

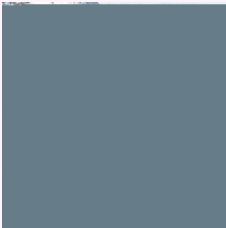
• NautaDutilh

NON CONFUSION INFRINGEMENT Benelux perspective

Professor Charles Gielen
NautaDutilh and University Groningen
UCL 11 February 2009

• NautaDutilh

Sir Hugh Laddie



• NautaDutilh

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?

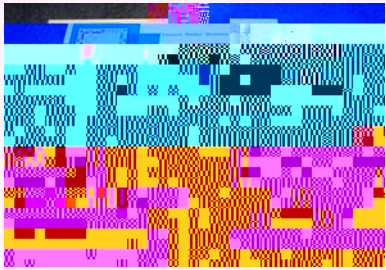
Benelux Court in re. *Union* (1983)

When, taking all circumstances into account, such as distinctiveness

Mark and sign show such a resemblance

NautaDutilh

Example: Supreme Court 1977



NautaDutilh

SMALL EXERCISE



NautaDutilh

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

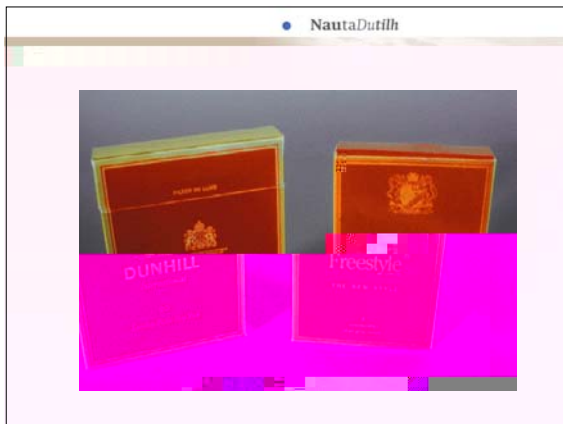
Example: Benelux Court 1975



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



• NautaDutilh

Not always party!

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


• NautaDutilh

Likelihood of prejudice

Mostly irrelevant Podalls (1992)

NautaDutilh

Stripes litigation under EU Directive regime



NautaDutilh

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.*
- ✓

• NautaDutilh

Detriment to repute

District Court The Hague 2001




• NautaDutilh

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



• NautaDutilh

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

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

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



THANKS!

charles.gielen@nautadutilh.com
