**TRADE MARK LAW INSTITUTE**

Leiden-Nijmegen-Groningen-Amsterdam-Rotterdam

**4th TLI SYMPOSIUM**

**TRADE MARK LAW, USE RESTRICTIONS and PUBLIC POLICY**

May 31-June 1 2013

Faculty of Law, University of Groningen (founded 1614)

Friday: Senaatszaal Academy Building, Broerstraat 5, Groningen

(<http://www.rug.nl/about-us/how-to-find-us/route-broerstrt5>)

Saturday: Board Room of the University, Oude Boteringestraat 44, Groningen

......

PURPOSE OF THE CONFERENCE

The purpose of this conference is to study and discuss the influence of public policy on the existence of trade marks. We have lived in times where trade marks could be obtained without other requirements than that they need to be distinctive of particular goods or services, that they should not be misleading or against public order or morality. This basic principle is given in art. 6*quinquies* Paris Convention.

Once obtained (mostly by registration), the life of a trade mark seems reasonably quiet in legal terms except that the prior rights of third parties should be respected. But a trade mark of course is not just made for purely legal reasons. It serves entrepreneurs to build and maintain a market position and communicate with the market. However the freedom to operate seems to be challenged for public policy reasons more and more and the question is how far public policy can go in restricting the use of trademarks. We have already seen legislation obliging companies to put particular indications on their packaging. One can think of indications concerning the use of the product, such as dosage information or information that would make a recall possible. Such obligations are more or less accepted.

However we are more and more confronted with legislation that would restrict the use of the trade marks themselves either by banning their use (ban on use of tobacco trade marks on non-tobacco products; ban on logo’s on tobacco products in Australia) or restricting the use (caused by health warnings on such products). The obvious example of far going legislation concerns what is known as plain packaging of tobacco products. But this certainly is not only an issue in the tobacco industry. For example: the State of Kuwait notified the WTO council of a measure according to which any propaganda for breast feed substitutes is forbidden together with a ban on the use of any picture that idealizes the use of infant formula (including trade marks showing such pictures); such pictures are often part of trademarks. One can also think of the case recently decided by the EFTA Court (E-2/12), concerning the question whether Iceland could legally oppose the importation of tins containing an alcoholic beverage (TEMPT 9 Cider), legally marketed in Denmark and showing naked women’s legs, based on a provision of Icelandic law forbidding that the packaging and labeling of the products contain loaded or unrelated information or suggest that alcohol enhances physical, mental, social or sexual function and do not merely relate to the product, its production method or its characteristics. And what can we expect regarding food products that could result in obesitas or diabetes?

The below programme will first deal with the basic question how trademarks should be looked at. Should it be looked at as positive right to use following the essence of being a property right (see for example Prof. Robert P. Merges, Justifying Intellectual Property, Harvard University Press, 2011; A. Kur, EIPR 1996, 198; M. Castren, EIPR 1995, 87; U. Bernitz EIPR 1990, 137) or is not much more than a right to exclude others (for example E. Bonadio, EIPR 2012, 599); or is it just an (advertising) means to communicate with the market (S. Maniatis, A. Kamperman Sanders, EIPR 1997, 237). In this context we need to address the economic theory behind trade marks. They serve to make consumer choices easier and help to reduce search costs. Restrictions on use seem to go against this rationale.

What can we learn from the international instruments (Paris Convention, TRIPS, CTM Regulation, Trademarks Directive) as well as EU case law on trademarks and in particular the function theory as developed by the European Court of Justice?

Then we will look into international agreement principles. Are restrictions of use permissible under the Paris Convention (which in its art. 6*quinquies* only seems to regulate the allowance of restrictions re. registration; meaning of art. 7 in this respect?), TRIPS (in particular art. 15(4), 17 and 20) and TBT Agreement on the preparation, adoption and application of technical regulations (in particular art. 2(2).

Also, the question of fundamental rights and in particular the fundamental right of freedom of enterprise and guarantee of property will be discussed (art. 1 First Protocol ECHR) also in the light of *Anheuser-Busch v Portugal* (2007) 45 EHRR 36, para. 72 and 78 and *Van Marle v Netherlands* (1986) 8 EHRR 483.

## PROGRAMME

# Friday, 31 May 2013

#### 13.30 Registration and coffee

14:00 Welcome to the University of Groningen by Professor Jan Berend Wezeman, Dean of the Faculty of Law

14.10 Aim of the Conference & Approach

*Prof. Charles Gielen, Chair Trademark Law Institute (Groningen)*

#### 14:15 Part 1: Trademarks: positive right to use v. right to exclude others or communication means and economic rationale of trade marks

Chair: *Prof. Dirk Visser, Leiden University*

14:15 Introduction I. Trademarks: is there a positive right to use?

*Prof. Dr. Annette Kur,* *Max Planck Institute München*

14:40 Introduction II. Trademarks: right to exclude others; communication means

*Prof. Dr. Spiros Maniatis, Queen Mary University of London*

15.00 Introduction III. The economic rationale of trademarks and restrictions on use

*Dr Max Oker-Blom, Hanken School of Economics, Helsinki*

15:20 Discussion

16:20 Coffee Break

#### 16:15 Part 2: Restrictions on use; Influence of Economic theory and compliance with international legal instruments

Chair: *Prof. Antoon Quaedvlieg (Nijmegen)*

16:35 Introduction I. Paris Convention and TRIPS

*Wolf Meier-Ewert, Counselor, WTO*

16:55 Introduction II. Restriction of use and function theory of trade marks in the light of CTM Regulation/Trade Marks Directive and the case law of the Court of Justice

*Dr. Jennifer Davies, Faculty of Law, University of Cambridge*

17:20 Discussion

18:00 Summary and conclusion

19:30 Conference Dinner at Restaurant De Pauw, Gelkingestraat 52, Groningen

# Saturday, 1 June 2013

#### 9:00 Part 3: Restrictions of use and fundamental rights, such as freedom of enterprise and freedom to guarantee property

Chair: *Prof. Martin Senftleben, Free University Amsterdam*

9:00 Introduction I. What can we learn from the ECHR and ECJ case law on trademarks and goodwill as protectable property

*Prof. Dr. Jonathan Griffiths, Queen Mary University of London*

9:25 Introduction II. Are restrictions of use infringements to fundamental principles?

*Dr. Wolfgang Sakulin, Attorney-at-law, Rotterdam, (PhD on Trade mark protection and freedom of expression)*

9:45 Discussion

10:30 Coffee Break

#### 10:45 Part 4: Other issues of restrictions of use

Chair: *Prof. Tobias Cohen Jehoram, University of Rotterdam*

10:45 Introduction I. View from Asian perspective on the topic of restriction of use.

*Prof Wushuang HUANG, East China University of Political Science and Law, Shanghai*

11:05 Introduction II. Public Order and restrictions in acquiring or using trademarks

*Dr. Caspar van Woensel, Assistant Professor Private Law, University of Leiden*

11:25 Discussion

#### 12:15 Conclusion and summary of main results

12:45 Closing and Information on Future Projects

*Prof. Charles Gielen, Chair Trademark Law Institute (Groningen)*

13:00 Conference Closing Lunch