

2020 AIPPI World Congress – Online  
Adopted SQ Resolution  
14 October, 2020

## Resolution

### 2020 – Study Question – Trademarks

#### Descriptive use as a defence in trade mark proceedings

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##### 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) 39 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 trademark infringement***

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

- 2) Such descriptive use as a defence may concern descriptive use of any type of trademarks.
- 3) The principles set out in the 1<sup>st</sup> and 2<sup>nd</sup> paragraphs do not mean that the prior trademark 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 trademark 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 trademark 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 trademark, 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 trademark, or
  - The use discredits or denigrates the proprietor's trademark 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 trademark, 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 trademark infringement proceedings.

**Links:**

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