

QUESTION 155

Conflicts between Trademarks and Company and Business Names

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Q155

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Conflicts between Trademarks and Company and Business Names

Resolution

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Considering:

- (a) the Resolution previously taken in Madrid in 1970 on Q 41, notes that a business name is a trade name, namely a sign which distinguishes any enterprise engaged in the manufacture or sale of products, or in providing services and may include surnames, fanciful denominations, designations of business activities, a characteristic component, an abbreviation, a symbol or any other identifying sign of the enterprise;
- (b) that a company name is the legal name of a corporation and may function as a trade name;
- (c) that there is an extreme diversity among countries with regards to the formalities for adopting company names and business names and notes that in some countries a company or business name is protected from its adoption and in others it is protected from the moment it is used in trade;
- (d) the importance of recognising an appropriate protection of company names and business names;
- (e) that as with trademarks the protection afforded to a company name or a business name depends on the level of its intrinsic or acquired distinctiveness;
- (f) that depending on the country it is possible to object to the use or registration of a company name or business name on the grounds of an earlier confusingly similar trademark;
- (g) that depending on the country it is possible to object to the use or registration of a trademark on the ground of an earlier confusingly similar company name or business name;

adopts the following resolution:

- 1 An earlier trademark right can be used to contest the registration and/or use of an identical or confusingly similar company name or business name provided that there is an identity or similarity between the goods or services of the earlier trademark and the activities undertaken under the company name or business name. Other criteria, including when relevant, dilution or risk of association, as well as the reputation or notoriety of the earlier trademark, should be taken into account.
- 2 An earlier established right to a company name or business name can be used to prevent the use and/or registration of an identical or confusingly similar trademark, provided that there is an identity or similarity of the activities undertaken under the earlier company name or business name and the goods or services of the trademark. Other criteria, including when relevant, dilution or risk of association, as well as the reputation or notoriety of the earlier company name or business name, should be taken into account. The mere registration of a company name or a business name, without use, creates no established rights for the purpose of this paragraph.
- 3 In addition to the principles as stated in paragraphs 1 and 2 above, the same principles that are applied to conflicts between trademarks should be applied to resolve conflicts involving company names and business names.
- 4 Principles applied to solve conflicts between company names, business names and trademarks could be used to solve conflicts between domain names and trademarks, and between domain names, company names and business names and vice versa.

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