internet constitue donc la contrefaçon de la marque. (cf. Ord. du Président du Tribunal d'arrondissement de Luxembourg du 28 mai 1999, Société Générale SA et autres c/ EDS Europe SA;

Ord. du Président du Tribunal d'arrondissement de Luxembourg du 20 octobre 2000, Fiat SPA et Fiat Auto SPA c/ Italcara sàrl).

4.2 L'usage par des clubs de fans ou des supporters

Conformément à l'article 13 A 1 sus d) LUB le titulaire de la marque peut s'opposer à *"tout usage qui, dans la vie des affaires et sans juste motif, serait fait d'une marque ou d'un signe ressemblant autrement que pour distinguer des produits, lorsque l'usage de ce signe tirerait indûment profit du caractère distinctif ou de la renommée de la marque ou leur porterait préjudice."*

L'usage de la marque par des clubs de fans ou des supporters, constitue la contrefaçon de la marque, si cet usage est effectué dans la vie des affaires et tire indûment profit du caractère distinctif et porte préjudice au titulaire de la marque.

L'utilisation d'une marque dans la vie des affaires est tout usage qui a lieu – dans un but autre qu'exclusivement scientifique – dans le cadre d'une entreprise, d'une profession ou de tout autre activité qui n'est pas exercée dans le domaine privé et dont l'objet est de réaliser un avantage économique. (CJB 9.7.1984, Rec. 1984, p. 1, Aff. Tanderill).

Chaque cas d'espèce doit dès lors être examiné au regard de ces critères.

4.3 *La parodie*

La parodie d'une marque tombe sous le champ d'application de l'article 13 A 1 sous c) ou d) LUB.

Constitue ainsi la contrefaçon de la marque "Vuitton", l'emploi d'un signe ressemblant à cette marque pour des aides – mémoires contenant des préservatifs! (Trib. de commerce de Luxembourg, 23.12.1992, SA Louis Vuitton c/ Nobilis Choserie)

4.4 *La publicité comparative*

Aux termes de l'article 3bis de la directive communautaire 97/55 CE du Parlement européen et du Conseil du 6 octobre 1997, qui n'a pas encore été transposée en droit luxembourgeois, la publicité comparative est licite si elle n'engendre pas de confusion avec une marque, si elle n'entraîne pas le discrédit ou le dénigrement d'une marque, si elle ne tire pas indûment profit de la notoriété attachée à une marque ou si elle ne présente pas un bien ou un service comme une imitation ou une reproduction d'un bien ou d'un service portant une marque protégée. (Art. 3 bis, 10 sous d, e, g et h)

5. **Si, d'après le régime national du Groupe, l'usage comme marque est confié aux indications traditionnelles d'origine ou d'identification, des usages non conventionnels sont-ils néanmoins punissable de par la loi sur les marques ou d'autres lois (par exemple les lois sur la concurrence déloyale ou sur les pratiques du commerce?)**

La LUB protège de manière efficace toute atteinte tant à la fonction d'origine qu'à la fonction publicitaire de la marque. (cf. Réponse à la question n° 4)

La marque ne peut être protégée par le biais de la législation sur la concurrence déloyale. cf. Réf. com. Luxembourg, 20.03.1982, SA Pernod-Ricard c/ Leuchter, Réf. com. Luxembourg 28.11.1986, Schiffmann c/ Gat Lux Intertrade Cy Ltd.)

6. **Si l'usage "en tant que marque" dans le sens traditionnel est requis pour établir la contrefaçon, est-ce que les marques "de haute renommée", "célebres", "notoires" ou "jouissant d'une réputation" utilisées sur des produits et services différents sont protégées?**

Les marques qui jouissent d'une renommée à l'intérieur du territoire Benelux jouissent d'une protection élargie en vertu de l'article 13 A 1. sous c) (cf. Question n° 4.1)

Propositions

Dans la mesure où tel n'est pas le cas la notion d'usage doit être harmonisée.

Cette notion doit être large.

Le groupe luxembourgeois est également d'avis que cet usage de la marque doit être normal et pour reprendre les termes du règlement sur la marque communautaire, sérieux.

Par ailleurs, les dispositions légales en matière de preuve de l'usage d'une marque doivent prévoir un renversement de la charge de la preuve à l'instar des articles 5, sous 2 a) LUB et 43, paragraphe 2 du règlement sur la marque communautaire.

Résumé

Le droit des marques est régi au Grand Duché de Luxembourg par la loi uniforme Benelux sur les marques entrée en vigueur le 1er janvier 1971.

Selon la loi aucun usage n'est exigé pour pouvoir acquérir une marque.

La déchéance du droit est encouru en cas d'absence d'un usage normal sur le territoire du Benelux pendant une période de 5 ans sans juste motif. La jurisprudence exige un usage effectif. Celui-ci devra être prouvé par le demandeur mais le juge a la possibilité de décider un renversement de la charge de la preuve.

L'usage de la marque sur internet est considéré par la jurisprudence luxembourgeoise comme une contrefaçon. Il en est de même pour l'usage fait par un supporter s'il est effectué dans la vie des affaires et tire indûment profit du caractère distinctif et porte préjudice au titulaire de la marque. La parodie est également une contrefaçon.

La loi uniforme Benelux protège efficacement la marque dans sa fonction publicitaire. La directive communautaire 97/55 CE, non encore transposée, encadrera strictement la publicité comparative.

Le groupe luxembourgeois propose que la notion d'usage soit harmonisée et entendue de façon plus large. De même, la charge de la preuve de l'usage sérieux devrait par principe peser sur le titulaire de la marque.

Summary

In Luxembourg, the Benelux trademarks Uniform Law that came into force the 1st of January 1971 govern trademarks.

According to the Uniform Law the use of the sign is not a condition to obtain a trademark.

The revocation of rights may be requested if there is not a genuine use of the trademark on the territory of the Benelux during an uninterrupted period of five years, without good reason. The use has to be genuine. The genuineness has to be proved by the plaintiff but the judge can reverse the burden of the proof.

The jurisprudence in Luxembourg considers the use of the trademark in the Internet as an infringement. The parody of the trademark is an infringement. The use by a fan is an infringement if it happens in the business life and profits from the distinctiveness of the trademark and causes a prejudice to the holder.

The Benelux Uniform Law protects efficiently the trademark in its advertising function. The European directive 97/55 CE, that is not yet applied, will strictly control the comparative advertising.

The group from Luxembourg suggests to harmonize the notion of "use" and to give it a wider definition. Furthermore, the burden of the proof in all cases should belong to the holder of the trademark.

Report Q168

In the name of the Dutch Group
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**Use of a mark "as a mark" as a legal requirement in respect of acquisition,
maintenance and infringement of Rights**

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 Acquiring a mark (if rights may be acquired by use according to national law?)

For "acquiring a mark" we will read "acquiring trade mark rights and/or a trade mark registration".

Under the Benelux Trademarks Act (BTA) a trade mark may be filed and registered (and thus trade mark rights can be invoked) with respect to trade marks which are not used at all, let alone used "as a mark". Only if the mark has not been put to genuine use during an uninterrupted period of five years or more, the trade mark right can be declared lapsed upon request by any interested third party (Art. 5.2 par. a BTA / Art. 12 par. 1 EC Trade Marks Directive). In this respect it should be noted that the (genuine) use of the mark should be use of the trade mark for the goods or services for which it has been registered, thus implying that the trade mark should have been used "as a mark".

We are therefore inclined to simply answer this question with "no". However, this is not true for one category of marks, namely for signs which lack sufficient distinctive character to be registered as a trade mark (Art. 6bis.1 par. a / Art. 3.1 par. b, c and d EC Trade Marks Directive). This lack of distinctiveness may be overcome if the sign has acquired distinctiveness through use (Art. 3.3 EC Trade Marks Directive). Although the EC Trade Marks Directive, nor the BTA gives any qualification as to this use, it is considered essential that the relevant public has recognised the use of the mark as "use as a mark"¹. This is logical, as it would be hard to imagine how else the sign could become distinctive. Therefore, for this category of (initially) insufficiently distinctive signs, use of that sign "as a mark" is a requirement for acquiring trade mark rights.

1.2 Maintaining a trade mark registration (e.g. against an application for cancellation on grounds of non-use)?

As indicated above, Art. 5.2 of the BTA (Art. 12 par. 1 EC Trade Marks Directive) provides for the possibility that a court declares a trade mark right lapsed upon request of an interested third party (which will lead to cancellation), in case the trade mark has not been used for the goods or services for which it was registered, during an uninterrupted period of five years or more. The provision therefore explicitly refers to the situation that the mark is used "for the goods or services for which the trade mark is registered", thus implying use "as a mark" .

However, there has been some discussion as to what could constitute genuine use of the trade-mark for the goods or services for which it was registered. In the case of *Ansul v. Ajax*² the Dutch Supreme Court referred questions to the ECJ in relation to what should be considered genuine use

¹ Court of Appeal The Hague, 4 June 1998, BIE 1998,42 (Libertel)

² Supreme Court, 26 January 2001, RvdW 2001,40, NJ 2001, 247

of the trade mark for the goods and services for which it was registered. This case related to fire extinguishers, which were not sold new anymore, but which were maintained by the trade mark holder, using the trade mark as a reference. This (among other things) meant that the fire extinguishers were refilled (the trade mark holder held the trade mark also for extinguishing agent), and the trade mark holder applied a sticker showing the trade mark, and mentioning the fact that the product was (again) ready for use.

There is jurisprudence on the issue of genuine use under Benelux trade mark law as it was prior to harmonisation³. The Benelux Court of Justice ruled that:

1. all facts and circumstances should be taken into consideration,
2. decisive are the facts and circumstances when taken into consideration together with
 - a) what is common in the respective branch,
 - b) what is common in trade in general,
 - c) what is commercially sound, and
 - d) whether the use gives the impression that it has as a goal that goods and/or services find their way to consumers under the trade mark, and that
3. especially the nature, scope, frequency and duration of the use in connection with the nature of goods or services and the size of the enterprise should be taken into consideration.

In *Ansul v. Ajax* the Dutch Supreme Court has asked whether or not this is still a relevant criterion under the EC Trade Marks Directive, and if not, which criterion should be applied. Furthermore the Supreme Court has asked whether there can be genuine use in case the trade mark is used not for selling new goods under the trade mark, but for maintaining those goods. Therefore in the Benelux there is still some uncertainty as to what could be considered genuine use of a mark for the goods and services for which it was registered.

1.3 *Establishing infringement?*

- 1.3.1 As set out in the introduction to this question, use "as a mark" is traditionally taken as "use for the purpose of indicating the origin or source of goods and services or the identity of a particular undertaking" (cf. the "normative functions" of a trade mark as described in Q68) - as opposed to e.g. use for purely descriptive purposes.

When it comes to verifying the existence of this requirement in the framework of assessing trade mark infringement, a distinction can be made between

1. the grounds of action laid down in Art. 13.A.1 par. a, b and c of BTA (Art. 5.1 par. a, b and Art. 5.2 EC Trade Marks Directive) and
2. the grounds of action provided in Art. 13.A.1 par. d of BTA (Art. 5.5 EC Trade Marks Directive).

In particular, paragraphs a, b and c of Art. 13.A.1 BTA (Art. 5.1 par. a, b and Art. 5.2 EC Trade Marks Directive) sanction the use of a trade mark for the purpose of distinguishing goods or services, whereas Art. 13.A.1 par. d BTA (Art. 5.5 EC Trade Marks Directive) sanctions the use of a trade mark not for the purpose of distinguishing goods or services (and hence for other purposes than functioning "as a mark")⁴. The latter paragraph is often

³ 3 Benelux Court of Justice, 27 January 1981, NJ 1981, 333 (*Turmac v. Reynolds*)

⁴ Cf. Under Art. 13.A.1 BTA the owner of a prior trade mark registration is entitled to prevent third parties from using in the course of trade

a) any identical sign used in relation to goods or services which are identical with those for which the trade mark is registered;

b) any sign which is identical with or similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, where such use could

applied in cases involving trade names, corporate names, domain names et cetera, although this will not necessarily be so in all cases (cf. *infra*, also, under question 5).

We therefore believe that the answer to this question is "yes" but only in case of trade mark infringement under Art. 13.A.1 par. a, b and c BTA (Art. 5.1 par. a, b and Art. 5.2 EC Trade Marks Directive), since the use of the same trade mark must be intended to distinguish goods or services and therefore "use as a mark" must be established.

Use "as a mark" in the traditional sense is not required for Art. 13.A.1 par. d BTA (Art. 5.5 EC Trade Marks Directive) to apply and trade mark infringement to occur. This article applies in the case of use of a trade mark that is not intended to distinguish goods or services but nevertheless takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark. So-called "unconventional" uses - such as use of a trade mark as part of domain names, trade names, as a title of books or in films, or for the purpose of parody, comparative advertising et cetera - may in certain circumstances qualify for action on the basis of Art. 13.A.1 par. d BTA (Art. 5.5 EC Trade Marks Directive) (cf. *infra*, also, questions 4 and 5). However, the aforementioned "unconventional" uses may, in certain circumstances, qualify for protection under Art. 13.A.1 par. a, b or c BTA (Art. 5.1 par. a, b and Art. 5.2 EC Trade Marks Directive), e.g. when a trade name is seen by the public "as a trade mark".

- 1.3.2 When a trade mark is considered used "as a mark" is not defined in the law, apart from what is stated in Art. 13.A.1 and Art. 13.A.7 BTA (Art. 6.1 EC Trade Marks Directive).

The infringing sign envisaged under Art. 13.A.1 par. a, b and c BTA (Art. 5.1 par. a, b and Art. 5.2 EC Trade Marks Directive) is clearly one that distinguishes products or services, be it a trade mark (registered or not) or an appellation of origin.

In its ruling *Hagens* in 1982, the Benelux Court of Justice held that the use to which the trade mark owner can object, shall be understood as "the use of this trade mark or sign by someone in relation to his own goods or services, with a view to enhance the trade or performance thereof, or to indicate his own undertaking"⁵.

In subsequent decisions, the Benelux Court of Justice - in broader terms - decided that there was use for the purpose of distinguishing goods or services when it is clear to the public that this use relates to specific goods commercialised or offered for sale or to services performed which, by this use, are distinguished from the goods or services from others⁶. Likewise, the re-filling of an empty packaging - supplied by a customer - carrying the original trade mark with a similar product which does not originate from the trade mark owner and the subsequent supply thereof to the customer, was considered "use for the purpose of distinguishing goods" (and therefore constitutes infringement), even when in the customer's mind there is no misunderstanding as to the origin of that product⁷.

Whether or not a trade name is also used for the purpose of distinguishing goods or services - as opposed to use for the purpose of distinguishing a particular undertaking only -

result in a likelihood of association (to be read as confusion: ECJ 11 November 1997, IRDI 2000, p.929 (*Sabel v. Puma*)) on the part of the public with the trade mark;

c) any sign which is identical with or similar to the trade mark and is used in relation to goods or services which are not similar to those for which the trade mark is registered, where the trade mark is known in the Benelux and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark;

d) any sign which is identical with or similar to the trade mark and is used other than for the purpose of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

⁵ Benelux Court of Justice, 29 June 1982, Jur. 1981-1982, p.40 (*Hagens*)

⁶ Benelux Court of Justice, 7 November 1988, NJ 1989, 300 (*Omnisport*); Benelux Court of Justice, 20 December 1993, NJ 1994, 638 (*Mercedes v. Haze*)

⁷ Benelux Court of Justice, 20 December 1993, NJ 1994, 637 (*Shell v. Walhout-de Visser*)

and hence, whether or not Art. 13.A.1 par. a, b or c BTA (Art. 5.1 par. a, b and Art. 5.2 EC Trade Marks Directive) applies, will depend on the public's opinion⁸.

When a service-providing undertaking carries no other signs than its trade name for the purpose of distinguishing its services, the public will perceive the use of that trade name as a use that relates to the services offered by that undertaking and hence, Art. 13.A.1 par. a BTA (Art. 5.1 par. a EC Trade Marks Directive) applies⁹.

In another case, the prominent use of the slogan "Ik ben Ben" (read in English: I am Ben) by the Dutch telecom provider Ben, was held not to serve the purpose of distinguishing its goods or services, as this slogan was used in the first place as a means to introduce itself to the public and hence the requirements of Art. 13.A.1 par. d BTA (Art. 5.5 EC Trade Marks Directive) - and not those of Art. 13.A.1 par. b BTA (Art. 5.1 par. b EC Trade Marks Directive) - applied¹⁰.

In its judgement of 25 September 2000, the Benelux Court of Justice in a case between BMW and Deenik reconsidered its previous considerations in the case Mercedes v. Haze of 1993 and came to the conclusion that these are no longer entirely in line with current harmonised European law, and this based on the ECJ ruling in *BMW v. Deenik*. However, in the first mentioned judgement the Benelux Court of Justice did not entirely follow the earlier decision by the ECJ¹¹.

In *BMW v. Deenik* the ECJ decided that use of a trade mark by a third party - not having the trade mark owner's consent - for the purpose of advertising repair and maintenance services in relation to the goods covered by the trade mark or for the purpose of indicating that he is specialised in those goods, is considered use in relation to goods in the meaning of (old) Art. 13.A.1 BTA - now Art. 13.A.1 par. a BTA (Art. 5.1 par. a EC Trade Marks Directive)¹². Nevertheless, the Benelux Court of Justice considered that use of a trade mark by a third party, for the purpose of advertising his activities in relation to the products marketed by the trade mark owner or his licensee - such as the resale of those products (cf. "specialised in BMW"), as well as rendering repair and maintenance services - is to be qualified as "other use" in the meaning of Art. 13.A.2 (old) BTA - now Art. 13.A.1 par. d BTA. (Art. 5.5 EC Trade Marks Directive).¹³

In addition, the exceptions laid down in Art. 13.A.7 BTA (Art. 6.1. EC Trade Marks Directive) (as applied by the courts) describe uses that do not amount to trade mark infringement, and therefore implicitly give an indication of what is not considered as infringing "trade mark use".

In particular, the trade mark owner is not entitled to prohibit a third party from using, in the course of trade:

- a) his own name or address;
- b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin¹⁴, the time of production of the goods or of rendering the service, or any other characteristics thereof (cf. "descriptive indications");

⁸ Benelux Court of Justice, 7 November 1988, NJ 1989, 300 (Omnisport); Benelux Court of Justice, 20 December 1996, NJ 1997, 313 (Europabank)

⁹ District Court Antwerp, 14 January 1997, BIE 1999, 73

¹⁰ Pres. District Court The Hague, 26 May 1999, BIE 1999, 113

¹¹ Benelux Court of Justice, 25 September 2000, IER 2000, 65/313 (*BMW v. Deenik*)

¹² ECJ, 23 February 1999, C-63/97, [1999] 1 CMLR 1999, Ing. Cons. 1999, p. 322 (*BMW v. Deenik*)

¹³ Under Art. 13.A.2 (old) BTA, the trade mark owner could object to any 'other use' (in the course of trade) of the trade mark - as opposed to use of an identical or similar mark in relation to identical or similar goods covered by Art. 13.A.1 (old) BTA - without valid reason in such circumstances that could cause damage to the trade mark owner

¹⁴ District Court Bruges, 18 April 2000, BIE 2001, 46

- c) the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

However, the aforementioned uses of a trade mark are only allowed if used "in accordance with honest practices in industrial or commercial matters".

Art. 13.A.7 par. b BTA (Art. 6.1 par. b EC Trademarks Directive) implies that use of indications identical to the trade mark should be strictly confined to information purposes in order not to constitute infringement. In its ruling in the *Polyglot* case in 1995, the Benelux Court of Justice held that a third party can not avail itself of this exception when the use is such that the impression is created in the public's mind that the indication used is a trade mark, *i.e.*, used to distinguish the goods or services concerned and hence as an indication of origin of that product from a particular undertaking¹⁵. This criterion was also applied by the Dutch Supreme Court in a case involving the trade mark ROUTE 66 filed for several goods and services including the organisation of tours¹⁶.

This means that third parties are allowed to indicate characteristics of a product with a descriptive term, provided this term is not given a "trade mark appearance". In this respect, national courts in Benelux seem to consider the same elements to determine whether or not such impression is created. Such would, for instance, be the case if the indication was printed in capitals and put on the place usually reserved for the trade mark (*Polyglot*, *cf. supra*).

National courts have therefore upheld infringement in the case of use of a generic or common sign because said sign was used "as a mark"¹⁷. In other cases, use of the generic or common name was allowed. For instance, it was held that use by Seiko, sponsor of the Olympics, of the indication "olympic" on watches was allowed and this notwithstanding the existence of the trade mark "Olympic"¹⁸.

2. Is there any definition of what is use "as a mark" either in statute or case law?

The BTA does not include any definition of use "as a mark", apart from what is stated in Art. 5.1 of the EC Trade Marks Directive. This refers to use of the trade mark in relation to goods or services. As to the relevant jurisprudence *cf.* question 1.2 and 1.3 *supra*, and question 4.1 to question 4.5 *infra*.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

We answer this question with "no"; there is no material difference.

4. Is any of the following considered to be use "as a mark":

As indicated above according to Dutch law, use required for the purposes of acquiring a trade mark and maintaining a registered trade mark, should be use "as a mark". The following therefore only concerns use for the purpose of establishing infringement.

4.1 Use on the internet, as a metatag, in linking or framing

¹⁵ Benelux Court of Justice, 16 June 1995, NJ 1995, 745 (*Polyglot*); see also Dutch Supreme Court, 5 December 1997, I.R.D.I. 1998, p. 61

¹⁶ Notwithstanding the validity of this trade mark, the Supreme Court held that the trade mark owner should not be able to prevent third parties from using those words to indicate organised tours which have Route 66 as destination, unless the impression is created in the public's mind that this indication is (also) used as (a) (their own) trade mark - which was found to be the case (Dutch Supreme Court, 5 December 1997, IRDI 1998, p. 61)

¹⁷ Pres. District Court Haarlem, 12 March 1986, IER 1986, 17; Court of Appeal Arnhem, 4 October 1988, BIE 1990, 4; Court of Appeal Amsterdam, 13 September 1990, IER 1990, 65

¹⁸ Pres. District Court Rotterdam, 7 August 1992, BIE 1994, 88

Dutch jurisprudence so far is limited to use on the internet by mere registration of a domain name, use of a domain name and as a metatag, i.e. not in linking or framing. In legal doctrine linking itself (absent any special circumstances) is usually considered allowed, also if the link contains a trade mark.

4.1.1 Mere registration of a domain name

It is still controversial whether mere registration of a trade mark as a domain name is to be considered as use of that trade mark in the course of trade¹⁹, let alone use "as a mark", as by mere registration the trade mark is not noticeable for the relevant public. One could question whether it should be at least a condition that the domain name gives access to a website and whether or not there is use in the course of trade. In *Gaos v. Passies*²⁰ it was held that a domain name functions in the course of trade also as a sign by which one could promote its business activities. Therefore, the address itself, besides being a tool to get access to a website, also has a promotional function.

In case mere registration is considered to be use of a trade mark in the course of trade, this mere registration is mostly held to be use of that trade mark for other purposes than functioning "as a mark"²¹. However, in *KLM-Alitalia v. Trading House Morellino*²² mere registration of a domain name was held to be use "as a mark" in case the domain name is intended to be used for similar goods as the trade mark was registered for.

4.1.2 Registration of a trade mark as a domain name, which domain name gives access to a website

Whether use of a domain name, containing a trade mark or a similar sign, which domain name gives access to a website, is to be considered as use "as a mark" is also still controversial.

Use of a domain name on the internet, indicating the location of an electronic magazine, dealing with similar goods or services as the trade mark is registered for, is held to be use of a sign for a good, thus "as a mark"²³.

Also use of a domain name, containing a trade mark (or a similar sign) and giving access to a website is held to be use of that sign "as a mark", in case the website deals with goods or services that are not similar to those for which the trade mark is registered²⁴. However, in these cases the trade mark registered was held to be a famous trade mark.

The defence that the trade mark was used for so called "dual-communication", establishing a valid reason, failed²⁵.

¹⁹ In *Dikkerboom v. InterboorIT* (Pres. District Court Utrecht, 16 November 2000, <http://www.domeinnaam-jurisprudentie.nl/disclaimer.html>) mere registration of a domain name, containing a trade mark, was held to be no use of that trade mark in the course of trade. In *KLM-Alitalia v. Trading House Morellino* (Pres. District Court Arnhem, 25 October 1999, IER 2000, 26) mere registration of a trade mark as a domain name was held to be use of that trade mark in the course of trade

²⁰ Court of Appeal Amsterdam, 7 December 2000, <http://www.domeinnaam-jurisprudentie.nl/disclaimer.html>

²¹ Pres. District Court Arnhem, 25 October 1999, IER 2000, 26 (*KLM-Alitalia v. Trading House Morellino*), Pres. District Court Groningen, 25 February 2000, BIE 2001, 23 (*Horselover.nl v. Horselover voor ruitersportartikelen*) and Court of Appeal Amsterdam, 7 December 2000, <http://www.domeinnaam-jurisprudentie.nl/disclaimer.html> (*Gaos v. Passies*)

²² Pres. District Court Arnhem, 25 October 1999, IER 2000, 26

²³ Pres. District Court Amsterdam, 20 September 1996, IER 1996, 44 (*Ouders van Nu*), Court of Appeal Amsterdam, 24 April 1997, BIE 1998, 11 (*Ouders Online II*) and Court of Appeal Amsterdam, 27 July 2000, BIE 2001, 21 (*Beursplein5.nl*)

²⁴ Pres. District Court Amsterdam, 7 April 2000, IER 2000, 28 (*Unilever v. Name Space*) and Court of Appeal Amsterdam, 27 July 2000, BIE 2001, 21 (*Beursplein5.nl*)

²⁵ Pres. District Court Amsterdam, 7 April 2000, IER 2000, 28 (*Unilever v. Name Space*)

To the contrary, registration of a domain name, containing a trade mark (or a similar sign), is also held to be use of a trade mark for other purposes than functioning "as a mark"²⁶.

Prior use of an identical trade name, use of an artist's name, indicating the content of a website and use in the course of trade by a natural person of his own surname, provided that the surname is not used for the purpose of distinguishing goods and services, viz. use in private for genealogical purposes, are held to establish valid reasons²⁷.

4.1.3 Registration of a domain name, giving access to a website, with the purpose of putting up this domain name for sale and /or for rent

Registration of someone else's trade mark as a domain name, which domain name gives access to a website, with the purpose of putting up this domain name for sale is held to be use for other purposes than functioning "as a mark"²⁸.

The defence that the various different persons were entitled to the trade mark, establishing a valid reason, failed²⁹.

4.1.4 Metatag

Whether use of a trade mark (or a similar sign) as a metatag on someone else's website domain name, is to be considered as use "as a mark" is also still controversial.

In *VNU v. The Monsterboard*³⁰ use as a metatag was held to be use "as a mark". In *Deutz v. ADT and Meatpoint*³¹ use of a trade mark as a metatag on someone else's website was held to be use of that trade mark for other purposes than functioning "as a mark".

4.2 Use by fan clubs or supporters

So far as a trade mark (or a similar sign) is used by fan (or hate) clubs or supporters in the course of trade, this use is considered to be for other purposes than functioning "as a mark". In establishing trade mark infringement, the sign must be used by the clubs or supporters without a valid reason, taking unfair advantage of, or being detrimental to the distinctive character or the repute of the trade mark. This can of course very well be the case. The most difficult question will be whether or not there is use of the trademark in the course of trade. Even if no trademark infringement can be established, such use may still be actionable under general tort law.

4.3 Parody

A parody calls to mind a (known) trade mark to make fun of or insult it. Parodies can be made in different ways.

²⁶ Pres. District Court Amsterdam, 15 May 1997, IER 1997, 44 (Labouchere), Pres. District Court Amsterdam, 4 September 1997, IER 1997, 61 (Meatpoint), Pres. District Court Dordrecht, 9 February 1999, BIE 1999, 49 (Deutz v. ADT), Pres. District Court Arnhem, 26 February 1999, <http://www.rechtbank-arnhem.org/9902261.htm> (Fortis Nederland N.V.) and Court of Appeal Leeuwarden, 4 April 2001, casenumber 000321 (LCI v. Livestock)

²⁷ Court of Appeal Leeuwarden, 4 April 2001, casenumber 000321 (LCI v. Livestock), Pres. District Court Amsterdam, 12 October 2000, <http://www.domeinnaam-jurisprudentie.nl/disclaimer.html> (Garnier v. RoosIT) respectively Pres. District Court Utrecht, 16 November 2000, <http://www.domeinnaam-jurisprudentie.nl/disclaimer.html> (Dikkerboom v. InterboorIT)

²⁸ Pres. District Court Amsterdam, 13 July 2000, <http://www.domeinnaam-jurisprudentie.nl/disclaimer.html> (Merkhouders v. Name Space) and Pres. District Court Amsterdam, 13 July 2000, <http://www.domeinnaam-jurisprudentie.nl/disclaimer.html> (Zeldenrust v. Basenames)

²⁹ Pres. District Court Amsterdam, 13 July 2000, <http://www.domeinnaam-jurisprudentie.nl/disclaimer.html> (Merkhouders v. Name Space)

³⁰ Pres. District Court The Hague, 29 June 1999, IER 1999, 42

³¹ Pres. District Court Dordrecht, 9 February 1999, BIE 1999, 49 respectively Pres. District Court Amsterdam, 4 September 1997, IER 1997, 61

In the first place, parodies can be made by copying features of another party's product or advertisement, without mentioning that party's trade mark (or a similar sign). In such a case, no use of a third party's trade mark is made and trade mark infringement cannot be established.

Secondly, parodies can be made by using another party's trade mark (or a similar sign) in order to increase the appeal of one's own product and/or to profit from the reputation of that trade mark.

In general, such use is not considered to be "use in order to distinguish goods and services" and is thus not regarded as use "as a mark"³². However, as indicated above, according to the BTA, the traditional requirements relating to use "as a mark" are not the only relevant uses of a trade mark for establishing infringement. Under Art. 13.A.1 par. d BTA (Art. 5.5 EC Trade Marks Directive), use of a trade mark other than to distinguish goods and services (and thus for other purposes than "as a mark") can also constitute a trade mark infringement. The use of a trade mark as a parody may therefore constitute an infringement on the basis of Art. 13.A.1 par. d BTA (Art. 5.5 EC Trade Marks Directive).

There is some uncertainty as to when a parody can be considered use in the course of trade. Parodies can be part of a for profit operation, where the parody might even greatly contribute to the profits made. It can be argued that this would constitute use in the course of trade.

A third possibility is the use and the registration of a trade mark that itself is a parody. Whether the use of such trade mark constitutes use "as a mark" or otherwise constitutes an infringement, depends on the way that trade mark is being used³³. In this respect, the general criteria described above apply.

Further to the above, the use of a trade mark (or of a similar sign) in a parody does - in general - not constitute use "as a mark". However, the use of a trade mark as a parody may constitute an infringement on the basis of Art. 13.A.1 par. d BTA (Art. 5.5 EC Trade Marks Directive). Use of a trade mark in a parody will usually not constitute a valid reason for such such use.

4.4 Comparative advertising

It is unclear whether the use of a trade mark in comparative advertising constitutes use "as a mark" or use for "other purposes than to distinguish goods or services".

The prevailing view (including that of the reporters) is that comparative advertising falls under Art. 13.A.1 par. d BTA (Art. 5.5 EC Trade Marks Directive)³⁴. According to Benelux jurisprudence, in principle, Art. 13.A.1 par. a, b and c BTA (Art. 5.1 par. a, b and Art. 5.2 EC Trade Marks Directive), refers to the use of a third party's trade mark in order to distinguish its *own* goods and services³⁵. In comparative advertising, the advertiser will use a third party's trade mark as a reference to the

³² Pres. District Court Dordrecht, 9 February 1999, BIE 1999, 49 respectively Pres. District Court Amsterdam, 4 September 1997, IER 1997, 6130 Pres. District Court Brussels, 24 February 1987, BIE 1988, 45 (Guerlain v. Comme un parfum de Guerlain); Pres. District Court Amsterdam, 28 July 1981, BIE 1982, 12 (Philips v. Haagsche Post); Pres. District Court Breda, 12 December 1980, BIE 1981, 26 (Papa Pia's v. Mama Mia's). Not explicitly: Pres. District Court Haarlem, 19 June 1985, BIE 1986, 65 (Lacoste). Such use was considered use "as a mark" by the Pres. District Court The Hague, 6 December 2000, IER 2001, 9 (Moet v. Xenos)

³³ Pres. District Court Brussels (11 May 1993, BIE 1995, 98) argued that the trade mark Bêteman "was regarded a parody of the trade mark Batman". The President argued that the fact that a trade mark constitutes a parody implies that both trade marks are similar. However, according to the President, it also implies that no confusion exists; confusion is in fact excluded by the parodying similarity. The judgment did not deal with the question whether the parody constituted use "as a mark" or whether it constituted an infringement

³⁴ PRAR, Chapter IIID.21, p.IIID-61; G. van Empel & P.G.F.A. Geerts, *Bescherming von Intellectuele Eigendom*, 1999, p.92; Mr R.V. de Very, IER 2001, p.174. However, some argue that this should be covered under Art. 13.A.1 par. a BTA as this would not only cover use of a sign for ones own good or services, but also for the good and services of others

³⁵ Benelux Court of Justice, 7 November 1988, NJ 1988, 300 (Omnisport)

goods or services of that party, which goods or services are not being sold by the advertiser. The advertiser uses the other party's trade mark solely in order to make a comparison with its own goods or services and not as a (distinguishing) trade mark. Subsequently, it can be argued that use of a trade mark in comparative advertising does not distinguish the advertiser's own goods and must therefore be regarded as use "other than as a mark"³⁶.

The legislative history of the Comparative Advertising Directive³⁷ and the EC Trade Marks Directive³⁸ do not provide clear information as to whether the use of a trade mark in comparative advertising must be regarded use "as a mark".

Considerations 14 and 15 to the Comparative Advertising Directive provide that use of another's trade mark in accordance with the requirements of the Comparative Advertising Directive, in order to make comparative advertising, and the intended target being solely to distinguish between them and thus to highlight differences objectively, does not constitute trade mark infringement. Apparently, such use constitutes a "valid reason". Use "without a valid reason" is only a requirement for trade mark infringement in Art. 13.A.1 par. c BTA (Art. 5.2 EC Trade Marks Directive) (regarding use of a famous trade mark "as a mark") and Art. 13. A.1 par. d BTA (Art. 5.5 EC Trade Marks Directive) (regarding use "other than as a mark"). Therefore, it appears that use of a trade mark in comparative advertising is intended to fall under Art. 13.A.1 par. d BTA (Art. 5.5 EC Trade Marks Directive) and thus, constitutes use "other than as a mark".

In our opinion, the use of a trade mark in comparative advertising does not constitute use "as a mark", because the advertiser does not use the other party's trade mark in order to distinguish its own goods and services. Such use may however, constitute an infringement if the requirements of Art. 13.A.1 par. d. BTA (Art. 5.5 EC Trade Marks Directive) are fulfilled.

According to the explanatory memorandum to Art. 6:194a of the Dutch Civil Code (BW), use of a trade mark as a reference ("specialist in BMW") falls under the definition of comparative advertising. With regard to such use cf. question 1.3 supra.

4.5 *Use in books, magazine articles, wordlists, encyclopaedias, et cetera.*

The Dutch group includes a fifth category of use in this question, viz. use in books, magazines, wordlists, encyclopaedias, et cetera.

Use of trade marks in books, magazine articles, wordlists, encyclopedias, et cetera, is also considered to be use for other purposes than functioning "as a mark"³⁹. In establishing trade mark infringement, the sign must be used in the course of trade without a valid reason, taking unfair advantage of or being detrimental to the distinctive character or the repute of the trade mark. It should be noted that sponsored use of a trade mark in such publications is considered use of the trade mark "as a mark."

³⁶ Pres. District Court The Hague, 14 January 1998, BIE 1999, 55 (Ferring v. Serrono). In the following cases, it was only decided that the use of the mark constituted "other use" within the meaning of Art. 13.A.1 par. 2 old BTA: Pres. District Court Breda, 24 February 1994, BIE 1996, 118, Procter v. Kimberley Clark; Pres. District Court The Hague, 9 August 1993, BIE 1994, 115 (Trage Foam); Pres. District Court Utrecht, 20 December 1990, BIE 1991, 72 (Bausch en Lomb v. Allergan). Other: Court of Appeal Amsterdam, 12 December 1996, BIE 1998, 75 (Hewlett-Packard v. Pelikan Hardcopy)

³⁷ Directive 97/55/EC of European Parliament and of the Council of 6 October 1997 amending Directive 84/450/EEC concerning misleading advertising so as to include comparative advertising (OJ No L290 p. 18, 1997/10/23)

³⁸ First Council Directive 89/104/EEC, of 21 December 1988, to Approximate the Laws of the Member States Relating to Trade Marks (OJ No L 40 p. 1, 1989/02/01)

³⁹ District Court Amsterdam, 8 January 1975, BIE 1977, 96 (Shell v. Vrij Nederland) and Pres. District Court Amsterdam, 28 July 1981, BIE 1982, 12 (Philips v. Haagsche Post)

5. If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws).

Next to the traditional functions of the use "as a mark", as defined in the introduction to this question (origin and identity), the Benelux has been a forerunner in recognising the additional function of the trade mark as a carrier of goodwill, and has provided for the means to protect that function of the trade mark as well. In Benelux trade mark law "use as a mark" is therefore not confined to "origin and identity".

In addition, the BTA (introduction to Art. 13.A.1) expressly allows for additional actions resulting from "the application of general legal rules concerning liability from wrongful acts (tort)". This is in conformity with the sixth preamble to the EC Trade Marks Directive. It is therefore fully possible, if only in theory, to institute legal proceedings, both against "use as a mark" and "unconventional use" based on the general articles on tort in the Dutch Civil Code (Art. 6:162 ff BW). However, the fact that an act does not constitute a trade mark infringement sometimes is considered an indication that such an act also does not constitute a tort if such an act relates (solely) to the use of a sign as an indicator or designator (so-called negative reflex effect of the BTA). This will in particular play a role in the situations covered by Art. 13.A.1 par. a and b BTA (Art. 5.1 par. a and b EC Trade Marks Directive).

Art. 12 BTA expressly forbids any legal action "for protection of a sign that can be considered a mark" without a prior trade mark application having been made. Since this requirement also applies to actions based on tort, in practice the trade mark holder will choose to proceed under trade mark law rather than institute the general action based on tort. If an action under tort would in fact be instituted, under Dutch law (general civil law is not harmonized within the Benelux) the grounds to be alleged for an action based on tort would be that, through copying or imitating the plaintiff's distinguishing sign, the alleged infringer creates confusion with the relevant public.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

The Benelux made use of the option offered in Art. 5 par. 2 of the EC Trade Marks Directive, granting protection against use for dissimilar goods and services under the conditions set forth in that section (the protected mark must have a "reputation" within the Benelux and the infringing use must take unfair advantage of, or be detrimental to, the distinctive character or the repute of the mark).

Report Q168

in the name of the Paraguayan Group

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 Acquiring a mark (if rights may be acquired by use according to national law)

Our system is "attributive". The "use" of the trademark - (non-registered) - does not grant rights over a trademark. The owner acquires rights over a trademark from the time of its registration. (Art. 15).

1.2 Maintaining of a trademark registration (e.g. against an application for cancellation on grounds of non-use)

The Trademark Law establishes that, as per the interested party's request, the registration of a trademark shall be cancelled:

- i) when it has not been "used" within the five years upon its registration (***The period of 5 years, for trademarks granted under the former law, shall be considered from the time of enforcement of the new law – art. 25 Decree.***)
- ii) when its "use" has been interrupted for more than 5 consecutive years.
- iii) when its use, within the estimated term, has been carried out with substantial alterations of its original distinctive, as recorded in the corresponding registration certificate.

See Art. 27 (a) (b) (c)

1.3 Establishing infringement

If it refers to the use of a trademark by its owner, the law does not specifically establish that there is a requirement for the use of a trademark "as a trademark" in order to determine an infringement. However, we understand that in an action of infringement against an infringing third party, for unlawful use of a trademark, the infringing third party could allege the owner's lack of use of the trademark with the purpose of rejecting the action.

If it refers to the use of a trademark by a third party, the following cases **are considered as infringement**:

- i) when a sign that is identical or similar to a trademark or trade name **is used in the market** for whatever products or services when such use "**could cause confusion**" or "**a risk of association to the owner's registration**".
- ii) when a sign that is identical or similar to a trademark or trade name **is used in the market** for whatever products or services, services or activities, when such action "**could cause the owner an unfair economic or commercial harm**" due to the dilution of the distinctive strength or the commercial or advertising value of the sign, or of an unfair advantage of the prestige of the sign or its owner's.

- iii) when a sign that is identical or similar to a trademark or trade name **is publicly used, even for non-trading purposes**, when it **could cause a dilution** of the distinctive strength or of the commercial or advertising value of the sign or **an unfair advantage of its prestige**.

See Art. 84 (e) (f) (g)

2. Is there any definition of what is use "as a mark" either in statute or case law?

There is no legal definition of what constitutes the use "as a trademark" in the traditional sense (origin and role of the identity).

In some judicial cases, it has been stated that the trademarks' role is to indicate origin and identity.

However, the Trademark Law establishes that the registered trademark is under "use" when:

- i) The products it covers have been placed in the market, or
- ii) The services by which it is distinguished are available in the market with said denomination, and
- iii) When advertising is promoted for the launching of products or services into the market for trading (as long as effective use is made within the following 4 months from the beginning of the advertising campaign).

To determine the "use" of a registered trademark regarding the launching of the products into the market or the availability of the services in the market, the following shall be considered:

- i) the number (**quantity**) and way (**nature**) that corresponds due to the nature of the products and services
- ii) the number (**quantity**) and way (**nature**) that corresponds due to the modalities of its trade, and
- iii) the dimension of the market.

See Art. 29

The Regulatory Decree determines that **"the use of the trademark in any country"** shall be enough to prove the use of a trademark and as a defence before a cancellation action for the lack of use.

See 23 - Decree

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

The definition of "use" in our legal regime is very extensive, which allows for the court to decide, in each case, whether the use in question complies with the requirements established by our Trademark Law.

4. Is any of the following considered to be use "as a mark"?

4.1 Use on the internet, as a metatag, in linking or framing

There is no specific provision on these types of use in our Trademark Law.

It is our understanding that the use of a trademark in the Internet, such as (i) metatag - "playboy" case; (ii) linking - "ticketmaster" case or (iii) - "total news" case could be considered as the use of a trademark

4.2 *Use by fan clubs or supporters*

4.3 *Parody*

4.4 *Comparative advertising*

The Trademark Law No. 1294 does not contain a specific provision on the use of the trademark in comparative advertising.

The Law No. 1334 of Consumer and User Defence, states that "comparative advertising will not be allowed when, through fraudulent (*illegal/unlawful*) actions or general and indiscriminated declarations, shall the consumer be lead to establish the superiority of a product or service over another."

See Art. 36

Pursuant to the Law 1334, the Trademark Law establishes in its Title of Unfair Competition that "the **inadequate use** of a trademark" and "the use or widespread of indications or allegations susceptible of leading into error or causing confusion regarding the origin, manufacture, aptitude for the use or consumption or other characteristics of one's own or a third party's products" constitute acts of unfair competition.

See Art. 81 (h) (f)

If necessary, please differentiate between acquisition, maintenance and infringement of marks

Acquisition

It is not possible, according to the Trademark Law, to acquire rights over a trademark for the sake of using - non-registered - a trademark in Internet as metatag, linking and/or framing.

Maintenance

We understand that the use of a trademark in Internet - once it has been registered - could be of use for keeping the owner's rights over the trademark, especially in "linking" cases.

Infringement

The general rule foreseen by the Trademark Law is that the registration of a trademark grants the owner the "right of exclusive **use**" of the trademark and the right to oppose "to the **use** of any other sign that could lead to direct or indirect confusion or association between the products or services."

We understand that the use of a trademark in Internet - once it has been registered - could constitute an infringement of the owner's rights, particularly in the assumptions of Art. 84 (e,f,g)

As a matter of fact, the following constitute **infringements** to the rights of a registered trademark's owner:

- i) when a sign that is identical or similar to a trademark or trade name **is used in the market** for whatever products or services when such use "**could cause confusion**" or "**a risk of association to the owner's registration**".
- ii) when a sign that is identical or similar to a trademark or trade name **is used in the market** for whatever products or services, services or activities, when such action "**could cause the owner an unfair economic or commercial harm**" due to the di-

lution of the distinctive strength or the commercial or advertising value of the sign, or of an unfair advantage of the prestige of the sign or its owner's.

- iii) when a sign that is identical or similar to a trademark or trade name **is used for non-trading purposes**, when it could cause a dilution of the **distinctive strength or of the commercial or advertising value of the sign or an unfair advantage of its prestige**.

See Art. 84 (e) (f) (g)

- 5. **If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws)?**

The Trademark Law does not contain provisions that specifically establish or recognize that the use of a trademark is limited to the traditional indication of origin or identity. Therefore, the concept of the use "as a trademark" could also be expanded to the so-called "unconventional use".

We understand that the "unconventional use" could be objected based on the dispositions of the Trademark Law and based on the dispositions on Unfair Competition.

Trademark Law

The owner of a trademark has the "right of exclusive use of it" and to "execute before the competent authorities the corresponding actions and measures against those who infringe its rights".

The owner of a trademark has the right to oppose "to the use of any other sign that could lead to direct or indirect confusion or association between the products or services".

See Art. 15

Unfair Competition

According to the Trademark Law, "the inadequate use of a trademark" constitute unfair competition.

See Art. 81 (h)

- 6. **If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?**

The Trademark Law protects the owners of trademarks "notoriously known in the public's pertinent sector", by establishing the absolute prohibition for the registration of "signs that constitute a reproduction, imitation, translation, transliteration or transcription, total or partial" of said notoriously known trademarks, **"whatever products or services the sign is applied to"**, when its "use" and registration were susceptible of causing confusion or risk of association to a third party's or shall mean an exploitation of the notoriety of the sign or the dilution of its distinctive strength.

See Art. 2 (g)

Traduction française

- 1. **Y a-t-il une nécessité d'utiliser la marque "en tant que marque" dans les cas suivants:**
 - 1.1 *L'acquisition d'une marque (si, d'après la loi nationale, des droits peuvent être acquis par l'usage)*

Notre système est "attributif". "L'usage" de la marque, - sans enregistrement - ne donne aucun droit sur une marque. A partir de l'enregistrement de la marque le titulaire possède les droits sur une marque. (Art. 15)

1.2 *Le maintien d'un enregistrement de marque (c'est-à-dire contre une action en déchéance pour non-usage)*

La Loi de marques établit que sous demande, on procédera à l'annulation d'une marque:

- i) si le début de "l'usage" n'a pas eu lieu dans un délai de 5 ans immédiatement postérieurs à l'octroi de son enregistrement. (**La période de 5 ans, pour les marques octroyées sous la loi antérieure, à partir de la mise en vigueur de la nouvelle loi - art. 25 Décret.**)
- ii) lorsque son "usage" a été interrompu pour une période supérieure à 5 ans consécutifs.
- iii) lorsque son usage, dans le délai stipulé, a eu lieu avec des altérations importantes de son caractère distinctif original, constaté dans le certificat d'enregistrement pertinent.

Voir articles 27 (a) (b) (c)

1.3 *La condition pour qu'il y ait contrefaçon*

S'il fait allusion à l'usage d'une marque par son titulaire, la loi n'établit pas explicitement qu'il existe une condition d'usage d'une marque "comme marque" pour établir une infraction. Cependant, nous comprenons que dans un acte d'infraction contre un tiers transgresseur pour l'usage illicite d'une marque, le tiers transgresseur pourrait invoquer le non usage de la marque par le titulaire/propriétaire afin de refuser l'action.

S'il fait allusion à l'usage d'une marque par un tiers, **sont considérés comme une infraction** les cas suivants:

- i) lorsqu'on **fait usage dans le commerce** d'un signe identique ou similaire à la marque ou au nom commercial pour n'importe quel produit ou service lorsque cet usage **"peut provoquer une confusion" ou "un risque d'association avec le titulaire de l'enregistrement"**.
- ii) lorsqu'on **fait usage dans le commerce** d'un signe identique ou similaire à la marque ou au nom commercial pour n'importe quel produit, service ou activité, lorsque cette situation **"peut provoquer au titulaire un dommage économique ou commercial injuste"** à cause de la dilution de la force distinctive ou de la valeur commerciale ou publicitaire du signe, ou d'un profit injuste du prestige du signe ou de son titulaire.
- iii) Lorsqu'on **fait usage publiquement** d'un signe identique ou similaire à une marque ou au nom commercial, **même avec des finalités non commerciales**, lorsque cela **pourrait provoquer la dilution** de la force distinctive ou de la valeur commerciale ou publicitaire du signe ou **d'un profit injuste à son prestige**.

Voir art. 84 (e) (f) (g)

2. **Y a-t-il une différence dans l'évaluation de l'usage "en tant que marque" entre l'acquisition, le maintien et la contrefaçon des droits?**

Il n'existe pas de définition dans la loi pour ce qui constitue l'usage "comme une marque" dans le sens traditionnel (indication d'origine et fonction de l'identité).

Dans certains cas judiciaires on a affirmé que les marques accomplissent une fonction d'indication d'origine et d'identité.

Cependant, la Loi de Marques, établit, que la marque enregistrée se trouve "en usage" lorsque:

- i) les produits qui permettent sa distinction ont été mis dans le commerce, ou
- ii) les services qui permettent sa distinction se trouvent disponibles dans le marché avec cette dénomination, et
- iii) lorsque l'on réalise une publicité pour l'introduction des produits ou des services dans le commerce pour le marché (sous la condition que l'usage se réalise effectivement dans les 4 mois qui suivent le début de la campagne publicitaire).

Pour déterminer "l'usage" d'une marque enregistrée par rapport à sa mise en vigueur dans le commerce des produits ou la disponibilité dans le marché des services, on tiendra compte des points suivants:

- i) la quantité et le mode qui correspond par sa nature aux produits et aux services
- ii) la quantité et le mode qui correspond par les modalités de son commerce et
- iii) la dimension du marché.

Voir art. 29

Le Décret Réglementaire détermine que "**l'usage de la marque dans n'importe quel pays**" sera suffisant pour prouver l'usage d'une marque et comme défense auprès d'une action d'annulation comme conséquence du manque d'usage.

Voir 23 - Décret

3. Y a-t-il une différence dans l'évaluation de l'usage "en tant que marque" entre l'acquisition, le maintien et la contrefaçon des droits?

La définition de "l'usage" sous notre régime légal est très ample ce qui permettra que la cour décide dans chaque cas si l'usage en question réunit les conditions requises établies par notre Loi de Marques.

4. Est-ce que l'un des points suivants est considéré comme usage "en tant que marque"?

4.1 L'usage sur Internet, comme metatag, comme "linking" ou "framing"

Notre loi de Marques ne s'exprime pas à ce sujet.

D'après nous l'utilisation d'une marque en Internet comme (i) metatag – cas "playboy"; (ii) linking - cas ticketmaster ou (iii) framing - cas "total news" pourraient être considérés comme un usage de marques.

4.2 L'usage par des clubs de fans ou des supporters

4.3 Parodie

4.4 Publicité comparative

La Loi 1294 de Marques n'exprime rien concernant l'usage de la marque en publicité comparative.

La Loi 1334 de Défense du Consommateur et de l'Utilisateur, stipule que "la publicité comparative ne sera pas permise lorsque, à travers des actes frauduleux ou des déclarations générales et non discriminées on induit au consommateur à établir la supériorité d'un produit ou d'un service sur un autre".

Voir Art. 36

Concernant la loi 1334, la Loi de Marques dans son titre de la Concurrence Déloyale stipule que "**l'usage illicite** d'une marque" et "l'usage ou la propagation des indications ou des allégations susceptibles de provoquer une erreur ou une confusion par rapport à l'origine, la fabrication, l'aptitude pour son emploi ou sa consommation ou toute autre caractéristique des produits propres ou d'autrui" constituent des actes de concurrence déloyale.

Voir art. 81 (h) (f)

En cas de besoin, prière de distinguer entre acquisition, maintenance et infraction des marques.

Acquisition

Il n'est pas possible, selon la loi de Marques d'acquérir des droits sur une marque par son simple usage - sans enregistrement - d'une marque en Internet soit comme metatag, soit comme "linking" soit comme et/ou "framing".

Maintenance

Nous comprenons que l'usage d'une marque en Internet - déjà enregistrée - pourrait servir pour conserver les droits du titulaire sur la marque, particulièrement en cas de "linking".

Infraction

La règle générale prévue par la Loi de Marques c'est que l'enregistrement d'une marque concède au titulaire le "droit à son **usage** exclusif" de la marque et le droit de s'opposer "à l'usage de tout autre signe capable d'induire directe ou indirectement à une confusion ou à une association entre les produits et les services".

Nous comprenons que l'usage d'une marque en Internet - déjà enregistrée - peut constituer une infraction aux droits du titulaire, en particulier aux supposés de l'art. 84 (e,f,g.).

En effet, il constitue **une infraction** aux droits du titulaire d'une marque enregistrée les actes suivants:

- i) **utiliser dans le commerce** un signe identique ou similaire à la marque ou au nom commercial pour n'importe quels produits, services, lorsque leur usage "**peut provoquer une confusion**" ou "**un risque d'association avec le titulaire de l'enregistrement**".
- ii) **utiliser dans le commerce** un signe identique ou similaire à la marque ou au nom commercial pour n'importe quels produits, services ou activité, lorsque cela "**peut provoquer au titulaire un dommage économique ou commercial**" injuste à raison de la dilution de la force distinctive ou de la valeur commerciale ou publicitaire du signe, ou d'un profit injuste du prestige du signe du titulaire.
- iii) Utiliser publiquement un signe identique ou similaire à la marque ou au nom commercial, même **pour des finalités non commerciales**, lorsque cela peut provoquer la dilution de la **force distinctive ou de la valeur commerciales ou publicitaire du signe, ou d'un profit injuste de son prestige.**

Voir art.84 (e) (f) (g)

5. **Si, d'après le régime national du Groupe, l'usage comme marque est confié aux indications traditionnelles d'origine ou d'identification, des usages non conventionnels sont-ils néanmoins punissables de par la loi sur les marques ou d'autres lois (par exemple les lois sur la concurrence déloyale ou sur les pratiques du commerce).**

La Loi des Marques ne contient pas des provisions qui expriment ou reconnaissent que l'usage d'une marque est limité à la traditionnelle indication d'origine ou d'identité. En

conséquence, le concept d'usage "comme marque" peut aussi s'appliquer à ceux que l'on appelle "usages non conventionnels".

Nous comprenons que les "usages non conventionnels" peuvent être contestés sur la base des dispositions de la Loi des Marques et sur la base des dispositions concernant la Concurrence déloyale.

Loi de Marques

Le Titulaire d'une marque a le "droit à l'usage exclusif de la même" et "à exercer auprès des organes juridictionnels des actions et des mesures qui correspondent vis à vis de quelqu'un en cas de préjudice de ses droits".

Le Titulaire d'une marque a le droit de s'opposer "à l'usage de toute autre signe qui peut induire directe ou indirectement à une confusion ou à une association entre les produits ou les services", Voir Art. 15

Concurrence déloyale

Selon la Loi des Marques, il constitue un acte de concurrence déloyale "l'usage illicite d'une marque" Voir Art. 81 (h)

6. **Si l'usage "en tant que marque" dans le sens traditionnel est requis pour établir la contrefaçon, est-ce que les marques "de haute renommée", "célèbres", "notoires" ou "jouissant d'une réputation" utilisées sur des produits et services différent sont protégées?**

La loi des marques protège les titulaires des marques "notoirement connues au sein du secteur pertinent du public" puisqu'elle établit une interdiction absolue pour l'enregistrement des "signes qui constituent une reproduction, imitation, traduction, translittération ou transcription, totale ou partielle, de telles marques notoirement connues, **"quelque soit le produit ou le service auxquels on applique ce signe"**, lorsque son "usage" et son enregistrement sont susceptibles de provoquer une confusion ou un risque d'association avec un troisième ou signifient un profit de la notoriété du signe ou la dilution de sa force distinctive.

Report Q168

in the name of the Portuguese Group
by Ana FERREIRA SILVA

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 *Acquiring a mark (if rights may be acquired by use according to national law)*

The Portuguese legal regime establishes that the acquisition of property and exclusive rights on a mark only occurs by means of the respective registration, the earlier use as a condition of acquisition of such rights being not demanded.

The acquisition regime of rights on a mark, in force in Portugal, as an attributive registration of rights may be classified as a regime of "first to file" and not of "first to use", the cases of a mark notoriously known in Portugal as belonging to a national of any country of the Paris Union, the cases of marks, which enjoy of a great prestige, in Portugal or in the Community, and even the case of registration by an Agent or representative being obviously safeguarded.

The only case in which the law confers legal effect to the **use** is the use "as a mark" as a **free or non registered mark**, during a term not exceeding six months, situation in which the law confers the priority right to whom uses the mark, to apply for the registration in that term, and to oppose it to an application for registration filed by third parties, during that same term.

However, as in this case the law does not confer to the use an attributive property and exclusive rights effect, the protection conferred to this specific use, does not alter the character of the legal regime in force in Portugal, of attributive regime of rights by means of registration.

Another case in which the use occurs in the law regarding the acquisition of rights on a mark is the case of acquisition of distinctive character of the mark resulting from the commercial use of the same. However, in this case is not the right on the mark that is acquired as resulting from the use but the mark itself that acquires capability of being registered.

1.2 *Maintaining of a trade mark registration (e.g. against an application for cancellation on grounds of non-use)*

The Portuguese legislation establishes that as for effects of maintenance of the right on the mark, the serious use of the same must not be interrupted during five consecutive years.

By serious use it is understood the offer in fact of the goods or services identified by the mark, in the market, the law expressly establishing that it is considered serious use the exportation of goods and services and also the use of the mark, so that the same only differs from the way in which was registered, in elements that do not alter its distinctive character.

In this way, the Portuguese legislation, although does not establish the quantity of use necessary for the preservation and maintenance of the right on the mark, establishes as **nature**

of that use, that the same be **serious**, bearing in mind that this use has to be made regarding the goods or services.

1.3 *Establishing infringement*

The Portuguese legislation establishes some acts considered infringement in which it is supposed that the use of a mark is “as a mark” as in the following cases:

- use of counterfeited or imitated marks
- use of notorious or reputed marks
- use of other registered mark in its goods
- use of own registered mark in other goods capable of deceiving the consumer as far as the origin of the same goods is concerned.

Although the use of a mark “as a mark” is not expressly established as a requirement or assumption of infringement all the acts established by the law as sorts of infringements, and even the acts that the owner of the mark may prevent, have a form of use of a mark “as a mark”.

2. **Is there any definition of what is use "as a mark" either in statute or case law?**

The legislation does not expressly define what constitutes use of mark “as a mark”. However, there are some references that indicate what can be understood as such.

Thus, as far as the acquisition of rights on a mark is concerned the law establishes that “**the one, who adopts certain mark to distinguish the goods or services of an economic or professional activity** will enjoy of the property and exclusive of the same since the legal prescriptions, mainly the one regarding the registration, are accomplished.”

As far as the maintenance of the right is concerned the law refers “serious use”, reference of which has already been made herein.

As for the infringement, all cases established by the law indicate a use related to the classic distinctive function.

3. **Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?**

From what the law establishes, there are in principle no relevant differences in the assessment of use “as a mark”.

4. **Is any of the following considered to be use "as a mark"**

4.1 *Use on the Internet, as a metatag, in linking or framing*

Although there are no sufficient data to be considered as decided, since the use in the Internet shows the adoption of a mark as a distinctive sign regarding an offer of goods or services, such use may be understood as relevant for the purposes of acquisition, maintenance and infringement.

As for the use as a metatag, in linking or framing, we believe that if that use is connected to an activity with commercial purposes or of captation, it may well be considered relevant “as a mark” for the purposes of infringement.

4.2 *Use by fan clubs or supporters*

As far as the acquisition of distinctive character for the purposes of registration is concerned, we admit that this use may be accepted as illustrative that the mark is recognized “as a mark” acquiring the distinctive character or Secondary Meaning.

In general terms this use will not be considered for the purposes of maintenance, as it does not imply acts of real and effective offer of the goods or services identified by the mark.

As far as the infringement is concerned, the use by fan clubs or supporters may be prevented by the owner if that use were not recognized by the same and if it could jeopardize the image and reputation of the mark.

4.3 *Parody*

Although there are no data on the relevance of this use for the purposes of acquisition of rights and of maintenance we believe that it is not considered as relevant. For those purposes we are of the opinion that it may be considered as an act of unfair competition.

We believe that from this hypothesis are excluded the situations of “product placement” that has been understood by the modern marketing point of view as a new kind of advertising of a mark, though it can be understood as use of mark “as a mark”.

4.4 *Comparative advertising*

The comparative advertising is regulated by the legislation regarding the advertising being only admitted in very restrictive terms, as the cases of advertising that is not supported in essential, similar and objectively illustrative characteristics of the goods or services or which compare them with others non similar or unknown, are forbidden.

However, the use of a mark in this way may be understood as use of mark “as a mark” for the purposes of maintenance and infringement.

5. **If, under the Group’s national regime, use as a mark is confined to be traditional indications of the origin or identity, are unconventional uses nevertheless objectionable under mark or other laws, (e.g. unfair competition or trade practice laws).**

In the terms of the Portuguese legal regime the unconventional uses of a mark (as those of, besides the use as a mere indication of the origin or identity) are usually forbidden by the rules regarding the unfair competition.

6. **If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?**

The Portuguese legislation only confers protection to reputed marks for the purposes of infringement, if it is also used on goods or services different from the ones in which the mark became reputed.

In this sense, protection granted to these marks is not confined to the principle of speciality.

Final note

Once the laws of marks of the member states of the European Community are uniformized and as the traffic of international trade is even more global, it would be convenient a greater uniformization of concepts of use of a mark “as a mark” in such way that the new uses resulting from the advent of new technologies are contemplated, the relevance of the same at least for the purposes of maintenance and infringement being so defined as possible.

Report Q168

in the name of the Korean Group
by Ho-Hyun NAHM

**Use of a mark "as a mark" as a legal requirement in respect of acquisition,
maintenance and infringement of rights**

1. Is there any requirement for use of a mark "as a mark"?

1.1 Acquiring a mark (if rights may be acquired by use according to national law)

"Use of a mark" is not a prerequisite to trademark registrability under the Korean trademark laws. As an exception, however, a descriptive mark can become registrable when it is recognized as having obtained a secondary meaning among consumers as a result of consistent and exclusive use on the relevant goods or services (Paragraph 2, Article 6 of the Trademark Act). In the past, the Trademark Examination Standard (TES) of the Korean Industrial Property Office (KIPO) had required, for recognizing the secondary meaning, actual trademark use of more than three (3) years. However, it has lifted this requirement in light of the fact that a descriptive mark may be able to acquire secondary meaning in a relatively short period in the present era of immediate distribution of information through the Internet and mass media.

On the other hand, the Trademark Act and TES strictly require that the mark subject to registration based on secondary meaning must be restricted to a mark identical to that which obtained the secondary meaning in respect of the identical goods or services on which said mark was used.

1.2 Maintaining a trademark registration (e.g. against an application for cancellation on grounds of non-use)

A trademark registration is subject to cancellation by a cancellation action which can be brought by an interested party where the registered trademark, without justification, has remained unused for a continuous period of not less than three (3) years (Item 3, Paragraph 1, Article 73 of the Trademark Act). The use of a registered trademark by a licensee is regarded as use by the owner of the trademark.

Evidence of use must be proved by the owner of the trademark in a cancellation action. A registered mark is required to be used in the form as registered on goods or services as designated in the registration. In other words, neither the use of a similar mark on the goods specified in the trademark register nor the use of identical mark on similar goods constitutes a proper use for defending a non-use cancellation action. The scope of identity has been interpreted as being comparatively narrow. A partial cancellation action against certain designated goods is available. A nominal use or a token use of a trademark is not considered as constituting a proper use.

Where other pertinent laws, e.g., the Pharmaceutical Affairs Act, requires a registration or license thereunder in order to manufacture or sell the goods concerned, the use of a trademark without obtaining a valid registration or license to manufacture or sell the relevant goods does not constitute a proper use of the mark (89hu 1240 & 1257, July 10, 1990, the Supreme Court; 74 hu 16, January 28, 1975, the Supreme Court).

A commercial advertisement may constitute a proper use. There is a Supreme Court precedent, which recognized a commercial advertisement placed in a foreign magazine, which was duly distributed in Korea, as constituting a proper use (91 hu 356, December 13, 1991, Supreme Court).

The use by a contract manufacturer only for the purpose of exporting the pertinent goods (OEM) is also recognized as a trademark use in Korea for both the maintenance of a trademark registration and establishment of infringement (98 hu 959, April 24, 2001, Supreme Court; 93 do 3227, February 22, 1994, Supreme Court; 90 hangwon 1159, April 30, 1992, the Appellate Trial Board of KIPO).

1.3 *Establishing infringement*

The use of a mark identical with or similar to a registered mark in respect of the goods identical with or similar to those as specified in the pertinent trademark registration, without the authorization of the trademark owner, constitutes infringement of the trademark right.

The use of a registered mark on the part of the registrant is not a prerequisite to establishing infringement under the Trademark Act. According to court precedents, however, the petition for a preliminary injunction and/or the claim for damage compensation based on a registered trademark which has not been used is not accepted on the ground that i) there is no urgent need to grant a preliminary injunction; ii) such a legal action is considered as being abuse of trademark right; or iii) there is no actual damage incurred.

2. **Is there any definition of what is use "as a mark" either in statute or case law?**

Yes, there is definition of what is use "as a mark" under the Trademark Act. According to Item No. (vi), Paragraph (1), Article 2 of the Trademark Act, "use of a trademark" means any of the following acts:

- a) applying trademarks on goods or their packaging;
- b) selling or delivering goods or their packing on which trademarks have been applied or displaying exporting or importing such goods or their packaging for the purpose of selling or delivering;
- c) indicating the trademark on advertisements, price lists, business papers, signboards or labels or displaying or distributing them.

Acts of using a trademark on goods, packaging of goods, advertisements, signboards of labels as stipulated above include using goods, packaging of goods, advertisement, signboards or labels as shapes of marks (Paragraph (2), Article 2 of the Trademark Act).

3. **Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?**

There is no difference in the assessment of use "as a mark" in terms of definition of "use of a trademark" between the acquisition, maintenance and infringement of rights. However, the legitimate scope of use in terms of similarity of mark and goods varies depending on the purpose. The use for the acquisition (on the basis of secondary meaning) and the maintenance should relate to identical mark in respect of identical goods while even the use of a similar mark in respect of similar goods may constitute infringement of a trademark right.

4. **Is any of the following considered to be use "as a mark"**

4.1 *Use on the Internet, as a metatag, in linking or framing*

In general

To date, there has been neither explicit statutory law nor reported decision regarding claims by trademark owners against a third party's use of a trademark on the Internet as a metatag, in linking or framing.

A trademark as used in metatags serves to indicate the source of one's goods or services. As such, if a person were to use a trademark in metatags, which is identical with or similar to another person's trademark or service mark and sells or provides consumers with the same or similar goods or services, such conduct should constitute "use" of a trademark under the Trademark Act, and accordingly, would be subject to the rights and liabilities, as the case may be.

In a case where a person advertises certain goods by using a trademark in metatags, which is identical with or similar to a registered trademark owned by another person and the goods so advertised are identical with or similar to those of said registered trademark, there should be no reason to deny the finding of infringement in this case since advertisement itself constitutes a use of a trademark.

It may perhaps be argued that use of a metatag on the Internet is not an active communication of an advertisement to a customer since it can only be retrieved when a computer user enters the particular website. However, it should not be difficult to find that the elements for a trademark infringement have been satisfied in this case.

Conversely, it should be possible for the trademark owner to submit such use of a trademark on the Internet as an evidence of use in a cancellation action filed against said owner's trademark based on non-use if such use was made by the trademark owner or its licensee. As a matter of course, there should be some "commercial effect" from the use made in this manner.

Use of a mark in metatags

A metatag is a software parameter of the HTML code in which web pages are written. It is possible to view the metatags used in a site clicking on View, then clicking on Page Source. It is known that metatags have been improperly used around the world by listing the names of well-known businesses that are unrelated to the web site or the marks of direct competitor's goods or services. We are of the opinion that the use of another person's trademark in metatags to pass off one's goods or services as those of another; or to mislead consumers regarding the source of goods or services will constitute infringement as long as the goods/services concerned are considered as being similar to those of the pertinent trademark pursuant to the provisions of infringement of the Trademark Act.

Use of a mark in linking

Very recently (December 7, 2001), the Seoul District Court held in favor of a plaintiff in a damage compensation suit in the matter involving unauthorized linking to its homepage. The plaintiff "G" developed Geography Information Service ("GIS") and entered into a contract authorizing company "N" to operate the map searching service, which subsequently arranged for linking the "map searching corner" within the site of the defendant "S Telecommunication" without the authorization of the plaintiff "G." The plaintiff "G" sued the defendant "S Telecommunication" who linked to the home page of the plaintiff "G", claiming that the plaintiff sustained damages due to the defendant's unauthorized linking to the service of the electronic map service. The defendant asserted that only users utilized the map services in the linked site.

The court reasoned to the effect that the defendant neglected in its efforts to prevent copyright infringement. The court did not find persuasive the defendant's argument that "linking" is generally and customarily conducted for the convenience and efficiency in searching information on the Internet, stating that the defendant's "linking" impaired the defendant's ability to sell the products which it developed through substantial investment.

Although not a trademark case, this case is likely to extend the court's reasoning to apply to future trademark linking cases.

Use of a mark in framing

In a framing situation, a web page is split into parts, which contain the content from another site while the frame around it from the original site remains the same. If such an unauthor-

ized display of other sites involves the use of a trademark on the relevant goods /services, we are of the opinion that it will constitute an act of infringement under the Trademark Act for the same reasons as in the use of a trademark in metatags and linking as discussed above.

4.2 *Use by fan clubs or supporters*

To date, there has been no reported decision regarding claims by trademark owners against a use of one's trademark by fan clubs or supporters. When fan clubs or supporters use a trademark in relation to the goods/services of the trademark owner and/or its licensee, such a use will constitute a legitimate use. As such, the use in this fashion may be utilized as evidence of use when the trademark owner is seeking to acquire a trademark registration on the basis of the secondary meaning, for establishing the notoriety of the trademark, and for maintaining a trademark right.

Problems may arise when fan clubs or supporters use a trademark in relation to the goods/services outside the scope of that used by the trademark owner and/or its licensee. If the trademark owner has approved or authorized such use, then the consequence of the use of a trademark will be the same as discussed above. On the other hand, if the trademark owner has disapproved such use or remained silent, the use of a trademark by fan clubs or supporters will not constitute a proper use of the trademark for acquisition of a trademark or maintenance of a trademark right. It may even constitute an infringement of a trademark right.

4.3 *Parody*

We wish to understand the term "parody" in this report as referring to a "literary or artistic work that imitates the characteristic style of an author for comic effect or ridicule." To date, there has been no reported decision regarding claims by trademark owners against a parody of one's trademark.

The traditional infringement under the Trademark Act requires the existence of the element of "likelihood of confusion" in terms of similarity of marks as well as goods concerned. As such, in the event that the parody does not refer to any goods/services or it refers to irrelevant goods/services, there should be no finding of infringement.

If the parody is found as being confusingly similar to the trademark in respect of identical or similar goods, then the parody will constitute infringement. However, in cases of a successful parody, consumers are not likely to be confused or misled in that such a successful parody should inherently convey the distinction between the original and the parody.

On November 2, 2001, the Seoul District Court granted a preliminary injunction to a famous singer "Seo, Tae Ji", prohibiting the defendant from broadcasting or otherwise distributing a parody, which changed the lyrics and music of the singer's songs. The court reasoned that such a change of lyrics and music constituted infringement of the singer's copyright, specifically the copyright holder's right to maintain his identity over the copyrighted matter.

In another case, however, the Supreme Court upheld the Seoul High Court's decision, which held that a person's reputation was not damaged by a parody placed in a comic strip appearing on a daily newspaper (99 da 6203; July 28, 2000).

Again, although they are not trademark cases, they may be referenced to future trademark parody cases.

4.4 *Comparative advertising*

If a comparative advertising using an indication identical with or similar to another person's registered trademark in respect of similar goods/services is likely to mislead consumers on the quality of goods/services or to cause confusion on the source of goods/services among consumers, then such a comparative advertising will constitute infringement of trademark right by applying the traditional infringement principles of the Trademark Act.

On the other hand, even if a comparative advertising involved an indication identical with or similar to another person's registered trademark in respect of relevant goods/services, it would not constitute infringement of the trademark right if it provided correct information to consumers. More discussion on comparative advertising will be presented below.

4.5 *Our suggestion for harmonization in relation to use of trademarks in terms of territorial boundary*

We have court cases which recognize international exhaustion of trademark rights, as a result of which parallel import of genuine goods is permitted. This is in contrast with the position of the EU, which recognizes only European exhaustion, and not international exhaustion. Not recognizing international exhaustion may not conform to the recognized need to protect trademarks beyond one's own or regional territories, especially due to the emergence of the Internet. In other words, prohibiting parallel importation by applying only regional or European exhaustion while demanding protection of one's own trademarks beyond such territories do not appear to be consistent.

As such, the Korean group wishes to suggest that the harmonization should be directed toward applying one common principle in terms of territoriality to deal with both the grey market and the use of trademarks on the Internet. More specifically, if the EU desires the protection of trademarks beyond the regional territories, they should first reconsider their current position of not recognizing international exhaustion.

5. **If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trademark or other laws (e.g. unfair competition or trade practice laws)?**

Yes, they maybe objectionable under the Unfair Competition Prevention and Trade Secret Protection Act ("**UCPTSPA**"), the Monopoly Regulation and Fair Trade Act ("**MRFTA**"), or the Fair Indication · Advertisement Act ("**FIAA**").

1. **Under the Unfair Competition Prevention and Trade Secret Protection Act ("**UCPTSPA**")**

Because a mark as used in metatags, linking, framing or parody may serve to indicate the source of goods/services, if a person were to use a mark in such fashion in a website to engage in transactions for goods/services, which name is identical with or similar to a trademark/service mark widely recognized in Korea, said person would be subject to the liabilities under UCPTSPA (Article 2(1)(a) and (b)).

According to Article 2(1)(e), an act of "advertising or indicating ... which is likely to confuse as to the quality or content of the goods" is defined as an act of unfair competition, regardless of the well-known status of the indication used. As such, this provision may be utilized to regulate unfair or illicit use a mark in metatags, linking, framing or parody, irrespective of the well-known status of the trademark concerned. There are opinions as opposed to this position in that the indication of origin and metatag is not considered as being similar to each other in terms of concept.

The unfair competition act involving the use of a well-known mark had been determined based on the existence of likelihood of confusion. However, according to the Amendment to **UCPTSPA**, which took effect as of July 1, 2001, the following act is presently regarded as constituting an act of unfair competition, for which there are civil and criminal sanctions (Article 2(1)(c)).

"An act of damaging the distinctiveness or reputation of another person's indication, by using indications identical with or similar to another person's name, trade name, trademark, container or package of goods or any other indication indicating another person's goods or services which is widely recognized in Korea, or by selling, distributing, importing or ex-

porting the goods bearing such indications, without due cause as prescribed by the Presidential Decree for instance non-commercial use."

The Presidential Decree of the Unfair Competition Prevention and Trade Secret Protection Act enumerates the instances with respect to "due cause" as follows (Article 1-2 of the Presidential Decree):

1. non-commercial use,
2. use for news report and news commentary,
3. use without bad faith by a person (including his successor) who has used an indication identical with or similar to the pertinent indication such as another person's name · trade name · trade mark · container or package of goods or any other indication indicating another person's goods or services, or
4. where the use of a pertinent indication is recognized as not constituting an unfair trade practice.

In this regard, other acts of unfair competition require a person's intentional or negligent act in order for such person to be subject to civil or criminal liabilities. However, where the elements of unfair damages, confusion or similarity in goods/services are not involved, punishing a person for a negligent act was considered too severe. As a result, the Amendment contemplates the application of civil and criminal liabilities only against intentional acts which unfairly damages another person.

The provision relating to protection against "unfairly damaging" is expected to play an important role in combating unconventional uses of a domain name or a mark in metatag, linking or framing which injure the image, advertising and purchasing power of a well-known trademark, irrespective of the similarity of the relevant goods or services.

In view of the purpose of UCPTSPA, however, it is most likely that the domain name or a mark in metatag, linking or framing must be "used" in some form, as opposed to only maintaining its registration, in order for UCPTSPA to apply against such unconventional uses.

The prior cases dealing with conflicts between well-known trademarks and domain names, as decided by the lower courts, have recognized acts of unfair competition based on UCPTSPA and resulted in issuances of injunctions against the use of domain names as well as court orders for de-registration.

However, where the court did not find any likelihood of confusion, as measured by the scope and extent of use, no such remedy was granted. In this regard, as the Amendment to UCPTSPA took effect as of July 1, 2001, recognizing the "act of unfairly damaging" as being an act of unfair competition, the legal issues relating to the conflict between well-known trademarks and unconventional uses of a mark should enter a new and different era which require further attention and analysis.

2. Under the Fair Indication Advertisement Act (FIAA)-comparative advertising

In Korea, comparative advertising had been treated in terms of whether a particular advertising fell within the scope of unfair trade as stipulated in the "Types and Criteria of Unfair Trade Acts" (Regulation No. 90-7) based on the "Monopoly Regulation and Fair Trade Act." In this regard, fair and objective comparative advertising had not been subject to regulation under said laws.

As of July 1, 1999 the Fair Indication · Advertisement Act (FIAA) became effective and it prohibited unfair comparative advertising (indication · advertisement stating superiority or advantages of advertiser's own goods/services in comparison with those of another person without specifying object · criteria of comparison or without

objective ground (Article 3 of the FIAA; Item 3, Article 3 of the Enforcement Decree of the same Act).

The Examination Guidelines on the Comparative Indication · Advertisement took effect as of September 1, 2001 (Rule No. 52 of the Fair Trade Commission). Said Guidelines apply to anyone of the followings:

- i) comparative indication · advertisement which directly refers to another business entity, trade name · trademark · inherent name of goods · other symbols indicating goods/services of another business entity; and
- ii) comparative indication · advertisement using metaphoric expression, or similar pronunciation · symbol through which general consumers are likely to recognize another business entity or goods/services of another business entity.

According to the above Guidelines, comparative advertising, which is unlikely to deceive or mislead consumers, is not prohibited even if the comparison were made only based on objectives and criteria that were unilaterally advantageous to the advertiser.

Critical advertising even on the basis of correct facts is not allowed if it prominently highlights only the shortcomings of the goods of another business entity, and thereby leading consumers to understand that the goods of another business entity were far inferior or disadvantageous.

In the case IBM vs. COMPAQ of 1998, the Seoul District Court recognized the need for comparative advertising as it enabled consumers to obtain easy access to comparative materials and business entities so that consumers can be informed of the advantages of their own goods or services; on the other hand, however, the court reasoned that the expression "sinking of a certain company", as used in the advertisement, exceeded the legally allowable scope of comparative advertising.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious", "reputed" marks used on dissimilar goods and services protected?

Yes, they are protected although the scope of protection may vary depending on the extent of the well-known status of a particular mark. The act of unfair competition does not necessarily require the similarity of goods. A Supreme Court decision recognized the likelihood of confusion among consumers notwithstanding the absence of any economical dependent relationship between the respective goods of the marks, i.e., clothing vs. alcoholic beverages (HENNESSY case; 88 Hu 226, October 10, 1990, Supreme Court). However, in most cases, the Supreme Court has held the position that there should be an economical dependent relationship between the respective goods of the marks in question in order to recognize the likelihood of confusion, although "similarity" in its legal sense is not strictly required.

According to the UCPTSPA, an act of causing confusion with another person's goods by using any indication identical with or similar to another person's name, trade name, trademark, container or package of goods or any other mark which is widely known in Korea, or by selling, distributing, importing or exporting the goods with such marks constitutes an act of unfair competition which is subject to civil and criminal sanctions.

First, the indication used must be widely known "in Korea". Therefore, a trademark, which is not widely known among consumers in Korea even though it is well-known overseas, cannot be protected under the UCPTSPA.

Secondly, the subject matter protected under the UCPTSPA not only includes trademarks, but any containers, packages, etc. which serves as an indicator of the source of one's goods. As such, in addition to such traditional subject matters as containers, etc., the external appearance of a good or service, also known as "trade dress", a relatively recent controversial issue, may also receive protection under the UCPTSPA.

Report Q168

in the name of the Romanian Group
by Lucian ENESCU, Cristian NASTASE, Daniel PLOSCA

**Use of a mark "as a mark" as a legal requirement in respect of acquisition,
maintenance and infringement of rights**

Enclosed please find the Romanian Group answers based on the Romanian IP laws:

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 *Acquiring a mark*

According to Romanian Trade Mark Law, it is necessary to obtain the registration in order to acquire rights in relation to the mark. However there are special cases when the registration could be obtained through the use of the mark. A mark which is lacking a distinctive character or is made up exclusively of signs or indications which have become customary in the current language or consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services are usually not registered. These provisions shall not apply if, prior to the date of the application for registration of a mark and by reason of its use, the mark has acquired a distinctive character.

1.2 *Maintaining a trade mark registration*

The Romanian Trade Mark Law stipulates in article 45 paragraph a) that any interested person may require the cancellation of a registered trade mark if, within a continuous period of five years, the mark has not been put to genuine use on the territory of Romania in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use. The Romanian Trade Mark Office does not require a declaration of use, evidence of use in order to maintain a registration or to obtain a renewal.

1.3 *Establishing infringement*

The owner of the mark may request the competent judicial body to prohibit any person not having his consent from using in the course of trade:

- a) any sign which is identical with the mark in relation to goods or services which are identical with those for which the mark is registered;
- b) any sign where, because of its identity with or similarity to the mark or the identity or similarity of the goods or services on which the sign is affixed with the goods or services for which the mark is registered, there exists a likelihood of confusion on the part of the public, including the likelihood of association between the sign and the mark;
- c) any sign which is identical with or similar to the mark in relation to goods or services which are not similar to those for which the mark is registered, where the latter has a reputation in Romania and where use of that sign without due cause could take unfair advantage of the distinctive character or the repute of the mark or where such use would cause prejudice to the owner of the mark.

The owner of the mark may request that any other person be prohibited, under the above paragraph, from performing, in particular, the following acts:

- a) affixing the sign to goods or to their packaging;
- b) offering the goods, putting them on the market or stocking them for such purposes under that sign, or offering or supplying services thereunder;
- c) importing or exporting the goods under that sign;
- d) using the sign on business papers and in advertising.

2. Is there any definition of what is use "as a mark" either in statute or case law?

The following shall be considered effective use of a mark:

- a) Use of the mark by another person with the consent of the owner;
- b) Use of the mark in a form that differs in certain respects from that of the registered mark, but which does not impair its distinctive character;
- c) Affixing of the mark on goods or their packaging exclusively for the purposes of export;
- d) Impossibility of using the mark due to circumstances beyond the control of the owner of the mark, for example restrictions on import or other provisions by public authorities in respect of the goods or services to which the mark applies.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

All the cases require the use of mark in order to acquire a mark, to maintain the registration or to establish the infringement.

4. Is any of the following considered to be use "as a mark"

According to Romanian Trade Mark Law the evidence of trade mark use may be furnished by any proof means. Since there are no very specific legal provisions regarding this matter and the Trade Mark Law allows proving the evidence of use by any means, we consider the judge could accept these uses in certain circumstances. However it is up to the Judge to consider or not these utilization as trade mark use.

4.1 Use on the Internet as a metatag, in linking or framing

The use of a mark on Internet (doesn't matter if it use as a domain name, a metatag etc.) is always a problem. There are no legal provisions in the Romanian Laws regarding this matter. As we mention above it is up to the judge to decide in this matter.

4.2 Use by fan clubs or supporters

Yes. We think it might be consider it as use as a mark. For example when a mark is advertised in magazines or in other publications belonging to fan clubs and they have the consent of the owner it could be consider as use of the mark. Advertisements in newspapers are considered as evidence of use in order to acquire a mark or maintaining the registration. It is also possible to be considered as an infringement where there is no consent of the owner.

4.3 Parody

There are no legal provisions regarding the parodies. We believe the main issue is that the parody not to create confusion in relation to the original trade mark and its owner. In case there is confusion between the original and the parody we consider that we have an in-

fringement case. Since there are no legal provisions regarding the parody of a trade mark, the judge will decide upon this matter.

4.4 *Comparative advertising*

Referring to comparative advertising there are special rules regarding this matter. For example if there is a risk of confusion between the firm which makes the advertising and the competitor, or between the marks, commercial names or other distinctive signs, goods or services which belong to the firm which makes the advertising and those belongs to the competitor, the comparative advertising is forbidden. In this case the comparative advertising could be considered as a basis for establishing the infringement. If the comparative advertising fulfils the requirements of the Romanian Advertising Law, we believe it will be considered as "use as a mark", since the legal provisions concerning the evidence of use are very broad.

5. **If use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws?**

The trade mark law has no legal provisions regarding the unconventional use. Taking into consideration the provisions of the Advertising Law the comparative advertising is forbidden under certain circumstances, so it is objectionable under this law (please see the answer 4.4). As concerns the parodies, the Copyright Law or other law does not provide special provisions regarding the parody of trade marks.

6. **If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?**

As we mentioned in our response to the question 1.3 the trade mark law requires the use to establish the infringement in this case too.

The owner of the mark may request the competent judicial body to prohibit any person not having his consent from using in the course of trade any sign which is identical with or similar to the mark in relation to goods or services which are not similar to those for which the mark is registered, where the latter has a reputation in Romania and where use of that sign without due cause could take unfair advantage of the distinctive character or the repute of the mark or where such use would cause prejudice to the owner of the mark.

Summary

According to Romanian Trade Mark Law the trade mark use is required to maintain the registration. The RPTO does not require to file declaration or evidence of use in order to maintain a registered mark. A registered mark could be cancelled only if a third party file a cancellation action to the Court.

Under certain circumstances the trademark registration could be obtained through the use of mark. The use of the mark is not required as a condition for filing an application. Generally to infringe a mark, the infringer must use a similar or identical mark in the course of trade. The Romanian Trade Mark Law provides what is considered as effective use of the mark. The trade mark law has no legal provisions regarding the unconventional use. The Advertising Law provides that the comparative advertising is forbidden under certain circumstances, so it is objectionable under this law.

Report Q168

in the name of the Singapore National Group

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 *Acquiring a mark (if rights may be acquired by use according to national law);*

Yes.

Refer to s 5(2) Trade Marks Act 1998 ("TMA 98")

The application shall state that the trade mark is being used in the course of trade, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.

Refer to s 7(2) TMA 98

A trade mark shall not be refused registration by virtue of subsection (1) (b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

Note: s 7(1) (a) to (d) states the absolute grounds for refusal of registration and these are:

- a) signs which do not satisfy the definition of a trade mark in section 2(1);
- b) trade marks which are devoid of any distinctive character;
- c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering or services, or other characteristics of goods or services;
- d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

1.2 *Maintaining of a trade mark registration (e.g. against an application for cancellation on grounds of non-use)*

Yes.

Refer to s 22 TMA 98

S 22(1)

The registration of a trade mark may be revoked on any of the following grounds:

- a) that, within the period of 5 years following the date of completion of the registration procedure, it has not been put to genuine use in the course of trade in Singapore, by

the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

- b) that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use;
- c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for the product or service for which it is registered;
- d) that, in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

S 22(2)

For the purposes of subsection (1), use of a trade mark includes use in the form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in Singapore includes applying the trade mark to goods or to materials for the labelling or packaging of goods in Singapore solely for export purposes.

1.3 *Establishing infringement*

Acts amounting to infringement of registered trade mark.

S 27 TMA 98

A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, he uses in the course of trade a sign where because:

- a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or
- b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public.

A person infringes a registered trade mark which well known in Singapore if:

- a) without the consent of the proprietor of the trade mark, he uses in the course of trade a sign which is identical with or similar to the trade mark, in relation to goods or services which are not similar to those for which the trade mark is registered;
- b) the use of the trade mark in relation to those goods or services would indicate a connection between goods or services and the proprietor and would be likely to cause confusion to the public;
- c) there exists a likelihood of confusion on the part of the public because of such use; and
- d) the interests of the proprietor are likely to be damaged by such use.

A person uses a sign if he

- a) applies it to goods or the packaging thereof; or

- b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplier under the sign; or
- c) imports or exports goods under the sign; or
- d) uses the sign on an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document; or
- e) uses the sign in advertising.

2. Is there any definition of what is use "as a mark" either in statue or case law?

There is a definition section for use of a sign for purposes of infringement of trade marks. Refer to s 27(4).

A person uses a sign if he

- a) applies it to goods or the packaging thereof; or
- b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplier under the sign; or
- c) imports or exports goods under the sign; or
- d) uses the sign on an invoice, wine list, catalogue, business letter, business paper, price list or other commercial document; or
- e) uses the sign in advertising.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

Under the TMA 98, there is no apparent difference in the assessment of use "as a mark" in the three instances.

4. Is any of the following considered to be use "as a mark"?

4.1 Use on the Internet, as a metatag, in linking or framing

In general, there is no legal provision for this type of trade mark use in Singapore. Therefore, it is likely that in any court case on such an issue, the court would follow international trade mark practices. In our view, all the instances of use apply within the context of what was identified above:

- The use of the trade mark in the context of a linking or a metatag, or as part of a web frame, the trade mark owner will apply his trade mark to identify his business (so, use in relation to goods or services for which the trade mark is registered). Therefore, indeed, the use can be considered as legally relevant use to acquire and/or maintain the validity of a trade mark right.
- As to whether unauthorised use in this context constitutes trade mark infringement, has not been decided in Singapore case law yet. Likely, courts will follow international practice. It has been determined in various cases especially in the United States, that linking as such does not qualify as infringing trade mark use, nor does a metatag or framing. This may not be surprising, as all these features are very much essential to the functioning of the Internet. The situation will be different only, when there is question of additional circumstances whereby there is a misleading factor of using somebody else's trade mark as part of a metatag or link to, for example, attract business to a website, or to defame the products or the trade mark owner. Same applies to framing, in particular if such is done to give the impression that the consent of somebody else's website belongs to another website, or that there is

question of giving the impression of some other type of relationship with another firm whereas this in reality does not exist.

4.2 *Use by fan clubs or supporters*

There is no statutory law or case law available to cover this situation in Singapore. In general, any of the three use perspectives will apply to this situation.

- As to whether a trade mark right can be acquired by this type of use, or whether use qualifies to actually maintain existing trade mark rights, a formal link between the trade mark owner and the third party concerned is relevant. For the trade mark owner, in order to benefit from the use by this third party, a licence under s.42 TMA 98 needs to be made. A mere consent given to fan clubs or supporters to use the trade mark will not be sufficient: there should be a formal contract, whereby apart from general requirements under contract law, the trade mark owner is able to exercise effective quality control on the products. For a licence, it is required that the registered trade mark rights of the owner comprises the use by these third parties. For example, use of the trade mark on merchandise articles will not be supportive for acquiring or maintaining trade mark rights in relation to (other) products actually marketed by the trade mark owner and covered in his trade mark registration.
- When the trade mark owner did not authorise the use by fan clubs or supporters, an infringement could be established in two ways:
 - 1) When there is question of use in the course of trade, under s. 27 (2) a TMA 98 in the case of the trade mark being identical and used for identical or similar goods covered. This may be the case when the club or supporters are actually marketing products provided with the trade mark;
 - 2) When there is no question of use in the course of trade (think of use on posters, banners, et cetera that will not be marketed), the situation is a bit more complicated. Here, s. 27 (6) TMA 98 applies, saying: "Nothing in subsections (1) to (5) shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee, but any such use otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trade mark *if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.*" (pm: italics added) So, in that case the basis for the trade mark owner to take action is quite narrow.

4.3 *Parody*

There is no statutory law or case law available to cover this situation in Singapore. This situation should be considered only in the context of infringing trade mark use, as use for acquiring/maintaining a trade mark right rather refers to use by or with permission of the trade mark owner himself, not by thirds. Parody will likely not occur in the course of trade. In that case, trade mark infringement can be construed under the already mentioned s. 27 (6) TMA 98.

4.4 *Comparative advertising*

There is no statutory law or case law available to cover this situation in Singapore specifically. Narrowly defined exceptions allowing competitive advertising as apply in for example Europe, do not exist. The situation therefore may be captured also under s. 27 TMA 98 on trade mark infringement, in particular when the sign is identical to the trade mark and used in relation to products identical to those for which the trade mark is registered. Contrary to the use in a parody-sense as referred to above, comparative advertising definitely is use practised in the course of trade, although not in order to distinguish goods of the party concerned, but rather to *refer* to goods marketed by the trade mark owner. Nevertheless, in this

situation the use certainly would be "in relation to" goods identical to those of the trade mark owner and therefore qualify as trade mark infringement under s. 27 (1) TMA 98.

5. If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g unfair competition or trade practice laws)?

Unfair competition or trade practice laws are not well developed here in Singapore. There are no relevant statutes enacted by the Singapore parliament in this area and thus far, there are also no cases on point.

The law of passing off may be relevant with regard to unconventional uses of trade marks.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

Yes. Refer to s 8 (3).

A trade mark which is identical with or similar to an earlier trade mark and is to registered for goods or services which are not similar to those for which the earlier trade mark is protected, shall not be registered if

- a) the earlier trade mark is well known in Singapore;
- b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered would indicate a connection between those goods or services and the proprietor of the earlier trade mark;
- c) there exists a likelihood of confusion on the part of the public because of such use; and
- d) the interests of the proprietor of the earlier trade mark are likely to be damaged by such use.

Report Q168

in the name of the South African Group
by Mariëtte VILJOEN and Gérard DU PLESSIS

**Use of a mark "as a mark" as a legal requirement in respect of acquisition,
maintenance and infringement of rights**

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 Acquiring a mark (if rights may be acquired by use according to national law)

Statutory Rights

Before addressing the above question it is important to provide the definition for a "mark" in terms of South African Trade Mark Law.

The Trade Marks Act 194 of 1993 ("the Act") defines "mark" in section 2(1)(x) as "any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned".

A "trade mark" is defined as meaning "... a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person".

From the definition of a "trade mark", it is clear that the intention to use is required, but the nature of such use becomes apparent from the wording of section 10(4) of the Act:

"a mark in relation to which the applicant for registration has no *bona fide* intention of using it as a trade mark, either himself or through any person permitted or to be permitted by him to use the mark as contemplated by section 38;"

Common Law Rights

Common law rights may be acquired through use of a mark as a trade mark, i.e. a person/company may acquire rights in a mark by using it and building a reputation in the mark. It is submitted that in order to acquire the necessary reputation and common law rights, there has to be *use as a trade mark*, rather than descriptive use.

1.2 Maintaining of a trade mark registration (e.g. against an application for cancellation on grounds of non-use)

The non-use provisions of the Act (sections 27(1)(a) and (b)) do not refer to use "as a mark". However, a trade mark registration may be cancelled or attacked where the proprietor had no *bona fide* intention of using a mark "as a trade mark" (refer to section 10(4) mentioned in paragraph 1.1 above).

1.3 Establishing infringement

There is no reference to use "as a mark" in any of the infringement sections. Accordingly, use of a mark "as a mark" and use of a mark "otherwise than as a mark" will both constitute infringement, unless such use falls within the ambit of one of the exceptions set forth section 34(2) of the Act.

2. Is there any definition of what is use "as a mark" either in statute or case law?

The distinction between use "*as a mark*" and "*use otherwise than as a trade mark*" was only of relevance under the previous Trade Marks Act of 1963, as the infringement provisions applied to different types of use.

For the interpretation of "*use as a trade mark*", reference has to be had to the definition of a trade mark in section 2(1) of the Act (see section mentioned in paragraph 1.1 above), which means use for the purpose of distinguishing the goods or services from the same kind of goods or services connected in the course of trade with any other person. The use of a mark purely for purposes of describing the goods to which it is applied is not use as a trade mark. (See *Webster and Page, South African Law of Trade Marks, Fourth Edition*, page 4-9, par 4.4)

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

There is a difference in the assessment of use "*as a mark*" between the acquisition, maintenance and infringement of rights. With regard to acquisition and maintenance, the requirement is that there must be *bona fide use of a mark "as a mark"*, whereas for infringement purposes there is no such distinction.

4. Is any of the following considered to be use "as a mark"?

4.1 Use on the Internet, as a metatag, in linking or framing

There is no reported case law in South Africa on use of a trade mark "*as a mark*" on the Internet, whether as a metatag, in *linking* or *framing*.

However, if such use on the Internet in general complies with the various requirements as set out above, such use will be considered to be use "*as a mark*". Accordingly, use of a mark as a metatag is unlikely to satisfy the requirements for the acquisition or maintenance of a trade mark by a proprietor, but may well amount to trade mark infringement. Due to the technical purpose and operation of "*linking*" and "*framing*", use "*as a mark*" will not be relevant for purposes of the acquisition and maintenance of a trade mark. (For purposes for this discussion we assume that "*linking*" and "*framing*" is limited to unauthorised conduct of a third party.) As far as infringement is concerned the position is somewhat more complex. In the event of a link or frame to a non-genuine site, for example that of a competitor of the proprietor of the trade mark that is used, such use is likely to amount to infringement.

Based on the assumption that the link is to the site of the true trade mark proprietor, it will probably not amount to infringement. Where framing takes place and the trade mark of the true proprietor is not displayed on the "*framed*" page, use of the trade mark "*as a mark*" and infringement will not be relevant. It will, however, depend on the extent of the content and whether a trade mark is used.

4.2 Use by fan clubs or supporters

Due to business considerations, trade mark proprietors are normally reluctant to take any action in these instances. However, assuming that the proprietor would like to take action, the requirements of infringement will still have to be met, in particular the proprietor will have to prove that use of the trade mark by the fan club or supporters is use "*in the course of trade*". Whether that is the case, will depend on the facts.

4.3 Parody

If the parody makes unauthorised use of the trade mark and complies with the other requirements of infringement it may amount to infringement. The mere fact that such use is in the form of a parody, is not a defence.

4.4 Comparative advertising

There are different views held in South Africa. According to one view, if in comparative advertising the advertiser is using the mark, it will constitute infringement. This view is supported by our courts. According to *Webster & Page* (supra), comparative advertising is not limited to the use of the identical trade mark, as imaginative advertisers will often rely on a play of words or an innuendo in comparative advertising. This would therefore also constitute use "*as a mark*". Comparative advertising is also regulated and is prohibited by the South African Advertising Standards Authority Code.

A dissenting view has been published by *Wheeldon* (September 1996 *De Rebus* 585 and September 2000 *De Rebus* 20).

5. **If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws).**

Unconventional uses could be objectionable under South African trade mark law. As mentioned above, the current Act does not, for purposes of infringement, distinguish between "*use of a mark*" and "*use otherwise than as a mark*".

6. **If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?**

As mentioned in the answer to question 5 above, the Act does not distinguish between "*use as a mark*" and "*use otherwise than as a mark*", when infringement is determined. In any event, the Act does afford protection to "*well-known*" marks even if the infringing use is in relation to dissimilar goods and services. Section 34(1)(c) of the Trade Marks Act states that the unauthorised use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered will amount to infringement, if such a trade mark is well-known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception. This is the South African "*dilution*" provision.

Report Q168

in the name of the Spanish Group
by Juan CASULÁ OLIVER (Chairman), Isidro-José GARCÍA EGEA,
Salvador SÁNCHEZ QUILES, Jordi ROMANÍ LLUCH,
Elia SUGRAÑES COCA, Cristina GOICOECHEA MARGALEF
and Antonio CASTÁN PÉREZ-GÓMEZ

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 *Acquiring a mark (if rights may be acquired by use according to national law)?*

In Spain, Trade Marks Act 32/1988 in force for the time being provides that rights in and to a mark may be solely and exclusively acquired by registration.

This general principle is relaxed under Trade Marks Act articles 3.2 and 77 pursuant to which, in keeping with articles 6 Bis and 8 of the Paris Union Convention for the protection of Industrial Property of 20th March 1883 (hereinafter "Paris Convention"), the user of a *well-known mark or trade name* -even without a certificate of registration- is entitled to claim the invalidity of a subsequent trade mark or trade name registration. Accordingly, that well-known use must be a use "as a mark" (or as the case may be as a "trade name") and be intended for "*the relevant sectors*" of the Spanish market.

This law is nevertheless to be amended shortly by the Trade Marks Bill, which is currently being debated by Parliament based on the text published by the Congress Gazette on 3rd July 2001 (hereinafter "Bill"). The new statutory framework will confer on the unregistered user of a well-known mark an "ius prohibendi" almost equivalent to that of a registered trade mark, establishing that it must be "*well known in Spain within the meaning of article 6 Bis of the Paris Convention*". The territorial scope in which the earlier well-known use of the mark must be established is not a quiet issue in Spanish case law, for a twofold interpretation may be made, as the Supreme Court emphasised in a Judgment dated 9th April 1992 (in re CAMELO): a) it has traditionally been deemed necessary to establish that the mark is well known in the relevant sectors of the Spanish market throughout the country and not merely in certain geographical areas; and b) there is increasing support for the stand that it is sufficient for the mark to be well known in the country in which it is registered, as the Supreme Court upheld in regard to unregistered trade names in the case of CASADEI.

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.2 *Maintaining a trade mark registration (e.g. against an application for cancellation on grounds of non-use)?*

Under the current legal regime, which the Bill does not change, maintenance of a trade mark registration is clearly dependent on its being put to a "*genuine and effective use in connection with the goods or services in respect of which it was registered*". Consequently, use of a trade mark "as a mark" is a sine qua non for it to be maintained, for only if the trade mark is visibly and continuously present in the market sector for which it was registered will it be able to fulfil the function and purpose for which the proprietor was conferred the exclusive rights.

Moreover, both the laws now in force and the law that is about to be enacted endorse the need for a use “as a mark” since the following are expressly laid down as grounds for revocation of the trade mark registration:

- a) If, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name for a product or service in respect of which it is registered.
- b) If, in consequence of the use made of it by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

Thus it follows that use “as a mark” is prescribed as a requirement for maintaining its registration, under penalty of either the Office (*Spanish Patent and Trade Mark Office*) or any third party with a lawful interest taking action for the court to declare its revocation because it already functions as an indication of origin or source.

1.3 *Establishing infringement?*

Under article 31.1, the Act entitles the “*proprietor of a registered trade mark*” to bring civil and criminal actions against third parties “*using an identical or similar mark or sign in the course of trade to distinguish identical or similar goods or services*” without his consent, whenever a comparison as to their name, device and/or application “*is liable to mislead*”. Accordingly, the trade mark rights may only be infringed at present by whoever uses the trade mark “as a mark”, albeit distorting its distinctive function and purpose because the true origin or source of the goods or services to which it is applied is not identified.

As for the Bill, the “*ius prohibendi*” conferred on the proprietor of a registered trade mark entitles the proprietor to prevent third parties from “*using a sign that is identical or similar to the trade mark in the course of trade for ... goods or services*” without his consent. We take it that in deleting the expression “*to distinguish*” in referring to an unlawful third-party use “as a mark”, along with the replacement of the likelihood of “*misleading*” with the broader literature covered by “*the likelihood of confusion*” (including therein the “*likelihood of association*”), the *likelihood of indicating a “connection” between the goods or services of the third party and the proprietor of the trade mark*, and in general the *intention of taking “an unfair advantage of the distinctive character or the reputation of the trade mark” or “being detrimental to the same*”, would have us conclude that our future Act generously regulates the “*ius prohibendi*” in order to guarantee use of the trade mark “as a mark”:

- a) As an indication of “origin”, in the sense of identifying the origin or source of the goods or services to which it is applied;
- b) As an indication of “identity”, since it informs as to the common quality of the goods or services to which it is applied with others that are already known to the consumer public; and
- c) As an indication of goodwill, extending the consumer’s trust to other goods or services for which the trade mark was not originally registered or used (particularly in the case of well-known or reputed trade marks; their expansive commercial and advertising action evolving towards new business -e.g. merchandising, patronage, sponsorship, ...- gradually dilutes the principle of trade mark speciality).

At the same time, the Bill -under innovative article 34.3.d)- includes among the registered proprietor’s “*ius prohibendi*” the use of his trade mark “*as a domain name*”. It seems that the Lawmaker rather avoids the expression use “as a mark” because a domain name proper does not seek to distinguish goods or services, but is a location element or a virtual business sign for consciously or unconsciously “directing” the consumer to goods or services not distinguished by the sign but competing with those to which the proprietor applies the registered trade mark. Accordingly, upon the entry into force of the new Act, using the trade mark “as a domain name” shall be an **infringement**, although the legal regime shall be

equivalent to use “as a mark” because they have a common purpose to avoid unfair advantage from being taken or detriment from being caused.

2. Is there any definition of what is “use as a mark” either in statute or case law?

A mark arises when a connection is established in the consumer’s mind between the sign and the product or service distinguished by that sign, serving as an indication of “origin” and “identity”. Thus, article 1 of the Trade Marks Act in force for the time being defines a mark as “*any sign or means distinguishing or capable of distinguishing in the market the goods or services of one person from the identical or similar goods or services of another person*”.

These elementary and traditional functions attached to trade mark rights were compiled by an emblematic Supreme Court judgment entered on 30th October 1986, which was unanimously praised by the leading authority, which had it that “*in relation to Trade Mark Law, it should appropriately be borne in mind that trade marks protect not only the private interests of the proprietor who registered the marks, but also the general interests of consumers, who are the true addressees and presumed beneficiaries of the functions discharged by a trade mark in regard to **origin, indication of qualities, advertising and reputation** among the consumer public of the goods distinguished precisely by the trade mark*”, concluding that it is precisely that “functional” character that determines that a registered trade mark needs must be put to use.

Those legal principles have been shared not only by countless judgments entered by lower and provincial appellate courts, but also -standing as consolidated case law- by Supreme Court judgments entered on 18th December 1992, 16th December 1997, 1st March and 2nd December 1999, and 22nd January 2000, which time and again echo the Directive “*for illustrative and supplementary purposes*”.

In this setting, the Trade Marks Act in force for the time being provides for a twofold aspect of legal powers vested in the proprietor of the registered trade mark, to wit:

- a) Positive effectiveness under art. 30, in the sense that “*registration of the trade mark confers on its proprietor an **exclusive right to use it in the course of trade***”; he may therefore “*designate with the trade mark the relevant goods or services, put on the market, duly identified therewith, the goods or services in respect of which registration was granted and use the trade mark for advertising purposes*”.
- b) Negative effectiveness under art. 30.1, because “*the proprietor of the registered trade mark may exercise the -civil or criminal- actions -for which provision is made in the Act- against third parties using an identical or similar **mark or sign** in the course of trade and without his consent to distinguish identical or similar goods or services, where the similarity of the **signs** and the similarity of the goods and services is likely to mislead*”.

The underlining is ours, bearing in mind that the general term “*sign*” goes beyond the conception of the distinctive sign par excellence -the trade mark- to provide legal cover for such other business creations as **company names** (case law since the “case of DOMESTOS” in 1985), **domain names** (art. 34.3.d of the Bill), **titles of published works, advertising creations** or “**means for identifying or decorating the product or service**” (art. 34.3.f del Bill, in relation to characteristic aesthetic or functional designs **not registered** as *label marks, container marks, industrial designs or drawings*), among other realities in an extremely dynamic market with the lawmaking process always lagging behind. In the words of Unfair Competition Act 3/91, this is the repertoire of “*renderings and business enterprises*” which may be freely copied, “*unless they are covered by an exclusive right vested by law*” such as a trade mark.

In short, the current Spanish Act largely leaves it up to case law to fashion the signs that may be used “as a mark”, and indeed what the concept of use “as a mark” actually means.

In this sense, the first draft of the Bill introduces a new concept of trade mark, which is generally defined under article 4.1 as “*any sign capable of being represented graphically, serving to **distinguish in the market the goods or services** of one undertaking from those of other undertakings*”. The future Act uses a more generic definition, including *domain names or identification or decora-*

tion means as appropriate instruments for operating in the course of trade in a manner equivalent to use “as a mark”.

In conclusion, the Bill recognises that other signs that are not a trade mark proper may fulfil its same functions of indicating the business origin of goods or services, or expressing their quality, condensing their good reputation, and operating as advertising means.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

A trade mark is **acquired** only by obtaining a registration certificate.

Only indirectly so, the power vested by law for the unregistered user of well-known marks to request the cancellation of a registered trade mark allows him to subsequently obtain his own registration certificate, for concurrently on bringing an invalidity action he must apply for registration, the application being stayed until the invalidity judgment is final. Whereas the current Act requires that use “as a mark” should be well known *in Spain to the relevant sectors*, the Bill delimits the concept of being well known to the circumstances determined on a case-by-case basis by *turnover, duration, intensity or geographical scope of use, credit or reputation achieved*.

As for **maintenance** of the trade mark, both the current and the future Act require that its use “as a mark” be “*genuine and effective*”, whereas it shall be for case law to define in each case what an appropriate use consists of. If the ground for revocation affects only part of the goods or services in respect of which the trade mark is registered, the revocation declared will be limited to the goods or services at issue.

In this regard, it is only noteworthy that the Bill eliminates the statement of use that is currently required for the trade mark registration to be renewed.

Now, in connection with the incidence of the use “as a mark” in **trade mark infringement** actions, any **actual or potential** use by third parties in the course of trade without the proprietor’s consent may be prevented by law. Both statutory texts subject of this report make provision for such acts as *offering, putting on the market and stocking for these purposes* among uses that are actionable by the proprietor of the trade mark, as coming under its natural scope in the course of trade.

At the same time, a growing trend in case law - particularly represented by Supreme Court judgments dated 5th April 1994 and 2nd December 1999 - makes legal actions by the “*proprietor of a registered trade mark*” conditional on the mark being put to a genuine and effective use “as a mark”, in order to be able to prevent such a use “as a mark” by third parties without the proprietor’s consent. In such cases, it is held that there can be no likelihood of any error or confusion “*until and unless there is a competitive set of similar goods put on the market by both parties which are identical in the trade mark mentioned*”, actually denying that the proprietor of a registered trade mark that is not used “as a mark” has a lawful interest.

In this line, the Bill provides that the defendant -in trade mark infringement (and even invalidity) proceedings- may demand that the registered proprietor prove that during the five years preceding the action “*the trade mark was put to a genuine and effective use in connection with the goods or services in respect of which it is registered and on which the action is based, or that proper reasons exist for non-use*”, specifying in that regard that the trade mark shall be deemed to be registered only for the goods or services for which it was actually used.

4. Is any of the following considered to be use "as a mark"?

4.1 Use on the Internet, as a metatag, in linking, or framing

The Trade Marks Act in force for the time being includes no such forms of use in the “*ius prohibendi*” in which the proprietor of the registered trade mark is vested.

The Bill however expressly declares that use of a domain name is equivalent to use “as a mark”. In any event, in accordance with the Trade Marks Act in force for the time being, use

of a sign on the Internet could also be assimilated to use “as a mark” (such cases as “OZÚ” and “NOCILLA”, among others, decided by the lower courts) if trade is directly affected.

In principle, use as a metatag, in linking, or framing would not be considered use of the trade mark because they are merely informative tools which may not be attributed any effect in the course of trade.

If METATAGS are a key word included in the HTML code of a website designed for search systems and Internet navigators to categorise the contents of a site, they cannot be considered to be use “as a mark” because they do not identify goods or services, they are not visible to the user, and their purpose is not commercial but informative.

As for LINKS, taken to be digital routes linking separate websites without establishing a connection between the specific goods or services, they have no trade effect either.

Finally, FRAMING is a specific manner of linking websites allowing web pages to be imported from one site to another in use in such a way that the host site surrounding the imported pages will typically contain advertising, but this is not a use “as a mark” either because this is unrelated to specific goods or services.

In ruling out the eligibility of those means -FRAMING, METATAGS and LINKING- for use “as a mark”, document SCT/6/7 (as worded on 30th March 2001) prepared by the WIPO through its Electronic Forum is no doubt enlightening where it lists the main factors to weigh up when use of a sign on the Internet will have a “*commercial effect*” or not, linked to the “*intention to deliver the goods or provide the services offered to customers*”.

In our view, the use of FRAMING, METATAGS and LINKING may be the subject of restrictions or prohibition in due course if it is established that there is an undue likelihood of association with a registered trade mark, which in the end entails taking unfair advantage of its reputation in the market.

4.2 *Use by fan clubs or supporters*

Fan clubs or supporters may use the name of an artist “as a mark” if that name is used and promoted for specific purposes, because this is one of the means of identifying a certain fashion and/or music. Now, therefore, any use by the fan club liable to be detrimental to or take advantage of the credit of a natural or legal person recognised by the public may come under the events of prohibition laid down in both the Trade Marks Act in force for the time being and the Bill.

It is not in vain that the Bill specifically prohibits the registration of “*names, surnames, pen names or any other sign identifying a person other than the applicant for the general public*” as marks. Many court cases, noteworthy among which are Supreme Court Judgments dated 18th February 1999 (in re “ANTOÑITA MORALES”) and 22nd January 2000 (in re “EL CORDOBÉS”)- have already enhanced the recognisable protection of stage names liable to be used “as a mark”, with the ensuing compensations for economic and moral damages.

4.3 *Parody*

Parodies, taken to be humorous imitations, do not stand as a use of the trade mark under statute law in force for the time being, because this does not mislead as to the origin of the product or service, nor do they have an effect in the course of trade.

However, under Act 3/91 “*any conduct that is objectively contrary to the requirements of good faith*” is unfair. A parody could conceivably be deemed to be unfair competition, particularly if it entails a likelihood of confusion with the original work or is liable to be detrimental to that work or the author, in which case the Copyright Act in force for the time being considers that a parody is an unlawful transformation of the original work, to the detriment of the economic and moral rights attaching to copyright.

4.4 *Is use of a mark in cases of comparative advertising considered use "as a mark"? If necessary, please differentiate between acquisition, maintenance and infringement of marks*

Naturally, advertising is one of the paradigmatic uses of a mark "as a mark", and is legally relevant: a) for the purposes of maintaining the trade mark rights, since it contributes to its being put to a genuine and effective use; and b) for trade mark infringement purposes, since the law allows any third-party advertising to be prevented from using another's mark without his consent.

In turn, by combining Directive 97/55/EC of 6th October with the AIPPI report on Question Q140 "Unfair competition - Comparative advertising", comparative advertising may be defined as advertising in which a trader compares his supply with that of another or other competitors, clearly identifying the same, with the direct or indirect result of highlighting the advantages of his own over the others' goods. Reference to a competitor's goods may be explicit -for instance to the trade mark- or implicit, particularly using pictures of those competitive goods.

In this setting, the quintessence of comparative advertising lies in comparing goods or services -often identified through their respective trade marks, indicating different business origins and qualities- with an informative purpose that **cannot in our view be considered to be use "as a mark"**. Exceptionally, only when it is unlawful -particularly because it is deceptive or denigratory- may comparative advertising be considered to entail an unlawful use "as a mark" which the proprietor of the registered trade mark may prevent, using the actions in which the proprietor is vested under Unfair Competition Act 3/91 and/or General Advertising Act 34/88. By definition -beyond the likelihood of error, confusion or association prohibited by law- the purpose of comparative advertising is to differentiate.

In conclusion, use of a third-party trade mark in advertising without the third-party's consent shall not be a violation of his exclusive rights, provided that the comparison between the goods or services identified by the third-party's trade mark and those identified by the advertiser's own, takes place within the limits set by advertising and unfair competition laws. This possibility is an exception to the absolute power of disposal vested in the trade mark proprietor and is explained by the prevalence of consumers' interests beyond the private interests of the owner of the sign.

5. **If, under the Group's national regime, use as a mark is confined to traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws)?**

Article 30 of the Trade Marks Act in force for the time being provides an exclusive right to use the trade mark in the course of trade, i.e. to use it to identify the goods or services for which registration was granted and use it for advertising purposes.

Noteworthy among the "unconventional uses" listed in the Trade Marks Act proper is the event in which *"third parties use the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts, provided that such a use takes place in accordance with honest practices in industrial or commercial matters"*. These events, in which another's trade mark may lawfully be used without the proprietor's consent, have been exceptionally and restrictively fashioned by our Supreme Court from the case of CEMSA and by the Court of Justice of the European Communities from the case of BMW, where the informative aspect underlying trade mark law as a whole was paramount.

Furthermore, Unfair Competition Act 3/91 prohibits the following types of acts, inter alia, which might result from the use of trade marks:

- Acts of confusion (article 6). Any conduct that is liable to cause confusion with another's activity, renderings or establishment shall be prohibited, and it is established that the likelihood of association on the part of consumers as to the source of the rendering shall suffice as grounds for a practice to be deemed to be unfair.

- Misleading acts (article 7). The use or dissemination of incorrect or false indications, and any other practice whatsoever that may be liable, in the circumstances in which it takes place, to mislead those for whom they are intended or whom they reach as to the nature, manner of distribution, specifications, and quality of the products is prohibited.
- Denigratory acts (article 9). The making or dissemination of statements regarding the activity, renderings, establishment or commercial relations of another that are liable to bring discredit in the market are prohibited, unless they are accurate, true and appropriate.
- Acts of comparison (article 10). The public comparison of one's own or another's activity, renderings or establishment with those of a third party is prohibited where the comparison refers to particulars that are neither similar, nor relevant or verifiable. In other words, comparative advertising is regulated.
- Acts of imitation (article 11). Imitation is prohibited where exclusive rights exist, such as trade marks for instance, and at all events where it is liable to generate an association on the part of consumers as to the rendering or takes unfair advantage of another's reputation or effort.

For its part, General Advertising Act 34/1988 also contains rules limiting the use of trade marks, particularly in cases of misleading and unfair advertising:

- It is established that advertising is misleading where it deceives its targets, and may be or is capable of being detrimental to a competitor, and in determining this its indications concerning -inter alia- the existence of industrial property rights are taken into account.
- Advertising is deemed to be unfair where it causes confusion with *"the undertakings, activities, goods, names, trade marks or other distinctive signs of competitors, and where it makes unwarranted use of the name, acronym, trade marks or distinctive marks of other undertakings or institutions"*.

In short, the same unlawful uses of a mark are -cumulatively or alternately- objectionable under the Trade Marks Act, the Advertising Act or the more far-reaching Unfair Competition Act.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

We should firstly point out that distinguishing between those categories is not a quiet issue, for in practice they overlap one another. In accordance with the traditional concept of Paris Convention article 6 Bis, *well-known marks* are unregistered signs that have come to be well known by the public in the relevant sectors. However, this concept is usually applied without distinction to registered and unregistered marks, provided they are widely disseminated among consumers. Thus, *famous or notorious marks* are marks whose dissemination among the public extends beyond the sectors in which they are used, and finally *reputed marks* are marks that have come to have a lasting reputation among consumers due to a recognised quality of the goods or services distinguished.

We should bear in mind that, nowadays, knowledge or dissemination to a significant extent is not always tantamount of a special quality of renderings. It is sometimes the case that intensive advertising campaigns for a product can yield a *well-known mark* within a short space of time, without necessarily having shown a quality so justifying (NIKE) and, conversely, other products have permeated the market over time, generating *famous marks* (BAYER, COCA COLA) or *reputed marks* (CHANEL), based on their larger or smaller circle of loyal consumers.

The Trade Marks Act in force for the time being accords the proprietors of *well-known unregistered marks* limited protection, since they are allowed to request the invalidity of a subsequent registration that is likely to be confused with their own mark. That prerogative, which does not include the possibility of opposing the registration of the trade mark in the office, or bringing the appropriate

civil actions to avoid an improper use, is governed by the standards of the traditional speciality principle.

Insofar as *reputed marks* are concerned, art. 13.c) of the current Act provides that signs or means that take unfair advantage of the reputation of other previously registered signs or means cannot be registered as a mark. No reference is made here to the need for the new sign to be applied to identical or similar goods or services, nor even related to those distinguished by the reputed mark. This is therefore the protection for what authority (as opposed to the Act) has designated a *trade mark with a reputation*, whose proprietor is accorded to power to oppose in the office; the effects of such a mark can extend beyond the speciality principle.

Nevertheless, both civil and contentious-administrative case law is reluctant to apply this rule beyond the goods or services claimed by the well-known mark.

Indeed, the current Act imposes the speciality principle on any trade mark proprietor, irrespective of the extent to which the mark is well known, and provided that it is a registered trade mark, in fashioning its “*ius prohibendi*” against uses of the trade mark “as a mark” by third parties acting without the proprietor’s consent.

The scarce protection of a trade mark with a reputation under the current Act has been made up for in practice resorting to the Unfair Competition laws, particularly the prohibitions regarding confusion (art. 6) and the taking of unfair and avoidable advantage of another’s reputation (art. 12).

The Bill takes a substantially different approach, and the Preamble already stresses that for the first time our laws establish a statutory definition of the concept of a well-known mark, fixing the scope of protection therefor.

As for well-known unregistered marks, their proprietor is authorised not only to bring the appropriate invalidity action, but indeed to file an opposition to registration in the office, subject to the speciality principle.

The major novelty is however related to well-known registered marks, for the same may be relied upon to prevent in the office the registration as a mark of a subsequent sign “*although it is filed for goods or services dissimilar to those protected by the earlier well-known mark*”. To do so, it is a requirement for the mark to be well known in Spain and for the use of the subsequent mark **to be liable indicate a connection between the goods or services** covered by that mark and the proprietor of the well-known mark. That use may also be prevented if it may, without just cause, **result in unfair advantage being taken or be detrimental to the distinctive or well-known character** of the earlier mark, i.e. that its reputation may be affected.

Now then, in defining a *well-known mark*, the Bill distinguishes between a mark that is *generally known to the relevant sector of the public* targeted by the goods or services distinguished thereby, and a mark that has come to be *known to the general public*:

- a) In the first case (qualifying as *well-known marks*), the protection accorded shall extend to goods, services or activities whose nature shall be more different the greater the extent to which the trade mark is known in the relevant sector of the public or in other related sectors;
- b) In the second case listed above (assimilable to *marks with a reputation*), the scope of protection shall extend to any kind of goods, services or activities, thereby absolutely overcoming the speciality principle.

It is finally noteworthy that the Bill boosts the “*ius prohibendi*” of the proprietors of well-known registered marks because they may prevent third-party uses “as a mark”, even for goods or services unlike those for which the trade mark is registered. The extension to goods further or distinct from those that are protected will depend on the extent to which the trade mark is well-known, and it will in any event be required that use of the sign without just cause may either result in a connection between the goods or services, or seek to take unfair advantage of the distinctive or well-known character of the trade mark, or indeed be detrimental to them.

Well-known unregistered marks are however put on a level with all other trade marks (that are not well known), to the extent that their proprietors may now enforce the “ius prohibendi”, bringing the appropriate civil actions for which provision is made in the law, albeit in no event beyond the limits of the speciality principle.

Report Q168

In the name of the Swedish Group
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**Use of a mark "as a mark" as legal requirement in respect of acquisition,
maintenance and infringement of rights**

1. Is there any requirement for use of a mark "as a mark" for the following purposes?

1.1 *Acquiring a mark (if rights may be acquired by use according to national law)*

Under the Swedish Trade Marks Act (1960:644) an exclusive right to a sign can be acquired either by registration at the Patent and Registration Office or by use. The protection afforded is equal, irrespective of means of acquisition, with the exception that while registered trade marks are valid for the whole territory of Sweden, trade mark rights acquired by use are limited to the area where the trade mark right is established.

A trade mark right by use is established on the market when a sign is known as an indication of source by a significant part of the public concerned by the products or services which it covers ("secondary meaning"), sec. 2(2). This can also be the effect of international marketing, whereby the Swedish public has got a knowledge about the trade mark to such an extent that it is known also in that country. The unregistered trade mark is protected where it has been established and for as long as this secondary meaning remains.

By the provision on trade mark rights acquired by use, Sweden has traditionally also fulfilled its obligation to protect well known marks under article 6*bis* of the Paris Convention (1883).

The provisions on trade mark protection by use did play a more important role before the implementation of Directive 89/104/EC on the approximation of trade mark laws in the Member States on January 1 1993, when the object of registration under the Swedish Act was limited to: words, designs, letters, numerals and the individual shape of goods or their packaging. Today, when everything that can be graphically represented, if distinctive, is also registrable there are not so many items that would be dependent on protection by use, except possibly smells. *Cf.*, however, OHIM R 156/98-2 ("The smell of fresh cut grass").

1.2 *Maintaining of a trade mark registration (e.g. against an application for cancellation on grounds of non-use)*

Being a Member of the European Union Sweden has implemented the Directive 89/104/EC, including *article 10* under *sec. 25, 25(a)* and *25(b)*. The effect is invalidation on claim of a counterpart if a registered trade mark has not, within a period of five years following the date of completion of the registration procedure, been put to genuine use in connection with the goods or services in respect of which it has been registered, or if such use has been suspended during an uninterrupted period of five years, unless there are proper reasons for non-use. If the trade mark has been used only in connection with one or some of the goods or services it has been registered for, it can be invalidated partially, *sec. 25(b)*.

Some cases concerning genuine use can be referred to:

SPOTLIGHTSERIEN, NJA (Supreme Court Reports) 2001 p. 265: Use of only a part of a registered mark and not in the same typography as the registered logo did not constitute trade mark use.

BIG MAC, NJA 1991 p. 619: Use of BIG MAC (in two words) satisfied the use requirement for the registration of BIGMAC (in one word).

AGRIVET, NJA 1983 p. 875: Use of a registered trade mark, as the dominant feature of a trade name did not satisfy the use requirement.

Following from the answer to 1.1. trade mark rights acquired by use remain also when the sign is no longer used in the course of trade, as long as it is established and has secondary meaning on the market. It will therefore also be an obstacle to the registration of an identical or similar mark for identical or similar goods, or in the case of a reputation also for marks that could be detrimental to or take unfair advantage of its reputation.

1.3 *Establishing infringement*

Use of a registered mark is not a prerequisite for starting infringement proceedings, or to have success with such litigation. But it seems logic that a trade mark, which has not been used, will enjoy just a narrow protection. This logic has, however, so far not been expressed in case law.

It is also obvious that the more established a trademark has become and the more original the trade mark is as such, the greater is its scope of protection, *se inter alia* from the European Court of Justice cases C-39/97 of 29 September 1998 (Canon) and C-342/97 of 22 June 1999 (Lloyd) referring to the statement 10 of the preamble of Directive 89/104/EC.

As an unregistered right is to be respected as long as the mark is established on the market, no use is required for infringement proceedings in that case either.

With regard to an alleged infringer, he must have used an identical or similar sign in the course of trade. Also a citation of the trade mark is an infringing use, for example "liqueur type Benedictine".

It could also be noted that protection is not only afforded for identical or similar marks on identical or similar goods, but protection extends to dissimilar goods or services, where a mark has a reputation and its use by another could be detrimental to or take unfair advantage of the older mark, *sec. 6(1) compared to sec. 6(2) of the Trade Marks Act* in accordance with *articles 4(4)(a) and 5.2 of the Directive 89/104/EC*.

2. **Is there any definition of what is use "as a mark" either in statute or case law?**

The exclusive right is afforded for trade marks as a special sign in the course of trade, *sec. 1(1) and 2(2) and 4*. In addition *sec. 4* contains a non-exhaustive enumeration of confusingly similar trademark uses: "on the goods, or its packaging, in advertising or on business documents or in other ways, including oral use".

Some cases can be referred to in this respect:

PAYLESS, Case No. T 979/95 Svea Court of Appeal judgement of 6 May 1996. A successful non-use attack was launched by Payless Shoe Source Inc. against the trade mark PAYLESS registered for footwear, clothing and headgear. PAYLESS was used on price tags and labels attached to footwear of sales stock twice a year. The mark appeared on the price tag written PAY LESS in two words where also the ordinary price and the sale price was noted. It was held that the trade mark had not been used in a trade mark sense but merely as an indicator of reduced prices "pay less" and the registration was consequently cancelled.

VOLVO-TUNING, Case No. T 202-00 Stenungsund District Court judgement of 17 January 2001. Volvo Personvagnar AB brought a successful claim of trade mark infringement against SCT Scandinavians Car Tuning AB's use of the domain name www.volvo-tuning.com. The court regarded the domain name as a use of the trade mark VOLVO. Since SCT Scandinavians Car Tuning AB did not have a license for such use the domain name was infringing the trademark VOLVO.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

By the trade mark application for a sign which is of somewhat doubtful distinctiveness the Patent- and Registration Office, which presently makes a pre-examination, will be satisfied by the proof of use of such sign as a trade mark. No secondary meaning has to be shown. But if the sought sign is of a more descriptive or semi-descriptive character, or its registrability could be doubted with regard to third parties' rights to use a word or a symbol, full proof of secondary meaning has to be established.

BABY DRY, Patents Appeals Court case 96-589. In Sweden the application for PAMPERS BABY-DRY as a trade mark for diapers was denied registration on opposition by SCA Hygiene Products AB. It was found merely descriptive. There was a need for access to the combination "baby dry" also for others. Very high figures showing the establishment of "Pampers Baby-Dry" only proved that the trade mark PAMPERS is well known on the Swedish market, claimed SCA. Cf. The European Court of Justice in Case C-383/99 P of September 20, 2001.

To prevent the cancellation of a trade mark the owner has to prove that he has put the mark to *genuine* use. The prerequisite *genuine* use is of particular relevance in cancellation proceedings and is not an issue in the acquisition of trade marks or infringement proceedings. The requirement is not fulfilled by the mere advertising of the goods or services in question, if not within a reasonable period of time it is followed by actual offering of the goods to the market, cf. NJA 1987 p. 22 (BUDWEISER/BUDVAR).

By an alleged infringement there can be a counterclaim that the trade mark has not been genuinely used over the five passed years. Furthermore, the extent of use will, according to above mentioned case law of European Court of Justice influence the scope of protection; a strongly established mark will have a greater scope of protection and cover a broader range of activities, or deviations from what the trade mark in question was registered for.

4. Is any of the following considered to be use "as a mark"?

4.1 Use on the Internet, as a metatag, in linking or framing

The Swedish Group does not see any difference in the appreciation of use of trade marks in electronic media to in any other medium.

Use on Internet of a trade mark in the course of trade is definitely a trade mark use, similar to any other use.

Whether the use of metatags is to be regarded as a trade mark use is still for the courts to decide. There exists no case law to the matter.

Use in linking or framing could well be a trade mark use, but case law is lacking. In legal literature it has been strongly argued that the use of an image of a trademark highlighting a link to another site should be considered use "as a mark". As a consequence, linking involving logos or figurative marks could possibly constitute "use as a mark". The situation has, however, as always in trade mark law, to be appreciated with account taken to all relevant factors involved.

Finally it could be mentioned that in the view of the Swedish Group the mere registration of a domain name (without use or offering for sale) does not constitute an infringement in trade mark rights to the identical or similar sign, or a trade name infringement.

4.2 *Use by fan clubs or supporters*

If the trade mark is used in the course of trade, for instance on items sold, where these on the market will be appreciated as having a connection with the trade marked establishment, or its goods or services, the activities should be regarded as trade mark use. Unauthorised such use should be regarded as infringement

4.3 *Parodies*

In trade mark law there is no traditional exception, as exists in many jurisdictions including the Swedish Copyright Law, with regard to parodies etc. As the whole idea with a parodical use is that the object of mockery should be recognised, only well known trade marks come in to question for such use. The use of another's trade mark even with a parodical touch or intent will therefore *prima facie* be regarded as an infringement, if the (parodical) use is made in the course of trade. And in a commercial context a parodical use is no defence, neither within nor outside the scope of identical or similar goods.

In the latter case the extended protection for reputed trade marks will afford protection against the detrimental use of a reputed mark also outside similar goods. Within the same or similar goods, the association to a confusingly similar mark will be precluded. But it is obvious that the mere association with another's mark does not in itself constitute a criterion for trade mark infringement, *cf.* European Court of Justice Case C-251/95 (Sabel v. Puma). Within the framework for same or similar goods it has to be confusing similarity; outside the similarity of goods the use has to take an unfair advantage of or be detrimental to the repute of the trade mark.

A Swedish decision that comes close to the problems discussed here is the following:

TULOSBA/ABSOLUT: The application for registration of TULOSBA ADKOV for mineral waters etc. The Patent Appeals Court on 23 April 1999 (case 97-065, 97-641) denied registration on the ground that that the requested mark would take unfair advantage of the reputed ABSOLUT VODKA. It could, however, be discussed whether this situation is covered by the text of articles 5(1)(b)-5(2) of Directive 89/104/EC.

Cf. also FRISKIS & SVETTIS, NJA 1992 p. 633, which was decided before the implementation of the Directive 89/104/EC. "Friskis & Svettis" ("Healthy & Sweaty") was a well-established mark for fitness centres. The use of "Skakis & Bakis" (Shaky & Hang-over)" was, notwithstanding the association, not found similar enough to constitute an infringement under the at the time available extended protection for highly renowned trade marks.

4.4 *Comparative advertising*

Comparative advertising, including referring to another's trade mark or trade name, is since long well seen in Sweden as a good means of consumer information. Special correctness is, however, called for by such use, and strict requirements are put on the comparison. If in a comparison use is made of another's trade mark and it does not meet the standards or criteria for relevance and correctness, the comparison is a trade mark infringement or will be deemed as unfair competition according to the Act on Marketing Practices (1995:450), where the Directive on Comparative Advertising 97/55/EC has been implemented in sec. 8 a.

5. -----

6. **If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?**

As mentioned under 1.3 and 4.3 above, protection is not only afforded for identical or similar marks on identical or similar goods, but protection extends to dissimilar goods or services, where a mark has a reputation and its use by another could be detrimental to or take unfair advantage of the older mark in accordance with *articles 4(4)(a) and 5.2* of the Directive 89/104/EC. It could be mentioned that the original Swedish implementation did not take full account of the wording of these articles and the scope of protection could be doubtful, as the law still required confusion. But this misunderstanding is now being rectified by a trade mark reform (see *SOU (Swedish Official Committee Reports) 2001:26*).

Proposals for harmonisation:

- Definition of "descriptive" marks.
- In infringement proceedings: Attitudes to and balancing of common words that are parts of a trade mark, but still have to be free for use by others in their presentation of goods or services, cf. "keeps the baby dry".

Observations of interest:

- a) Under Swedish Law there is no remedy against the use of a trade mark outside the course of trade. This is also true when the use of the mark of another is (wilfully) detrimental to the trade mark, for instance posters with a picture of a graveyard and the headline "Marlboro Country". The Constitutional provision on freedom to speak and publish exceeds commercial interests.
- b) New needs for service mark registrations of retailers' or distributors' are in conflict with traditional views on registration in classes and use requirements.
- c) The need for protection against detrimental or sponging use of a well known mark *within* the area of identical or similar goods, where there is no confusion, seems not to be expressly covered by the European directive, cf. TULOSBA/ABSOLUT above.
- d) As descriptive words to an increasing extent are registrable as trade marks under EC Law (cf. BABY DRY), the borderline between a legitimate and illegitimate use of another's trade mark as a (necessary) description of the goods or services might cause new problems.

Summary

Under the Swedish Trade Marks Act (1960:644) an exclusive right to a sign can be acquired either by registration or by (established) use. Trade mark protection extends to dissimilar goods or services, where a mark has a reputation and its use by another could be detrimental to or takes unfair advantage of the older mark.

The Swedish Group does not see any difference in the appreciation of use of trade marks in electronic media to in any other medium.

The use of another's trade mark even with a parodical touch or intent will *prima facie* be regarded as an infringement, if made in the course of trade.

Comparative advertising, including referring to another's trade mark or trade name, is since long well seen in Sweden as a good means of consumer information.

The treatment of descriptive trade marks ought to be further discussed.

Résumé

Suivant la loi suédoise sur les marques de fabriques, commerces et services (1990:644) un droit exclusif d'un signe peut être acquis soit par enregistrement, soit par usage (prouvé). La protection des marques s'étend aux produits et services dissemblables, quand le signe a un renommé et son usage par l'autrui pourrait être au détriment du signe antérieur ou quand il abusivement profit duquel signe.

Le groupe suédois ne voit pas une différence dans l'évaluation de l'usage des marques dans les médias électroniques en comparaison à n'importe quel autre médium.

L'Usage d'une marque d'autrui, de même avec une touche ou intention de parodie aura été vu prima facie comme une contrefaçon, s'il se passe dans le commerce.

En Suède la publicité comparative, comprenant la référence au signe ou nom d'autrui, est depuis longtemps regardé avec bienveillance comme un bon moyen d'information aux consommateurs.

Le traitement des marques descriptives aurait dû être discuté de plus.

Zusammenfassung

Gemäss schwedischem Warenzeichengesetz (1960:644) kann exklusives Recht zum Kennzeichen durch Registrierung oder eingeübten Gebrauch erworben werden.

Warenzeichenschutz kann auf unähnliche Waren und Dienstleistungen ausgedehnt werden, falls der Warenzeichenschutz über ein eingearbeitetes Ansehen verfügt und dessen Gebrauch durch Andere schädlich wäre oder zu unlauteren Vorteilen gegenüber dem alten Warenzeichen führen würde.

Die schwedische Gruppe sieht keinen Unterschied in der Bewertung der Anwendung des Warenzeichenschutzes in elektronischen oder anderen Medien.

Der unbefugte Warenzeichengebrauch wird auch wenn in parodischer Weise oder mit Absicht, prima facie als Verletzung angesehen, wenn im Handelsverkehr ausgeführt.

Vergleichende Reklame, inklusive der Hinweis auf ein anderes Warenzeichen oder Name ist von jeher in Schweden akzeptiert und wird als gutes Mittel der Verbraucherfreundliche Information angesehen.

Der Gebrauch von beschreibenden Warenzeichen muss weiterhin diskutiert werden.

Switzerland

Suisse

Schweiz

Bericht Q168

im Namen der Schweizergruppe
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Benützung einer Marke "als Marke" als rechtliche Voraussetzung bezüglich Erwerb, Aufrechterhaltung und Verletzung der Rechte

1. Gibt es ein Erfordernis, das die Benützung einer "Marke" verlangt

1.1 Um eine Marke zu erwerben (falls Rechte durch Benützung gemäss dem nationalen Recht erworben werden können)?

Das Markenrecht entsteht grundsätzlich mit der Eintragung im Register unabhängig von einer allfälligen Benützung der Marke (Art. 5 MSchG).

Es gibt jedoch subjektive Rechte nach dem Markenschutzgesetz, deren Voraussetzungen zumindest eng mit einer Benützung der Marke zusammenhängen:

- Der Inhaber einer Marke, welche in der Schweiz nicht eingetragen, jedoch notorisch bekannt ist im Sinne von Artikel 6^{bis} der Pariser Verbandsübereinkunft vom 20. März 1883 zum Schutz des gewerblichen Eigentums (PVÜ), hat das Recht, sich gegebenenfalls der jüngeren Registrierung einer Drittmarke in der Schweiz zu widersetzen. Artikel 6^{bis} PVÜ ist im Lichte von Art. 16 Abs. 2 des Abkommens über handelsbezogene Aspekte der Rechte an geistigem Eigentum vom 15. April 1994 (TRIPS) auszulegen. Um Notorietät gemäss Artikel 6^{bis} PVÜ zu erlangen, ist indessen nach der in der Schweiz wohl herrschenden Anschauung zwar nicht zwingend eine Markenbenützung in der Schweiz erforderlich, jedoch mindestens ein erhöhtes Markenbewusstsein der Abnehmerkreise. Notorietät wird dabei ohne mindestens im Ausland erfolgte Benützungshandlungen praktisch kaum zu erreichen sein.
- Die Benützung einer Marke auf einer offiziellen oder offiziell anerkannten Ausstellung im Sinne des Übereinkommens vom 22. November 1928 über die internationalen Ausstellungen in einem Mitgliedstaat der PVÜ verleiht das Recht, für die Hinterlegung das Datum des Eröffnungstages der Ausstellung zu beanspruchen, sofern die Marke innerhalb von sechs Monaten nach diesem Zeitpunkt hinterlegt wird. Schweizerische Rechtsprechung zu diesem Staatsvertrag ist spärlich. Es darf angenommen werden, dass der Begriff der Benützung hier derselbe ist wie nach 1.2 / 1.3.
- Der Markeninhaber kann einem Dritten nicht verbieten, ein von diesem bereits vor der Hinterlegung benütztes Zeichen weiter zu benützen (Art. 14 MSchG). Die Erlangung eines solchen Weiterbenützungrechts bedarf keiner Vorbenützung, wie sie zur Aufrechterhaltung einer Marke erforderlich ist (vgl. Fragen 1.2 und 3). Das Zeichen muss bloss in irgendeiner Weise gutgläubig im Wirtschaftsverkehr benützt worden sein. Andererseits bildet der (auch qualitative) Umfang dieser bisherigen Benützung die entsprechende Grenze des Weiterbenützungrechts. Wenn also die Vorbenützung nicht "als Marke" erfolgte, so besteht auch kein Weiterbenützungrecht "als Marke".

- Im Gemeingut stehende Zeichen, die nicht absolut freihaltebedürftig sind, können als Marken eingetragen werden, wenn sie sich im Verkehr als Marke für die Waren und Dienstleistungen durchgesetzt haben, für die sie beansprucht werden (Art. 2 lit. a MSchG). Diese Verkehrsdurchsetzung verlangt einen Gebrauch "als Marke". Ein nicht markenmässiger Gebrauch führt nicht zur Durchsetzung.

1.2 *Um eine Markenregistrierung aufrechtzuerhalten (d.h. gegen einen Antrag auf Löschung wegen Nicht-Benützung)?*

Der Markeninhaber kann sein Markenrecht laut Gesetz grundsätzlich nur geltend machen, wenn er seine Marke innerhalb von fünf Jahren nach Ablauf der Widerspruchsfrist oder nach Abschluss eines Widerspruchsverfahrens im Zusammenhang mit den Waren und Dienstleistungen benützt, für die sie beansprucht wird (Art. 11 / 12 MSchG).

Eine solche rechtserhaltende markenmässige Benützung setzt nach der Lehre voraus, dass die Marke als Kennzeichen von Waren oder Dienstleistungen im grundsätzlich inländischen Wirtschaftsverkehr mit einer gewissen Ernsthaftigkeit gebraucht wird. Der Zusammenhang zwischen Marke und Ware bzw. Dienstleistung wird dann als hinreichend betrachtet, wenn die Marke umgehend als deren Identifizierungsmittel zu erkennen ist (vgl. Frage 3). Gemäss Art. 1 Abs. 1 MSchG ist eine Marke "ein Zeichen, das geeignet ist, Waren oder Dienstleistungen eines Unternehmens von solchen anderer Unternehmen zu unterscheiden". "Identifizierung" bedeutet daher im Licht dieser Bestimmung "Identifizierung der unternehmensmässigen Herkunft von Waren oder Dienstleistungen". Eine rechtserhaltende markenmässige Benützung liegt zudem gemäss Art. 11 Abs. 2 MSchG nur vor, wenn die Marke entsprechend der Registrierung oder in einer von der Registrierung nicht wesentlich abweichenden Form gebraucht wird.

1.3 *Um eine Verletzung zu begründen?*

Zur Begründung einer Markenrechtsverletzung verlangen Lehre und Rechtsprechung gestützt auf den offenen Gesetzeswortlaut von Art. 13 MSchG das Vorliegen einer rechtsverletzenden kennzeichenmässigen Benützung der Marke, wofür nicht nur die Benützung eines identischen oder verwechselbar ähnlichen Kennzeichens zur Identifizierung einer Ware oder Dienstleistung genügt, sondern insbesondere auch die Benützung einer identischen oder verwechselbar ähnlichen Firma, Enseigne oder anderen Geschäftsbezeichnung (zum Vergleich mit der rechtserhaltenden markenmässigen Benützung siehe Fragen 1.2 und 3). Ausserdem kann eine Markenverletzung auch durch die Verwendung einer fremden Marke in der Werbung erfolgen, namentlich wenn dies zwecks anlehrender oder vergleichender Werbung geschieht oder der Beschreibung des eigenen Angebots dient.

Die Benützung "als Marke" ist daher für die Frage der Verletzung weniger wichtig. Die Abgrenzung zwischen verletzendem und nicht-verletzendem Gebrauch entscheidet sich nicht an der Frage der Benützung "als Marke".

2. **Gibt es eine Definition dessen, was die Benützung "als Marke" ist, entweder im Gesetzesrecht oder im Fallrecht?**

Art. 1 Abs. 1 MSchG definiert die Marke als ein "Zeichen, das geeignet ist, Waren oder Dienstleistungen eines Unternehmens von solchen anderer Unternehmen zu unterscheiden". Daraus darf im Prinzip abgeleitet werden, dass eine Benützung "als Marke" eine solche ist, bei der das Zeichen vom Publikum als Hinweis auf die unternehmensmässige Herkunft der Waren oder Dienstleistungen verstanden wird.

3. **Gibt es einen Unterschied in der Beurteilung der Benützung "als Marke" zwischen dem Erwerb, der Aufrechterhaltung und der Verletzung von Rechten?**

Da das subjektive Markenrecht grundsätzlich nicht gestützt auf eine Benützung der Marke, sondern durch die Eintragung in das Markenregister entsteht (Art. 5 MSchG, vgl. Frage 1.1), wobei das Recht demjenigen zusteht, der die Marke (zuerst) hinterlegt hat (Art. 6 MSchG), gibt es im Zusammenhang mit dem Erwerb des Markenrechts an sich überhaupt kein rechtliches Erfordernis der Benützung. Somit kann insofern auch keine Abgrenzung

zur Benützung der Marke bei der Aufrechterhaltung und bei der Verletzung von Rechten stattfinden. Dies gilt auch in den Ausnahmefällen, in denen das subjektive Markenrecht auf Grund der Beanspruchung der Priorität gemäss Art. 4 PVÜ (Art. 7 MSchG) oder der Ausstellungspriorität im Sinne von Art. 11 PVÜ (Art. 8 MSchG) bei einem Hinterleger entsteht, der die Marke nicht als Erster in der Schweiz hinterlegt hat. Dabei ist insbesondere zu beachten, dass die Benützung im Rahmen einer Ausstellung für sich allein genommen noch kein Recht an einem Kennzeichen bewirkt, sondern allenfalls eine bessere Priorität, wenn später eine Hinterlegung vorgenommen wird. Schliesslich ist die Benützung der Marke auch für die Zuteilung des Markenrechts bei gleichem Hinterlegungsdatum zweier Anmelder unerheblich.

Notorische Marken im Sinne von Art. 6^{bis} PVÜ und Art. 16 Abs. 2 TRIPS sind in Hinblick auf den Schutz gegen Drittzeichen auch ohne Registrierung zumindest im Widerspruchs- und im Lösungsverfahren den in der Schweiz hinterlegten oder eingetragenen Marken gleichgestellt (Art. 3 Abs. 2 lit. b MSchG). Für diesen Schutz notorischer Marken ist eine Benützung in der Schweiz nicht zwingend erforderlich. Somit ist ein Vergleich mit der Benützung der in der Schweiz eingetragenen Marke bei der Aufrechterhaltung und bei der Verletzung von Rechten in diesem Fall ebenfalls nicht möglich. Obwohl auch eine Benützung im Ausland an sich gesetzlich nicht vorgeschrieben ist, geht die wohl herrschende schweizerische Lehre davon aus, dass Notorietät in der Schweiz zumindest Benützungshandlungen im Ausland voraussetzt. Dabei dürfte es sich jedoch um eine faktische und nicht um eine rechtliche Voraussetzung handeln, zumal zumindest theoretisch Ausnahmen nicht völlig ausgeschlossen erscheinen. Da im Recht des betreffenden Territoriums sodann gar kein Benützungszwang vorgesehen sein muss (Art. 5 C PVÜ und Art. 19 Abs. 1 TRIPS), kann die im Ausland vorausgesetzte Benützung auch nicht generell mit der Benützung der Marke für die Aufrechterhaltung des Markenrechts im betreffenden ausländischen Territorium verglichen werden.

Der Markeninhaber kann einem Dritten die Benützung eines bereits vor der Hinterlegung benützten Zeichens im bisherigen Umfang nicht verbieten (Art. 14 MSchG). Obwohl das Gesetz von «Zeichen» und nicht von "Marke" spricht, geht die wohl herrschende Lehre stillschweigend davon aus, dass sich dieses Weiterbenützungsrecht nicht auf die bisherige Benützung irgendeines Kennzeichens, sondern nur auf die bisherige Benützung eines Zeichens als Marke bezieht. Nach einem Teil der Lehre werden hier allerdings auch Fälle früherer Benützung miteinbezogen, in denen überhaupt kein kennzeichenmässiger Gebrauch vorliegt. Nach der Meinung der Arbeitsgruppe liegt dann aber ohnehin keine Markenverletzung vor, so dass ein Weiterbenützungsrecht hier ausser Betracht fällt. Da sich das Recht des Vorbenützers sowohl quantitativ als auch qualitativ nach seiner bisherigen Benützung richtet, werden an diese Benützung vom Gesetz her nicht dieselben Anforderungen gestellt wie für die Aufrechterhaltung eines Markenrechts. Geht man jedoch mit der wohl herrschenden Lehre davon aus, dass diese Benützung als Marke erfolgen muss, so ist zumindest die ernsthafte Benützung im Wirtschaftsverkehr als Kennzeichen für Waren und Dienstleistungen erforderlich (vgl. Frage 1.2). Wie auch die unmittelbar anschliessenden Ausführungen zeigen, entspricht die für ein Weiterbenützungsrecht notwendige Benützung somit weder genau der Benützung für die Aufrechterhaltung noch derjenigen für die Verletzung des Markenrechts.

Eine mit dem Recht des Vorbenützers vergleichbare Stellung kann derjenige Dritte erreichen, der die Marke während eines längeren Zeitraumes kennzeichenmässig benützt und sich dadurch einen wertvollen wirtschaftlichen Besitzstand aufbaut, obwohl der Markeninhaber diese Benützung kannte oder kennen musste. Unter diesen Umständen tritt nach der Lehre und Rechtsprechung die Verwirkung der Abwehransprüche des Markeninhabers ein. Ob dies unter allen Umständen nur dann gilt, wenn der Dritte jederzeit gutgläubig war, ist strittig. Das schweizerische Gesetzesrecht kennt keine feste Frist, nach welcher die Verwirkung eintritt, sondern überlässt die Festlegung des Zeitpunkts im Einzelfall dem Gericht. Im Gegensatz zum Vorbenützungsrecht kann diese Rechtsposition des Dritten nicht nur bei der Benützung des Zeichens als Marke, sondern bei jeder Benützung entstehen, die an sich unter einen der Abwehransprüche des Markeninhabers fällt, d.h. bei jedem kennzeichenmässigen Gebrauch für die beanspruchten Waren und Dienstleistungen im Wirtschaftsverkehr. Andererseits begründet die Verwirkung nur eine

schaftsverkehr. Andererseits begründet die Verwirkung nur eine Hinderung der Rechtsdurchsetzung auf Seiten des Markeninhabers und kein subjektives Recht des Dritten, was sich unter anderem darin niederschlägt, dass sich diese Rechtsposition des Dritten, anders als das Weiterbenützungsgeschäft (Art. 14 Abs. 2 MSchG), nicht und auch nicht gemeinsam mit dem Unternehmen übertragen lässt.

Die Marke ist geschützt, soweit sie im Zusammenhang mit den beanspruchten Waren und Dienstleistungen gebraucht wird (Art. 11 Abs. 1 MSchG). Wird die Marke während eines ununterbrochenen Zeitraums von 5 Jahren nach unbenütztem Ablauf der Widerspruchsfrist oder nach Abschluss des Widerspruchsverfahrens nicht gebraucht, so kann das Markenrecht unter Vorbehalt von wichtigen Gründen für den Nichtgebrauch nicht mehr geltend gemacht werden (Art. 12 Abs. 1 MSchG). Bereits der Wortlaut des Gesetzes verlangt somit den Gebrauch des eingetragenen Zeichens als Marke und nicht bloss irgendeinen kennzeichenmässigen Gebrauch. Zudem muss die Marke im Zusammenhang mit den geschützten Waren und Dienstleistungen im Wirtschaftsverkehr benützt werden. Wird das Zeichen im Wirtschaftsverkehr benützt, ist nicht zwingend das Vorliegen eines Veräusserungsgeschäftes notwendig. Die Lehre verlangt sodann eine gewisse Ernsthaftigkeit der Benützung. Die Marke muss ausserdem entweder im Inland oder im Zusammenhang mit der Ausfuhr von Waren und Dienstleistungen benützt werden (Art. 11 Abs. 2 MSchG). Ein Zusammenhang des Gebrauchs der Marke mit den Waren und Dienstleistungen wird nach der Lehre nur angenommen, wenn die Marke im traditionellen Sinne "als Marke" benützt wird, d.h. also zur Unterscheidung von Waren und Dienstleistungen eines Unternehmens von solchen anderer Unternehmen. Dies schliesst allerdings nicht aus, dass die Marke zugleich auch der Unterscheidung von anderen Waren und Dienstleistungen desselben Unternehmens dient. Für den rechtserhaltenden Gebrauch ist jedoch kein Anbringen auf der Ware oder Verpackung notwendig, sofern die Benützung der Marke als Kennzeichen zur Unterscheidung von Waren und Dienstleistungen eines Unternehmens ohne weiteres erkennbar ist. Insofern gibt es keinen Numerus Clausus der rechtserhaltenden Benützungformen. Um das ganze Markenrecht aufrecht zu erhalten, muss die Marke allerdings für alle beanspruchten Waren und Dienstleistungen benützt werden. Eine Benützung in abweichender Form wird angerechnet, soweit keine wesentliche Abweichung vorliegt (Art. 11 Abs. 2 MSchG). Anders als bei der verletzenden Benützung genügt es jedoch nicht, dass die abweichende Form mit der eingetragenen Marke verwechselbar ist. Vielmehr muss die benützte Marke nach der wohl herrschenden Lehre von den betroffenen Verkehrskreisen als dieselbe Marke wie das eingetragene Zeichen aufgefasst werden.

Demgegenüber bestehen die Abwehransprüche des Markeninhabers gegen eine verletzende Benützung nicht nur dann, wenn der Verletzer das eingetragene Zeichen markenmässig benützt. Vielmehr genügt jede Benützung als Kennzeichen im Wirtschaftsverkehr, um eine Verletzung zu begründen (Art. 13 Abs. 1 und Abs. 2 in Verbindung mit Art. 3 MSchG). Dies bedeutet, dass ein Markenrecht durch die Benützungshandlung eines Dritten verletzt sein kann, obwohl dieselbe Handlung, wenn sie vom Markeninhaber ausgeführt würde, zur Aufrechterhaltung des Markenrechts nicht geeignet wäre. Sofern keine berühmte Marke (Art. 15 MSchG) vorliegt, muss allerdings auch die verletzende Benützung einen Zusammenhang zu den geschützten Waren und Dienstleistungen haben. Es wird jedoch nicht verlangt, dass der Verletzer das Zeichen «als Marke» benützt, d.h. dass seine Zeichenbenutzung die Herkunfts- und die Unterscheidungsfunktion erfüllt. Im Unterschied zur rechtserhaltenden Benützung kann eine verletzende Benützung zudem auch schon dann vorliegen, wenn das geschützte Zeichen nur in einem Einzelfall gebraucht wird, was bei der Beurteilung einer Benützung zur Aufrechterhaltung des Markenrechts unter Umständen noch nicht als ernsthafter Gebrauch bewertet würde. Schliesslich genügt es, wenn das verletzende Zeichen mit der eingetragenen Marke verwechselbar ist. Anders als bei der rechtserhaltenden Benützung müssen die betroffenen Verkehrskreise die beiden benützten Zeichen somit nicht unbedingt als gleiche Marke auffassen.

4. Wird eine der folgenden Nutzungsformen als Benützung "als Marke" beurteilt

4.1 Benützung im Internet, als Metatag, in "linking" oder "framing"?

Die Benützung auf einer Website im Internet gilt nach der wohl herrschenden Lehre als Benützung des Zeichens "als Marke". Zu beachten ist allerdings, dass auch in diesem Fall die übrigen Voraussetzungen der Markenbenützung erfüllt sein müssen. Aus dem Erfordernis der Benützung der Marke in der Schweiz ergibt sich nach der wohl herrschenden Lehre insbesondere, dass die Website entweder von einem schweizerischen Provider stammen oder der Inhalt der Website einen Bezug zur Schweiz aufweisen muss. Im Lichte der allgemeinen Voraussetzungen dürfte die Benützung einer Marke durch einen Knaben auf seiner privaten Website sodann beispielsweise nach der wohl herrschenden Lehre keine markenverletzende Benützung darstellen, da die Benützung des Zeichens nicht im Geschäftsverkehr erfolgt. Als Ausnahme einer Markenverletzung, die nicht an die Benützung des Zeichens in Zusammenhang mit den beanspruchten Waren und Dienstleistungen geknüpft ist, muss auch hier die berühmte Marke (Art. 15 MSchG) genannt werden.

Die Benützung einer Marke als Domain Namen stellt in diesem Lichte ebenfalls eine Markenverletzung dar, wenn ein Gebrauch im Zusammenhang mit den geschützten Waren und Dienstleistungen anzunehmen ist. Dies ist insbesondere dann der Fall, wenn auf der bezeichneten Website selbst diese Waren und Dienstleistungen angeboten oder beworben werden. Unter welchen Umständen eine Weiterverweisung genügt, ist strittig. Unter denselben Voraussetzungen gilt die Benützung eines Domain Namens grundsätzlich auch als ausreichende Benützung zur Aufrechterhaltung des Markenrechts. Auch hier sind aber die allgemeinen Voraussetzungen einzuhalten, was in diesem Zusammenhang insbesondere bedeutet, dass der Domain Namen nicht wesentlich von der eingetragenen Marke abweichen darf (Art. 11 Abs. 2 MSchG). Die bloße Reservierung eines Domain Namens stellt nach der wohl herrschenden Lehre dagegen in der Regel weder eine Markenverletzung noch einen genügenden Gebrauch zur Aufrechterhaltung des Markenrechts dar. Da sich der Markeninhaber nach schweizerischem Recht allerdings auch gegen die bloße Gefährdung durch eine drohende Verletzung wehren kann (Art. 55 Abs. 1 lit. a MSchG), kann unter Umständen auch gegen eine bloße Reservierung vorgegangen werden, wenn zugleich eine drohende Verletzung nachgewiesen wird.

Die Benützung als Metatag ist nach noch nicht gefestigter Lehre unter den gleichen Voraussetzungen eine Benützung des Zeichens als Marke wie die Benützung des Zeichens als Domain Name. Der Umstand, dass Metatags, anders als Domain Namen, nicht ohne weiteres erkennbar sind, hindert es nach dieser Lehre nicht, ihre Benützung als Gebrauch im Wirtschaftsverkehr anzusehen.

Nach der wohl herrschenden Lehre ist der Outlink, der einer Marke unterlegt wird, zumindest immer dann eine rechtsverletzende Benützung, wenn nicht auf die Homepage des Markeninhabers verwiesen wird und ein Gebrauch im Zusammenhang mit den beanspruchten Waren und Dienstleistungen vorliegt. Bei einem Verweis auf die Homepage des Markeninhabers nimmt die noch nicht gefestigte Lehre zwar einen an sich kennzeichenmässigen Gebrauch, aber zugleich auch einen Rechtfertigungsgrund an. Eine rechtserhaltende Benützung durch einen blossen Outlink dürfte nach der noch nicht gefestigten Lehre regelmässig an dem nicht ausreichenden Zusammenhang mit den geschützten Waren und Dienstleistungen scheitern. Diese Überlegungen gelten nach der wohl herrschenden Lehre grundsätzlich auch für den Inline-Link, bei dem Bausteine in die Seite einer Website integriert sind, die auf einem Web selber gespeichert sind, so dass also nicht erkennbar ist, dass ein Teil der Seite einen anderen Ursprung hat. Nach der wohl herrschenden Lehre kommt bei Datenbanken im Internet in diesem Fall allerdings Art. 16 MSchG über die Kennzeichnung in Wörterbüchern und anderen Nachschlagewerken zur Anwendung, so dass von den Verantwortlichen der Website eine Kennzeichnung des Zeichens als geschützte Marke verlangt werden kann.

Beim sogenannten "framing" besteht nach der noch nicht gefestigten Lehre diesbezüglich keine andere Rechtslage als beim Inline-Link (siehe den vorangehenden Abschnitt).

4.2 *Benützung durch Fan-Clubs oder Anhänger?*

Nach der wohl herrschenden Lehre ist die Benützung der Marke durch Fanclubs oder Anhänger weder eine Benützung, die zur Aufrechterhaltung des Markenrechts genügt, noch

eine markenverletzende Benützung. Die rechtserhaltende Benützung der Marke scheidet in der Regel bereits deswegen aus, weil diese dem Markeninhaber nur zugerechnet wird, wenn er sie selbst vornimmt oder sie durch einen Dritten mit seiner Zustimmung erfolgt, wobei die Marke im Zusammenhang mit den geschützten Waren- und Dienstleistungen gebraucht werden muss (Art. 11 Abs. 1 und Abs. 2 MSchG). Sowohl die Annahme einer rechtserhaltenden Benützung als auch die Annahme einer rechtsverletzenden Benützung scheitern nach der wohl herrschenden Lehre aber vor allem daran, dass keine Benützung im Wirtschaftsverkehr erfolgt. Eine Benützung im Wirtschaftsverkehr und damit auch eine rechtsverletzende Benützung liegt aber selbstverständlich dann vor, wenn der Fanclub Fanartikel vertreibt etc. und die geschützte Marke für solche Waren eingetragen ist.

4.3 *Parodien?*

Die Frage der Benützung von Parodien eines Zeichens «als Marke» ist nach der sehr spärlichen Lehre zu dieser Frage nach den allgemeinen Prinzipien zu entscheiden. Danach ist es entscheidend, ob die Benützung markenmässig (bei der Aufrechterhaltung) oder kennzeichenmässig (bei der Verletzung) erfolgt. Im Rahmen der allgemeinen Voraussetzungen ist ein rechtserhaltender Gebrauch daher nur dann anzunehmen, wenn die Parodie nicht als solche zu erkennen ist und sie von den betroffenen Verkehrskreisen zudem der eingetragenen Marke zugerechnet wird. Eine rechtsverletzende Benützung liegt vor, wenn nicht ohne weiteres erkennbar ist, dass es sich um eine Parodie handelt und im übrigen eine kennzeichenmässige Benützung im Wirtschaftsverkehr im Zusammenhang mit den beanspruchten Waren und Dienstleistungen vorliegt (siehe Frage 3). Wenn an sich keine kennzeichenmässige Benützung im Wirtschaftsverkehr gegeben ist, dies aber ebenfalls nicht ohne weiteres erkennbar ist, liegt nach noch nicht gefestigter Lehre ebenfalls eine Markenverletzung vor.

4.4 *Vergleichende Werbung?*

Der Gebrauch in der Werbung im Zusammenhang mit den beanspruchten Waren und Dienstleistungen ist nach der wohl herrschenden Lehre grundsätzlich rechtserhaltend, sofern das Kriterium der Ernsthaftigkeit des Gebrauchs nicht verneint werden muss, was jedoch bei länger anhaltender Benützung ausschliesslich in der Werbung nach Ansicht der Arbeitsgruppe regelmässig zutreffen dürfte. Die Benützung der Marke in der vergleichenden Werbung ist nach der herrschenden Lehre insbesondere rechtsverletzend, wenn sie kennzeichenmässig im Zusammenhang mit den geschützten Waren und Dienstleistungen geschieht. Wie weit in solchen Fällen allenfalls Rechtfertigungsgründe zum Zuge kommen, die eine solche vergleichende Benützung dennoch als nicht rechtswidrig erscheinen lassen, ist bisher noch weitgehend ungeklärt.

5. **Si, d'après le régime national du Groupe, l'usage comme marque est confiné aux indications traditionnelles d'origine ou d'identification, des usages non conventionnels sont-ils néanmoins punissables de par la loi sur les marques ou d'autres lois (par exemple les lois sur la concurrence déloyale ou sur les pratiques du commerce)?**

L'art. 13 al. 2 let. e LPM donne au titulaire de la marque le droit d'interdire à des tiers d'apposer la marque sur des papiers d'affaires, de l'utiliser à des fins publicitaires ou d'en faire usage de quelque autre manière dans les affaires.

La LPM ne précise cependant pas si l'usage dont il est question se réfère à l'usage nécessaire à la protection de la marque ou s'il faut interpréter cet usage plus largement.

En réalité, ce qui est déterminant c'est de savoir si l'usage critiqué crée un risque de confusion avec la marque du titulaire.

Par conséquent, la loi sur la protection des marques permet au titulaire d'une marque de se défendre contre tout usage de son signe ou d'une imitation de celui-ci qui causerait un risque de confusion, peu importe la manière dont la marque est concrètement utilisée (cf. pt. 1.3. supra).

La loi contre la concurrence déloyale accorde également une protection complémentaire au titulaire de la marque en cas de dénigrement, p. ex. si la marque est parodiée ou piratée.

6. Si l'usage "en tant que marque" dans le sens traditionnel est requis pour établir la contrefaçon, est-ce que les marques "de haute renommée", "célèbres", "notoires" ou "jouissant d'une réputation" utilisées sur des produits et services différents sont protégées?

Lorsqu'une marque acquiert une haute renommée, son titulaire peut en vertu de l'art. 15 LPM interdire à tout tiers l'usage de cette marque pour tous les produits ou les services pour autant qu'un tel usage menace le caractère distinctif de la marque, exploite sa réputation ou lui porte atteinte.

Sont réservés les droits acquis sur un signe, avant que la marque ne devienne de haute renommée (art. 15 al. 2 LPM en relation avec l'art. 14 LPM).

Les marques de haute renommée bénéficient d'une protection plus étendue que celle que la loi réserve aux marques qui ne présentent pas la caractéristique d'être de haute renommée.

Cette protection est soumise à certaines conditions:

- a) La marque doit en premier lieu être une marque de haute renommée, ce qui implique qu'elle soit très connue et que le public lui associe des biens ou services de grande qualité.
- b) La marque de haute renommée n'est protégée que si l'une des sous-conditions suivantes sont réalisées:
 - i. L'usage de la marque par le tiers doit menacer le caractère distinctif de la marque. Peu importe la forme de l'usage, la loi vise en réalité toute utilisation qui serait faite de la marque de haute renommée.

Le caractère distinctif de la marque de haute renommée doit être menacé. Ce sera le cas, en particulier si la marque de haute renommée est utilisée en relation avec des biens ou services similaires ou identiques à ceux pour lesquels la marque de haute renommée est utilisée.

La marque de haute renommée est également protégée contre les variations (RSPI 1981 p. 69, Coca line/Coca Cola).

- ii. Le tiers doit chercher à exploiter la réputation de la marque de haute renommée.

La jurisprudence tend à examiner dans chaque cas si le tiers tire véritablement profit de la réputation de la marque de haute renommée (ATF 124 III p. 285, Nike).

- iii. Le titulaire de la marque de haute renommée peut également interdire à tout tiers de faire usage de cette marque lorsque cet usage lui porte atteinte.

Pour déterminer s'il existe une atteinte, il faut examiner la situation au regard du droit de la personnalité ou du droit de la concurrence déloyale.

En revanche, les marques notoires ne disposent pas d'une protection plus étendue. La LPM ne contient aucune disposition propre à fonder un régime préférentiel.

La LCD peut naturellement s'appliquer pour autant que l'usage de la marque par le tiers puisse être considéré comme un acte de concurrence déloyale.

Il faut cependant noter que la jurisprudence fait toujours preuve d'une certaine réserve et hésite à accorder à une marque une protection qui n'est pas prévue par la législation sur les marques.

Report Q168

in the name of the Ukrainian Group

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

- 1. Is there any requirement for use of a mark "as a mark" for the purpose of**
 - 1.1 Acquiring a mark (if rights may be acquired by use according to national law)**

The Ukrainian laws do not require use of a trademark for the purpose of acquiring a mark.
 - 1.2 Maintaining of a trademark registration (e.g. against an application for cancellation on grounds of non-use);**

Under the Ukrainian laws, to maintain a trademark registration it is necessary to use a trademark in relation to goods and services for which it has been registered. Otherwise, in the case of non-use of a trademark by its owner for three years and longer, the registration may be cancelled.
 - 1.3 Establishing infringement**

A right owner shall use his trademark in good faith. To establish an infringement of his rights to a trademark by the third parties, an owner should have a title (registration certificate) as a proof that the registration is being maintained. Furthermore, well-known trademarks may be protected in Ukraine under the international treaties, the registration being non-obligatory. If an identical or confusingly similar trademark infringing rights of a registered trademark owner is used by the third party, then an infringer may be sued.
- 2. Is there any definition of what is use "as a mark" either in statute or case law?**

There is no case law in Ukraine.

Under Article 16 of the Law of Ukraine "On the Protection of Rights to Marks for Goods and Services", the use as a mark shall be constituted by use of a trademark in relation to goods and services for which it has been registered, on a packaging for goods, in advertising, printed matters, on signboards, during exhibiting the displays at exhibitions and fairs held in Ukraine, in booklets, invoices, headletters and any other documents related to the placing of those goods and services on the market."
- 3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?**

There is no difference.
- 4. Is any of the following considered to be use "as a mark":**
 - 4.1 Use on the Internet, as a metatag, in linking or framing**

Unfortunately, this question is not exactly governed by the Ukrainian legislation. But to our mind if such use falls under definition "use as a mark" given in item 2 (e.g. use of a mark in advertising on the Internet), it may be considered to constitute the use as a trademark, while the trademark is required to be registered in the territory.
 - 4.2 Use by fan clubs or supporters**

This situation may be considered to constitute the use as a mark, provided that a trademark is used by fan clubs and supporters for identification of goods and services in respect of which it has been registered, etc. (according to the definition given in item 2). This may be also taken to constitute an unfair competition in order to undermine the repute of the trademark and its owner.

4.3 *Parody*

This situation may be considered to constitute the use as a mark, provided that a trademark is used in a parody for identification of goods and services in respect of which it has been registered, etc. (according to the definition given in item 2). This may be also taken to constitute an unfair competition in order to undermine the repute of the trademark and its owner.

4.4 *Comparative advertising*

This situation may be considered to constitute the use as a mark, provided that a trademark is used in comparative advertising for identification of goods and services in respect of which it has been registered, etc. (according to the definition given in item 2). The unfair competition law admits use of comparison in advertising, provided that the information on goods or services is supported by factual data and is useful for consumers. However, even in this case any trademark cannot be used without its owner's consent.

5. **If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trademark or other laws (e.g. unfair competition or trade practice laws).**

Under the Ukrainian unfair competition law, an unconventional use of a trademark by an infringer may be considered to constitute a basis for establishment of infringement.

6. **If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?**

For the time being, the use of well-known, famous, notorious or reputed trademarks on dissimilar goods without the right owner's consent constitutes unfair competition. Also, respective laws are expected to be amended in the near future to be harmonized with the provisions of the TRIPS. These expected amendments shall enable to consider such use of a well-known trademark to constitute a direct infringement.

Summary

Article 16 of the Law of Ukraine "On the Protection of Rights to Marks for Goods and Services" provides a list of possible uses of a mark for goods and services. Unconventional uses of a sign registered as a trademark for goods and services, including the use on the Internet, are not governed by the Ukrainian legislation in force. At the same time, as a result of global Internet "expansion", urgency of the studied problem whether the use on the Internet is considered to be the use "as a mark", and whether such use of an identical or confusingly similar sign by the third parties infringes the registered trademark owner's rights, increases significantly.

Under such circumstances, unconventional use of a registered trademark for goods and services by the third parties may be considered to constitute an infringement of rights of a registered trademark owner under the Law of Ukraine "On the Protection against Unfair Competition".

At the same time, trademark owners' rights may obtain indirect protection against such infringement under the Law "On the Protection of Rights to Marks for Goods and Services", taking into account exclusive rights of an owner to use a mark and prevent the third parties from use of the registered trademark without his consent. This case also encompasses, in particular, the use of a mark on the Internet since advertising generally falls within traditional use, and thus is governed by the current trademark law.

Furthermore, amendments to special trademark laws, related to the above problems, in particular to the use of trademarks on the Internet, are being developed.

As far as the protection of rights to well-known trademarks used by the third parties in respect of dissimilar goods and services is concerned, it has been possible to obtain protection under the provisions on prevention from unfair competition. At the same time, corresponding amendments to the national legislation are being prepared in view of further harmonization with the provisions of the TRIPS Agreement.

Report Q168

in the name of the United Kingdom Group
by members of sub-committee Q168

**Use of a mark "as a mark" as a legal requirement in respect of acquisition,
maintenance and infringement of rights**

4.1. Is there any requirement for use of a mark "as a mark" for the purposes of

4.1.1 Acquiring a mark (if rights may be acquired by use according to national law)

- a) It is possible to apply for and be granted a registered trade mark without any use having been made of the trade mark, although it will be vulnerable to revocation if there is no genuine use made of it within 5 years of grant and there are no proper reasons for such non use.
- b) However, where there are "absolute grounds" (grounds which are related to the application itself) for objecting to the registration of a mark, those objections are capable of being overcome by evidence demonstrating that the mark has acquired a distinctive character as a result of the use made of it. An applicant will have difficulty in showing the necessary amount of acquired distinctive character if he cannot prove use as a trade mark. In the *British Sugar Plc v James Robertson and Sons Limited*¹ case, the judge said that mere evidence of use of the word TREAT would not suffice, without more to prove that it was taken by the public as a badge of origin. The Judge's views were confirmed by the Court of Appeal in *Phillips Electronics BV v Remington Consumer Products Limited*². Here it was held that the use of a picture of a shaver head was not shown to be recognised as an indication that the goods were from a particular trader. In general, if a mark has not clearly been used in a trade mark manner it will be more difficult to demonstrate that it has in fact acquired a sufficiently distinctive character.
- c) The Court of Appeal held that "Elvis"³ could not be granted as a registered trade mark (the application had been filed in the mid 1990s) because it did not operate as an indication of origin – one would not think that goods bearing the brand "Elvis" came from a particular source or were derived under an authorised licensing regime. While this case turned very much on its own facts (the public is now increasingly familiar with the existence of merchandising activities and if an application was made now for a trade mark of the name of a contemporary icon, it would likely be granted) this is a further example of the need for use as a trade mark, rather than simply use.
- (e)d) In the *Windsurfing Chiemsee*⁴ case the ECJ adopted the same general approach.

¹ [1996] RPC 281.

² ~~insert Court of Appeal citation~~ [1999] E.T.M.R. 816.

³ [1999] RPC 567 a decision under the Trade Marks Act 1938.

⁴ *WSC Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots and Segelzubehör Walter Huber and WSC Windsurfing Chiemsee Produktions und Vertriebs GmbH v Franz Attenberger* (C-108/97 and C-109/97); Opinion of Advocate-General, 5 May 1998; judgment of the Court [1999] ETMR 585.

4.21.2 Maintaining of a trade mark registration (eg against an application for cancellation on grounds of non-use):

- (a)a) Yes. To defeat an application for cancellation on the ground of non-use the trade mark owner must prove use which is "genuine" use in the relevant period and/or that there were good reasons for non use. This use must be as a trade mark.
- (b)b) The requirement that the use must be "genuine use" is not directly related to use "as a mark" but rather to "bona fide" use.
- c) Where there has been genuine use and/or good reasons for non use but not for all the goods or services covered by the registration then the mark may be partially cancelled.

4.31.3 Establishing infringement

- (a)a) This question has been referred to the ECJ by the English Court in the *Arsenal Football Club Plc v Reed*⁵ and the *Philips v Remington* cases. Decisions are awaited.
- (b)b) Until recently, the answer to the question posed was "no". In the *British Sugar* case and in the Court of Appeal decision in *Philips v Remington*, it was held that infringing use is not restricted to trade mark use in relation to the Defendant's goods or services but the exceptions⁶ to infringement may allow for use other than use as a trade mark to be held not to infringe. ~~{Fill in information on pertinent questions referred to the ECJ in the Philips case on this issue}~~. In the *Philips v Remington* case the Court of Appeal referred questions relevant to this issue to the ECJ. Firstly the Court asked whether the exclusive right granted by Article 5 (1) of the Council Directive 89/104/EEC extends to enable the proprietor to prevent third parties using identical or similar signs in circumstances where that use was not such as to indicate origin or is it limited so as to prevent only use which wholly or in part does indicate origin. Secondly the Court asked whether the use of an allegedly infringing shape of goods, which is and would be seen as an indication as to the kind of goods or the intended purpose thereof, was none the less such as to indicate origin if a substantial proportion of the relevant trade and public believe that goods of the shape complained of come from the trade mark proprietor, absent a statement to the contrary. These questions have not been answered by the opinion of the Advocate General. The ECJ decision is awaited.
- (c)c) The question was recently raised again in *Arsenal Football v Reed*. The alleged infringement involved use of the claimant's registered marks (trade marks of Arsenal football club on scarves etc) in a manner which the Judge found was not trade mark use, but rather such as would be perceived as a "a badge of support, loyalty or affiliation to those to whom they are directed". The Judge referred various questions to the ECJ including whether there is infringement where the use is not trade mark use and there is no defence of honest descriptive use of the sign⁷.
- (d)d) Also of interest is the question referred to the ECJ in the *Holterhoff*⁸, case. That case concerns registered trade marks which are the names of goods (diamonds) possessing certain characteristics. The Opinion of the Advocate General is that:
 - Article 5(1) of Council Directive 89/104/EEC does not entitle a trade mark proprietor to prevent third parties from referring orally to his trade mark

⁵ 2001 ETMR 917.

⁶ Section 10(6): use in relation to the goods or services of the proprietor or licensee; Section 11(1): use of own registered trade mark; or Section 11(2): use of own name etc and descriptive and other indications.

⁷ Section 11(2) Trade Marks Act 1994 (Article 6(1)(b) of Council Directive 89/104/EEC).

⁸ C-2/00.

when offering goods for sale provided it is made clear that the trade mark owner did not produce those goods and provided there can be no question of the mark being perceived in trade, whether at that stage or subsequently, as indicating the origin of the goods offered for sale.

- Even if Article 5(1) of the Directive does give a right to prevent such use, Article 6(1) precludes the exercise of that right if the use is for the purpose of indicating characteristics of the goods in question, unless such use is not in accordance with honest practices in industrial or commercial matters.

This Opinion does not however answer the questions referred to in the ECJ in the *Philips* and *Arsenal* cases.

(e) It is important to recall that in the *Arsenal* case, ~~for tactical reasons~~, the potential defence of honest descriptive use of a sign was not pleaded. If this defence had been pleaded it is suggested that the *British Sugar* and *Philips* line of case law may have been followed. In our view this case law provides a useful way of analysing a potential infringement where the focus is removed from distinguishing between trade mark and non-trade mark use and uses the following more logical approach:

(i) the Defendant's use of the sign **need not** be use as a trade mark for his goods or services BUT:

(ii) the use must fairly be capable of being regarded as "in relation to" the goods or services in question; and

(iii) the defendant has the scope to show that his use is not "as a mark" and does not infringe pursuant to one or more of the relevant exceptions including, for example, honest descriptive use of a sign.

(f) However, one can envisage examples of non-trade mark use which may not necessarily have the benefit of the exceptions. For example⁹, the use of a punctuation mark "!", which may be the subject of a trade mark registration, may not qualify as use of a descriptive indication falling within the relevant exception. We suggest that one possible approach which would protect the position of an honest trader using non-descriptive, but non trade mark matter is to place some restriction on the words from the infringement provision¹⁰ which require that the Defendant "uses in the course of trade a sign...**in relation to goods or services**". In the *Trebor Bassett v Football Association*¹¹ case the alleged infringement was of a registration of the England football team crest which covered, amongst other things, printed matter in class 16. Trebor Bassett had included in packets of candy sticks, cards bearing the photographs of English footballers wearing shirts on which the registered mark could be seen. The Judge held that the reproduction of the crest was not even arguably "using" it in any real sense of the word and was certainly not using it as a sign in respect of the cards. So where there is only incidental use of, for example, a punctuation mark which is the subject of a trade mark registration, which is open to traders to use in a completely non trade mark sense, there is a proper basis for finding that the use is not truly "in relation to" the goods or services concerned.

(g) A further restriction on the infringement provisions may also assist. For example, suppose that P has a registration of a trade mark "X" in Class 16 which covers printed matter including posters and that the Defendant uses posters to advertise completely different goods say sunglasses under the same mark. Although this may be regarded as use "as a mark" it should not suffice for the use to constitute an in-

⁹ As cited in "The Modern Law of Trade Marks" by Morcom, Roughton and Graham.

¹⁰ Section 10 Trade Marks Act 1994.

¹¹ [1997] FSR 211.

fringement under Section 10(1) (identical sign in relation to identical goods/services). If the matter is approached on the basis that the words "in the course of trade...in relation to goods or services" mean **in the course of a trade** in the goods or services in question then the difficulty is avoided.

2.2. Is there any definition of what is use "as a mark" either in statute or case law?

- (a) There is no definition. Use "as a mark" will depend on the facts of each case, in particular, the nature of the mark and the goods and services concerned.
- (b) English case law indicates that the judges are looking for use which is taken by the public as a badge of origin, in other words as an indication that the goods or services are from a particular trader. This requirement is not the same as a requirement that the relevant public should know the identity of that trader. After all, frequently members of the public are not aware of the identity of owners of trade marks but nevertheless associate the marks for products with a particular trade origin.
- (c) It will be more difficult for an applicant or proprietor to show use as a trade mark with very non-distinctive marks or where the use has been mainly in conjunction with another trade mark.

3.3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

- (a) In principle there should be no difference in assessment. If use of the sign must be "as a mark" to constitute infringement then the same assessment of what amounts to use "as a mark" must apply whether it is acquisition, maintenance and/or infringement of rights that is being considered.
- (b) The main guidance from the Courts has come in cases in which the validity of registrations has been challenged by way of a counterclaim in infringement proceedings. However, in most of these cases (for example *British Sugar*) the Court, when looking at the question of infringement, has not had to analyse strictly whether for the purposes of infringement there was use *as a mark* since the relevant provision was, until the *Arsenal* case, interpreted as not being restricted to such use.
- (c) In practice, the UK Registry's approach to cases in the past has been that use of a mark for the purposes of acquiring a mark does not involve a strict analysis of use in a trade mark sense. In the past, the UK Registry has sought evidence of use of sufficient sales of the relevant goods or services rather than evidence on whether the public regards the mark as a badge of origin. However, in *British Sugar*, Jacob J rejected this practice and said that it was key that the evidence showed that the sign was known as a trade mark. —Going forward and subject to the ECJ's decisions in the *Philips* and *Arsenal* cases, the Registry may take more account of the remarks about evidence on use of a trade mark *as a mark* from the Courts.
- (d) In the celebrated *Arsenal* case the Defendant is appealing based on a counterclaim for revocation of the relevant trade marks based on non-use. It remains to be seen how his argument that the marks must be revoked for non-use given that the public do not and did not perceive them as trade marks will be viewed.

4.4. Is any of the following considered to be use "as a mark"?

4.4.1 Use on the internet, as a metatag, in linking or framing;

On the Internet

The principles set out above would apply equally to use on the Internet.

Metatag

As regards metatags, an analogy can be drawn between the use of a trade mark as a badge of allegiance as in the *Arsenal* case and the hidden use of a trade mark in a line of

code as a metatag. It can be said that the metatag is not being used by the Internet user as an indication of origin. On the other hand, the search engine uses the metatags to do automatically what the user would do manually in looking for goods or services which the user would generally expect to originate from the owner of the trade mark or metatag. Whether or not an English court would view a hidden use of a trade mark as a metatag as use as a *mark* remains to be seen.

Linking/Framing

If the "link button" on which the user clicks is the trade mark of the owner of the linked site then assuming-if it is clear to the user that by clicking on the "link button" they are being taken to the third party site, then that use is unlikely to be use as a *mark*. Instead, it is likely to fall within one or more of the exceptions to the infringement provisions, for example, use in relation to the goods or services of the proprietor (that is, the proprietor's own website). If the "link button" is used in a manner so that the public may regard it as an indication of the operator of the website (on which it is used) then that may amount to use "as a mark".

4.24.2 Use by fanclubs or supporters

Pending the ECJ decision in the *Philips* and *Arsenal* cases, the question of whether there is infringement by use as "a badge of support", loyalty or affiliation, rather than use "as a mark" remains open.

Following the rationale of the *Trebor Bassett* case it does not necessarily follow that a sign is used "in relation to" the goods in respect of which the trade mark is registered merely because it is affixed to them. Accordingly, irrespective of the ECJ decisions in the *Philips* and *Arsenal* cases, there may remain a proper basis for finding that this form of use (when it is merely incidental) is not truly "in relation to" the goods or services concerned.

4.34.3 Parody

Whether use in a parody will amount to use as a *mark* will depend on the form and content of the parody.

4.4 Comparative Advertising

Use of a sign in comparative advertising may offer a defence to infringement under section 10(6) Trade Marks Act 1994 irrespective of whether or not use as a *mark* is required in order to fall within the infringement provisions. Section 10(6) which has no equivalent in Council Directive 89/104/EEC excludes from the scope of infringement, use in relation to the goods or services of the proprietor of a registered trade mark. This extends into the area of comparative advertising. There are limitations on the kind of use which is to be protected. Two requirements must be satisfied:

- (a) the use must be in accordance with honest practices in industrial or commercial matters; and
- (b) the use must not without due cause take unfair advantage or be detrimental to the distinctive character or repute of the trade mark.

Under English law the question of whether use in a comparative advertisement is use as a *mark* is somewhat irrelevant. The important question is whether the requirements of the S.10(6) exception to infringement are fulfilled. If the method of analysis set out in *British Sugar* and *Philips* cases is applied then the Defendant has the scope to show that his use of a mark in a comparative advertisement is (pursuant to S.10(6)) not use as a *mark* and does not infringe.

4.54.5 If, under the Group's National Regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (eg unfair competition or trade practice laws)?

- (a) The *British Sugar* and *Philips* line of case law indicates that unconventional uses may (subject to any appropriate exceptions) be objectionable under UK trade mark law.

Passing Off

- (b) Unconventional uses may also amount to passing off. To find a cause of action for passing off the necessary characteristics are:
- (i) a misrepresentation;
 - (ii) made by a trader in the course of trade;
 - (iii) to prospective customers of his or ultimate consumers of services supplied by him;
 - (iv) which is calculated to injure the business or goodwill of another trader; and
 - (v) which causes actual damage to the business or goodwill of the trader by whom the action is brought (or will probably do so).
- (c) Use *as a mark* is not one of the required characteristics for passing off. ~~However~~The key issue is that, a misrepresentation ~~must be~~is shown. The majority of cases refer to a situation where the misrepresentation is that the Defendant's goods are those of the Claimant when in fact they are not. Alternatively, the misrepresentation may be that the Defendant is associated in some way with the Claimant. Therefore, the law of passing off may, upon proof of the required elements, enable traders to object to unconventional uses irrespective of the use of the relevant indicia "as marks".

Malicious Falsehood, Trade Libel, Defamation and False Attribution

- (d) Other causes of action including malicious falsehood, trade libel and defamation may be used to object to unconventional uses.
- e) Malicious falsehood (sometimes called trade libel) concerns false statements maliciously made about a person's trade, the goods which they sell or the services which they provide where those statements cause or are calculated to cause, pecuniary damage to the trader concerned. Defamation is about the protection of a person's reputation.....[fill in more]. The classic definition is that of Parke J in *Parmiter v Coupland*¹², where he said: "A publication ...which is calculated to injure the reputation of another by exposing him to hatred, contempt or ridicule." But as this definition was widely regarded as inadequate to cover all the cases, the Faulks Committee in their report have recommended that for the purpose of civil cases the following definition of defamation should be adopted¹³ "Defamation shall consist of the publication to a third party of matter which in all the circumstances would be likely to affect a person adversely in the estimation of reasonable people generally"¹⁴. In everyday language, a publication is likely to be defamatory of a person if it makes others think worse of that person. Corporate bodies may be defamed as well as human individuals.
- (f) These causes of action protect the interest that a person has in relation to the views of others, i.e. reputation. In a trade mark context, the relevance lies in the fact that rival traders sometimes want to say rude, uncomplimentary or denigratory things about their competitors. They may do this in a manner which does not use the company's trade mark *as a mark* but may still be objectionable under one or more of these causes of action.

¹² (1840) 6 M & W 105 at 108.

¹³ Cmnd 5909 para 65.

¹⁴ Neill/Rampton, Duncan & Neill on Defamation, 2. Ed., Butterworths, London, 1983, 7.01 – 7.07.

- g) Further, under S.84 Copyright Designs and Patents Act 1988 a person has a right to take action to prevent a literary, dramatic, musical or artistic work being falsely attributed to him as author. In the case of *Clark v Associated Newspapers Limited*¹⁵ parodies of the well known diaries of the Plaintiff were held to falsely attribute their authorship to the Plaintiff.

4.64.6 If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

Where there is no similarity of goods or services, there can be infringement (under Section 10(3) Trade Marks Act 1994) but only where the registered mark has a reputation. Whether the mark has a reputation is a question of fact; it is not necessary that the mark should be "well-known" within the meaning of Article 6 bis of the Paris Convention and the reputation need not be in the whole of the UK.

There is a requirement that the use is "without due cause" which seems to involve the absence of any objective justification for the use complained about. The use must also take unfair advantage of or be detrimental to the distinctive character or repute of the registered mark.

There is no requirement to show a likelihood of confusion.¹⁶

To date we have had no Court guidance on how this provision will be interpreted in scenarios where it is accepted that there is no use *as a mark* in relation to identical or similar goods/services to those of the trade mark registration. However, the proprietor of the registration would not be precluded from arguing (in, for example, the poster and sunglasses example set out above) that there is infringement under Section 10(3) which applies where there is no identity or even similarity of goods or services.

A common international standard for the necessary level of repute of the mark before protection against use on dissimilar goods/services and/or against dilution would help with international harmonisation.

Summary

In the UK, it is possible to apply for and be granted a registered trade mark without any use having been made of the mark. Where there are our grounds (related to the application itself) for objecting to the registration of a mark, those objections may be overcome by evidence showing that the mark has acquired a distinctive character. It may be difficult to show the necessary amount of distinctive character without proving use *as a trade mark*.

Similarly, to defeat an application for cancellation on the ground of non-use, the evidence must be of use *as a trade mark*.

The question of whether use *as a trade mark*, is required to establish infringement has been referred by the English Court to the ECJ. A decision is awaited. Prior to this referral, under English law, infringing use was not restricted to use *as a trade mark*. Instead, the use had to be fairly capable of being regarded as "in relation to" the goods or services in question and the defendant had the scope to show that his use was not *as a mark* and therefore did not infringe pursuant to one or more of the relevant exceptions to infringement.

Where use is *as a mark* will depend on the facts. In principle there should be no difference in this assessment between acquisition, maintenance and infringement of rights.

¹⁵ Lightman J Transcript, 21 January 1998.

¹⁶ Typhoo case [2000] FSR 767.

The principles set out above will apply to use on the Internet. There is no specific case law guidance on use in metatags or as part of linking or framing. Use by fan clubs or supporters may amount to use as "a badge of support" rather than as a *mark*. How use in a parody is assessed will depend on the form and content of that parody. Under English law, the important question in relation to a comparative advertisement is whether the requirements of a specific exception to infringement (which extends into the area of comparative advertising) are satisfied.

Unconventional use of a mark in the UK may also amount to passing off, malicious falsehood, defamation or give rise to an action for false attribution.

Reputed marks used on dissimilar goods are protected in limited circumstances.

Résumé

Au Royaume-Uni, il est possible de déposer une marque de fabrique sans qu'il y ait eu utilisation antérieure de la marque. Lorsqu'il existe des motifs d'opposition à l'enregistrement d'une marque, les objections peuvent être surmontées par la preuve du caractère distinctif de la marque. Cependant, il peut s'avérer difficile de démontrer le caractère distinctif d'une marque sans en démontrer l'usage en tant que marque de fabrique.

De même, afin de s'opposer à une demande d'annulation pour non-usage il est nécessaire de prouver l'usage de la marque comme marque de fabrique.

Le fait de savoir si l'utilisation en tant que marque de fabrique est nécessaire afin d'établir l'existence d'une contrefaçon est une question qui a été référée par les tribunaux britanniques à la Cour Européenne de Justice, dont la décision est toujours attendue. Avant ce renvoi devant la Cour Européenne de Justice, en droit anglais la contrefaçon n'était pas limitée à la contrefaçon par l'usage d'une marque en tant que marque de fabrique. Il fallait simplement que l'usage puisse être raisonnablement perçu comme portant sur les biens ou les services en question et il était possible au défendeur de démontrer que l'usage n'était pas un usage en tant que marque de fabrique et ne constituait donc pas une contrefaçon conformément à l'une ou plusieurs des exceptions à la contrefaçon.

L'usage d'une marque en tant que marque de fabrique ou non est une question de fait. En principe il ne devrait pas y avoir de différence dans l'appréciation de l'usage d'une marque comme marque de fabrique lors de son acquisition, son entretien ou en cas de contrefaçon.

Les principes évoqués ci-dessus sont également applicables à l'utilisation d'une marque sur internet. Il n'existe pas de jurisprudence portant sur l'usage sur des "metatags" ou lors de la connexion ou du cadrage. L'usage par des fans clubs ou des supporters pourrait constituer un usage en tant que "badge de support" plutôt qu'en tant que marque. L'appréciation de l'usage d'une marque lors d'une parodie dépend de la forme et du contenu de la parodie. En ce qui concerne les publicités comparées, en droit anglais la question de fond est de savoir si tous les éléments de l'une des exceptions à la contrefaçon (qui sont également applicables à la publicité comparative) sont réunis.

L'usage non conventionné d'une marque au Royaume-Uni peut également constituer un acte délictuel de "passing off", de constitution intentionnelle de faux, de diffamation ou peut donner lieu à une action pour fausse attribution.

Les marques réputées utilisées en rapport avec des biens dissemblables ne sont protégées que dans des circonstances limitées.

Zusammenfassung

In Grossbritannien ist es möglich, eine Marke anzumelden und registrieren zu lassen, ohne dass es hierzu auch nur irgendeiner Benutzung der Marke bedarf. Einspruchsgründe gegen die Registrierung der Marke (in bezug auf die Markenmeldung) können durch den Beweis widerlegt werden, dass die Marke Unterscheidungskraft erlangt hat. Möglicherweise ist es schwierig ohne den Nachweis der Benutzung der Marke das erforderliche Mass an Unterscheidungskraft aufzuzeigen.

Auch um einen Antrag auf Löschung einer Marke wegen Nichtgebrauchs zu Fall zu bringen, muss der Beweis der Benutzung *als Marke* erbracht werden.

Die Frage, ob es der Benutzung einer Marke *als Marke* bedarf, um eine Verletzung zu begründen, wurde seitens der englischen Gerichte dem Europäischen Gerichtshof übertragen. Eine Entscheidung steht noch aus. Nach englischem Recht war vor dieser Verweisung die Benutzung einer Marke *als Marke* nicht zwingende Voraussetzung für eine Markenrechtsverletzung. Entscheidend war vielmehr, dass die jeweilige Benutzung der Marke allgemein als "in Verbindung mit" der jeweiligen Ware oder Dienstleistung stehend angesehen wurde, und es oblag dem Beklagten nachzuweisen, dass seine Nutzung der Marke nicht eine solche *als Marke* war und deshalb gemäss einer oder mehrerer der einschlägigen Ausnahmen des Verletzungstatbestandes die Marke nicht verletzte.

Wann eine Benutzung *als Marke* vorliegt, hängt von den Einzelfallumständen ab. Prinzipiell sollte kein Unterschied in der Beurteilung dieser Frage im Hinblick auf den Erwerb, die Aufrechterhaltung und die Verletzung von Markenrechten bestehen.

Die hier dargelegten Grundsätze lassen sich auch auf das Internet übertragen. Bisher gibt es noch keine speziell von der Rechtsprechung entwickelten Richtlinien hinsichtlich der Benutzung einer Marke als Metatag, in linking oder framing. Die Benutzung einer Marke durch Fanclubs oder sonstige Anhänger dürfte eher als "Zeichen der Unterstützung" denn als Benutzung *als Marke* einzuordnen sein. Wie der Markengebrauch im Rahmen der Parodie zu bewerten ist, hängt von Form und Inhalt der Parodie ab. Im Bereich der vergleichenden Werbung ist nach englischem Recht die entscheidende Frage, ob die Voraussetzungen einer speziellen Ausnahme vom Verletzungstatbestand (der sich auf den Bereich der vergleichenden Werbung erstreckt) erfüllt sind.

Unkonventionelle Benutzungsformen einer Marke können in Grossbritannien als Kennzeichenmissbrauch, böswillige Unwahrheit, Verleumdung oder falsche Kennzeichnung auf dem Klagewege verfolgt werden.

Bekannte Marken, die für unähnliche Waren benutzt werden, sind unter eingeschränkten Voraussetzungen geschützt.

Report Q168

in the name of the Uruguayan Group

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of?

1.1 Acquisition of the Trademark

1.2 Maintenance of a Trademark Registry

Article 9 of Law N° 17.011 on Distinctive Signs establishes that: *"The right to a trademark is acquired by the proper application of said trademark in accordance with the present law. The application of a trademark states the presumption that the individual or corporation under whose name the application has been submitted is the legal owner"*.

In addition, article 11 of Law N° 17.011 establishes that: "The exclusive ownership of the trademark can only be acquired in relation to the products and services for which it was requested".

Therefore, for the Trademark Right to be properly protected, it is necessary that the following conditions are given: first, the existence of a sign with distinctive characteristics that will be applied to products and/or services of a given corporation or individual; second, the filing of said application of a sign before the relevant administrative authorities.

Our law also establishes in article 19 that: *"The use of a trademark is optional"*. Thus, neither for the acquisition nor the maintenance of an application, its use is a requirement. And therefore, there are no requirements to use the trademark in order to acquire and/or maintain the trademark registry.

1.3 Violations

The legal protection of a trademark is based in the existence of an exclusive right over certain signs in relation to their use in connection to the identification of certain goods and services. The so-called right over a trademark does not imply, however, the approval of a sign. On the contrary, it pre-supposes the right to avoid certain acts in relation to a sign, which is considered a trademark. Thus, the right to a trademark does not prevent the legality of a series of acts related to the voices that form that trademark: it can be mentioned in texts, they can be used by consumers, they can be exposed by sellers, etc.; as a consequence, it is necessary to determine which acts constitute a violation of the exclusive right to a trademark.

The starting point is that a trademark presents multiple functions: a distinction, an identification of origin, a guarantee of quality, it can be used in publicity, as a competitive product, as protection to the consumer, etc.

From this collection of functions, the essential one, from the legal point of view, is the quality of distinction, and the rest are a consequence of this one.

Law N° 17.011 on Distinctive Signs offers the following definition of a trademark: *“It is hereby meant by a trademark any sign with certain characteristics which distinguishes products and services which belong to a corporation or individual from those of others”*.

The use of a trademark “AS TRADEMARK” with its distinctive and essential characteristic, implies therefore the distinction of products and services which allow the consumers to make, and more importantly, to repeat the selection desired. This requires a “marked” product or service. On the other hand, it allows the manufacturer, businessman, etc., to differentiate and distinguish his product from of his competitors.

Therefore, there is a violation when a third party not authorized by the holder of the registry is using an identical trademark or one that can be confused with the registered trademark, for the same or similar products or services.

The sole fact that a third party acts as in one of the conducts described in articles 81, 82 and 83 of Law N° 17.011 which are stated below, grants the owner of the trademark the right to claim the discontinuation of the use of the other trademark and to start a lawsuit for damages.

Article 81. *If, with the objective of gaining profit or causing prejudice, a person uses, manufactures, falsifies, adulterates or imitates a trademark filed in the corresponding registry by another person, he will be punished with six months of imprisonment to three years of prison.*

Article 82. *The person that fills in containers with false products and other’s trademark, will be punished with six months of imprisonment to three years of prison.*

Article 83. *The person that knowingly manufactures, stores, distributes or markets goods with the trademarks referred to in the previous article, will be punished with three months of imprisonment to six years of prison.*

In summary, the Law does not distinguish the use of a trademark “AS TRADEMARK” from other types of use, as those derived from the distinctive function of the trademark, and therefore in our legislation, a violation occurs with the non-authorized use of the same or similar trademark susceptible of confusing the consumer.

2. **Is there any definition of what is use “as a mark” either in statute or case law?**
3. **Is there any difference in the assessment of use “as a mark” between the acquisition, maintenance and infringement of rights?**

In relation to the questions on legal definition of “THE USE OF A TRADEMARK AS A TRADEMARK”, it can be deduced that this means the essential distinctive function, because there is no legal definition in relation to the subject. It can also be deduced that there are no differences between the use of a trademark and the acquisition, maintenance and violation of rights.

4. **Is any of the following uses considered “use as a trademark”?**

4.1 *Internet use, as a metatag, for link or frame setting*

Internet - Domain Names

In the first place, it is necessary to evaluate how the mark in question is functioning in the Internet. For instance, we can clearly identify four functions:

- i) A merely informative function, which informs about its products or services in a web site which belongs to the trademark owner.
- ii) An active function, that is to say that its products and services are marketed and therefore made available to the public in its web site.
- iii) An advertising function in a web site other than the one of the trademark owner.

iv) A domain name.

Undoubtedly, in any of said functions the trademark is identifying a product or service and therefore it has a trademark function, but in view of the Internet's global scope, whether it is considered or not a trademark use in our country will eventually depend on the fact that the Uruguayan consumer can access such products and/or services.

The same analysis should be applied to the case of links and frames, since they serve the function described on item iii), that is to say that they are ways of advertising a trademark in a web site which does not belong to the trademark owner.

Metatags

Metatags are codes (which the user does not see) used by Internet search engines in order to identify the site the user is searching. For this purpose, companies use their main trademark or trademarks or the company's trade name as the main metatag. Therefore, since metatags identify and distinguish a company, and consequently its services and products, it can be stated that they are used as a trademark.

Likewise, some companies and web sites usually use another person's trademark (generally a notorious mark) as metatags in order to attract to its own web site the public whose intention was to enter the site of the owner of that trademark. This unauthorized use of another person's trademark can perfectly be the object of an action for trademark infringement.

General consideration

In conclusion, regarding the question whether the use of certain signs within the context considered above (Internet, domain name, link, metatags, frames) should or can be considered "use as a trademark", it should be taken into account that there is no legal regulation in our country on that issue and there is no case law related to the same. In view of the above, plus the fact that our legal system DOES NOT require the use of the trademark and that the right on the same is acquired by the mere registration, the question whether the use of a sign can be considered use as a trademark is not often raised.

Thus, it is difficult to establish a general rule in these cases, whereby we deem that it is more convenient to consider each case in particular.

4.2 *Use by fan clubs or supporters*

This kind of group uses a trademark in a particular way, firstly because the trademark implies the name (either real or artistic) of a "famous" person or group of people.

Generally these groups use a trademark with the previous authorization of its owner, under previously established specific conditions and for certain purposes.

These purposes are precisely the ones which should be considered and therefore we should study each case in particular, in order to determine whether there is use as a trademark and whether the trademark rights of the owner of the mark in question can be violated or not.

4.3 *Parody*

By parody we understand a burlesque imitation of something, and when this something is a registered trademark, it means that such mockery acts against the trademark. Our trademark law does not specifically contemplate this situation. However, section 81 states that the person who falsifies or imitates a trademark entered in the register belonging to other people in order to cause damage shall be punished by six months to three years imprisonment. In conclusion, the paradoxical use of another person's trademark shall have negative consequences for the offender.

4.4 *Comparative advertisement*

Our country's legal system accepts comparative advertisement, provided it is transmitted and spread in a way that the consumer can identify it as such (section 24, Law 17.250). Therefore, using the trademark within the context of comparative advertisement can be considered "use as a trademark".

5. If under national legislation the use as a trademark is limited to the traditional indications of origin or identity, are unconventional uses objectionable under trademark legislation or other laws (for instance, unfair competition or trading practice laws)?

Nothing prevents the person who acquired the trademark from using it either in a traditional or unconventional way. Thus, whatever the use the owner is giving to the trademark, it shall not be punished in any way whatsoever.

Third parties' unconventional uses of other people's trademarks shall be objectionable, as traditional uses are, with the previous complaint of the damaged party, who shall prove that his/her trademark rights have been violated due to this unconventional use.

6. If in order to establish a violation the traditional use as a trademark is required, are well-known, famous or notorious trademarks used for different products and services protected?

We believe they are. From the moment the registration of a trademark gives its owner the right of exclusive use and considering that our trademark Law does not distinguish between unconventional and traditional uses, such trademarks shall be protected, whatever their use. Besides, although this kind of trademarks does not have a specific protection system, a special inflexibility has been accepted in the doctrine and case law when assessing the potential infringements against them.

Report Q168

in the Name of the United States Group
by Clark W. LACKERT and David M. VISCOMI

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

Introduction

The United States of America has a flexible, expansive approach to the question of use of a mark "as a mark" in connection with trademark acquisition, maintenance, and enforcement. The limits of what can be considered proper trademark use have been expanded significantly in the internet and famous mark contexts, and the United States of America has a developed statutory and jurisprudential legal structure on these and related issues. Nevertheless, new media and the developing global economy have presented novel issues. While some appear easily recognizable when filtered through the lens of traditional doctrines, others have proven far more elusive and have challenged both the legislature and the judiciary to fashion new forms to address the concerns of mark owners.

1. Is there any requirement for use of a mark "as a mark" for the purposes of?

1.1 *Acquiring a mark (if rights may be acquired by use according to national law)*

Yes. In the United States of America, trademark rights arise out of use and registration. When registrations are based on the Paris Convention, enacted through Section 44 of the Trademark ("Lanham") Act, they do not require use before registration. For trademark rights to arise out of use (Lanham Act Section 1), they must be both "affixed" to the goods and services in some manner and used in interstate commerce, which we would interpret as use of a mark "as a mark".

Typical examples of trademark affixation are labels, hangtags, displays, or packaging for goods, and advertising or signage for services. As TMEP 905 states:

"The mode or manner by which a mark may be applied to goods is explained in §45 of the Trademark Act, 15 U.S.C. §1127, in the definition of "use in commerce." The section states that, for purposes of the Act, a mark shall be deemed to be in use in commerce on goods when "it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale...."

Once the mark's owner has "affixed" the mark to the goods and/or services he or she must demonstrate the use to the Examiner through submission of specimens. Based on the nature of the goods and/or services these specimens may vary. According to TMEP 905, they can:

"consist of samples of the material used for labeling the goods in trade, or of photographs of labeled goods in the trade channel. The type of material which is submitted as specimens will vary depending on the particular circumstances of each application. Specimens provide part of the basis for examination because they show the manner in which the mark is seen by the public, including

matter which appears in association with the mark in trade; specimens also provide supporting evidence of facts recited in the application. Regarding specimens for service marks, see 37 C.F.R. §2.58; TMEP §1301.04."

As was stated, registrations under the Paris Convention do not require a showing of use to mature to registration.

While a §44 applicant must assert a bona fide intent to use the mark in commerce, the applicant need not assert actual use in commerce prior to registration if the application is based solely on §44. In addition, the applicant in such a case need not specify any mode or manner of use of the mark in connection with the goods or services. See *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909 (TTAB 1984); TMEP §1009.03.

Moreover, TMEP 905.04(c), offers guidance as to the types of specimens that will meet the "affixation" requirement. Specifically, this section states:

"The terminology "applied to the containers for the goods" means applied to any type of commercial packaging which is normal for the particular goods as they move in trade. Thus, a showing of the mark on the normal commercial package for the particular goods would be acceptable as a specimen. For example, gasoline pumps are normal containers or "packaging" for gasoline, but machinery for retreading tires is not normal "packaging" for tires. See *Heintz v. American Tire Machinery Co.*, 54 USPQ 105, 107, 328, 329, 510 (Comm'r Pats. 1942). The following cases illustrate instances in which dispensing containers and transporting vehicles for the goods are not proper as specimens: *In re Lyndale Farm*, 186 F.2d 723, 88 USPQ 377 (C.C.P.A. 1951); *Ex parte Chicago Towel Co.*, 99 USPQ 480 (Comm'r Pats. 1953); *In re Webcor, Inc.*, 122 USPQ 97 (TTAB 1959). However, use of the mark on a vehicle, or in a similar fashion, may constitute use of the mark on the goods if this is the normal mode of use for that commodity. *In re E.A. Miller & Sons Packing Co., Inc.*, 225 USPQ 592 (TTAB 1985). In TMEP 905.04(d), specimens for trademarks identifying computer programs, movies or video tapes are reviewed. This section states: "The computer program, video tape and movie industries have adopted the practice of applying trademarks to their goods in such a manner that the marks are visible only when the programs or movies are displayed on a screen (perhaps, for example, on the first several frames of a movie). A photograph of a display screen projecting the identifying trademark of a computer program or a photograph of a frame or frames of a movie or video tape bearing the mark sought to be registered should be acceptable as evidence of trademark use. It is not a prerequisite to acceptability of specimens that purchasers be able to see the mark prior to purchase of the goods. *In re Brown Jordan Co.*, 219 USPQ 375 (TTAB 1983) (stamping the mark after purchase of the goods, on a tag attached to the goods, which thereafter are transported in commerce, held sufficient). (Note: The specimen issue is a different issue from the registration requirement that a mark be used in commerce in relation to goods or services.)"

As will be discussed later, an important difference between the requirements for registration and those for maintenance of an infringement action is that, advertising is not acceptable for establishing trademark rights. As TMEP 905.05, states:

"Advertising material is generally not acceptable as specimens for goods. Any material whose function is merely to tell the prospective purchaser about the goods, or to promote the sale of the goods, is unacceptable to support trademark use. Similarly, information or instruction sheets are generally not acceptable for showing trademark use. *In re Schiapparelli Searle*, 26 USPQ2d 1520 (TTAB 1993); *In re Drilco Industrial Inc.*, 15 USPQ2d 1671 (TTAB 1990); *In re ITT Rayonier Inc.*, 208 USPQ 86 (TTAB 1980); *In re*

Bright of America, Inc., 205 USPQ 63 (TTAB 1979). But see *In re Ultraflight Inc.*, 221 USPQ 903 (TTAB 1984).”

Additionally, Professor J. Thomas McCarthy states in his famous treatise: “The manner of use, or physical affixation of a trademark to a product, must be viewed against the overall Section 45 definition of “use in commerce” which became effective November 16, 1989. This definition establishes the standard for the volume of commercial use of the mark which must be made, as distinguished from the means of applying the mark to the product. “Use in commerce” means, under Section 45, “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” McCarthy, *Trademark Protection and Practice*, Vol. 1 Sec. 3.02, Matthew Bender Publishing, 2000.

In summary, good faith commercial use, not mere token use, is required to support registration and acquisition of trademark rights.

1.2 *Maintaining of a trademark registration (e.g., against an application for cancellation on grounds of non-use)*

Yes. The U.S. law on maintaining a registration is the same as the law on acquiring rights, namely, the mark must be used “as a mark” and must be affixed to the goods or services in the manner prescribed by law. Under the Lanham Act, as amended in 1988, the trademark owner must make bona fide use of the mark in commerce to prevent a cancellation action on the basis of non-use. The Act provides a rebuttable presumption that the mark has been abandoned if a party can show that it has not been used for three (3) consecutive years.

1.3 *Establishing infringement*

Sometimes. The standards for establishing infringement are broader than those for establishing or maintaining trademark rights since the test will always be likelihood of consumer confusion. Once the focus of the inquiry shifts from the requirements of the U.S. Trademark Office to a question of consumer perception the judicial system is free to consider many factors, among them are the mark’s strength and the mark owner’s investment in promotion of the mark. See e.g. *New West Corp. v. NYM Co. of California, Inc.*, 595 F.2d 1194 (9th Cir. 1979).

2. **Is there any definition of what is use “as a mark” either in statute or case law?**

Yes, since use of a mark “as a mark” in use of a mark is lawful trademark use. Section 45 of the Trademark Act, 15 U.S.C. §1127, defines “commerce” as “all commerce which may lawfully be regulated by Congress.” Section 45 defines “use in commerce” as follows:

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce:

- 1) on goods when:
 - a) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and
 - b) the goods are sold or transported in commerce, and
- 2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

This strict definition of “use in commerce” applies to all applications, affidavits of use and renewals filed on or after November 16, 1989, the effective date of the Trademark Law Revision Act of 1988, Public Law 100-667, 102 Stat. 3935. Cf. *Ralston Purina Co. v. On-*

Cor Frozen Foods Inc., 746 F.2d 801, 223 USPQ 979 (Fed. Cir. 1984). See, TMEP Sec. 901.01.

For use on a display to count as use of a mark it must predominantly display the mark in question and associate it with, or relate it to, the goods or services. Further, the design of the display should be intended to catch the attention of consumers as an inducement to consummate a sale. Even if the goods are not placed in close proximity to the display their relationship should be such that consumer association of the two is inevitable. See, TMEP sec. 905.06; In re Bright of America, Inc., 205 USPQ 63 (TTAB 1979), and cases cited therein. See also In re ITT Rayonier Inc., 208 USPQ 86 (TTAB 1980). Cf. In re Shipley Co., 230 USPQ 691 (TTAB 1986); In re Jones, 216 USPQ 328 (TTAB 1982).

The definition of “displays” does not, per se, include folders and brochures describing goods and their characteristics or serving as advertising literature. In re Schiapparelli Searle, 26 USPQ2d 1520 (TTAB 1993); In re Drilco Industrial Inc., 15 USPQ2d 1671 (TTAB 1990). In order to rely on such materials as specimens, an applicant must submit evidence of point-of-sale presentation. See In re Ancha Electronics Inc., 1 USPQ2d 1318 (TTAB 1986); In re Columbia Chase Corp., 215 USPQ 478 (TTAB 1982). See TMEP §905.06(a) regarding the criteria by which a catalog or other advertising may constitute a display associated with the goods. See TMEP, sec. 905.06.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

Yes. As was stated in the answer to Question 2, use of a mark is more broadly assessed when considering likelihood of confusion in an infringement issue. For example, use in respect of advertising and promotional materials may be “tacked on” to use of a mark as “affixed” to the goods to provide the plaintiff in an infringement action a more advantageous position. The same use, however, will not be considered by the Trademark Office for the purposes of achieving registration. Section 32(1) of the Lanham Act expressly includes advertising among its forms of actionable infringement, prohibiting use of a “reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the ... advertising of any goods or services,” where it is likely to cause confusion.

On the other hand, use which may support a registration may not be considered sufficient to maintain an action for infringement. While the test for registration of a mark requires trademark use to be both in interstate commerce and directly affixed to the goods, there is no requirement as to the scope of the use. Thus a company which has mailed its product to a single customer in another state could achieve a registration based on that use, yet they would encounter difficulty in an infringement action due to the public’s minimal exposure to the mark. See, Procter & Gamble Co. v. Johnson & Johnson Inc., 485 F. Supp. 1185, 205 U.S.P.Q. 697 (S.D.N.Y. 1979), *aff’d* without opinion, 636 F.2d 1203 (2d Cir. 1980).

4. Is any of the following considered to be use "as a mark"?

4.1 Use on the internet, as a metatag, in linking or framing

Metatags: Yes. These are key words embedded in a website’s HTML source code. When conducting a search on the Web, a search engine reviews, among other things, a websites metatags to assess whether the key words are related to the search terms. When a match is found it is listed by the search engine as a search result or “hit” to be examined by the person conducting the search. While metatags undoubtedly serve a useful purpose and are commonly used in websites, they are also subject to abuse. For instance, there have been a number of instances in which a competitor to a particular business has placed its competitor’s trademarks in their website’s metatags. The competitor’s obvious intent is to appear on a list of results together with the other sites and thereby get noticed, and possibly also direct traffic away from the legitimate site and toward the competitor’s site. This is not to state that a third party may never use trademarks in their metatags. A “fair use” doctrine does exist (it applies to use of a mark in its non-trademark sense, such as “my friend has a WHIRLPOOL dishwasher,” or to certain limited legitimate uses such as comparative advertising, for example “the WHIRLPOOL dishwasher is better than the KITCHENAID dish-

washer”) but its applicability varies with the surrounding circumstance and it should not be assumed to apply.

There is a growing body of cases in the United States that recognizes that such use of a party’s trademark in connection with a website’s metatags constitutes trademark infringement under a theory of liability known as “initial interest confusion.” Under this doctrine a party can be held liable for trademark infringement for using a competitor’s trademark in order to direct the public to the party’s site even if the public immediately realizes it is not in the right website and there is no risk of confusion. See *New York State Society of Certified Public Accountants v. Eric Louis Assocs. Inc.*, 79 F. Supp.2d 331 (S.D. N.Y. 12/2/99). (Court found that initial interest confusion existed where defendant used plaintiff’s acronym in its domain name and metatags in its web site. Defendant established nysscpa.com, while plaintiff’s site was nysscpa.org. Court noted that acronym had no relationship to defendant’s business, and its use appeared to be a deliberate attempt to divert traffic from the society’s web site to the company’s.) See also, *N.V.E. v. Hoffman-La Roche*, 1999 U.S. Dist. LEXIS 20204 (D. N.J., Dec. 27, 1999); *SNA Inc. v. Array et al*, No. CIV A 97-7158 (E.D. Pa., June 9, 1999) (Court enjoined use of plaintiff’s trademarked name in metatags embedded in defendants’ web sites, based on showing of intent to confuse Internet users and harm plaintiff’s businesses. Distinguished other cases finding metatags to be legitimate indexing tool on factual grounds); *Playboy Enterprises Inc. v. Calvin Design Label*, 985 F. Supp. 1220 (C.D. Cal. 9/8/97) (Injunction issued against Web site operators who used plaintiff’s registered trademarks PLAYBOY and PLAYMATE in domain names, in Web site text, and in metatags); *Brookfield Communications v. West Coast Entertainment Corp.*, No. 98-56918 (9th Cir., April 22, 1999). (Court ordered the defendant to cease using the plaintiff’s registered mark “moviebuff” in its meta tags). *But See, Playboy Enterprises v. Welles*, 47 U.S.P.Q.2d (BNA) 1186, 7 F.Supp.2d 1098, 1998 U.S. Dist. LEXIS 9180 (S.D. Cal. 5/18/98) (Playboy’s motion for preliminary injunction against former Playmate Terri Welles’s Web site denied). Pleadings may be found at:
<<http://www.pmdlaw.com/playboywellesdocs.htm>>.

Linking: Sometimes. This is the practice of placing a link from one’s own webpage to another’s site. Most often, these links are directed to another site’s homepage. Generally speaking, this use is fairly commonplace and generally considered to be acceptable. Nevertheless, it could raise liability issues as the linker has control over the presentation of the linkee’s site. This assumption of control, if abused, could rise to an actionable level. Further, one author has suggested that it may be considered the creation of a derivative work. See, “Intellectual Property Counseling & Litigation” Lester and Ethan Horwitz, Part II A sec. 13.10. More controversial, is the practice of providing links to a site other than a homepage - so called deep-linking. This practice has the effect of bypassing the homepage, the site provider’s policies and terms of use, and as a result, the site’s sponsor or creator may remain unknown to the viewer. This is particularly pertinent in the unfair competition arena as it creates issues of both “passing-off” and “reverse passing-off.” As a result of deep-linking, an internet user may find him or herself viewing pages written by an unannounced author or the user may believe that the content originated with the site that provided the link.

While this area has generated a few cases to date, none have provided a definitive guide from which the risks of infringement can be evaluated. In *Ticketmaster Corp. v. Tickets.com*, 2000 U.S. Dist. LEXIS 12987, Copy. L. Rep. (CCH) P28146 (C.D. Cal., August 10, 2000) (No. CV99-7654-HLH (BQRx)) (unpublished opinion), Ticketmaster alleged that Tickets.com provided “thousands” of links to pages deep within Ticketmaster’s site. Notably, Ticketmaster’s claims under the law of unfair competition for “passing off” and “reverse passing off” survived Tickets.com’s motion for dismissal and, as yet, remain adjudicated. Nevertheless, the ruling by Judge Hupp included a statement that, “deep linking by itself (i.e. without confusion of source) does not necessarily involve unfair competition.” While far from a definitive statement on the topic, this reminds us that these are intensely fact-driven situations and a prospective deep linker should be aware that their actions may be confusing to the public and therefore, actionable under U.S. law.

Framing: Sometimes. This occurs when a website is viewed in one section of a webpage which is otherwise dominated by content under the framer's control. This practice allows the controlling site to frame a page with anything from its own trademarked content to the banners of advertisers who pay the controller for their presence. This wrests control over the framed site's presentation and content from its original presenter. While this type of use can be considered fair use in certain contexts, it could also constitute infringement, dilution or a violation of the law of unfair competition. In particular this practice runs the risk of creating confusion as to source, sponsorship or affiliation. Further, there is a risk of blurring or tarnishment, traditional forms of dilution. Finally, a framer may be guilty of either "passing off" or "reverse passing off". As yet this a largely undeveloped area of law and it is difficult to predict how either the courts or the legislature will come to treat framing. As with metatags and linking, framing is one of the new issues raised by an emerging medium and there is no telling how custom and usage will come to inform the developing legal debate.

4.2 Use by fan clubs or supporters

Yes. It is accepted that the presence of trademarks and service marks have an impact on the culture and style of the populous to whom they are exposed. For many people worldwide MCDONALD'S famed arches symbolize more than a fast food chain, they represent the American way of life. Marks such as COCA-COLA, STAR TREK, and PORSCHE are also bought or used to express identification with a product or the lifestyle they have come to represent. Even educational institutions market their names to people other than alumni who desire to identify with an institution. Simply put, trademarks have become as much a part of the cultural dialogue as celebrities themselves. As trademark owners create associations between marks and cultural values, it is only logical to assume that once the associations are established they will be reassumed by society as symbols of those values originally targeted by the mark's owners. This charges the marks with an expressive significance which must be respected as any other form of speech.

Despite the fact that fan usage of trademarks as expressive elements, even when it was for profit, had been the province of third-parties, consumer awareness of "the intervening phenomenon of licensing, franchising, brand extensions, brand leveraging, co-branding, umbrella brands and reach brands,"¹ has grown in recent years. Now purchasers of these products are more likely to assume that there is a connection between the trademark owner and any products bearing the mark.

The assumption of sponsorship, affiliation or endorsement has shifted the responsibility for the appearance of a brand back to its originators. Along with this phenomenon there came acceptance of the idea that that third-party, unauthorized marketers should not be entitled to profit from that which could otherwise be licensed. Courts thus routinely reject efforts "to capitalize on the good will created by the tremendous expenditure in advertising [and effort] by [a] plaintiff."² Thus, actual merchandising, such usage on t-shirts, bumper stickers and mugs, for example, is the accepted province of the trademark owner.

As a consequence of these transitions, Courts have had an increasingly difficult time drawing the line between fair use and actionable infringement or dilution. With fan or club usage, the Court's have to balance both the trademark owner's interest in its mark against the free speech rights of the mark's users. Invariably, the intent of the third-party in assuming the mark, the possibility of third-party profit from that use and diligence of the trademark owner in protecting the mark will all factor heavily in the Court's determination as to whether the use has been "fair" or not.

¹ Jerre B. Swann, Sr., *Dilution Redefined for the Year 2000*, 90 Trademark Rep. 823, 835 (2000).
² *Chemical Corp. of America v. Anheuser-Busch, Inc.*, 306 F.2d 433, 437 (5th Cir. 1962); see also *University of Georgia v. Laite*, 756 F.2d at 1545-46; *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 35 (1st Cir. 1989); *Rolls-Royce Motors Ltd. v. A&A Fiberglass, Inc.*, 428 F. Supp. 689, 695 (N.D.Ga. 1976)

In the final determination the Lanham Act should prove particularly useful when the “fan usage” is actually an attempt to profit from the good will already established by the trademark owner. When profit is not the motive, the trademark owner may find a greater measure of success when the “fan” usage is destructive to the reputation which mark’s owner have acted to build. “The trademark laws are designed not only to prevent consumer confusion but also to protect ‘the synonymous right of a trademark owner to control his product’s reputation.’”³

In this case, therefore, Judge Learned Hand’s classic formulation is particularly apt:

[An owner’s] mark is his authentic seal; by it he vouches for the goods which bear it; it carries his name for good or ill. If another uses it, he borrows the owner’s reputation, whose quality no longer lies within his own control. This is an injury, even though the borrower does not tarnish it, or divert any sales by its use; for a reputation, like a face, is the symbol of its possessor and creator, and another can use it only as a mask.⁴

While trademark owners have both legitimate concerns about and strong weapons to respond to misuse by fan or clubs, legitimate usage and free expression will necessarily play an important part in the development of this area of trademark law.

4.3 Parody

Sometimes. In parody, which is not a defense to infringement but rather a factor to be considered in the likelihood of confusion analysis, there is no claim that the parodist is not using the mark as a mark. Rather, the mark is used as a mark but it is claimed that there is no likelihood of confusion because the use must be seen as a “joke” or promoting a free speech message.

Defendants will likely maintain that their product is a parody. “In a traditional trademark infringement suit founded on the likelihood of confusion rationale, the claim of parody is not really a separate ‘defense’ as such, but merely a way of phrasing the traditional response that customers are not likely to be confused as to source sponsorship or approval.” *Sheffield & Co. v. The Jack Company of Boca*, 725 F.Supp. 1314, 1323 (S.D.N.Y. 1989) (citations omitted). “A parody must convey two simultaneous - and contradictory - messages: that it is the original, but also that it is not the original and is instead a parody. To the extent that it does only the former but not the latter, it is not only a poor parody but also vulnerable under trademark law, since the customer will be confused.” *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.*, 886 F.2d 490 (2d Cir. 1989).

An important element to a claim of parody is the ability to prove that the criticism was directed to the company or person whose mark was appropriated. “The heart of any parodist’s claim to quote from existing material [] is the use of some elements of a prior author’s composition to create a new one that, at least in part, comments on that author’s works.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580, 127 L.Ed. 2d 500, 114 S. Ct. 1164 (1994). The parody must have some, “critical bearing on the substance or style of the original composition.” *Id.* Thus, it is insufficient for one to merely claim that the use of another’s trademark was merely an exercise of the First Amendment right to criticism if the criticism is not directed to the appropriated trademark or trademarked product.

The courts are not unfamiliar with infringers who claim their products are protected as parody. In *Bacardi & Co. Ltd. v. New York Lighter Company, Inc.*, 2000 U.S. Dist. LEXIS 19852, the defendants attempted to create a comic version of plaintiff’s BACARDI bottle and label design and market it as a lighter. The court, in entering the permanent injunction, noted that defendants had, “merely use[d] the protected mark and label design, albeit in an

³ *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979).

⁴ *Yale Electric Corp. v. Robertson*, 26 F.2d 972, 974 (2d Cir. 1928).

arguably humorous manner, to promote defendants' product." *Id.*, at *33. See also, *Harley-Davidson v. Ronald Grottanelli*, 164 F.3d 806, 813 (2d Cir. 1999); *Hard Rock Café Licensing Corp. v. Pacific Graphics, Inc.*, F.Supp. 1454, 1462 (W.D. Wash. 1992).

When the parodist's work is evaluated under the likelihood of confusion standard, the Court is empowered to consider both pre-sale confusion and post-sale confusion. In the first instance the Court must examine the reaction of the initial consumer who encounters the product as it is offered for sale. Here the concern is that the consumer, viewing the product or service as sold, is likely to be confused as to the source or origin of the parody or to assume that trademark owner has endorsed or licensed the competing product or service. In the latter case, the Court examines whether the product as used will be likely to confuse consumers. Thus, one can imagine a product which is clearly labeled on it's face so as to eliminate the possibility of in store confusion but, once separated from its packaging and in store displays is nevertheless likely to confuse its viewers.

4.4 Comparative advertising

Sometimes. Comparative advertising is liberally permitted in the United States as long as the use involves telling the truth in a truthful way about the differences in the goods or services. The reason for this policy is that it is seen as beneficial to the consumer to be well-informed as to aspects and pricing of the competitors' goods and services. However, Section 43(a) of the Lanham Act is the tool to fight false comparative advertising. See, e.g., *Tyco Industries v. Lego Systems*, 853 F. 2d 921 (3d Cir. 1988).

Although there are advertising restrictions for specific lawful goods and services in the United States, the overall regulatory scheme has been conducted through a self-regulation model as opposed to a government regulation model. The main reason for this approach is the long-standing U.S. tradition of free enterprise and free speech as embodied in the U.S. Constitution, which in its First Amendment protects freedom of speech. This protection has not been limited to public discourse on political issues and extends to advertising as well.

The strong judicial support for the First Amendment is best stated by the late U.S. Supreme Court Justice Oliver Wendell Holmes, who said in 1919, "I think that we should be eternally vigilant against attempts to check the expression of opinions that we loathe..." *Abrams v. United States*, 250 U.S. 616, 630 (1919). In the landmark case of *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748 (1976), the U.S. Supreme Court clearly established advertising as a form of "commercial speech" to be protected under the U.S. Constitution. As the court stated, "Advertising, however tasteless and excessive it sometimes may seem, is nonetheless dissemination of information as to who is producing and selling what product, for what reason, and at what price." 425 U.S. at 765. The U. S. Supreme Court set forth a four-part "commercial speech" test in *Central Hudson Gas & Electric Corp. v. Public Service Com.*, 447 U.S. 557 (1980) to determine whether the appropriate balance was created between the individual's right to free speech and the government's right to regulate commerce. The *Central Hudson* test is: (1) the speech must be non-misleading and concern lawful activity, (2) the government must assert a substantial interest, (3) the government interest must be directly enhanced by the regulation, and (4) the regulation must not be more extensive than is necessary. This four-part test is still applied, including in recent commercial speech cases such as *44 Liquormart v. Rhode Island*, 517 U.S. 484 (1996). Accordingly, in the U.S., the presumption is clearly in favor of the advertiser (trademark owner), not the regulator (government).

The self-regulation model followed in the U.S. permits advertisers to police their own conduct, and is conducted in many organizations, at many levels. One of the best known examples of self-regulation is the Better Business Bureau (BBB), which operates a National Advertising Division (NAD) and a National Advertising Review Board (NARB). These quasi-administrative bodies operated by a neutral, non-profit entity have been quite successful in the area of self-regulatory dispute resolution. Moreover, television networks have their own advertising review procedures which must be completed before an advertisement is aired.

The principal U.S. agency which regulates all advertising is the Federal Trade Commission (FTC) pursuant to its authority in the FTC Act, and in particular, Section 5 of such Act (15 U.S.C. § 45). The FTC reviews advertising for issues of (1) unfairness, (2) deception, and (3) substantiation to ensure that commercial advertising is not deceptive or misleading. Many states also have consumer protection agencies, sometimes called "Little FTCs", which protect consumers at the state level. Section 43(a) of the Trademark Act (15 U.S.C. §1125(a)) allows private action by prohibiting commercial advertising or promotion which "misrepresents the nature, characteristics, qualities, or geographic origin" of the goods, services, or commercial activities. Section 43(a) has become a powerful tool for competitors to fight false and misleading advertising generally.

5. If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trademark or other laws (e.g., unfair competition or trade practice laws).

As was noted above, the United States of America recognizes various forms of use.

6. If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

Yes, there is significant famous trademark protection in the United States.

Dilution law was based entirely upon state statutory and common law until 1996. The Federal Trademark Dilution Act of 1995 (the "Act") was intended to rectify this gap in trademark protection. Prior to the Act's effective date of January 16, 1996, famous marks such as COCA-COLA, KODAK, EXXON, DUPONT or MCDONALD'S, were only accorded protection under state and common law. Since then, Section 43(c) has provided a non-exclusive list of factors relevant to a determination of whether a mark is famous. The factors are: (A) the degree of inherent or acquired distinctiveness of the mark; (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (C) the duration and extent of advertising and publicity of the mark; (D) the geographical extent of the trading area in which the mark is used; (E) the channels of trade for the goods or services with which the mark is used; (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owners and the person against whom the injunction is sought; (G) the nature and extent of use of the same or similar marks by third parties; and (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register. 15 U.S.C. §1125(c)(1).

The Act provides that "[t]he owner of a famous mark shall be entitled...to an injunction against another person's commercial use of a mark or trade name if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark."⁵ Dilution is recognized in the U.S. under two main approaches, namely, i) "blurring" which waters down the strength of a famous mark and, ii) "tarnishment" which causes a famous mark to become associated with unsavory good or services.

One of the best-known examples of dilution by tarnishment under state and common law is the ENJOY COCAINE case. See, *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F.Supp. 1183 (S.D.N.Y. 1998). There the defendant claimed that its sale of posters reading ENJOY COCAINE in a script and color identical to that used by COCA-COLA was only a satirical spoof of COCA-COLA. The court granted a preliminary injunction based on both trademark infringement and dilution. Emphasizing the damage to the reputation of the COCA-COLA trademark caused by an unwholesome association with an illegal drug, the court remarked that: "[A] strong probability exists that some patrons of COCA-COLA will be "turned off" rather than "turned on" by defendant's so-called "spoof" [P]laintiff's good will and business reputation are likely to suffer in the eyes of those who, believing it responsible for defendant's poster, will refuse to deal with a company which could seek commercial advantage by treating a dangerous drug in such jocular fashion." *Id.* at 1191. In *Hormel Foods*

⁵ 15 U.S.C. 1125(c)(1)

Corp. v. Jim Henson Productions, Inc.⁶, one of the first cases involving the Federal Trademark Dilution Act, the Second Circuit held that a movie producer's use of the character SPA'AM did not infringe the famous mark SPAM used for luncheon meat. Apparently, the use of a famous mark on cartoon character by Defendant did not rise to the level of tarnishment that was found in the ENJOY COCAINE case. However, the Second Circuit and Southern District have enjoined other marks which were found to dilute fish shaped GOLD-FISH brand crackers and the NBA silhouetted running logo.

Conclusion

The United States of America, perhaps more than most countries, has had extensive experience with new forms of trademark use, particularly in the internet area. Although the rules on trademark acquisition and maintenance are fairly conservative in that they require affixation, the infringement standards are broad. National trademark and service mark provisions accept use on the internet provided it incorporates traditional trademark functions of indications of origin or quality, sponsorship or endorsement. Trademark misuses in the internet can be addressed through the laws of infringement, dilution and unfair competition under Section 43(a) of the Lanham Act, or general common law principles of misappropriation and business torts such as trade libel or injury to reputation. The U.S. system creates a balanced approach to protecting trademark rights while at the same time protecting other important rights such as freedom of speech. This framework has worked well in the past and will become even better as U.S. law adapts to new technologies and new commercial realities in a global marketplace.

Summary

The United States of America has a flexible, expansive approach to the question of use of a mark "as a mark" in connection with trademark acquisition, maintenance, and enforcement. The limits of what can be considered proper trademark use have been expanded significantly in the internet and famous mark contexts, and the United States of America has a developed statutory and jurisprudential legal structure on these and related issues. Nevertheless, new media and the developing global economy have presented novel issues. While some appear easily recognizable when filtered through the lens of traditional doctrines, others have proven far more elusive and have challenged both the legislature and the judiciary to fashion new forms to address the concerns of mark owners.

In the United States of America, trademark rights arise out of use and registration. When registrations are based on the Paris Convention, enacted through Section 44 of the Trademark ("Lanham") Act, they do not require use before registration. For trademark rights to arise out of use (Lanham Act Section 1), they must be both "affixed" to the goods and services in some manner and used in interstate commerce, which we would interpret as use of a mark "as a mark". Typical examples of trademark affixation are labels, hangtags, displays, or packaging for goods, and advertising or signage for services.

The U.S. law on maintaining a registration is the same as the law on acquiring rights, namely, the mark must be used "as a mark" and must be affixed to the goods or services in the manner prescribed by law. Under the Lanham Act, as amended in 1988, the trademark owner must make bona fide use of the mark in commerce to prevent a cancellation action on the basis of non-use. The Act provides a rebuttable presumption that the mark has been abandoned if a party can show that it has not been used for three (3) consecutive years.

The standards for establishing infringement are broader than those for establishing or maintaining trademark rights since the test will always be likelihood of consumer confusion. Once the focus of the inquiry shifts from the requirements of the U.S. Trademark Office to a question of consumer perception the judicial system is free to consider many factors, among them are the mark's strength and the mark owner's investment in promotion of the mark.

⁶ 73 F.3d 497 (2d Cir. 1996)

Use of a mark is more broadly assessed when considering likelihood of confusion in an infringement issue. For example, use in respect of advertising and promotional materials may be “tacked on” to use of a mark as “affixed” to the goods to provide the plaintiff in an infringement action a more advantageous position. The same use, however, will not be considered by the Trademark Office for the purposes of achieving registration. Section 32(1) of the Lanham Act expressly includes advertising among its forms of actionable infringement, prohibiting use of a “reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the ... advertising of any goods or services,” where it is likely to cause confusion. On the other hand, use which may support a registration may not be considered sufficient to maintain an action for infringement. While the test for registration of a mark requires trademark use to be both in interstate commerce and directly affixed to the goods, there is no requirement as to the scope of the use. Thus a company which has mailed its product to a single customer in another state could achieve a registration based on that use, yet they would encounter difficulty in an infringement action due to the public’s minimal exposure to the mark. In the internet uses of metatags, linking, and framing, trademark infringement and/or unfair competition can definitely occur, depending upon the circumstances. In parody, which is not a defense to infringement but rather a factor to be considered in the likelihood of confusion analysis, there is no claim that the parodist is not using the mark as a mark. Rather, the mark is used as a mark but it is claimed that there is no likelihood of confusion because the use must be seen as a “joke” or promoting a free speech message.

Comparative advertising is liberally permitted in the United States as long as the use involves telling the truth in a truthful way about the differences in the goods or services. The reason for this policy is that it is seen as beneficial to the consumer to be well-informed as to aspects and pricing of the competitors’ goods and services. However, Section 43(a) of the Lanham Act is the tool to fight false comparative advertising.

Famous marks are extensively protected in the United States. Dilution law was based entirely upon state statutory and common law until 1996. The Federal Trademark Dilution Act of 1995 (the “Act”) was intended to rectify this gap in trademark protection. Prior to the Act’s effective date of January 16, 1996, famous marks such as COCA-COLA, KODAK, EXXON, DUPONT or MCDONALD’S, were only accorded protection under state and common law. Since then, Section 43(c) has provided a non-exclusive list of factors relevant to a determination of whether a mark is famous. The factors are: (A) the degree of inherent or acquired distinctiveness of the mark; (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (C) the duration and extent of advertising and publicity of the mark; (D) the geographical extent of the trading area in which the mark is used; (E) the channels of trade for the goods or services with which the mark is used; (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks’ owners and the person against whom the injunction is sought; (G) the nature and extent of use of the same or similar marks by third parties; and (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register. 15 U.S.C. §1125(c)(1).

The United States of America, perhaps more than most countries, has had extensive experience with new forms of trademark use, particularly in the internet area. Although the rules on trademark acquisition and maintenance are fairly conservative in that they require affixation, the infringement standards are broad. National trademark and service mark provisions accept use on the internet provided it incorporates traditional trademark functions of indications of origin or quality, sponsorship or endorsement. Internet trademark misuses can be addressed through the laws of infringement, dilution and unfair competition under Section 43(a) of the Lanham Act, or general common law principles of misappropriation and business torts such as trade libel or injury to reputation. The U.S. system creates a balanced approach to protecting trademark rights while at the same time protecting other important rights such as freedom of speech. This framework has worked well in the past and will become even better as U.S. law adapts to new technologies and new commercial realities in a global marketplace.

Résumé

Aux Etats-Unis, la question de l'usage d'une marque «en tant que marque» en vue de l'acquisition des droits, leur maintien et leur protection fait l'objet d'une approche flexible et expansive. Les limites de ce qui peut être considéré comme un usage valable d'une marque ont été étendues de façon significative, à l'aide d'une structure légale et jurisprudentielle, dans le contexte de l'Internet et des marques notoires. Cependant, les nouveaux médias et le développement d'une économie globale ont fait apparaître de nouveaux problèmes. Alors que certains paraissent pouvoir être résolus aisément à l'aide des concepts traditionnels, d'autres sont apparus beaucoup plus insaisissables et ont forcé l'élaboration de nouvelles règles -tant légales que jurisprudentielles- afin de répondre aux attentes des titulaires de marques.

Aux Etats-Unis, les droits naissent de l'usage et de l'enregistrement. Lorsqu'une marque est enregistrée sur base de la Convention de Paris, introduite dans l'ordre juridique par l'article 44 du Trademark (Lanham)Act, l'usage préalable à l'enregistrement n'est pas requis. En revanche, lorsque les droits naissent par l'usage (article 1 du Lanham Act), la marque doit être apposée sur des biens et des services et utilisée dans le commerce inter-états, ce que l'on peut considérer comme l'usage d'une marque «en tant que marque». Des exemples typiques d'apposition d'une marque sont les étiquettes, affichages, emballages pour des produits ou publicité pour des services.

Les règles relatives au maintien des droits sont identiques à celles relatives à leur acquisition, à savoir que la marque doit être utilisée «en tant que marque» et doit être apposée sur les produits et les services de la façon prescrite par la loi. Le Lanham Act, tel qu'amendé en 1988, précise que le titulaire de la marque doit faire un usage de bonne foi de celle-ci dans le commerce pour éviter une action en annulation pour cause de non-usage. Une marque dont il n'a pas été fait usage pendant trois années consécutives est présumée, de façon réfragable, avoir été abandonnée.

L'évaluation de l'usage est plus large lorsqu'il s'agit de déterminer, dans un cas de contrefaçon, s'il y a un risque de confusion. Par exemple, l'usage d'une marque dans une publicité et dans du matériel promotionnel pourra être pris en considération afin de donner une position plus avantageuse au titulaire de la marque. En revanche, un tel usage ne pourra être pris en considération par le Trademark Office aux fins d'enregistrement. L'article 32 du Lanham Act inclut en effet précisément la publicité dans les formes possibles de contrefaçon. Cette disposition interdit en effet «la reproduction, contrefaçon, copie ou imitation colorée d'une marque enregistrée pour la publicité de tout produit ou service», lorsqu'un tel usage est de nature à créer une confusion. D'autre part, un usage suffisant pour faire naître des droits peut être considéré comme insuffisant pour servir de base à une action en contrefaçon. En effet, l'enregistrement d'une marque requiert que celle-ci soit apposée sur des produits et utilisée dans le commerce inter-états mais il n'y a pas d'exigence quant à la portée de cet usage. Dès lors, une société qui aurait envoyé un de ses produits à un seul consommateur dans un autre état pourrait obtenir l'enregistrement de sa marque mais rencontrerait des difficultés à poursuivre sa contrefaçon à cause de l'exposition minimale de la marque auprès du public. En cas d'usage de la marque à titre de metatag, linking et framing il peut certainement y avoir contrefaçon de la marque et/ou concurrence déloyale, selon les circonstances. Dans le cas de la parodie, qui ne constitue pas un moyen de défense contre la contrefaçon mais plutôt un facteur à considérer dans l'analyse du risque de confusion, l'on considère que la marque est utilisée en tant que marque mais qu'il n'y a pas de risque de confusion parce que l'usage doit être considéré comme une blague ou comme promotion pour un message basé sur la liberté d'expression.

La publicité comparative est autorisée aux Etats-Unis dans la mesure où il est fait usage de la marque pour énoncer de façon véridique des différences entre des produits ou services. La ratio legis est que l'on considère qu'il est bénéfique pour le consommateur d'être bien informé quant aux caractéristiques et prix des biens et services.

Les marques notoires sont protégées de façon extensive aux Etats-Unis, jusqu'en 1996 uniquement sur base de lois des états et du common law . Le Federal Trademark Dilution Act de 1995 avait pour objectif de combler cette lacune . Avant l'entrée en vigueur de la nouvelle loi le 16 janvier 1996, les marques notoires telles que COCA-COLA, KODAK, EXXON, DUPONT ou MCDO-

NALD'S n'étaient protégées que par des lois des états et le common law. Depuis lors, l'article 43(c) a établi une liste non-exclusive de facteurs pour déterminer si une marque est notoire. Ces facteurs sont (A) le degré de pouvoir distinctif de la marque, (B) la durée et l'étendue de l'usage de la marque pour les produits ou services concernés, (C) la durée et l'étendue de la publicité de la marque, (D) l'étendue géographique de l'usage de la marque, (E) les canaux de commercialisation des produits ou services concernés, (F) le degré de reconnaissance de la marque dans les milieux concernés, (G) la nature et l'étendue de l'usage de marques similaires ou identiques par des tiers et (H) la circonstance que la marque est enregistrée sous l'empire de la loi du 3 mars 1881 ou de la loi du 20 février 1905 ou sur le registre principal. (15 U.S.C., par. 1125(c)(1).

Les Etats-Unis ont, probablement plus que d'autres pays, une expérience étendue des nouvelles formes d'usage de la marque, en particulier dans le domaine de l'Internet. Bien que les règles relatives à l'acquisition et le maintien de la marque soient relativement conservatrices dans la mesure où elles requièrent une apposition, le concept de contrefaçon est assez large. Les règles relatives aux marques et aux marques de service acceptent un usage sur Internet dans la mesure où cet usage remplit les fonctions traditionnelles d'indication d'origine, de qualité ou à titre de parrainage. Les cas d'usage illicite d'une marque peuvent être appréhendés par les règles en matière de contrefaçon, dilution, concurrence déloyale sous l'article 43(a) du Lanham Act ou par les principes généraux de détournement, faute, diffamation ou atteinte à la réputation.

Le système américain a créé une approche balancée de la protection des droits de marque tout en protégeant à la fois d'autres droits important tels que la liberté d'expression. Ce système a bien fonctionné dans le passé et fonctionnera encore mieux lorsque le droit américain se sera adapté complètement aux nouvelles technologies et aux nouvelles réalités commerciales du marché global.

Zusammenfassung

Die Vereinigten Staaten von Amerika vertreten einen flexiblen und breiten Ansatz, wenn es um die Frage der Benutzung einer Marke „als eine Marke“ im Zusammenhang mit dem Erwerb, der Aufrechterhaltung und Durchsetzung einer Marke geht. Die Grenzen desjenigen, was als vertretbare Benutzung von Marken angesehen werden kann, wurden im Bereich des Internets und bekannter Marken bedeutend ausgedehnt, und die Vereinigten Staaten von Amerika haben in diesen und verwandten Bereichen eine rechtliche Struktur anhand von Gesetzgebung und Jurisprudenz entwickelt. Nichtsdestotrotz hat die „New Media“ und die sich entwickelnde globale Wirtschaft neue Probleme aufgeworfen. Während einige dieser Probleme durch die Linse vorhandener traditioneller Ansätze erkannt werden können, haben sich andere Probleme als schwer fassbar erwiesen und haben sowohl die Gesetzgebung als auch die Rechtsprechung herausgefordert, neue Konzepte zu entwickeln, um auf die Sorgen von Markeninhabern zu reagieren.

In den Vereinigten Staaten von Amerika entstehen Marken durch deren Benutzung und Eintragung. Wenn Eintragungen gemäß der Pariser Konvention vorgenommen werden, die in Section 44 des Trademark („Lanham“) Act umgesetzt wurde, ist es nicht erforderlich, dass die Marken vor Eintragung benutzt werden. Für die Entstehung von Rechten an Marken durch Benutzung (Lanham Act Section 1), müssen diese an Waren und Dienstleistungen in irgendeiner Weise „angebracht“ werden und im zwischenstaatlichen Wirtschaftsverkehr benutzt werden; dies würden wir als die Benutzung einer Marke „als eine Marke“ interpretieren. Typische Beispiele der Anbringung von Marken sind Etikette, Anhängeschilder, Ausstellungsschilder oder Verpackungen für Waren, und Werbung oder Schilder für Dienstleistungen.

Das US Recht zur Aufrechterhaltung einer Eintragung entspricht dem Recht über den Erwerb von Rechten, namentlich muss die Marke „als eine Marke“ benutzt und in der rechtlich vorgeschriebenen Weise an Waren oder Gütern angebracht werden. Nach dem Lanham Act, wie 1988 geändert, muss der Inhaber der Marke die Marke in gutgläubiger Weise im Wirtschaftsverkehr nutzen, um ein Lösungsverfahren aufgrund von Nichtbenutzung zu verhindern. Der Lanham Act enthält eine widerlegbare Vermutung, dass eine Marke aufgegeben wurde, wenn jemand belegen kann, dass diese über drei aufeinander folgende Jahre nicht benutzt wurde.

Die Maßstäbe für den Nachweis einer Markenrechtverletzung sind weiter gefasst als die für die Begründung oder Aufrechterhaltung von Markenrechten, da der Test jeweils die Wahrscheinlichkeit der Verwechslung durch Konsumenten ist. Sobald der Fokus der Untersuchung von den Anforderungen des US Trademark Office zu der Frage der Wirkung auf den Konsumenten verschoben wird, kann die Rechtsprechung ungehindert eine Vielzahl von Faktoren berücksichtigen, darunter die Stärke der Marke und die vom Inhaber der Marke getätigten Investitionen in die Förderung der Marke.

Die Benutzung einer Marke wird großzügiger angenommen, wenn es um die Wahrscheinlichkeit der Verwechslung in einer Markenrechtsverletzungsfrage geht. Zum Beispiel kann die Benutzung einer Marke in Werbe- und Promotionsmaterialien als die Benutzung einer Marke für bestimmte Waren angesehen werden, um dem Kläger in einem Markenrechtsverletzungsprozess eine vorteilhaftere Position zu verschaffen. Die gleiche Art von Benutzung würde vom Trademark Office für Zwecke der Eintragung der Marke jedoch als für nicht-ausreichend angesehen werden. Section 22(1) des Lanham Act schließt ausdrücklich Werbung als eine Form verfolgbarer Markenrechtsverletzungen ein, in dem es die Benutzung einer „Reproduktion, Fälschung, Kopie oder Imitation einer eingetragenen Marke in Verbindung mit... Werbung für Waren oder Dienstleistungen“ verbietet, wenn die Benutzung geeignet ist, Verwechslungen zu erzeugen. Auf der anderen Seite kann eine Art der Benutzung für die Eintragung der Marke ausreichend sein, nicht aber für die Aufrechterhaltung eines Markenrechtsverletzungsverfahrens. Während der Test für die Frage der Eintragung der Marke erfordert, dass die Marke sowohl im zwischenstaatlichen Wirtschaftsverkehr benutzt als auch direkt an den Waren angebracht wird, gibt es kein Erfordernis hinsichtlich des Umfangs der Benutzung. Demzufolge könnte ein Unternehmen, das sein Produkt an einen einzelnen Kunden in einem anderen Bundesstaat versendet hat, eine Eintragung auf dieser Basis erlangen, trotzdem aber in einem Markenrechtsverletzungsverfahren Schwierigkeiten wegen der minimalen Ausbreitung der Marke in der Öffentlichkeit haben. Bei den Internetanwendungen Meta Tags, Links und Frames kann es - je nach den Umständen - zu Markenrechtsverletzungen und / oder unlauterem Wettbewerb kommen. In Fällen von Parodie - wobei Parodie keine Verteidigung hinsichtlich einer Verletzungshandlung darstellt, sondern eher ein Faktor ist, der in der Analyse der Wahrscheinlichkeit einer Verwechslung berücksichtigt wird - gibt es keinen Anhalt dafür, dass der Parodist die Marke nicht als eine Marke benutzt. Vielmehr wird die Marke als eine Marke benutzt, aber es wird behauptet, dass keine Verwechslungswahrscheinlichkeit besteht, da die Benutzung einen „Witz“ oder die Ausübung der Redefreiheit darstellt.

Vergleichende Werbung wird in den Vereinigten Staaten solange frei erlaubt, wie deren Verwendung nur den Bericht der Wahrheit in einer ehrlichen Weise über die Verschiedenheiten der Waren oder Dienstleistungen beinhaltet. Der Grund für diese Praxis ist, dass es als vorteilhaft für den Konsumenten angesehen wird, gut über die Eigenschaften und Preise der Waren und Dienstleistungen von Konkurrenten informiert zu sein. Section 43(a) des Lanham Act sieht jedoch einen Rechtsbehelf vor, um gegen unrichtige vergleichende Werbung vorzugehen.

Bekannte Marken werden in den Vereinigten Staaten weitreichend geschützt. Das Dilution Recht basierte bis 1996 ausschließlich auf einzelstaatlichem Recht und Common Law. Der Federal Trademark Dilution Act of 1995 (der „Dilution Act“) sollte diese Lücke im Warenzeichenschutz schließen. Bis der Dilution Act am 16. Januar 1996 in Kraft trat, wurden bekannte Marken wie Coca-Cola, Kodak, Exxon, DuPont oder McDonald's Schutz nur nach einzelstaatlichem Recht und Common Law gewährt. Seitdem enthält Section 43(c) eine nicht abschließende Aufzählung von Faktoren, die zur Ermittlung der Bekanntheit einer Marke relevant sind. Bei diesen Faktoren handelt es sich um: (A) die der Marke anhaftende oder erworbene Unterscheidungskraft; (B) die Dauer und das Ausmaß der Benutzung der Marke in Verbindung mit den Waren oder Dienstleistungen, für die die Marke benutzt wird; (C) die Dauer und das Maß an Werbung für die Marke und die Publizität der Marke; (D) das geographische Ausmaß des Handelsraums, in dem die Marke benutzt wird; (E) die Handelskanäle der Waren oder Dienstleistungen, für die die Marke benutzt wird; (F) der Grad des Wiedererkennenswerts der Marke in den Handelsräumen und Handelskanälen, die vom Inhaber der Marke und der Person, gegen die eine einstweilige Verfügung ersucht wird, benutzt werden; (G) die Natur und das Ausmaß der Benutzung der gleichen oder einer ähnlichen Marke durch dritte Parteien; und (H) ob die Marke nach dem Dilution Act vom 3. März 1881, oder dem Dilution Act vom 20. Februar 1905, oder im

dem Dilution Act vom 20. Februar 1905, oder im Haupteintragungsregister eingetragen wurde. 15. U.S.C. §1125(c)(1).

Die Vereinigten Staaten von Amerika haben ausgedehnte Erfahrung mit neuen Formen der Benutzung von Marken, vielleicht mehr als andere Länder, insbesondere im Bereich des Internets. Obwohl die Regeln über den Erwerb und die Aufrechterhaltung einer Marke relativ konservativ sind, weil sie die Anbringung der Marke verlangen, sind die Maßstäbe für Verletzungshandlungen breit angelegt. Nationale Vorschriften über Warenzeichen und Servicezeichen akzeptieren deren Benutzung im Internet, solange die traditionellen Warenzeichenfunktionen der Indizierung der Herkunft oder Qualität der Sponsoren oder Unterstützer eingehalten werden. Unbefugter Benutzung von Marken im Internet kann durch die Vorschriften über Markenrechtsverletzungen, Dilution und unlauterem Wettbewerb in Section 43(a) des Lanham Act oder durch die generellen Prinzipien der Veruntreuung, unerlaubter Wirtschaftshandlungen - wie Verleumdung oder Rufschädigung im Handel - nach dem Common Law begegnet werden. Das US System schafft einen ausgewogenen Ansatz zum Schutz von Markenrechten, wobei es gleichzeitig andere wichtigen Rechte, wie z.B. die Redefreiheit, schützt. Dieses Gerüst hat in der Vergangenheit gut funktioniert und wird in der Zukunft sogar noch besser werden, wenn sich das US Recht an die neuen Technologien und wirtschaftlichen Realitäten in einem globalen Marktplatz anpasst.

Report Q168

in the name of the Venezuelan Group

Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights

1. Is there any requirement for use of a mark "as a mark" for the purposes of

1.1 Acquiring a mark (if rights may be acquired by use according to national law)

In Venezuela, there is no requirement for obtaining from the registry a mark the **previous use**; pursuant to "1955 Ley de Propiedad Industrial" (Law of Industrial Property), a national law, that is in force in all that do not collide with Andean sub-regional Resolution 486, that rules for the five countries that form the Andean Community of which text is also ratified by the same previously mentioned principle.

Nevertheless, in the 1955 law the **previous use** is acknowledged for exercising a better law making it possible to oppose the registry of a trademark alleging via jurisdiction in the lapse contemplated for exercising administrative objections, the previous use of a symbol in commerce that has not been registered, but counting with all evidentiary means requested by the Venezuelan Civil Code in order to demonstrate that such symbol is known, can be found in commerce previously to the registry application of the trademark to which it has objections, whether it be identical or similar to this one.

1.2 Maintaining of a trade mark registration (e.g. against an application for cancellation on grounds of non-use)

Resolution 486 contains a disposition similar to that established in TRIPS in its article 19 that sets forth that the trademark that would not have been use, in at least one of the countries members of the Andean Community over three consecutive years up to the date in which the cancellation is initiated the cancellation may be executed, unless the bearer can demonstrate that the non-use was due, among other factors, to an act of God to force majeure.

1.3 Establishing infringement

In Resolution 486, in its article 155, establishes the rights of the bearer the rights of the bearer of a trademark to impede any third party the use in commerce of a distinctive symbol, whether identical or similar to the one registered by him/her, respecting any product or service when its use could cause confusion or risk of association, dilution of the distinctive force or with commercial or advertising value of a trademark, or by reason of an unjust benefit from the prestige of the trademark.

Likewise, the public use of an identical or similar signal, even for non-commercial purposes may be considered improper use of a trademark and may constitute grounds for an action of infringement, when it may cause dilution of the distinctive force or of the commercial or advertising value of a trademark, or of an unjust benefit from its prestige.

The actions for infringement for improper use of a trademark has incorporated in this matter of observance set forth in the Resolution 486 by mandate and in the application of that established in TRIPS in reference to this matter.

2. Is there any definition of what is use "as a mark" either in statute or case law?

Yes, Article 166 of Resolution 486, establishes that according to the criterion of the legislator it should be understood as use of a trademark for the purpose of its assessment, determining that to be considered as use for legal effects, the trademark should be available in the market in the amount of in the manner that normally corresponding, taking into consideration the nature of the product.

Likewise, to legal effects it shall be considered that a trademark is being used when it distinguishes products that are exported from any of the countries of the sub-region, in the same terms than those established in the previous paragraph.

3. Is there any difference in the assessment of use "as a mark" between the acquisition, maintenance and infringement of rights?

In our country there is no assessment of the use as a trademark for the acquisition, because it is not a requirement for obtaining it. (See point 1.1).

The assessment in relation to maintenance is different because it is a legitimate use, and its assessment falls back on evidences that can demonstrate that the bearer or its Licencee or the person authorized by him/her has made use of the trademark during the three previous years from the time of bringing an action (See point 1.2).

In relation to the infringement, the assessment shall be determined by the legitimate use that the third party shall have made in the mentioned terms in point 1.3.

4. Is any of the following considered to be use "as a mark"?

4.1 Use on internet, as a metatag, in linking or framing

Legitimate use

Although there is no legislation or jurisprudence because of the innovativeness of the issue, the Group considers that when the bearer of the trademark incorporates to it the name of the domain that identify it in internet and this is the one designating the origin, and the precedence of the commercialized product, among others by e-commerce, such use ought to be considered for assessing the use preserving the maintenance of the trademark.

Non-legitimate use

The use of a trademark alien to whom is not its legitimate no bearer, as METATAGS for illegally attracting Internet users into a Web page or to be positioned within searchers in the best places than that which would correspond it in case of not using it, even when is not expressly contained in the law ruling the matter, such behavior can be repressed in matter of civil law through action due to unfair Competition, and also the penal alternative, for being deemed a crime by the new special law against information crimes, that establishes penalty deprived of liberty from one to five years, additionally to a monetary sanction.

4.2 Use by fan clubs or supporters

The use of a trademark by one who is not its legitimate bearer is deemed fraudulent use, with the exception of the limitations established Resolution 486 of the Commission of the Andean Community, in its articles 157 and 158, that do not confer the bearer the right to impede that third parties use the trademark to advertise, including with comparative advertising, to offer in sale or to indicate the existence or availability of products or services legitimately branded; or to indicate the compatibility or to adequate pieces of re-change or usable accessories with registered trademark products.

Likewise, it constitutes an exception to the right of the bearer to impede the use of a third party when the assumptions proceed of what the doctrine has called the exhaustion of the right, contemplated in our legislation as international exhaustion.

4.3 Parody

The same previously mentioned criteria is applied, whereas all that may cause an economic and commercial damage, that is unjust by reason of a dilution that may affect the prestige of the trademark and may cause confusion or association due to that previously stated or by unjust benefiting from the trademark is considered improper use .

4.4 *Comparative advertising*

Even when Resolution 486 mentions comparative advertising in our country, a special law prohibiting comparative advertising exists. Nevertheless, there is a bill under discussion in the National Assembly that incorporates rules that regulate such issue.

5. **If, under the Group's national regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (e.g. unfair competition or trade practice laws)?**

It may be objected under unfair competition rules and the arbitration before international entities for settlement of disputes under the rules of the ICAM to which these are subordinated, for example, the regime of inscription of the name of domain in our country.

6. **If use "as a mark" in the traditional sense is required to establish infringement, are "well-known" "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?**

Yes, pursuant to article 155 of Resolution 486, in its literals e) and f).

Proposals for harmonization and observations

The Group considers that the initiative of the WTO through the Marrakech Treaty and over the issue that concerns us, The TRIPS Agreement constitute a source of harmonization that ought to be continued whereas it has been of benefit for our countries that have incorporated the mandate of such agreement in its internal legislations.

Traduction française

1. **Y a-t-il une nécessité d'utiliser la marque "en tant que marque" dans les cas suivants:**

1.1 *L'acquisition d'une marque (si, d'après la loi nationale, des droits peuvent être acquis par l'usage)*

Au Vénézuéla, **l'usage antérieur** n'est pas exigé pour obtenir l'inscription d'une marque; d'après la Loi de propriété Industrielle de 1955. Cette loi nationale qui est efficace dans tout ce qui colida du non avec la Décision 486, norme pour le sub-régional andin qui gouverne pour les cinq pays conformant la Communauté andine dont son texte principale ratifie aussi le même principe.

Cependant, dans la Loi de 1955, **l'usage antérieur** est reconnu comme fondation pour l'exercice de l'action dénommée "pour meilleur droit" qui permet de s'opposer à l'inscription d'une marque prétendue pour via juridictionnel, et dans la défaillance prévue pour l'exercice des oppositions administratives, l'usage antérieur dans le commerce d'un symbole qui n'a pas été enregistré, mais qui compte sur les moyens demandés par le Code Civil vénézuélien pour démontrer qu'un tel symbole est connu et qu'apparaît dans le commerce avant l'inscription de l'application de la marque auquel s'oppose, que ce soit ce chemin identique ou semblable à ceci.

1.2 *Le maintien d'un enregistrement de marque (c'est-à-dire contre une action en déchéance pour non-usage)*

La Décision 486 retient un contenu semblable à l'établi dans le TRIPS qui dans son article 19 signale que la marque qui n'a pas été utilisée dans au moins un des pays du Pacte andin pendant les précédents d'une série de trois années à la date dans laquelle l'annulation

commence, pourrait être annulé, à moins que le détenteur démontre que le manque de l'usage s'est due parmi d'autres à cas fortuit ou une plus grande force.

1.3 *La condition pour qu'il y ait contrefaçon*

Dans la Décision 486, dans son article 155, les droits du détenteur d'une marque sont établis pour mettre obstacle à tout troisième souhaitant l'usage dans le commerce d'un signe distinctif identique ou semblable à l'enregistré qui puisse causer de la confusion ou du risque de fausse association, dilution de la force distinctive ou de l'annonce publicitaire ou faire de la publicité pour valeur de la marque, ou pour raison de tirer avantage injuste du prestige de la marque.

Également l'usage public d'un signe identique ou semblable, encore pour d'autres fins que commerciales,, il peut être considéré comme usage indu d'une marque, et ceci pourrait être fondation d'une action de l'infraction, car il peut causer de la dilution de la force distinctive ou de l'annonce publicitaire ou faire de la publicité pour valeur de la marque, ou un usage injuste de leur prestige.

Les actions pour infraction pour usage indu de marque ont été incorporées dans la matière d'observation établie dans la Décision 486 pour ordre et dans application de cela réglée dans le TRIPS d'après cette matière.

2. **Y a-t-il une définition de l'usage "en tant que marque", dans la législation ou la jurisprudence?**

Oui, l'article 166 de la Décision 486 établit ce qui devrait être compris comme usage d'une marque pour effets de leur évaluation à l'approche du législateur, ce qui peut être considéré comme usage à effets de la loi, la marque sera disponible dans le marché selon la quantité et le chemin qui correspond habituellement, compte tenu de la nature du produit.

Également, il sera considéré aux effets de la loi qu'une marque est utilisée quand elle distingue des produits qui sont exportés n'importe quel pays de la région du sud, dans les mêmes termes que les établies dans le paragraphe antérieur.

3. **Y a-t-il une différence dans l'évaluation de l'usage "en tant que marque" entre l'acquisition, le maintien et la contrefaçon des droits?**

Dans notre pays il n'existe pas d'évaluation de l'usage en tant que marque pour l'acquisition, c'est pourquoi qu'elle n'est pas une exigence pour l'obtenir (Voir le point 1.1).

L'évaluation concernant l'entretien est différent depuis qu'il s'agit d'un usage légitime, et son évaluation rechte sur les épreuves qui démontrent que le détenteur ou la personne autorisée a fait usage de la marque dans les précédents de trois années à l'intervention de l'action (Voir le point 1.2).

Concernant l'infraction, l'évaluation sera déterminée par l'usage illégitime qu'un troisième a fait dans les termes exposés dans le point 1.3.

4. **Est-ce que l'un des points suivants est considéré comme usage "en tant qu'une marque"?**

4.1 *L'usage sur internet, comme metatag, comme "linking" ou "framing"*

L'usage légitime

Bien qu'il n'existe pas de législation ni de jurisprudence, du a la nouveauté du sujet, le Groupe considère que quand le détenteur de la marque l'incorpore dans le nom de domaine qui l'identifie dans l'internet en désignant l'origine du produit vendu, parmi d'autres pour commerce, cet usage devrait être considéré pour l'évaluation de l'usage qui conserve l'entretien de la marque.

L'usage illégitime

L'usage de la marque d'un autre gens pour qui n'est pas un habitué légitime, comme METATAGS pour attirer illicitement des utilisateurs de l'Internet à une page tissu ou être placé à l'intérieur des chercheurs dans une place meilleur que ce qui le correspondrait s'il ne les avait pas utilisés, même si cela n'est pas contenu spécifiquement dans la loi qui gouverne la matière.

Ce comportement peut être réprimé dans matière civile à travers l'action pour Compétition Déloyale, et dans via pénal, peut être considéré comme une infraction pour la nouvelle loi spéciale contre les infractions de l'ordinateur établissant des sanctions exclusives de liberté d'un à cinq ans ainsi que des sanctions pécuniaires.

4.2 *L'usage par les clubs de fans ou les supporters*

L'usage d'une marque pour qui n'est pas son détenteur légitime est considéré comme un usage illégitime, à l'exception des limitations règles par la Décision 486 de l'Ordre de la Communauté andine, dans ses articles 157 et 158, lesquels n'accordent pas que le détenteur aient le droit de prévenir qu'un troisième fait usage la marque annoncer, inclus dans la publicité comparative, offrir dans vente ou indiquer à juste titre l'existence ou empressement de produits ou services marqué; ou indiquer la compatibilité ou adaptation de morceaux du remplacement ou d'accessoires utilisables avec les produits de la marque enregistrée.

Également, il constitue une exception au droit du détenteur de mettre obstacle à l'usage d'un troisième quand les suppositions viennent de ce que la doctrine a appelé épuisement du droit que notre législation tient en tant qu'épuisement international.

4.3 *La parodie*

Les mêmes approches sont appliquées comme auparavant exposé, car tout ce qui cause un dégât économique, commercial injuste pour des raisons d'une dilution que je pourrais enfoncer au sujet du prestige de la marque peut causer de la confusion ou de l'association dans la raison du précédemment chose déjà exposé ou pour un usage injuste de la marque l'usage indu est considéré d'usage indu.

4.4 *La publicité comparative*

Même si la Décision 486 fait mention à la publicité comparative, dans notre pays il y a une loi spéciale qui interdit la publicité comparative . Cependant un projet de Loi existe en discussion dans l'Assemblée législative qui incorpore des droits dans ce sujet.

5. **Si, d'après le régime national du Groupe, l'usage comme marque est confiné aux indications traditionnelles d'origine ou d'identification, des usages non conventionnels sont-ils néanmoins punissables de par la loi sur les marques ou d'autres lois (par exemple les lois sur la concurrence déloyale ou sur les pratiques du commerce)?**

C'est inacceptable sous les normes de compétition déloyale et l'arbitrage pour avant les organismes internationaux de solution de controverse sous les normes de l'ICAM auquel est soumis, par exemple le régime d'inscription de nom de domaine dans notre pays.

6. **Si l'usage " en tant qu'une marque" dans le sens traditionnel est requis pour établir la contrefaçon, est-ce que les marques "de haute renommée", "célèbres", notoires" ou "jouissant d'une réputation" utilisées sur des produits et services différents sont protégées?**

Oui, de conformité avec l'article 155 de la Décision 486, dans leurs littéraux et) et f).

Propositions pour l'harmonisation et les observations

Le Groupe considère que l'initiative de l'OMC à travers le Traité de Marrakech et sur le sujet qui nous occupe, les Accords TRIPS, ils constituent une source d'harmonie qui devrait être continuée, il a été avantageux pour nos pays qui ont incorporé dans ses législations internes l'ordre de cet Accord.

Deutsche Übersetzung

1. Gibt es ein Erfordernis, das die Benutzung einer Marke "als Marke" verlangt

1.1 *Um eine Marke zu erwerben (falls Rechte durch Benutzung gemäss dem nationalen Recht erworben werden können)*

In Venezuela ist die **vorherigen Verwendung** keine Anforderung am Erhalten der Registrierung einer Marke. Dem Gesetz von Industrieller Eigenschaft von 1955 zufolge, nationales Gesetz, das in allem wirksam ist, der nicht mit der Entscheidung 486 koinzidiert, subregional andischer Norm, der in den fünf Ländern regiert, die die Andische Gemeinschaft anpassen, in deren Text das gleiche genannte Prinzip auch ratifiziert wird.

Nach dem Gesetz 1955 wird die **vorherige Verwendung** aber als Fundament für die Ausübung der bezeichneten Handlung "für besseres Recht", das erlaubt, sich zur Registrierung einer Marke durch rechtsprechende Behauptung zu opponieren und auch in der Zeit für die Ausübung der administrativen Widerstände, die vorherige Verwendung im Gewerbe eines Symbols verteidigen, die noch nicht registriert worden ist, aber das mit aller vom venezolanischen Zivilen Code verlangten probatory-Mittel rechnet. Denn kann man demonstrieren, dass dieses genannte Symbol schon bekannt ist und dass es im Gewerbe vor der Antragsregistrierung der Marke ist, zu dem es opponiert, entweder es gleich oder ähnlich ist.

1.2 *Um eine Markenregistrierung aufrechtzuerhalten (d.h. gegen einen Antrag auf Löschung wegen Nicht-Benutzung)*

Die Entscheidung 486 enthält eine Veranlagung ähnliche zu diese, die in der TRIPS in ihrem Artikel 19 feststeht, der festlegt, dass man die Marke, die nur in wenigstens einem der Länder des Andischen Paktes während der drei fortlaufend vorgegangenen Jahre zum Datum benutzt worden ist, zurückziehen kann, ausser wenn der Halter demonstriert, dass es der Verwendungsmangel unter anderen zufälligem Fall oder grösserer Gründung gab.

1.3 *Um eine Verletzung zu begründen*

In der Entscheidung 486, in ihrem Artikel 155, begründet es die Rechte des Halters einer Marke, um die Verwendung im Gewerbe von einem gleichen oder ähnlichen auffälligen Zeichen zum Eingeschriebenen vom irgendeinem dritten zu behindern, hinsichtlich irgendeines Produktes oder eines Dienstes, wenn die Verwendung davon Verwirrung oder Verbandrisiko verursachen kann, Verdünnung der auffälligen Macht oder vom Werbespot oder werbender Wert der Marke, oder für Grund einer ungerechten Benutzung des Prestiges der Marke.

Gleich die öffentliche Verwendung eines gleichen oder ähnlichen Zeichens, immer noch für nicht kommerzielle Enden, kann als unangemessene Verwendung einer Marke betrachtet werden, und es kann Fundament einer Übertretungshandlung sein, wenn es eine Verdünnung der auffälligen Macht oder vom Werbespot oder werbender Wert der Marke oder eine ungerechte Verwendung ihres Prestiges verursachen kann.

Die Handlungen für Übertretung für unangemessene Verwendung der Marke sind in der Sache feststehender Einhaltung in der Entscheidung 486 integriert worden und als es in der TRIPS in dieser Sache festgelegt ist.

2. Gibt es eine Definition dessen, was die Benutzung "als Marke" ist, entweder im Gesetzesrecht oder im Fallrecht?

Ja, der Artikel 166 der Entscheidung 486 begründet was als die Verwendung einer Marke für Wirkungen ihrer Einschätzung zum Ansatz des Gesetzgebers verstanden werden sollte und entschliesst, dass es nach dem Gesetz als die Verwendung betrachtet zu werden, soll die Marke in der Quantität und dem Weg, der normalerweise korrespondiert und die Natur vom Produkt in Verstand behält, im Markt verfügbar sein.

Gleich zu Wirkungen des Gesetzes wird es berücksichtigt werden, dass eine Marke benutzt wird, wenn diese Produkte unterscheidet, die von jemandem der Länder des Gebietes exportiert werden, im gleiche Begriffe, in den es im vorherigen Absatz feststeht ist.

3. Gibt es einen Unterschied in der Beurteilung der Benutzung "als Marke" zwischen dem Erwerb, der Aufrechterhaltung und der Verletzung von Rechten?

In unserem Land existiert keine Schätzung der Verwendung als Marke für den Erwerb, weil es keine Anforderung an ihrer Linderung ist – Siehe Punkte 1.1.

Die Schätzung als denn die Aufrechterhaltung ist anders, weil es eine rechtmässige Verwendung ist, und seine Schätzung fällt auf die Prüfungen zurück, die demonstrieren, dass der Halter oder sein Lizenzinhaber oder die ermächtigte Person die Verwendung der Marke in der drei vorgegangenen Jahren zur Einmischung der Handlung – Siehe Punkt 1.2.

Die Übertretung der Schätzung wird nach der unehelichen Verwendung, die der dritten gemacht hat, in den Begriffen, die im Punkt 1.3 freigelegt werden, bestimmt werden.

4. Wird eine der folgenden Nutzungsformen als Benutzung "als Marke" beurteilt

4.1 Benutzung im Internet, als Metatag, in "linking" oder "framing"

Rechtmässige Benutzung

Obwohl es weder Gesetzgebung nieder Jura, weil des Themas neu existiert, betrachtet die Gruppe, dass wenn der Titular die Marke in den Domänennamen, der sie in Internet identifiziert ist, einverleibt und dieses den Ursprung und den Ursprung des vermarkteten Produktes durch *e-Gewergen* bezeichnet, dann diese Verwendung sollte für die Einschätzung von der Verwendung, die die Aufrechterhaltung der Marke bewahrt, überlegen werden.

Unrechtmässige Benutzung

Die Verwendung einer fremden Marke von eine Person, dem sie nicht gehört, wie z.B. METATAGS, um Benutzer vom Internet zu einem Seitennetz unerlaubt anzuziehen oder in den Suchern in einer Position aufgestellt zu werden, die besser als diese, die ihr entsprechen würde, wenn sie es sie nicht benutzte, als dies nicht einen ausdrücklich nach dem Gesetz enthielt, das die Sache regiert, kann dieses Verhalten in ziviler Sache durch die Handlung für Treulose Konkurrenz unterdrückt werden, und im strafbaren Mittel, wie ein Verbrechen für das neue besondere Gesetz zu Computerverbrechen betrachtet sein, das die Freiheitsstrafe von einen bis fünf Jahren ausser finanzieller Sanktion begründet.

4.2 Benutzung durch Fan-Clubs oder Anhänger

Die Verwendung einer fremden Marke von eine Person, dem sie nicht gehört, ist als eine verbotene Verwendung betrachtet, ausser den Einschränkungen, die in der Entscheidung 486 der Kommission der Andischen Gemeinschaft, in seinen Artikeln 157 und 158, festgelegt werden, die dem Halter das Recht nicht gewähren, diese dritte Verwendung der Marke zu verhindern, um zu verkünden, einschliesslich in vergleichender Öffentlichkeit, sich in Verkauf zu bieten oder zu zeigen, dass die Existenz oder die Bereitschaft von Produkten oder Diensten rechtmässig markierte,; oder, um auf die Verträglichkeit oder die Adaptation der Ersatzstücke hinzuweisen oder von verwendbaren Zubehören mit den Produkten der eingeschriebenen Marke.

Gleich bildet es eine Ausnahme des Rechtes des Halters, die Verwendung einem dritten zu behindern, wenn die Mutmassungen von dem kommen, was die Doktrin Erschöpfung des Rechtes gerufen hat, der unser Gesetzgebung als internationale Erschöpfung betrachte.

4.3 Parodien

Die gleichen Ansätze werden zuvor ungeschützt angewandt, seit alle das einen ungerechten wirtschaftlichen, kommerziellen Schaden für Grund von einer Verdünnung, die eine Wirkung über dem Prestige der Marke sein könnte, verursacht, kann Verwirrung oder Verband in Grund der vorher ungeschützten Sache oder für eine ungerechte Verwendung der Marke verursachen, das als unangemessene Verwendung betrachtet wird.

4.4 Vergleichende Werbung

Immer noch wenn die Entscheidung 486 erwähnt zu dem vergleichender Öffentlichkeit, existiert in unserem Land ein besonderes Gesetz, das die vergleichende Öffentlichkeit verbietet. Aber eine Rechnung existiert in Diskussion in der gesetzgebenden Versammlung, die normativ von diesem Thema vorschriftsmässig integriert.

5. **Wenn im nationalen Recht der Gruppen die Benutzung als Marke auf die traditionellen Angaben der Herkunft oder Identität beschränkt ist, sind unkonventionelle Benutzungsformen gestützt auf Markenrecht oder andere Gesetze (z.B. unlauterer Wettbewerb oder Handelsrecht) trotzdem klagbar?**

Es ist unter den Normen von treuloser Konkurrenz und der Schlichtung vor den internationalen Organismen der Lösung zu Kontroverse unter den Normen vom ICAM widerwärtig, zum Beispiel das Regime der Inschrift des Domänennamens in unserem Land.

6. **Wenn die Benutzung "als Marke" im traditionellen Sinn notwendig ist, um eine Verletzung nachzuweisen, sind "bekannte", "berühmte", "notorische" oder "angesehene" Marken, die für unähnliche Waren oder Dienstleistungen benutzt werden, geschützt?**

Ja, nach dem Artikel 155 der Entscheidung 486, in ihren wörtlichen e) und f).

Vorschläge für Harmonisierung und Beobachtungen

Die Gruppe denkt, dass durch den Vertrag von Marrakesch und auf dem Thema, das uns einnimmt, für die Initiative vom OMC, die Einverständnisse *TRIPS* eine Harmonisierungs-Quelle bilden, die fortgesetzt werden sollte, weil es für unsere Länder gewinnbringend ist, die den Befehl dieses Einverständnisses in seine internen Gesetzgebungen integriert haben.

