

RECOMMENDATION ON MEASURES TO SAFEGUARD FREEDOM OF EXPRESSION AND UNDISTORTED COMPETITION IN EU TRADE MARK LAW

The Signatories,

- *Emphasizing* that, whatever the protection afforded to trade marks, it must always be balanced against general interests, in particular the fundamental freedom of expression and the guarantee of undistorted competition;
- *Recognizing* that the need for an appropriate balance is inherent in trade mark law and is an issue of particular importance in the light of ongoing technological, economic and social developments;
- *Pointing out* that in order to achieve an appropriate balance, the legitimate interests of trade mark proprietors, consumers, competitors and the public at large must be taken into account at all stages by legislators, trade mark registration offices and courts, meaning in particular that:
 - the grant of trade mark rights should not of itself confer a competitive advantage apart from the establishment of an exclusive link with a sign that can be used to distinguish goods and services in the marketplace and obtain a reputation. This principle must be respected independently of the kind of sign and the ground for refusal invoked;
 - the analysis of trade mark infringement must proceed not solely from the perception of the target public but must, as appropriate, take into account other normative aspects, such as the interests of competitors and the public to keep the sign available;
 - a fundamental distinction must be drawn between situations in which a trade mark is used to indicate the commercial origin of goods or services that do not originate from the trade mark proprietor and situations in which a mark is used to identify goods or services as those of the trade mark proprietor or to designate goods or services that are legitimately commercialized in the EU. In the latter situations, use of the mark should only be held to infringe the mark where it is manifestly unfair;
 - the burden of proving the existence, or absence, of conditions relevant to the establishment of trade mark infringement must be distributed appropriately between claimant and defendant, taking into account the equal importance of trademark protection on the one hand and freedom of expression and freedom of competition on the other.
- *Believing* that these measures are of a mandatory nature, deriving from overarching fundamental principles embodied in the Lisbon Treaty, the Charter of Fundamental Rights and the European Convention on Human Rights;
- *Recognizing* that the existing law already contains certain flexibilities to balance trade mark protection against freedom of expression and freedom of competition and that these flexibilities have, to some extent, been used by courts and that room for such flexibilities must continue to exist;

- *Recommending* nevertheless that, for the purposes of clarification, legal certainty and uniform implementation of these flexibilities in all Member States, certain free uses should be expressly secured in the envisaged new EU trade mark legislation, in particular:
 - political and artistic use, including use for the purposes of criticism, comment and parody;
 - use for the purpose of reporting current events;
 - use resulting from the exhaustion of trade mark rights, including use relating to the offering of goods or services in respect of trademarked products on downstream markets;
 - use in advertising that allows consumers to compare goods or services, informs consumers about alternative offers in the marketplace, or that brings the resale of trademarked goods to the attention of consumers;
 - use of a sign or indication that is descriptive in the language of any Member State even if the sign or indication also enjoys protection as part of, or in connection with, a national trade mark;
 - use of all kinds of signs which should remain free to prevent trade mark protection from granting its proprietor a monopoly on functional product characteristics of a technical or aesthetic nature which consumers are likely to seek in the products of competitors, such as use of signs resulting from the nature of goods or services, being necessary to obtain a technical result, or giving substantial value to goods or services.

- *Recommending* that, in order to keep pace with technological developments and to allow the adaptation of the law to changing circumstances, an open-ended clause should be added to the provision on limitations which allows courts to develop appropriate new defences on a case-by-case basis in circumstances where the purposes, objectives and fundamental principles underlying the existing legislation warrant permitting third party use notwithstanding the lack of an express limitation. The application of this open-ended clause should not be pre-empted by the existence of more specific limitations. Its scope must not be confined to non-commercial use;

- *Recommending* that any legislative requirement for flexibility tools, such as limitations, to be exercised in accordance with “honest practices”, should not be applied in a way that erodes their effectiveness. In particular, the honest practices requirement must leave room for courts to enter into a balancing of all rights and interests at stake. It must not consist of a repetition of infringement criteria that brings protection interests into focus.

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