

FICPI World Congress
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7. Balancing Fair Protection for Trade Marks with their
Fair Use by Third Parties

‘Fair Use’
in General
by Andrew Parkes

Abstract

TRIPs Art. 16 *Rights Conferred*

TRIPs Art. 17 *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.”

EC Harmonization Directive 89/104,

Art. 5 *Rights conferred by a trade mark*

Art.6 *Limitations of the effect of a trade mark*

Gerolsteiner Brunnen v. Putsch, ECJ Case C-100/02, [2004] ETMR 40
German trade mark GERRI for mineral water and non-alcoholic beverages.
Infringement action against KERRY SPRING as trade mark on drinks using water from Kerry Spring, a listed mineral water source in Ireland.

Anheuser-Busch v. Budejovicky Budvar, ECJ Case C-245/02, [2005] ETMR 286
Finnish trade marks BUDWEISER, BUD et al.. Infringement action against BUDEJOVICKY BUDVAR, BUDWEISER BUDVAR et al.

Gillette Co. v. LA-Laboratories, ECJ Case C-228/03, [2005] ETMR 825
Finnish Trade Marks GILLETTE and SENSOR. Infringement action against sale of PARASON FLEXOR razors and blades with legend: “All Parason Flexor and Gillette Sensor handles are compatible with this blade”.

Adam Opel AG v. Autec AG, ECJ Case C-48-05, Opinion of AG Ruiz-Jarabo Colomer, 07.03.2006
German trade mark ‘Opel-lightning’ logo registered for various goods including “toys”, used on licensed model vehicles. Infringement action against use of logo on grill of Autec’s radio-controlled model of an Opel Astra V8 Coupé sold under TM ‘Cartronic’, not licensed by Opel.

Comparative Advertising

EC Directives 84/450 and 97/55

Comparative advertising using competitor's trade mark permitted under certain conditions.

Pippig Augenoptik v. Hartlauer, ECJ Case C-44/01, [2004] ETMR 65

Price comparison between optician's shops in Austria. In Hartlauer's TV advertisements it was not stated that the spectacles compared had lenses of different brands. They also showed Pippig's shopfront.

O₂ v. Hutchinson, English High Court, [2004] EWHC 2571, [2004] ETMR 763

Comparative advertising concerning price of mobile phone services in England. Application for interim injunction to restrain use of UK and Community trade marks.

US Law summary

Fair use defense: use other than as a trade mark, that is descriptive and is used fairly and in good faith only to describe the goods.

Nominative fair use

New Kids on the Block v. News America Publishing Inc., 971 F.2d 302 (9th Cir.1992)

Century 21 Real Estate Corp. Lending Tree, Inc., 425 F.3d 211 (3rd Cir. 2005)