

Descriptive and Non-Distinctive Use Defences in EU Trademark Law

Anna Tischner



Art. 17 TRIPS (Exceptions)

Members may provide limited exceptions to the rights conferred by a trademark, **such as fair use of descriptive terms**, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties.

'Descriptive use' defence

Before...

Art. 6(1)b TMD2008/95 & Art.12(b)CTMR

Limitation of the effects of a trade mark

1. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

(b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services

Now...

Art. 14(1)b TMD & 12(1)b EUTMR

Limitation of the effects of a trade mark

1. A trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

(b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services

Issues

I. Terminology and Telos

II. Systemic problems:

- descriptive use v. absolute grounds for refusal
- descriptive use v. infringement criteria
- descriptive use v. referential use

III. Challenges/Opportunities

I. Terminology and Telos

use of descriptive/non-distinctive signs

v.

use for descriptive/non-distinctive purposes

Use of non-descriptive signs for descriptive purposes

- **C-109/97 *Chiemsee***, para 28: Article 6(1)(b), which aims, inter alia, to resolve the problems posed by registration of a mark consisting wholly or partly of a geographical name, does not confer on third parties the right to use the name as a trade mark but **merely guarantees their right to use it descriptively**, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters
- **C-48/05 *Opel***, para 43: that provision **might authorise a third party to use a trade mark if such use consists in giving an indication concerning the kind, quality or other characteristics of products marketed by that third party**, provided that use is made in accordance with honest practices in industrial or commercial matters
- **C-102/07 *Adidas Marca Mode***, para 48: the placing by those competitors of motifs with stripes on their garments **is not intended to give an indication concerning one of the characteristics of those goods**

MPI Study on the Functioning of the European Trade Mark System

- 2.257 *In addition, Article 6 (1) (b) TMD and Article 12 (b) CTMR could be extended to cover all cases in which a trade mark, even if distinctive as such, is not perceived as an indication of commercial origin by the relevant public.*

What the new wording might mean to those cases?

C-48/05 Opel

- informational use



C-102/07 Adidas Marca Mode

- decorative use



II. Systemic issues (1)

use of descriptive/non-distinctive signs

v.

absolute grounds for refusal

Mirroring?

Absolute grounds for refusal

Art. 4(1)b TMD trade marks which are devoid of any distinctive character

- non-distinctive signs

Art. 4(1)c TMD trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services

- descriptive signs

Limitations

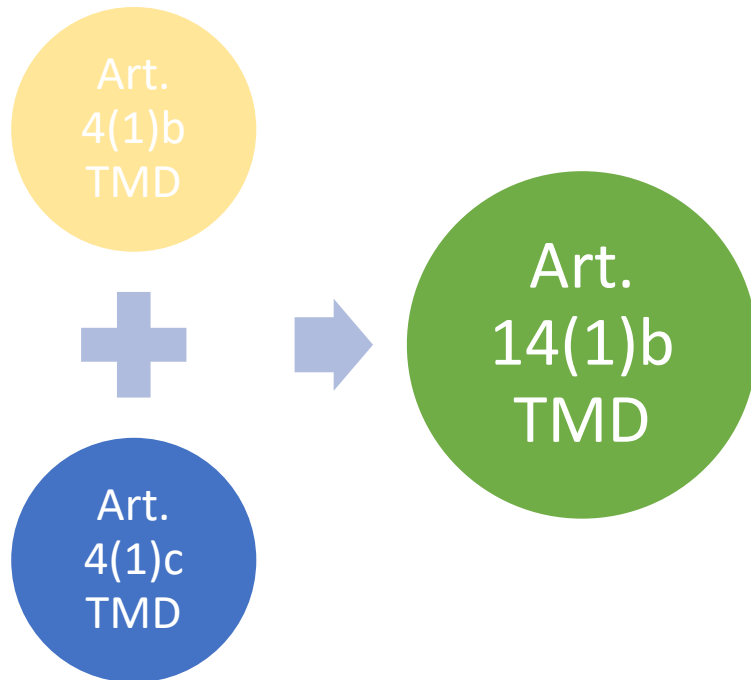
Art. 14(1)b TMD use of signs or indications which are not distinctive

- use of non-distinctive signs

Art. 14(1)b TMD use of signs or indications which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services

- use of descriptive signs

or Shadowing?



Hans-Jörg Aleff, Two Persons, One Shadow, Berlin 2014

II. Systemic issues (2)

use of descriptive/non-distinctive signs

v.

infringement criteria

C-705/17 Hansson

a complex (word+figurative) trade mark



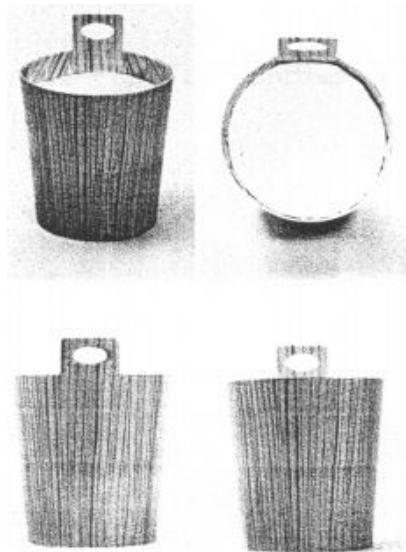
Fig. 1.

the word sign

ROSLAGSÖL

That registration was accompanied by a disclaimer stating that 'registration does not give an exclusive right over the word RoslagsPunsch'.

Polish Supreme Court IV CSK 23/12 'milking pail'



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IR 736770

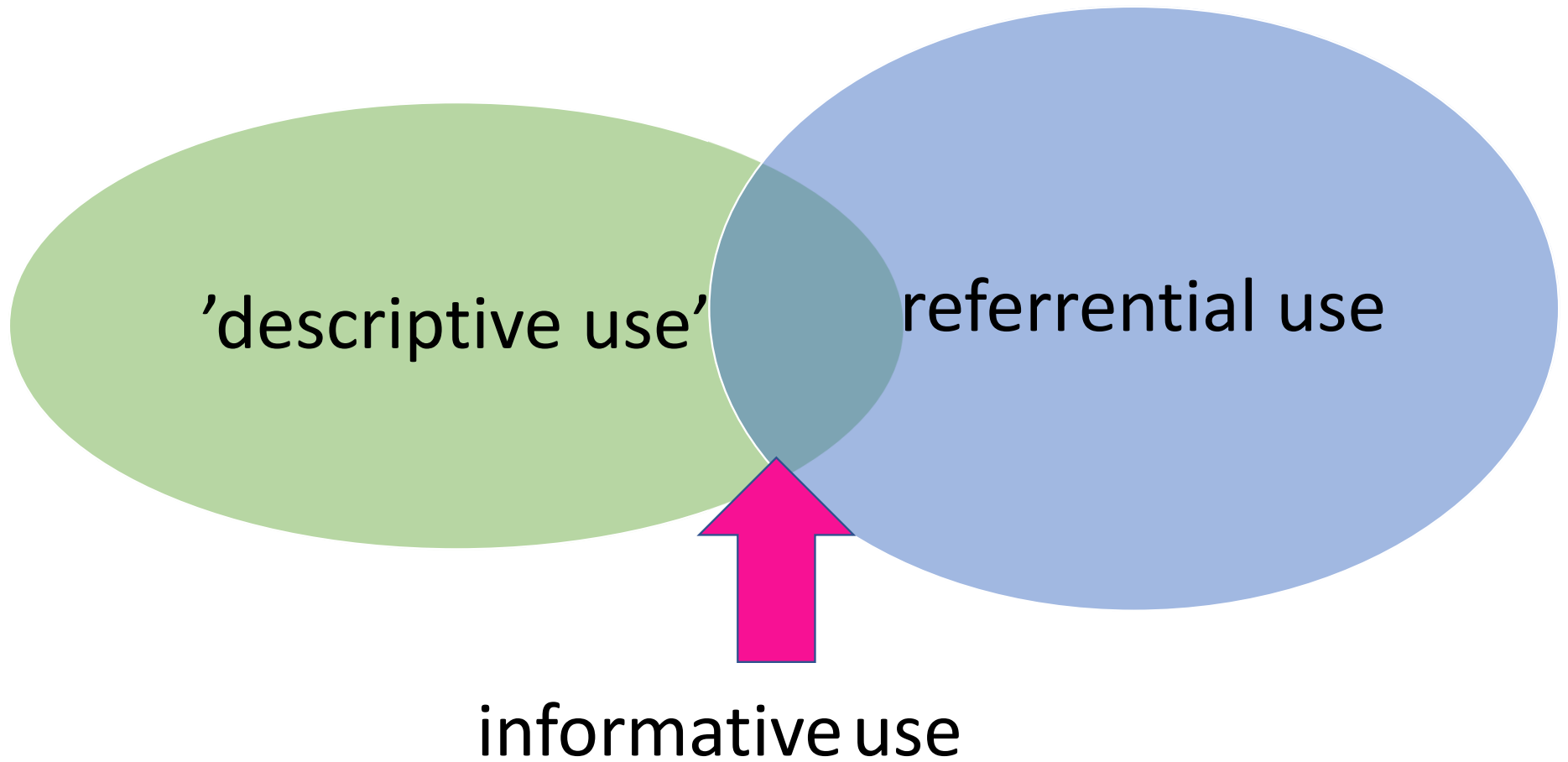
II. Systemic issues (3)

'descriptive use'

v.

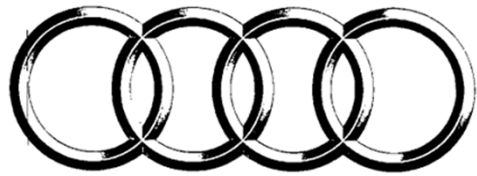
referential use

Informative use - Overlap?



C-334/22 *Audi* Informative use?

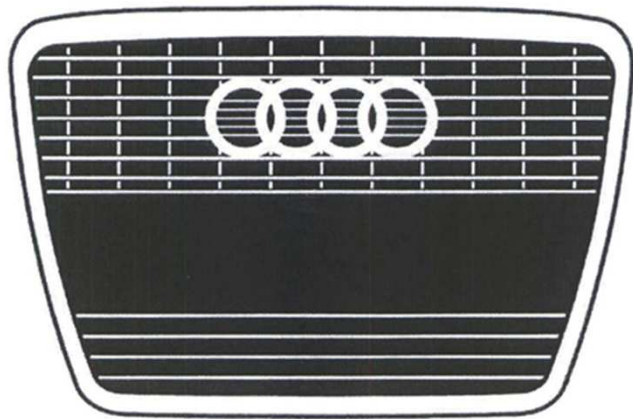
EUTM 000018762



the alleged infringer



C-334/22 Audi



RCD 000150461-0001



Trade mark as an inherent characteristic of a good



III. Challenges/Opportunities/Conclusions