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NON CONFUSION INFRINGEMENT

Benelux perspective

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Why non-confusion?

- ✓ Why not "dilution"?
- ✓ Dilution by blurring or tarnishment is only one form of non-confusion infringement
- ✓ Another one is taking unfair advantage of the reputation of the mark

Where do we come from?

- ✓ Benelux tm law until 1996:
- ✓ Nice and simple: ® owner could oppose:
 1. Any use of mark or *similar* sign for identical or similar products
 2. Any other use of mark or *similar* sign made without a valid reason under circumstances to be *prejudicial* to the tm owner

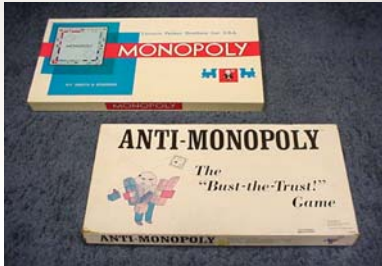
Use of *similar* sign

- ✓ No likelihood of confusion required
- ✓ The core was: *similarity*; what is that?
- ✓ Benelux Court in re. *Union* (1983)
 - ✓ When, taking all circumstances into account, such as distinctiveness
 - ✓ Mark and sign show such a resemblance phonetically, visually or conceptually, that by this alone
 - ✓ **Associations** between mark and sign are evoked

Likelihood of association

- ✓ In the case of identical or similar products the first infringement criterion ("similarity") therefore captures
 - ✓ Likelihood of confusion
 - ✓ Likelihood of dilution

Example: Supreme Court 1977



SMALL EXERCISE



Any other use

- ✓ The second criterion applicable
 - ✓ for any other use (non-trademark use and/or use for dissimilar products)
 - ✓ without a valid reason
 - ✓ provided use is likely to be prejudicial
- ✓ Reputation was not required but important factor in case law

Advertising function

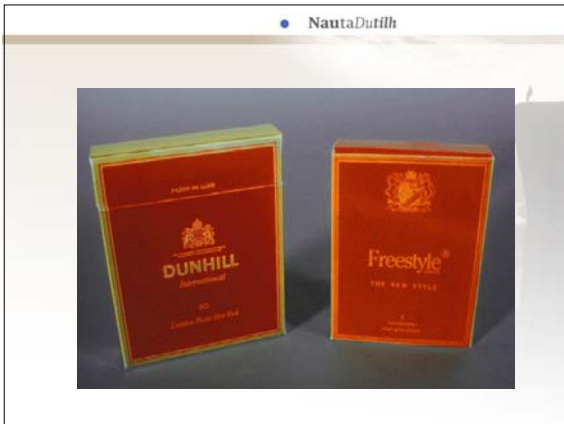
- ✓ Recognised by Benelux Court of Justice as protectable under both criteria
 - ✓ AP vs. Valeo 1992
 - ✓ Mercedes vs. Haze 1993
 - ✓ Claeryn vs Klarein 1975

Example: Benelux Court 1975



Any other use and prejudice

- ✓ Benelux Court in re. Claeryn vs. Klarein:
 - ✓ Adverse effect on the capacity of a mark to stimulate the desire to buy or on the canvassing effect of a mark



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Not always party!

- ✓ JEEP for cars vs. JEEP for ladies underwear (1980)
- ✓ RED HOT for clothing vs. RED HOT for minced meat balls (1992)

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Likelihood of prejudice

- ✓ Mostly in cases of
 - ✓ Icon marks (APPLE vs. APPLE for advertising and marketing)
 - ✓ Antagonism (MERCİ for chocolates vs MERCİ for pet food)
 - ✓ Related goods (REDDY for sauces vs. meat products)

Stripes litigation under EU Directive regime



Similarity?

- ✓ ECJ in *Chevy* (1999)
 - ✓ *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, ..., and that the earlier trade mark may consequently be damaged*
- ✓ ECJ in *adidas/Fitnessworld* (2003):
 - ✓ *It is sufficient for the degree of similarity (in visual, aural or conceptual respect, G.) between the mark with a reputation and the sign to have the effect that the relevant section of the public establishes a **link** between the sign and the mark.*
- ✓ So: if there is association, there is similarity

Unfair advantage of repute

District Court
The Hague
2003



Detriment to repute

✓ District Court The Hague 2001



Dilution and similar products

✓ SWIFT v. SWIFTPAY
both for financial services
Court Den Bosch 2006

✓ RED BULL v. BULLFIGHTER
Both for energy drinks
Court Brussels 2006



No link

District Court The Hague 2005

PEPSI



Benelux vs EU law

- ✓ Both: likelihood of association
 - ✓ (sufficient similarity to cause a link = connection = bringing to mind = association; see Sharpston, 46)
- ✓ Benelux:
 - ✓ no repute necessary, but it helps
 - ✓ (non-theoretical risk of) association sufficient in case of similar products

Benelux vs. EU law

- ✓ Dissimilar goods:
 - ✓ Both: link is not sufficient for prejudice (Intel)
 - ✓ Both: the stronger the distinctiveness (which is the more so if the mark is unique, Intel, 56), the more likely a link will be made (Intel, 54-55)
 - ✓ Both: the stronger the mark's distinctiveness and reputation: the easier detriment can be accepted (Chevy 30, Intel 69, 74)

EU law on injury

- ✓ INTEL (38)
 - ✓ The proprietor of the earlier trade mark is not required...to demonstrate actual and present injury...
 - ✓ When it is foreseeable that such injury will ensue from the use which the proprietor of the later mark may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use.
 - ✓ The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future.

Benelux vs. EU law

- ✓ Detriment to distinctiveness
 - ✓ EU: Serious risk of injury requires evidence of serious likelihood of a change of the economic behaviour of the consumer (Intel, 77)
 - ✓ Benelux: Non theoretical likelihood that canvassing power of trademark is affected (a.o. Claeryn)
 - ✓ Is rather close, provided 'serious' is seen as 'non theoretical'; see TDK order

ECJ Order re. TDK

- ✓ TDK for recording apparatus vs TDK for clothing
- ✓ ECJ 12/12/08: re. standard of proof:
 - ✓ *it is sufficient that evidence be produced enabling it to be concluded prima facie that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future*



Source picture: www.ajax.nl

Art. 16, 3 TRIPS

- ✓ Dissimilar products:
 - ✓ *provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.*

No link; no 'Intel' proof of injury
Pres. Court The Hague 2008



THANKS!

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