

2020 AIPPI World Congress – Online
Adopted Resolution
14 October 2020

Resolution

2020 – Study Question – Trademarks

Descriptive use as a defence in trade mark proceedings

Background:

- 1) This Resolution concerns whether and under what conditions a descriptive use of another party's trade mark may act as a defence to an allegation of trade mark infringement by that party. In this Resolution, "descriptive use" refers to the use of a sign that relates to the characteristic of the goods or services.
- 2) This Resolution is limited to the descriptive use defence in the context of trade mark infringement proceedings, whether before a court or an administrative office (hereafter a "tribunal"). Actions based on other grounds (e.g. unfair competition) are outside the scope of this Resolution, as are trade mark invalidity actions.
- 3) 41 Reports were received from AIPPI's National and Regional Groups and Independent Members providing detailed information and analysis regarding national and regional laws relating to this Resolution. These Reports were reviewed by the Reporter General Team of AIPPI and distilled into a Summary Report (see links below).
- 4) At the online AIPPI World Congress in October 2020, the subject matter of this Resolution was further discussed within a dedicated Study Committee, and again in a full Plenary Session, following which the present Resolution was adopted by the Executive Committee of AIPPI.

AIPPI resolves that:

Descriptive use as a defence in trade mark proceedings against an allegation of trade mark infringement

- 1) A descriptive use of a proprietor's trade mark or part of such trade mark should be available as a defence against an allegation of trade mark infringement by that proprietor.

- 2) Such descriptive use as a defence may concern descriptive use of any type of trade marks.
- 3) The principles set out in the 1st and 2nd paragraphs do not mean that the prior trade mark should be deemed invalid if the descriptive use defence is successfully argued.

Conditions for descriptive use to act as a defence in trade mark proceedings against an allegation of trade mark infringement

- 4) The descriptive use must be in accordance with the principles of honest and/or fair use or equivalent use.
- 5) The use of the proprietor's trade mark should not be considered as honest and/or fair use or equivalent use thereof in particular when:
 - The use takes unfair advantage of the distinctive character or repute of the proprietor's trade mark, or
 - The use gives the impression that there is a commercial connection with the proprietor, or
 - The product or the service is presented as an imitation or replica of the product or service bearing the proprietor's trade mark, or
 - The use discredits or denigrates the proprietor's trade mark or is detrimental to its reputation.
- 6) In considering whether the descriptive use defence is to be allowed, a tribunal can take the following factors, in particular, into account:
 - a. The reputation of the proprietor's trade mark, if any;
 - b. Whether the alleged infringing sign can be considered to be functioning as a source or origin identifier;
 - c. The context in which the third party uses the sign.

Rules of evidence

- 7) There should be no restrictions on the type of acceptable evidence.

Types of proceedings

- 8) It should be possible to invoke the descriptive use as a defence in any trade mark infringement proceedings.

Links:

- [Study Guidelines](#)
- [Summary Report](#)
- [Group Reports](#)