



European Communities Trade Mark Association

Summary report on the result of the survey conducted by the Harmonization Committee in the Community member countries on the question whether use of a TM in a form slightly deviating from the registered form supports the Reg., if the used deviating form is registered on its own

The Questionnaire, as per copy enclosed, has been answered for 26 countries (Benelux counting as 3 countries), Lithuania not being represented on the Committee as yet.

The answers to Question 1 reflect that the binding provision of Article 10 (2) a) of the Directive has been transferred into the national laws of 22 countries. 22 countries have national provisions stating that use of a registered trademark is constituted, if the used form is differing in elements from the registration which do not alter the distinctive character of the mark. 4 countries do not appear to have (as yet) adopted Article 10 (2) a) of the Directive, namely Bulgaria, Cyprus, Finland and Sweden. In Sweden a new national law is underway. In 3 of these countries (Cyprus, Finland, Sweden) legal practice appears to act in line with the principle of Article 10 (2) a) of the Directive, but not in Bulgaria. The answer for Bulgaria emphasizes that legal practice rules just to the opposite. Used variants of trade marks are not tolerated.

Question 2 a) asks for explicit provisions in the national laws stating that registration of the used variant of a TM is irrelevant for the issue whether such used variant is considered as use of another registration in a slightly varied form. Of 26 countries, 24 do not have such explicit provisions in their national law. Germany and Italy appear to be two exceptions in this regard. The Italian concept of defensive marks (Article 24.4 of the Italian Code of Intellectual Property) has been held incompatible with Community Trade Mark Law by the ECJ in the "Bainbridge"-decision. While the German law does not provide a system of defensive marks, Section 26, para 3, 2nd sentence German Trade Marks Act provides that the rule on proper use of a registered mark by use of a variant not altering the distinctive character, shall apply, if the variant is also registered.

As far as decisions have been reported by the members, national legal practice does not appear harmonized. Spain applies e.g. the "Bainbridge"-rule. France, UK, Germany adhere to the contrarious rule – so far -, which is also indicated by the answer for Portugal. Though, the German Federal Supreme Court in a recent decision expressly left the issue undecided as to whether Section 26, para 3, 2nd sentence of the German Trade Marks Act can be regarded to be still in line with European law.

The answers of the Committee Members are enclosed.

Date: October 26, 2009

Monika Wenz



European Communities Trade Mark Association

Country: [kindly insert here your country]

Questionnaire regarding Use of a TM in a form slightly different from the registered form

Preamble

Article 15 CTMR and Article 10 of the First Council Directive 89/104 EC, now replaced by Directive 2008/95 EC, for approximating the Trademark Laws of the Member States deal with the use of trademarks. These Articles provide in their para (1) a)

**“The following shall also constitute use
use of the trademark in a form differing in elements which do
not
alter the distinctive character of the mark in the form in which
it was
registered”.**

Article 10 of the Directive contains obligatory provisions for the Member States. It is assumed that this provision has been transferred into the national laws of the Member States.

For example, Paragraph 26, para 3, first sentence of the German Trademarks Act transfers this provision into national law and clarifies in a second sentence that such use shall constitute use of the trademark even if the trademark has also been registered in that form in which it has been used. By this second sentence, former contrarious case law became obsolete. Thus, by use of a slightly different form, two trademark registrations may be properly used.

As you all know, the ECJ ruled on September 13, 2007 in Case C-234/06 P – catchword “Bainbridge” (Il Ponte Finanziaria SpA v. OHIM/F.M.G. Textiles Srl) – by referring to Article 15 (1) and (2) (a) CTMR (No. 86):

“In any event, while it is possible, as a result (of these provisions) to consider a registered trademark as used where proof is provided of use of that mark in a slightly different form from that in which it was registered, it is not possible to extend, by means of proof of use, the protection enjoyed by a registered trademark to another registered mark, the use of which has not been established, on the ground that the latter is merely a slight variation on the former.”

This means that the principle of proper use of a registered trademark in a slightly different form does not apply if the slightly different form – for reasons whatsoever – was registered itself.

The following Questionnaire is proposed to you in order to find out whether the national laws of the Member States are, indeed, harmonized and whether the national legal practice follows the “Bainbridge”-rule of ECJ or not. .



European Communities Trade Mark Association

Question 1:

Has Article 10 (2) a) of the Directive been adopted into your national Trademark Law?

a) If the answer is "yes", kindly cite the national provision:

b) If the answer is "no", what are the reasons for non-adoption?

Question 2:

a) Is there a provision in your national law stating that the registration of the used variant itself of a trademark is irrelevant for the question as to whether use of that variant may constitute use of the trademark registered in a slightly different form?

b) Are any national court/NTMO decisions known dealing with this subject?

If yes, kindly outline the result of those

Question 3:

Any other remarks?



European Communities Trade Mark Association

ECTA Harmonization Committee:

Survey: Does use of a TM slightly deviating from Reg. support Reg. if its used deviated form is likewise registered?

Question 1:

Has Article 10 (2) a) of the Directive been adopted into your national Trade Mark Law?

a) "Yes", in the following countries (national provisions cited):

Country	National Provision
Austria	<p>Section 33a (4) Trade Mark Protection Law</p> <p>"The use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, also constitute use of the trademark".</p> <p>This paragraph corresponds to Article 10 (2a) of the First Council Directive 89/104/EEC for Aproximating the Trademark Laws of the Member States deal with the use of trademarks</p>
Benelux	Art. 2.26, point 3a Benelux Treaty
Czech Republic	<p>Section 13 of the Act no. 441/2003 Sb., the Trade Mark Act:</p> <p>Use of a trade mark</p> <p>(1) If, within the period of five years following the registration, the proprietor of the trade mark has not put the trade mark to genuine use for 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 trade mark shall be subject to the sanctions provided for in this Act (Sections 14 and 31), unless there are proper reasons for non-use.</p> <p><i>(2) the proper use of a trade mark for the purpose of paragraph 1 includes also</i></p> <p><i>a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the trade mark in the form in which it was registered.</i></p>
Denmark	<p>Danish Trade Marks Act, Section 25, subsection 2(1):</p> <p>"The following is also considered as use in accordance with subsection 1,1): Use of the trade mark in a form which does not essentially deviate from the from in which it is registered."</p>
Estonia	Article 17(2)(1) of the Trade Mark Act.



European Communities Trade Mark Association

France	<p>Article L714-5 (English translation) (Act No. 94-102 of 5 February 1994 Art. 32 Official Journal of 8 February 1994)</p> <p>An owner who has not put his mark to genuine use in connection with the goods or services referred to in the registration during an uninterrupted period of five years, without good reason, shall be liable to revocation of his rights.</p> <p>The following shall be assimilated to such use:</p> <p>a) Use made with the consent of the owner of the mark or, in the case of collective marks, in compliance with the regulations;</p> <p>b) Use of the mark in a modified form which does not alter its distinctive nature;</p> <p>c) Affixing of the mark on goods or their packaging exclusively for export. Revocation may be requested in legal proceedings by any concerned person. If the request concerns only a part of the goods or services referred to in the registration, revocation shall extend to the goods and services concerned only. Genuine use of the mark begun or resumed after the five-year period referred to in the first paragraph of this Article shall not constitute an obstacle thereto if it has been undertaken during the three months prior to the request for revocation and after the owner has gained knowledge of the possibility of such a request. The burden of proving exploitation shall rest with the owner of the mark for which revocation is requested. Proof may be furnished by all means. Revocation shall take effect as of the date of expiry of the five-year period laid down in the first paragraph of this Article. It shall have absolute effect.</p> <p>b)</p>
Germany	Yes, Section 26, para 3, first sentence German Trade Marks Act
Greece	Yes, Article 18 § 2 of Law No. 2239/1994
Hungary	<p>ACT XI OF 1997 ON THE PROTECTION OF TRADE MARKS AND GEOGRAPHICAL INDICATIONS</p> <p>Article 18</p> <p>(2) ... the following shall also constitute genuine use of the trademark in the country:</p> <p>(a) use of the trade mark in a form differing from the registered form only in elements which do not alter the distinctive character.</p>
Ireland	<p>Section 51(2) of the Irish Trade Marks Act, 1996:</p> <p>“... use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and the use in the State includes affixing the trade mark to goods or to the packaging of goods in the State solely for export purposes”.</p>



European Communities Trade Mark Association

Italy	Art. 24.2 of the Italian Code of Intellectual Property: "Use of the mark in a modified form not altering its distinctive character ... constitutes use of the mark within the meaning of the present article".
Latvia	Article 23 (2) of the Law on Trade Marks and Indications of Geographical Origin of the Republic states the following: "The use of a trade mark shall also be considered to be the use of a trade mark in a form differing in individual non-essential elements, if the changes permitted to the form of the mark do not alter the distinguishing features and distinctive character of the trade mark as registered."
Lithuania	- currently no Committee Member -
Malta	Article 42(2) of the Trade Marks Act 2000, Chapter 416 of the Revised Edition of the Laws of Malta. (Chapter 416 ist der Email v. L. Sansone beigefügt!!!)
Poland	Article 169.4 point 1,2 of Polish Law of Industrial Property of June 30, 2000: " ... 4. Use of a trade mark within the meaning of paragraph (1) shall also mean the use of a mark: 1. in a form differing in elements which do not alter the distinctive character of the mark in the form for which the right of protection has been granted, 2. by affixing the mark to goods or the packaging thereof solely for export purposes."
Portugal	Article 268(1)(a) of the Industrial Property Code
Romania	Art. 46 (b) of the Romania Trade Mark Law no. 84/1998 provides that: "The following shall be considered effective use of a mark: - (...); - 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."
Slovakia	YES, Article 28 (1) of the Act no. 55/1997 Coll. <i>A trade mark owner shall be obliged to use a trade mark, particularly on goods and on their packaging or on business documents, in promotion, advertising and publicity materials only in the form in which it is entered into the Register or in the form differing only in elements that do not change its distinctive character.</i>



European Communities Trade Mark Association

Slovenia	Point a) of 6 paragraph of Article 120 of the Slovenian IP Act prescribes as follows: “The following shall also constitute use of the mark: Use of the mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.”
Spain	Article 39.2.a) of the Spanish Trade Mark law 17/2001
United Kingdom	Section 46(2) of the UK Trade Marks Act 1994.



European Communities Trade Mark Association

ECTA Harmonization Committee:

Survey: Does use of a TM slightly deviating from Reg. support Reg. if its used deviated form is likewise registered?

Question 1:

Has Article 10 (2) a) of the Directive been adopted into your national Trade Mark Law?

b) "No", in the following countries (reasons for non-adoption cited):

Country	Reasons for non-adoption
Bulgaria	No information. But, the practice of the Bulgarian Patent Office is just the opposite.
Cyprus	It is considered that there is no significant change and that it is still the same use.
Finland	It may be due to the fact that the CTM Regulation and Implementing Regulation are directly applicable in Finland. The only provision in the Finnish Trade Marks Act (Section 23) may not be of assistance in this regard when it prescribes: "If the proprietor of a registered trade mark so requests, minor changes that do not alter the overall impression of the trade mark may be entered in the Register."
Sweden	The new Swedish trade mark law is under development. As up to this moment, it would certainly be possible to refer to Article 10 (2), but it would be judged case by case.



European Communities Trade Mark Association

ECTA Harmonization Committee:

Survey: Does use of a TM slightly deviating from Reg. support Reg. if its used deviated form is likewise registered?

Question 2:

- a) Is there a provision in your national law stating that the registration of the used variant itself of a trade mark is irrelevant for the question as to whether use of that variant may constitute use of the trade mark registered in a slightly different form?

Country	
Austria	No.
Benelux	No.
Bulgaria	Art. 19, 2, 1 of the Law on Marks and Geographic Indications provides that a mark should be used by its owner in a way which does not differ substantially from its registration.
Cyprus	No.
Czech Republic	No.
Denmark	No.
Estonia	No.
Finland	No.
France	No.
Germany	Yes, Section 26, para 3, second sentence German Trade Marks Act
Greece	No.
Hungary	No.
Ireland	N/A.



European Communities Trade Mark Association

Italy	<p>No. However, art. 24.4 of the Italian Code of Intellectual Property on the “defensive marks” states that <i>“Furthermore, forfeiture for non-use shall not occur if the proprietor of a non-used mark is at the same time the proprietor of one or more similar marks still in force, of which at least one is being genuinely used to distinguish the same goods or services”</i>. Therefore, the Italian law allows trademark owners to file and register marks which will never be used, with the sole purpose of broadening the scope of protection of the principle mark.</p> <p>As you all know, the ECJ stated in the Bainbridge decision that <i>„the argument that the holder of a national registration who opposes a Community trade mark application can rely on a earlier trade mark the use of which has not been established on the ground that, under national legislation, that earlier mark constitutes a „defensive trade mark“ is therefore incompatible with Article 43(2) and (3) of Regulation No. 40/94“</i>.</p> <p>Therefore, art. 24.4 of the Italian law is to be regarded as not applicable. To date, however, we are not aware of decisions explicitly disregarding defensive marks on the basis of the incompatibility of Art. 24.4 with the Regulation and the ECJ case-law.</p>
Latvia	<p>No. the applicable law does not provide a separate provision related to the question. However, it is a consequence from the above-mentioned Article 23 (2) that registration of the used variant is not relevant to the question as to whether use of that variant constitutes use of the trade mark registered in a slightly different form, because use of a mark slightly different from the registered trade mark is considered to be the use of a registered trade mark.”</p>
Lithuania	- currently no Committee Member -
Malta	No.
Poland	No.
Portugal	No.
Romania	No.
Slovakia	No.
Slovenia	No.
Spain	No.



European Communities Trade Mark Association

Sweden	No, but the Swedish courts would look into the overall impression of the mark when judging the variant of the used mark.
United Kingdom	No.



European Communities Trade Mark Association

ECTA Harmonization Committee:

Survey: Does use of a TM slightly deviating from Reg. support Reg. if its used deviated form is likewise registered?

Question 2:

- b) Are any national court/NTMO decisions known dealing with this subject?
If yes, kindly outline the result of those.

Country	
Austria	No.
Benelux	No.
Bulgaria	Yes, as far as the Committee Member knows, there are. In general the use of a variant of a registered mark is not considered as relevant use of the registration.
Cyprus	No.
Czech Republic	No.
Denmark	No.
Estonia	No.
Finland	No.
France	Yes. Until a series of decisions given by the Cour de Cassation in 2006, the French courts always applied a rule established by the Appeal Court of Paris on March 21, 1983 concerning the trademarks NAPOLEON, NAPOLEON I., N. NAPOLEON and NAPOLEON et CIE, of which only NAPOLEON was used. The court considered that the use of one mark did not allow to validate all other similar marks held by the same owner and that the fact of having registered different - although only slightly different - signs made obvious that this owner held them for being different. Paul MATHÉLY said already in "Le droit français des signes distinctifs" edited in 1984 by Librairie du Journal des Notaires et des Avocats that the court had not applied correctly Art.5 C2 of the Paris Convention and that the fact that the same owner held other similar registrations to the used mark is irrelevant. According to Mathély, the court must indeed examine each trademark separately and determine for each mark whether the modified use



European Communities Trade Mark Association

	<p>alters the distinctive character of this mark.</p> <p>This rule was adopted by the Cour de Cassation in 3 decisions given on March 14, 2006. The court stated that according to Art. L174-5 of the Intellectual Property Code it had to be determined, whether the use of the mark under a different form than the one registered altered the distinctive character of this mark or not and that the fact that the sign was also registered under the modified form was unimportant.</p>
Germany	Federal Supreme Court decision of December 15, 1999 in case I ZB 29/97 "Frenorm"/"Frenon"
Greece	No.
Hungary	No.
Ireland	N/A.
Italy	No.
Latvia	Not known so far.
Lithuania	- currently no Committee Member -
Malta	No, as far as the Committee Member is aware of.
Poland	No.
Portugal	The Committee Member is not aware of court decisions dealing with this specific subject.
Romania	No.
Slovakia	No.



European Communities Trade Mark Association

Slovenia	<p>Yes.</p> <p>The selected Judgement of the Supreme Court No. III Ips 83/98 dated Oct. 15, 1998 is as follows: The Decision deciding about the cancellation action on the basis of non-use states that the use of the word mark Magno in combination with additional suffixes in a composed word/s (for example <u>Magnoprint</u>, <u>Magnomatt</u> <u>Magnolux</u>) can be considered as a proper use of the mark Magno registered in class 16.</p> <p>The second selected case is the Decision of the Higher Court in Ljubljana No. I Cpg 891/2004 dated June 9, 2005 as follows: The changing of just one letter in the registered word mark DEE JEY TIME , namely the use of the letter A instead the letter E in word JEY/JAY (i.e. use of DEE JAY TIME instead of DEE JEY TIME), does not alter the distinctive character of the registered mark DEE JEY TIME, especially since the JAY is pronounced by the Slovenian consumer as "Džej", namely in the same way as word "JEY".</p>
Spain	<p>Yes.</p> <p>The Supreme Court has repeatedly stated that if one has a later trade mark which is the supposed variant, it is that trade mark which is being used and not the original trade mark in a variated form (e.g. Bandeira case).</p>
Sweden	Not any specific.
United Kingdom	<p>Yes.</p> <p>The Appointed Persons decision REMUS BL 0/061/08. REMUS and REMUS UOMO are both registered trade marks and use of REMU HOMO was considered use of REMUS.</p>



European Communities Trade Mark Association

ECTA Harmonization Committee:

Survey: Does use of a TM slightly deviating from Reg. support Reg. if its used deviated form is likewise registered?

Question 3:

Any other remarks:

Country	
Austria	No.
Benelux	No.
Bulgaria	It is constant practice of the Bulgarian Patent Office which is further accepted by the court because of the provisions of Art. 19,2,1 of the national Trade Mark Law. No information for new cases after the accession of Bulgaria to EU.
Cyprus	No.
Czech Republic	No.
Denmark	No.
Estonia	There is no case law in the current issue, just exists a case law of an unregistered sign deviating from the registered trade mark in a form which, according to the court, does not alter the distinctive character of a mark.
Finland	No.
France	The Committee Member thinks that the solution given by the Cour de Cassation is the only one which guarantees an equal treatment for all registered trade mark rights and therefore legal security.
Germany	Many legal authors have analyzed the difference between "Bainbridge" and German law. It is generally held that this issue has to be clarified by the ECJ in an appropriate case upon submission by a German court.
Greece	We would additionally refer to the legal interest to be proven by any third party filing a petition for cancellation against a registered mark due to non use. This third party would be in principle devoid of any legal interest to attack a trade mark registration in order to free the way for its own fresh and identical application because in most cases the second very similar registration would still constitute an insurmountable burden for the acceptance of the third party's application exactly due to the fact that this second registration is only a slightly different form of the attacked one.



European Communities Trade Mark Association

Hungary	As regards the present problem, the Committee Member informs that the registered and used forms should be closely related. For example the same word with more or less different letter type or design may be considered as proper use. In case of two registrations the use of one of them may also ensure protection of the other one in case they are not fully or considerably different from each other.
Ireland	N/A.
Italy	Please see above under Question 2 a).
Latvia	The use of word elements, incorporated into the combined trade mark, on the related documentation accompanying the goods is considered to be the use of the registered figurative/device trade mark.
Lithuania	- currently no Committee Member -
Malta	The Trade Marks Act 2000 came into effect as from 1 st January 2001. As far as the Committee Member is aware, the provision of law cited herein has not been the subject of a local judicial pronouncement.
Poland	The decisions of the Polish Patent Office's examiners are not uniform, especially in cases relating to trade marks which consist of many elements.
Portugal	<p>In the Committee Member's opinion, under the Portuguese trade mark law, the principle of proper use of a registered trade mark in a slightly different form is not affected by the fact that the slightly different form – for reasons whatsoever – was registered itself.</p> <p>The Committee Member thinks that par. 86 of the Bainbridge judgment is <i>obiter dictum</i> and should not be overestimated mostly because:</p> <ol style="list-style-type: none"> 1. The ECJ did not explicitly say that (or explained why) the principle of proper use of a registered trade mark in a slightly different form does not apply if the slightly different form was registered itself. 2. The ECJ did not really examine the question of whether the marks BRIDGE and THE BRIDGE may be regarded as being different "solely by reason of elements which do not alter the distinctive character of the trade mark". At least from the Portuguese legal point of view the Committee member would say that the difference between marks indeed alters their distinctive character. 3. The ECJ concluded that use of the mark THE BRIDGE was not established and therefore it was not even necessary to examine whether evidence of use of the latter could serve as



European Communities Trade Mark Association

	evidence of use of the mark BRIDGE.
Romania	No.
Slovakia	No.
Slovenia	In practice, deciding as to whether the use of a mark can still be considered as proper use of the same compared to its registered form, is difficult.
Spain	Spain has traditionally been a very "tolerant" country, in that it accepts changes as non-essential which in other countries have been rejected. However, this seems to be changing, especially after the cited <i>Bandeira</i> and the <i>Nike/Cidesport</i> case.
Sweden	The Swedish courts always try to judge every case looking at the overall impression of the respective marks.
United Kingdom	No.