

## **QUESTION 168**

**Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights**

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Q168

### **Question Q168**

**Use of a mark "as a mark" as a legal requirement in respect of acquisition, maintenance and infringement of rights**

### **Resolution**

**AIPPI**

**Observing that:**

- there is no widely accepted definition of what constitutes use "as a mark". Those countries which do define such use provide different tests;
- use "as a mark" has traditionally been understood as use to distinguish goods or services, in a broad sense;
- where use is required to acquire rights in or obtain a registration of a mark, use "as a mark" is required;
- use "as a mark" is required to maintain a trademark registration;
- there is a wide variety of activities which may constitute trademark infringement, not all of which require use of the infringing mark "as a mark";
- there are arguments for and against having a different assessment of use "as a mark" between acquisition, maintenance and infringement of rights;
- in many countries there has been little or no development of the law concerning the relationship between trademarks and the Internet. Nevertheless, such developments seem likely in the future;
- use of trademarks for profit (e.g. by fan clubs and supporters) may be distinguished from use in a non-commercial sense (e.g. as a badge of allegiance);
- the question of trademark use and parody raises cultural issues but is in general susceptible of trademark law analysis;
- no clear picture emerges as to the level of protection offered by various laws of unfair competition, comparative advertising and other laws concerning unauthorised trademark use;
- there is a benefit in harmonising national laws concerning "use of a mark" in the areas of acquiring and maintaining trademarks and in the laws applying to infringements.

**Noting:**

- AIPPI's Resolutions Q70, Q92A, Q95 and Q164
- the Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs on the Internet adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organisation (WIPO) at the Thirty-Sixth Series of Meetings of the Assembly of the Member States of WIPO September 24 to October 3, 2001 (the "WIPO Joint Recommendation"), which sets out a test of "commercial effect".

**Resolves:**

1. AIPPI supports the WIPO Joint Recommendation
2. Maintenance of a trademark registration should require authorised exploitation (which is a question of fact, and whether on the Internet or otherwise) in the relevant territory within any prescribed period.
3. Use other than traditional use "as a mark" may be an infringement. In the context of the Internet, infringement should be subject to the same analysis as other trademark use and may include unauthorised adoption or use of a domain name or use of a metatag or in linking or framing.
4. Use of trademarks by fan clubs and supporters should be subject to the same analysis as other trademark use.
5. Use of trademarks in parody should be subject to the same analysis as other trademark use.
6. AIPPI should follow developments in trademark usage on the Internet in an effort to facilitate harmonised developments in this area.