

QUESTION 70

Impact of use on the maintenance and renewal of a trade mark registration

Yearbook 1978/II, pages 160 - 161
30th Congress of Munich, May 15 - 19, 1978

Q70

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Impact of Use on the Maintenance and Renewal of a Trademark Registration

Resolution

The IAPIP,

having taken note of the Groups' reports (Annuaire 1977/II, p. 189 et seq.), the Summary Report (Annuaire 1978/I, p. 33 et seq.) and the Report of the Working Committee, as well as the various opinions voiced at the Munich Congress,

believes

- that the obligation to use a registered mark is now almost unanimously recognized, such obligation pertaining to the very nature of the mark. In fact, a mark must not be considered abstractly in isolation, but in connection with the function allotted to it of distinguishing the products or services of a business, and such a distinguishing function is only achieved by use;

- that the conditions of use necessary to maintain the registration and the related sanctions vary from one country to another;

- and that the harmonization of these conditions to the largest possible extent is in the interest of trademark owners,

notes

- that there is a high degree of agreement on the general lines of the Summary Report of the Reporter-General and of the Report of the Working Committee but that several points require a study in greater depth and, therefore,

decides

to continue the study of the question in those respects which have been pointed out in the Report of the Working Committee and those in which the discussion has shown an absence of agreement.

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QUESTION 70

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Yearbook 1980/I, pages 120 - 121

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Executive Committee and Council of Presidents of Toronto, September 23 - 29, 1979

Question Q70

Impact of use on the maintenance and renewal of a trademark registration

Resolution

The IAPIP,

after a further study of the question of the use of trademarks which had been taken up at the Congress of Munich, is of the opinion

a) Similarity of goods

- that in connection with the scope and maintenance of a registered trademark and encroachment on the right following therefrom, those goods are to be considered similar which, when presented under the identical trademark, would be attributed by the public to the same source, in taking account of the nature, type and the intended purpose of the goods as well as the channels of trade through which they circulate;
- that it would be correct to take a liberal view on the similarity of goods in so far as the use of the mark or the proposal to use it is linked with the bona fide expansion of trade;
- that on the other hand, the trademark registers should not be filled with deadwood so that there is an overriding need to give continuing protection only to used marks or to marks for which there is a genuine reason for temporary non-use; and where registration is the means for protection of the mark it may be accepted that the registration can be maintained for goods listed in the registration in so far as the mark has been used for such goods or for similar goods.

b) *Use by a third party*

- that any use by a third party which is authorized by the trademark proprietor and is under the law of the country a properly authorized use shall be sufficient to maintain the registration.

c) *The place of use*

- that to maintain the registration, the use must be in the country where the registration is, but that actual use in other countries might give a guide to future use;
- but that in the case of a mark used in international trade it might suffice that either the mark had become known in the country where it was registered or that there was a serious proposal to use the mark in that country;
- that use must be real (genuine) and substantial and should not be mere token use;
- that reserve is made for governments in their external relations to agree otherwise.

d) *The well-known mark*

- that there should in principle be an extended protection of the well-known mark but that this question should be further considered along with the concept of the defensive mark.

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