

AIPPI NEDERLAND – Q285 PROVING TRADE MARK USE

CONTRIBUTORS:

Huib Berendschot (AKD), Willemijn Rensen (DLA Piper Nederland), Gilles Rubens (Landmark) Liselotte Bekke (Nauta Dutilh), Bram Woltering (AKD), Jos Klaus (Leeway) en Arnout Gieske (Van Diepen Van der Kroef Advocaten)

I. Current law and practice

1. Is there any quantitative or temporal threshold (minimum level) on evidence requirement to prove genuine use?

Answer

No. The determination of genuine use of a trademark is subject to all facts and circumstances by which it can be determined if there is commercial exploitation of the trademark, and in particular whether such use in a specific economic sector or market justifies maintaining (or obtaining) protection of the trademark. The national courts or the Benelux Intellectual Property Office have to assess and judge each case on the individual merits and evidence provided, which evidence has to be valued by the court (art. 152 DCCP).

To sufficiently prove genuine use, the evidence will have to include indications of the location, duration, extent and way of use of the trademark (rule 1.25 sub 1, jo. sub 2. Implementing Regulations BCIP, jo. art. 2.16bis jo. art. 2.23bis BCIP).

2. If there is a minimum level on evidence requirement to prove genuine use, is that minimum level different for well-known/famous/commonly known marks from a quantitative, temporal or any other perspective?

Answer

No, there is no difference in the evidence requirement for “regular” and well-known trademarks. The Board of Appeal of the EUIPO has held that use of the contested mark has to be adduced from the evidence submitted by the proprietor, and not from the well-known facts or ‘common knowledge’, as the proprietor erroneously asserted (see Board of Appeal EUIPO, 14 December 2022, R 543/2019-4)

3. Could evidence of one single advertisement likely to be sufficient to prove genuine use and if so, in what circumstances?

Answer

No. According to the ECJ, there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark. (ECJ 11 March 2003, ECLI:EU:C:2003:145, C-40/01, Ansul).

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Qualitatively, a single advertisement will likely not meet the threshold of proving real commercial exploitation of the trademark, as a single advertisement does not show (consistent) effort into creating or preserving an outlet for the respective goods or services.

Quantitatively, a single advertisement will likely not provide the necessary indications of the location, duration, extent and way of use of the trademark. A single advertisement will likely be perceived as symbolic use to maintain the registered trademark. Additional evidence would have to be provided, to substantiate the genuine use.

4. When considering genuine use, are there specific types of evidence (A) always excluded, (B) always included, or (C) given weight according to the circumstances? Please consider the following types of evidence, and select category A, B or C for each of them and explain in each type why that category applies:

- a. declarations by or on behalf of the trade mark owner (e.g., corporate representatives)
- b. declarations by unconnected and unpaid third parties
- c. declarations by unconnected but paid third parties
- d. copies of current web pages
- e. copies of web pages from Wayback Machine (including entries from Wikipedia which cannot any longer be modified)
- f. unpaid consumer surveys (no payment to the respondents)
- g. paid consumer surveys (in which the respondents are paid in some means)
- h. copies of invoices, bills, and accounts
- i. copies of advertising materials
- j. copies of distribution contracts
- k. evidence admitted by the adverse party in case of an inter partes proceeding
- l. anything else: please name and explain.

Answer

As a general rule of Dutch procedural law, evidence can be provided by any means possible, and the evidence will be taken into account and given appropriate weight by the court (unless the law states otherwise, art. 152 DCCP. As noted above, the genuine use will be assessed by all relevant circumstances of the case, including the evidence provided. Therefore, category C applies to all types of evidence, which will be valued by the court.

Additional types of evidence that may be submitted are for example the following. In Dry Works use in tenders was accepted as evidence of use (Court of Appeal Arnhem Leeuwarden 23 February 2021, ECLI:NL:GHARL:2021:1766). In I4F v Reflin YouTube records and press releases were accepted as means of evidence (District Court The Hague 28 December 2022, ECLI:NL:RBDHA:2022:14419).

Use of the Mark in Forms Different from the Registered One and the Allowed Form Variation

5. What are the criteria when assessing the genuine use of a trade mark if the mark in actual use is in a form different from the trade mark as registered? In other words, how much form variation of the mark can be accepted in proving its genuine use?

Answer

Use of the mark in a form different from the one registered may still constitute genuine use of the trade mark as long as the differing elements do not alter the distinctive character of the trade mark, and

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regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor (article 18 (1) EUTMR and article 2.23bis (5) (a) BCIP).

Strict conformity between the sign as used and the sign registered is not necessary. However, the difference must be in negligible elements and the signs as used and registered must be broadly equivalent (judgment of General Court EU of 23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50; see for example Board of Appeal EUIPO, 21 January 2020, R-962/2019-5, Chiquita Brands v Fyffes).

In order to decide whether the sign as used and the sign as registered are broadly equivalent, it must first be established which elements are negligible. The General Court (EU) has developed criteria for doing so in several judgments, inter alia Court of Justice EU 18 July 2013, case C-252/12 (Specsavers vs Asda).

The test developed by the Court consists of first determining what the distinctive and dominant elements of the registered sign are and then verifying if they are also present in the sign as used.

6. What factors are considered when judging whether the use of a variation of the mark can be accepted as valid use of a registered trade mark in your jurisdiction? Please select one or more answers from the following choices and provide explanations as appropriate:

a. the distinctiveness of the registered trade mark and the variation;

Answer

YES: The assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (judgment of 24/11/2005, T-135/04, Online Bus, EU:T:2005:419, § 36 and General Court EU 8 July 2020, case T-800/19 (Mignot & De Block B.V. / Austria Tabak GmbH), paragraph 20).

There is interdependence between the strength of the distinctive character of a mark and the effect of alterations. Marks of strong distinctive character may be less influenced by changes than marks of limited distinctiveness. Adding elements to or omitting elements from the mark are more likely to affect the distinctive character of marks of limited distinctiveness (ibid, par. 20). The reverse is also true (ibid, par. 21).

In the event that a trademark is of a highly simple nature, even slight alterations may be capable to lead to significant variations, leading to a change in distinctiveness and, hence, a lack of the mark being considered to be used as registered. European case law, which has a direct effect on Dutch doctrine, confirms that the simpler the mark, the less likely it is to have a distinctive character and the more likely it is for an alteration to that mark to affect one of its essential characteristics and thereby perception of that mark by the relevant public (General Court 23 September 2020, case T-796/16 (CEDC), paragraph 148).

b. whether such a variation alters the distinctive character of the registered trade mark;

Answer

YES: This is certainly a criterium. If the variation alters the distinctive character of the trademark as registered, usually, there is no genuine use established. Whether the distinctive character is altered, is a test of a factual nature.

c. whether consumers view them as the same mark;

Answer

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NO: No, this does not play a role, unless the mark is not perceived as a mark anymore (e.g. due to a lack of distinctiveness or having diluted to a generic name).

d. whether the variation of the mark is also registered;

Answer

NO: This factor is not taken into account: Use of the mark in a different form is regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor.

e. other.

Answer

NO

7. Which of the following variations may be viewed as not altering the distinctive character of the registered trade mark in your jurisdiction?

Answer

Please choose one or more answers from the following choices:

Can be genuine use

a. in which the typeface, size, and/or colour of the registered trade mark is changed, partially or wholly;

There are no criteria whether the inclusion or exclusion of specific aspects will lead to a change of the distinctive character, as this is a factual test which has to be assessed on a case by case basis. Therefore, this depends on whether the differing elements are negligible. Common typefaces usually do not have a major influence on the distinctiveness of a mark, and usually colours are considered not to add substantial distinctiveness to a mark. Also, in most cases the size of the figurative elements within a composite mark compared to words or other device elements, will usually be considered as being broadly equivalent to the trademark as registered.

On the other hand, there could be cases where a completely different contrasting colour is used and a quite uncommon typeface which differs considerably from the trademark as registered. There could be rare cases where this kind of use would not be considered genuine use.

c. in which non-distinctive elements are added to the registered trade mark;

Non-distinctive elements are usually not altering the distinctive character of the trademark as registered, so this would most likely be still considered genuine use of the registered mark. If the addition is not distinctive, is weak and/or is not dominant, it most likely does not alter the distinctive character of the registered trade mark (judgments of 30/11/2009, T-353/07, Coloris, EU:T:2009:475, § 29-33 et seq.; 10/06/2010, T-482/08, Atlas Transport, EU:T:2010:229, § 36 et seq.)

e. in which the non-distinctive element is omitted, partially or wholly, from the registered trade mark;

If the omitted element is in a secondary position and not distinctive, its omission most likely shall not

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alter the distinctive character of the trade mark (judgment of 24/11/2005, T-135/04, Online Bus, EU:T:2005:419, § 37).

- g. in which the layout of the different elements in the registered mark is changed, for instance, changing the up-and-down arrangement into left-and-right arrangement;**

When the presentation of the elements is not particularly original or unusual in either form, which is usually the case with these kind of arrangements, the variation in them will most likely not affect the distinctive character of the trade mark.

- h. in which one composite element is omitted in case of a combined trade mark, for instance, the figurative element is omitted in use when it is a word/figurative combined trade mark;**

If the omitted element **is in a secondary position and not distinctive**, its omission does most likely shall not alter the distinctive character of the trade mark (judgment of 24/11/2005, T-135/04, Online Bus, EU:T:2005:419, § 37).

- i. in which the registered mark is used in conjunction with another mark;**

Several signs may be used simultaneously without altering the distinctive character of the registered sign (judgment of 08/12/2005, T-29/04, Cristal Castellblanch, EU:T:2005:438, § 34).

Not genuine use:

- b. in which distinctive elements are added to the registered trade mark;**

If the added distinctive elements change the perception of the trademark as a whole, this is not genuine use of the trademark as registered, since it becomes a different trademark with different distinctiveness. The distinctive character is altered.

(Where a mark is composed of several elements, only one or some of which are distinctive and have rendered the mark as a whole registrable, an alteration of that distinctive element(s) or its omission or replacement by another element will generally mean that the distinctive character is altered).

- d. in which part of the distinctive element is omitted from the registered trade mark;**

Where a mark is composed of several elements, only one or some of which are distinctive and have rendered the mark as a whole registrable, an alteration of that distinctive element(s) or its omission or replacement by another element will generally mean that the distinctive character is altered.

- f. in which the word of the registered trade mark has been changed other than adding or omitting words but constitutes similar mark to the registered trade mark;**

This will probably not constitute genuine use, since the word mark as used is similar but not the registered mark. This clearly changes the distinctive character, since, although being similar, it has a different distinctive character.

- h. in which one composite element is omitted in case of a combined trade mark, for instance, the figurative element is omitted in use when it is a word/figurative combined trade mark;**

If the omitted element **is not in a secondary position and distinctive**, its omission does alter the distinctive character of the trade mark (judgment of 24/11/2005, T-135/04, Online Bus, EU:T:2005:419, § 37).

Trade Mark Use on the Internet and Virtual World

8. **Is the use of a mark on the internet/on a website taken into account for genuine use, and if so, what are the criteria?**

Answer

YES, use of a mark on the internet can be taken into account for genuine use and – depending on the facts and circumstances – can serve as indirect or direct evidence. In general, the same criteria are to be applied compared to other types of evidence.

Among others, the probative value of the specific piece of evidence resulting from the evidence depends on whether the evidence shows the place, time and extent of use. Generally, the existence of a mark on a web page without any complementary information on place, time and extent of use will be considered insufficient.

As to use on the internet in specific, the extent of use can be proven by providing information on the number of visitors over a certain period of time and/or orders that have been made through the website. Regarding the time of use, this can be proven by e.g. dated print screens, WayBackMachine print outs (see for use of print outs of evidence derived from the Waybackmachine inter alia: Court of Amsterdam, 21 December 2016, B920161221, Ferm Living v Lifestyle; Court of Amsterdam, 10 December 2021, IEPT20211203, Ledgigant.nl), Google Cache or other time stamps on the web page. As to the geographical coverage, it is in general not sufficient that a website can be accessed in a certain country; facts that may be relevant in this respect are: the local language of the website, local currencies, country top-level domain or whether the website is otherwise targeting customers in a specific country.

In case the evidence does not show the place, time and extent of use, use on the internet may still be taken into account in the overall assessment as indirect/circumstantial evidence in conjunction with other evidence.

9. **Can a single use of a mark on the internet/on a website be attributed only to a specific single class of goods/services, or can it be attributed across a range of goods/services?**

Can be across a range of goods/services – please explain

This depends on the facts and circumstances and how the mark is actually being used, as there should be a clear connection with the use and the goods/services involved in order to establish use for those goods/services. In case of such connection, single use on the internet can in theory be across a range of goods/services (e.g. if those goods/services are actually presented on the same page).

Where a mark has only been put to use in relation to part only of the goods or services for which it is registered, it can only be attributed as genuine use for that part of the goods and services. In this regard, a criterium is whether it is possible sufficiently distinguish a subcategory within the broader class of goods and services, use can then be only attributed to said subcategory (it is, for the purposes of the examination of the opposition, to be deemed to be registered in respect only of that part of the goods or services (ECJ 16 July 2020, C-714/18 P (ACTC))).

10. **What is the effect (in terms of genuine use) by the use of a mark in the virtual world (such as in a Metaverse), and in particular does the use of a mark in the virtual world also signify use of the mark on physical goods/real-world services?**

Answer

To date, there are no guidelines, rules, policies, best practices, case law and/or Benelux IPO decisions whatsoever addressing this specific issue.

As to the classification of virtual goods and NFTs, both the Benelux IPO and the European IPO did clarify that virtual goods should be filed in class 9, and thus not in the corresponding physical goods/real-world services classes. As a result, it seems that use in the virtual world may in any event relate to use of those virtual goods and services. See [EUIPO's policy for NFTs](#) and [Benelux IPO's policy for NFTs](#)

11. **What factors are taken into account when assessing whether the use of a trade mark in a virtual world (such as the metaverse) can be accepted as use in your jurisdiction in terms of the geographical coverage? Please select one or more answers from the following choices and provide explanations as appropriate:**

Answer

In the absence of case law, best practices and/or /guidelines on genuine use in the virtual world, at this stage it is not clear what factors are to be taken into account.

Justification of Non-use

12. **What can be the justification of non-use in your jurisdiction? Please select one or more answers from the following choices and provide explanations as appropriate:**

a. None;

NO. Justification for non-use of a Benelux or an EU trade mark exists where there are 'proper reasons' for non-use, as is determined in art. 16 EUTMD, art. 2.23bis BCIP¹ and 18 EUTMR.

Proper reasons are understood in light of art. 19 TRIPs Agreement², which cites import restrictions on or other government requirements as examples. The CJEU has adopted a test to determine proper reasons as being: obstacles (i) having a direct relationship with a trademark (ii) which make its use impossible or unreasonable and (iii) which are independent of the will of the proprietor of that mark (ECJ, 14 June 2007, Häupl/Lidl, C246/05, EU:C:2007:340 (Le Chef de Cuisine)). Using that test it upheld that bureaucratic obstacles to use, such as the need to perform a clinical trial may be but are not per se a proper reason (CJEU 3 July 2019, C-668/17 Viridis/EUIPO).

Recent Dutch case law regarding proper reasons is sparse.³ Notable is the rejection of proper reasons in light of protracted litigation attacking validity of the trademark, citing that use in the circumstances would be unsound entrepreneurship (2 November 2021, Den Bosch Court of Appeal, ECLI:NL:GHSHE:2021:3295, 'Wendy's'). The court considered that generally a high bar applies and a use requirement was not beyond what can be considered reasonable. Another case concerned the

1 In French: 'justes motifs', and in Dutch: 'geldige reden'. This is in the singular so that it expresses less clearly that a set of circumstances and motives may constitute proper reasons.

2 Art. 19 TRIPs "Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services protected by the trademark, shall be recognized as valid reasons for non-use."

3 Reference is made to EU and Benelux case law referred by the Dutch Group in AIPPI Study Question Q218 (2011).

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rejection proper reasons where the proprietor made prolonged and failed attempts to secure municipal backing and permissions as the non-use was deemed not sufficiently beyond of the will and influence of the proprietor and his normal business risk (Noord-Holland District Court, 20 September 2017, IEF17120, 'Mall of the Netherlands').

b. Force majeure;

YES. Assuming that adverse circumstances are sufficiently beyond the will and influence of the trade mark proprietor.

c. Policy restriction in your jurisdiction; and

d. Policy restriction in other jurisdictions, for instance in the jurisdiction of the trade mark proprietor if it is out of your jurisdiction;

YES. A policy restriction that obviates the use of a trademark in its territory is likely to meet the test set out in CJEU, 14 June 2007, C-246/05, Häupl/Lidl Stiftung. (See also Court of The Hague, 2 February 2011, Reemtsma v Maxim, IEPT20110202).

e. Bankruptcy/insolvency of the trade mark proprietor; and

f. The trade mark proprietor being in financial difficulty (but not insolvent);

NO. These situations are deemed as a rule part of normal business risk (and as such not beyond the will of the proprietor). Also, normal use is still possible during the winding up of an insolvency.

g. Requirement of a licence or marketing authorization which takes long time to obtain;

NO. Assuming that management of the application process is not sufficiently beyond the will and influence and/or control of the trade mark proprietor.

h. A still-pending trade mark transfer;

NO. Will not likely meet the tests set out above.

i. A still-pending trade mark dispute regarding ownership, validity, etc.;

NO. Not likely to meet the test set out above.

j. sufficiently high existing reputation of the trade mark, such that further use is commercially pointless/futile because it would not significantly increase or enhance that reputation;

NO. It would not seem unreasonable to expect continued normal use of the trademark in these circumstances, if not to enhance reputation, then to realize the economic value of the mark.

13. Would the burden of proof to prove the justification be reduced if it relates to a widely known event, such as the COVID 19 pandemic? Please answer YES or NO and explain.

NO. If it is widely accepted that it would be unreasonable to expect continued normal use in light of a certain well-known event, this reduces the burden of proof for the proprietor of a trademark to establish 'proper reasons' in a practical sense only.

II. Policy considerations and proposals for improvements of your Group's current law

The group does not see the need for any policy considerations and/or improvements.

III. Proposals for harmonization

18. Do you believe that there should be harmonisation in relation to issues regarding genuine use and proving use? Please answer YES or NO.

NO

19. Should there be any quantitative or temporal threshold (minimum level) on evidence requirement to prove genuine use?

Answer

No. National courts should be free to assess and value evidence as they deem fit, dependent on all relevant circumstances (such as the specific market for the goods and/or services) and merits of the case.

20. When considering proof of genuine use, should there be specific types of evidence (A) always excluded, (B) always included, or (C) given weight according to the circumstances? If yes, please give the types of evidence for A, B and C above and explain why they should be treated differently.

Answer

NO

All types of evidence should be given weight according to the circumstances. A court is best positioned to determine whether sufficient evidence is provided, or whether additional evidence should be submitted. For example, if the sole evidence provided concerns a statement from the trademark owner, dependent on the contents thereof, the court may require additional evidence in order to determine genuine use.

21. Please consider the following types of evidence, and select category A, B or C for each of them and explain for each type why that category should apply:

- a. declarations by or on behalf of the trade mark owner (e.g. corporate representatives) (affidavits)
- b. declarations by unconnected and unpaid third parties
- c. declarations by unconnected but paid third parties
- d. copies of current web pages
- e. copies of web pages from Wayback Machine (including entries from Wikipedia which cannot any longer be modified)
- f. consumer surveys
- g. copies of invoices, bills, and accounts
- h. copies of advertising materials
- i. catalogues
- j. copies of distribution contracts
- k. witness evidence
- l. private documents, including private opinions
- m. anything else: please name and explain.

Answer

C for all types of evidence. See also the answer to question 20.

22. Should reputable/well known/famous/historical trademarks be treated differently in terms of proof? If so, in what respects?

Answer

For a famous mark as set forth in 6bis Paris Convention the question is irrelevant.

Yes. Well known trademarks enjoy additional trademark protection, in the form of opposing the use of a sign that takes unfair advantage of or is detrimental to the distinctive character or the repute of the trademark, regardless of the goods and services of the trademark and sign (art. 9 sub 2 (c) of EU TMR).

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In that respect, the group is of the opinion that in the situation that reputation is proven, that either court or the IPO may consider that evidence of genuine is also delivered by the same evidence.

We see no reason to treat historical marks different compared with any other mark.

23. Please explain what should be probative value of the following:

- a. single use of a mark on the internet/on a website
- b. mere advertising (real commercial advertisement rather than just advertising the ownership or information of the trade mark) – with no sales

Answer

- a. the single use of a mark on the internet will likely not be sufficient to proof genuine use. It provides few indications of the place, time and extent of use of the trademark, and will likely not prove commercial exploitation.
- b. probative value of mere advertisement will likely be highly dependent on the circumstances of the case, e.g. whether the lack of sales is intentional (mere symbolic use), or whether sales have not been generated yet despite best efforts. In the latter case, mere advertising could be sufficient to prove genuine use. Quantitatively however, the advertisement would have to provide indications of place, time, extent and nature of use of the trademark.

24. Please explain if evidence of use should include specific information, for example place, time, extent or nature of use? If yes, should all the evidence show all of the above information or whether this is not necessary and the evidence should be considered and assessed as a whole?

Answer

Yes, the evidence should include information regarding the place, time, extent and nature of use (see also the answer to question 1). The evidence should be assessed as a whole, as each type of evidence can proof a different type of use. The court will weigh each piece of evidence individually and as a whole, and determine whether genuine use is proven.

25. Should evidence of use be the same or different in courts and IP offices/administrative tribunals?

Answer

For the purpose of uniform caselaw and legal certainty, evidence of use should be the same in courts and IP offices/administrative tribunals.

Use of the Mark in Forms Different from the Registered One and the Allowed Form Variation

26. What should be the criteria when assessing the genuine use of a trade mark if the mark in actual use is in a form different from the trade mark as registered? In other words, how much form variation of the mark should be accepted in proving its genuine use?

Answer

The group is satisfied with the current regime as described under (5) above, i.e. that strict conformity between the sign as used and the sign registered is not necessary and that the difference must be in negligible elements and the signs as used and registered must be broadly equivalent (judgment of

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General Court EU of 23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50; see for example Board of Appeal EUIPO, 21 January 2020, R-962/2019-5, Chiquita Brands v Fyffes).

A stricter regime with less room for assessment of the circumstance by a court or by the Intellectual Property office runs the risk of leading to unfair results.

27. What factors should be considered when judging whether the use of a variation of the mark can be accepted as valid use of a registered trade mark? Please select one or more answers from the following choices and provide explanations as appropriate:

- a. the distinctiveness of the registered trade mark and the variation;
- b. whether such a variation alters the distinctive character of the registered trade mark;
- c. whether consumers view them as the same mark;
- d. whether the variation of the mark is also registered;
- e. the features of the industry in which the trade mark is used and the business customs of the industry in relation to trade mark use;
- f. other, please name _____.

Answer

The group is of the opinion that the main factors to be taken into consideration are the distinctiveness of the registered trade mark and the variation and whether such a variation alters the distinctive character of the registered trade mark.

Whether consumers view them as the same mark is not relevant unless the mark is no longer perceived as a mark (loss of distinctiveness).

28. Which of the following variations should be viewed as not altering the distinctive character of the registered trade mark? Please choose one or more answers from the following choices:

- a. in which the font, size, and/or colour of the registered trade mark is changed, partially or wholly;
- b. in which distinctive elements are added to the registered trade mark;
- c. in which non-distinctive elements are added to the registered trade mark;
- d. in which part of the distinctive element is omitted from the registered trade mark;
- e. in which the non-distinctive element is omitted, partially or wholly, from the registered trade mark;
- f. in which the word of the registered trade mark has been changed other than adding or omitting words but constitutes similar mark to the registered trade mark;
- g. in which the layout of the different elements in the registered mark is changed, for instance, changing the up-and-down arrangement into left-and-right arrangement;
- h. in which one composite element is omitted in case of a combined trade mark, for instance, the figurative element is omitted in use when it is a word/figurative combined trade mark;
- i. in which the registered mark is used in conjunction with another mark;
- j. others, please name and explain _____.

Answer

The following variations should be viewed as not altering the distinctive character of the registered trade mark:

- a. variations to the font, size, and/or colour of the registered trade mark (partially or wholly);
- b. variations that add non-distinctive elements to the registered trade mark;

- c. variations in which the non-distinctive element is omitted, partially or wholly, from the registered trade mark.

Trade Mark Use on the Internet and Virtual World

- 29. Should the use of a mark on the internet/on a website be taken into account for genuine use, and if so, what should be the criteria? Please answer YES or NO and explain.**

Yes, see earlier answer under 8 for the criteria

Depending on the specific circumstances, use in the virtual world should also be considered to relate to the goods/real-world services, for example when treated as any other medium for the purposes of advertising (similar to the internet).

- 30. Should a single use of a mark on the internet/on a website be attributed only to a specific single class of goods/services, or should it be attributed across a range of goods/services?**

Please select:

- a. only a specific single class of goods/services
b. should be possibly across a range of goods/services – please explain
c. other answer: please explain.

Yes, see earlier answer under 9.

- 31. What should be the effect (in terms of genuine use) by the use of a mark in the virtual world (such as in a Metaverse), and in particular should the use of a mark in the virtual world also signify use of the mark on physical goods/real-world services?**

Answer

We recommend that use of a mark in a virtual world can also signify use of the mark on physical goods/real-world service if use of the mark in the virtual world concerns the promotion of physical goods/real-world services.

- 32. What factors should be taken into account when assessing whether the use of a trade mark in a virtual world (such as the metaverse) can be accepted as use in a jurisdiction in terms of the geographical coverage?**

- a. whether the consumers in your jurisdiction can access the virtual world;**

YES, we would recommend that this is considered to be a relevant factor. It would seem logical that if access from a certain jurisdiction would not be possible any trademark use cannot attribute to use in said jurisdiction.

- b. whether there are users or participants from the jurisdiction in the virtual world;**

YES, we would recommend that this will be considered to be a relevant factor. Given that one ultimately one aims to create a market share in a certain jurisdiction amongst the consumer, the presence of users of participants from a particular jurisdiction in the virtual world is a relevant factor.

- c. whether the virtual world provides the option of using a local language of the jurisdiction;**

YES, we would recommend that this will be considered as a relevant factor. We do recommend that other (than local languages) that are sufficiently understood by the relevant public could also be relevant (from a Dutch perspective, for example English).

d. whether the virtual world provides the option of using a local currency of the jurisdiction;
YES, we would recommend that this will be considered a relevant factor. We do however recommend that the option of using a local currency of the jurisdiction is not decisive. Use of any other real-world currency (for instance dollars) or even an convertible in-game currency could be a relevant option.

e. whether the virtual world provides an environment mimicking the local real environment of the jurisdiction;

NO. We recommend that this will be NOT be considered a relevant factor. What matters is whether the public in the specific jurisdiction can be confronted with the use of the mark. The appearance of virtual world in that regard is irrelevant.

f. whether the organization who created or provides the virtual world is located in the jurisdiction;

NO. We recommend that this will be NOT be considered a relevant factor, given that it does not relate to the use of the mark in the virtual world.

g. whether any physical facilities used to provide the virtual world are located in the jurisdiction;

NO. We would recommend that this will be NOT be considered a relevant factor, given that it does not relate to the use of the mark in the virtual world.

h. whether there are any promotional activities targeting consumers in the jurisdiction by the user of the trade mark or the provider of the virtual world;

YES, we recommend that this will be considered a relevant factor. In this regard there should not be a difference in attributing weight to promotional activities for reason that it concerns the promotion of goods or services that are available in a virtual world.

i. Other, namely

When assessing whether there has been genuine use of the mark, regard must taken to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark. Given that it is an evolving, newly developing, economic sector we recommend that no quantitative or temporal threshold be set.

Justification of Non-use

33. What should be valid justifications of non-use? Please select one or more answers from the following choices and provide explanations as appropriate:

- a. none;
- b. force majeure;
- c. policy restriction in the jurisdiction where the trade mark is registered;
- d. policy restriction in other jurisdictions, for instance in the jurisdiction of the trade mark proprietor if it is out of trade mark registration jurisdiction;
- e. bankruptcy/insolvency of the trade mark proprietor;
- f. the trade mark proprietor being in financial difficulty;
- g. requirement of a licence or marketing authorization which takes long time to obtain;
- h. in the process of a trade mark transfer;
- i. in the process of a trade mark dispute regarding ownership, validity, etc.;
- j. a sufficiently high existing reputation of the trade mark, such that further use is commercially pointless/futile because it would not significantly increase or enhance that reputation;
- k. others, please name_____.

Answer

Valid justifications for non-use are sufficiently available where the tests set out above under current law and practice are met.

We found that this is may be the case for b) force majeure; c) policy restriction in the jurisdiction where the trade mark is registered; d) policy restriction in other jurisdictions, for instance in the jurisdiction of the trade mark proprietor if it is out of trade mark registration jurisdiction g) requirement of a licence or marketing authorization which takes long time to obtain.

However, we consider the application of that test may often be too strict with regard to e) bankruptcy/insolvency of the trade mark proprietor;

The winding up of an insolvency may involve several years where the enterprise and its trademarks are in limbo. It is in the interest of company stakeholders and creditors to accept that the bankruptcy-period itself normally constitutes 'proper reasons' for non-use.

34. Should the burden of proof to prove the justification be reduced if it relates to a widely known event, such as the COVID 19 pandemic? Please answer YES or NO and explain.

NO. We see no need for a separate legal approach for this type of event.