



ANKENÆVNET FOR PATENTER OG VAREMÆRKER

How to prove use and reputation

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TM Regulation **article 8(5)**

...Upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is **identical with, or similar to**, an earlier trade mark, **irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered**, where, in the case of an earlier EU trade mark, the trade mark **has a reputation** in the Union or, in the case of an earlier national trade mark, the trade mark **has a reputation** in the Member State concerned, and where the use without due cause of the trade mark applied for would **take unfair advantage of, or be detrimental to**, the distinctive character or the repute of the earlier trade mark.

Conditions of Application

The following – cumulative – conditions need to be met for article 8(5) to apply:

1. Earlier registered mark with reputation in the relevant territory
2. Identity or similarity between the contested EUTM application and the earlier mark
3. Use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark
4. Such use must be without due cause

Why?

The concept of **double identity of signs and goods** and **likelihood of confusion** as preconditions for the protection is replaced

8(5) requires neither identity/similarities of goods/services nor likelihood of confusion

A trademark is not only an *indicator of origin*

Promise or reassurance of quality, a certain image for luxury, lifestyle, exclusivity -> *the advertising function*

Investments in creating a brand associated with the trademark are protected

The Guidelines from 'the Office'

The relevant factors of the assessment of reputation

- Trade mark awareness
- Market share
- Intensity of use
- Geographical extent of use
- Duration of use
- Promotional activities
- Other factors

...all relevant for the degree of knowledge of the mark amongst the public

The Guidelines from 'the Office'

Proof of reputation – means of evidence

- sworn and affirmed statements
- decisions of Courts or Administrative authorities
- decisions of the Office
- opinion polls and market surveys
- audits and inspections
- certifications and awards
- articles in the press or in specialised publications
- annual reports on economic results and company profiles
- invoices and other commercial documents
- advertising and promotional material
- ...

What is *reputation*?

General Motors paras 21 and 23:

“...the trademark must be “known”...”

“...a quantitative level of certain degree of knowledge amongst the public.”

“...It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even when used for non-similar products or services, and that the earlier trade mark may consequently be damaged.”

How to prove reputation in the Union



How to prove reputation in the Union

PAGO:

*“Article 9(1)(c) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, **a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the European Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community.**”*

Establishing a trademark right

how to prove *use*

ELYSIUM (for funeral services)

- Use exercised during one single day was sufficient. And all the owner did was issuing a press release describing the new services to be launched under the ELYSIUM name. This resulted in the owner getting free publicity both in a message from the news agency Ritzau which resulted in articles in 15 newspapers with a total circulation of approximately 200,000 copies.
- One deliberated and calculated action – the press release from the organization behind these funeral services – resulting in some random actions by others, i.e. Ritzau and the 15 newspapers established the trademark right.
- Use is generally connected to proving an actual sale in the relevant territory of the said goods or services. The ELYSIUM decision demonstrates that it is possible to *establish* a right to a trademark without any actual sale under the mark.

Maintaining a trademark right

how to prove *genuine use*

“Genuine use” is required to maintain a trademark right – five years without and you’re out.

See for instance the council regulation on the *use of the community trademarks* article 15:

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

Maintaining a trademark right how to prove *genuine use*

LENO MERKEN:

Saying on “**genuine use**”:

*“As can be seen from the foregoing considerations, it is for the referring court to assess **whether the mark in question is used in accordance with its essential function and for the purpose of creating or maintaining market share for the goods or services protected. That assessment must have regard to all the facts and circumstances relevant to the main proceedings, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.**”*

Maintaining a trademark right how to prove genuine use *in the Union*

and on **the territorial question:**

*“...Article 15(1) of Regulation No 207/2009 must be interpreted as meaning that **the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’** within the meaning of that provision.” (par. 57)*

Maintaining a trademark right how to prove *genuine use in the Union*

Instead one must emphasize ***the characteristics of the product or service concerned on the corresponding market***, see par. 54:

*“Second, whilst it is reasonable to expect that a Community trade mark should be used in a larger area than a national mark, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on **the characteristics of the product or service concerned on the corresponding market...**”.*

Maintaining a trademark right

how to prove *genuine use in the Union*

JUMPMAN vs. JUMP

- documentation of actual sale of the said goods in only one occasion, namely to a retailer in Sofia in Bulgaria for a period of 16 months
- We also emphasized *the nature of the goods* (plain consumer goods) and the *characteristics of the market concerned* (considerable trade and turnover) *aimed at consumers all over the EU*. Footwear and socks are mass consumption products, thus the relevant public will be the public at large.
- Thus, this was not genuine use in the sense of art. 15.

The “link” between the signs

8(5): “...and where the use without due cause of the trade mark applied for would **take unfair advantage of**, or **be detrimental to**, the distinctive character or the repute of the earlier trade mark.”

Taking unfair advantage of or being detrimental requires a *link* or an *association* between the signs in the mind of the relevant public, see Intel Corporation par. 30:

*“The types of injury referred to in Article 4(4)(a) of the Directive, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public **makes a connection** between those two marks, that is to say, **establishes a link between them even though it does not confuse them...**”*

The “link” between the signs

T-586/10 ONLY/ONLY GIVENCHY



The “link” between the signs

*“Moreover, according to case-law, the various infringements referred to by Article 8(5) of Regulation No 207/2009 are the consequence of **a certain degree of similarity** between the earlier mark and the mark in respect of which registration is sought, by virtue of which the relevant section of the public **makes a connection between those two marks, even though it does not confuse them**. The existence of a link between the mark in respect of which registration is sought and the earlier mark, which must be assessed globally, taking into account all factors relevant to the circumstances of the case, is thus an essential condition for applying that provision” (par. 59)*

The “link” between the signs

*“There is a slight degree of visual and conceptual similarity between the signs at issue and a moderate degree of aural similarity. Even if earlier Danish and Community trade marks ... had a reputation, the **differences** between those signs, in particular due to the conceptual unit created by the combination of the element ‘only’ and the distinctive dominant element ‘givenchy’, **are significant enough for the public not to make any connection between them.**” (par 65)*

*“Therefore, the Board of Appeal was correct in finding that one of the conditions for applying Article 8(5) of Regulation No 207/2009, namely **that the signs be sufficiently similar to lead the relevant public to make a connection between them**, has not been met...” (par. 66)*

