

United Kingdom
Royaume – Uni
Vereinigtes Königreich
Report Q168

In the name of the United Kingdom Group by members of sub-committee Q168
Use of a Mark "As a Mark" as a Legal Requirement in respect of Acquisition Maintenance
and Infringement of Rights

UK Group Report

1. ***IS THERE ANY REQUIREMENT FOR USE OF A MARK "AS A MARK" FOR THE PURPOSES OF:***
 - 1.1 ***Acquiring a mark (if rights may be acquired by use according to national law)***
 - (a) It is possible to apply for and be granted a registered trade mark without any use having been made of the trade mark, although it will be vulnerable to revocation if there is no genuine use made of it within 5 years of grant and there are no proper reasons for such non use.
 - (b) However, where there are "absolute grounds" (grounds which are related to the application itself) for objecting to the registration of a mark, those objections are capable of being overcome by evidence demonstrating that the mark has acquired a distinctive character as a result of the use made of it. An applicant will have difficulty in showing the necessary amount of acquired distinctive character if he cannot prove use *as a trade mark*. In the *British Sugar Plc v James Robertson and Sons Limited*¹ case, the judge said that mere evidence of use of the word TREAT would not suffice, without more to prove that it was taken by the public as a badge of origin. The Judge's views were confirmed by the Court of Appeal in *Philips Electronics BV v Remington Consumer Products Limited*². Here it was held that the use of a picture of a shaver head was not shown to be recognised as an indication that the goods were from a particular trader. In general, if a mark has not clearly been used in a trade mark manner it will be more difficult to demonstrate that it has in fact acquired a sufficiently distinctive character.
 - (c) The Court of Appeal held that "Elvis"³ could not be granted as a registered trade mark (the application had been filed in the mid 1990s) because it did not operate as an indication of origin – one would not think that goods bearing the brand "Elvis" came from a particular source or were derived under an authorised licensing regime. While this case turned very much on its own facts (the public is now increasingly familiar with the existence of merchandising activities and if an application was made now for a trade mark of the name of a contemporary icon, it would likely be granted) this is a further example of the need for use *as a trade mark*, rather than simply use.
 - (d) In the *Windsurfing Chiemsee*⁴ case the ECJ adopted the same general approach.

¹ [1996] RPC 281.

² [1999] E.T.M.R. 816.

³ [1999] RPC 567 a decision under the Trade Marks Act 1938.

⁴ *WSC Windsurfing Chiemsee Produktions und Vertriebs GmbH v Boots and Segelzubehör Walter Huber and WSC Windsurfing Chiemsee Produktions und Vertriebs GmbH v Franz Attenberger* (C-108/97 and C-109/97); Opinion of Advocate-General, 5 May 1998; judgment of the Court [1999] ETMR 585.

1.2 **Maintaining of a trade mark registration (eg against an application for cancellation on grounds of non-use):**

- (a) Yes. To defeat an application for cancellation on the ground of non-use the trade mark owner must prove use which is "genuine" use in the relevant period and/or that there were good reasons for non use. This use must be *as a trade mark*.
- (b) The requirement that the use must be "genuine use" is not directly related to use "as a mark" but rather to "bona fide" use.
- (c) Where there has been genuine use and/or good reasons for non use but not for all the goods or services covered by the registration then the mark may be partially cancelled.

1.3 **Establishing infringement**

- (a) This question has been referred to the ECJ by the English Court in the *Arsenal Football Club Plc v Reed*⁵ and the *Philips v Remington* cases. Decisions are awaited.
- (b) Until recently, the answer to the question posed was "no". In the *British Sugar* case and in the Court of Appeal decision in *Philips v Remington*, it was held that infringing use is not restricted to trade mark use in relation to the Defendant's goods or services but the exceptions⁶ to infringement may allow for use other than use as a trade mark to be held not to infringe. In the *Philips v Remington* case the Court of Appeal referred questions relevant to this issue to the ECJ. Firstly the Court asked, whether the exclusive right granted by Article 5 (1) of the Council Directive 89/104/EEC extends to enable the proprietor to prevent third parties using identical or similar signs in circumstances where that use was not such as to indicate origin or is it limited so as to prevent only use which wholly or in part does indicate origin. Secondly the Court asked whether the use of an allegedly infringing shape of goods, which is and would be seen as an indication as to the kind of goods or the intended purpose thereof, was none the less such as to indicate origin if a substantial proportion of the relevant trade and public believe that goods of the shape complained of come from the trade mark proprietor, absent a statement to the contrary. These questions have not been answered by the opinion of the Advocate General. The ECJ decision is awaited.
- (c) The question was recently raised again in *Arsenal Football v Reed*. The alleged infringement involved use of the claimant's registered marks (trade marks of Arsenal football club on scarves etc) in a manner which the Judge found was not trade mark use, but rather such as would be perceived as a "a badge of support, loyalty or affiliation to those to whom they are directed". The Judge referred various questions to the ECJ including whether there is infringement where the use is not trade mark use and there is no defence of honest descriptive use of the sign⁷.
- (d) Also of interest is the question referred to the ECJ in the Holterhoff⁸, case. That case concerns registered trade marks which are the names of goods (diamonds) possessing certain characteristics. The Opinion of the Advocate General is that:

⁵ 2001 ETMR 917.

⁶ Section 10(6): use in relation to the goods or services of the proprietor or licensee; Section 11(1): use of own registered trade mark; or Section 11(2): use of own name etc and descriptive and other indications.

⁷ Section 11(2) Trade Marks Act 1994 (Article 6(1)(b) of Council Directive 89/104/EEC).

⁸ C-2/00.

- Article 5(1) of Council Directive 89/104/EEC does not entitle a trade mark proprietor to prevent third parties from referring **orally** to his trade mark when offering goods for sale provided it is made clear that the trade mark owner did not produce those goods and provided there can be no question of the mark being perceived in trade, whether at that stage or subsequently, as indicating the origin of the goods offered for sale.
- Even if Article 5(1) of the Directive does give a right to prevent such use, Article 6(1) precludes the exercise of that right if the use is for the purpose of indicating characteristics of the goods in question, unless such use is not in accordance with honest practices in industrial or commercial matters.

This Opinion does not however answer the questions referred to in the ECJ in the *Philips* and *Arsenal* cases.

- (e) It is important to recall that in the *Arsenal* case the potential defence of honest descriptive use of a sign was not pleaded. If this defence had been pleaded it is suggested that the *British Sugar* and *Philips* line of case law may have been followed. In our view this case law provides a useful way of analysing a potential infringement where the focus is removed from distinguishing between trade mark and non-trade mark use and uses the following more logical approach:
- (i) the Defendant's use of the sign **need not** be use as a trade mark for his goods or services BUT:
 - (ii) the use must fairly be capable of being regarded as "in relation to" the goods or services in question; and
 - (iii) the defendant has the scope to show that his use is not "as a mark" and does not infringe pursuant to one or more of the relevant exceptions including, for example, honest descriptive use of a sign.
- (f) However, one can envisage examples of non-trade mark use which may not necessarily have the benefit of the exceptions. For example⁹, the use of a punctuation mark "!", which may be the subject of a trade mark registration, may not qualify as use of a descriptive indication falling within the relevant exception. We suggest that one possible approach which would protect the position of an honest trader using non-descriptive, but non trade mark matter is to place some restriction on the words from the infringement provision¹⁰ which require that the Defendant "uses in the course of trade a sign...**in relation to goods or services**". In the *Trebor Bassett v Football Association*¹¹ case the alleged infringement was of a registration of the England football team crest which covered, amongst other things, printed matter in class 16. Trebor Bassett had included in packets of candy sticks, cards bearing the photographs of English footballers wearing shirts on which the registered mark could be seen. The Judge held that the reproduction of the crest was not even arguably "using" it in any real sense of the word and was certainly not using it as a sign in respect of the cards. So where there is only incidental use of, for example, a punctuation mark which is the subject of a trade mark registration, which is open to traders to use in a completely non trade mark sense, there is a proper basis for finding that the use is not truly "in relation to" the goods or services concerned.

⁹ As cited in "The Modern Law of Trade Marks" by Morcom, Roughton and Graham.

¹⁰ Section 10 Trade Marks Act 1994.

¹¹ [1997] FSR 211.

- (g) A further restriction on the infringement provisions may also assist. For example⁹, suppose that P has a registration of a trade mark "X" in Class 16 which covers printed matter including posters and that the Defendant uses posters to advertise completely different goods say sunglasses under the same mark. Although this may be regarded as use "as a mark" it should not suffice for the use to constitute an infringement under Section 10(1) (identical sign in relation to identical goods/services). If the matter is approached on the basis that the words "in the course of trade...in relation to goods or services" mean **in the course of a trade** in the goods or services in question then the difficulty is avoided.

2. ***IS THERE ANY DEFINITION OF WHAT IS USE "AS A MARK" EITHER IN STATUTE OR CASE LAW?***

- (a) There is no definition. Use "as a mark" will depend on the facts of each case, in particular, the nature of the mark and the goods and services concerned.
- (b) English case law indicates that the judges are looking for use which is taken by the public as a badge of origin, in other words as an indication that the goods or services are from a particular trader. This requirement is not the same as a requirement that the relevant public should know the identity of that trader. After all, frequently members of the public are not aware of the identity of owners of trade marks but nevertheless associate the marks for products with a particular trade origin.
- (c) It will be more difficult for an applicant or proprietor to show use as a trade mark with very non-distinctive marks or where the use has been mainly in conjunction with another trade mark.

3. ***IS THERE ANY DIFFERENCE IN THE ASSESSMENT OF USE "AS A MARK" BETWEEN THE ACQUISITION, MAINTENANCE AND INFRINGEMENT OF RIGHTS?***

- (a) In principle there should be no difference in assessment. If use of the sign must be "as a mark" to constitute infringement then the same assessment of what amounts to use "as a mark" must apply whether it is acquisition, maintenance and/or infringement of rights that is being considered.
- (b) The main guidance from the Courts has come in cases in which the validity of registrations has been challenged by way of a counterclaim in infringement proceedings. However, in most of these cases (for example *British Sugar*) the Court, when looking at the question of infringement, has not had to analyse strictly whether for the purposes of infringement there was use *as a mark* since the relevant provision was, until the *Arsenal* case, interpreted as not being restricted to such use.
- (c) In practice, the UK Registry's approach to cases in the past has been that use of a mark for the purposes of acquiring a mark does not involve a strict analysis of use in a trade mark sense. In the past, the UK Registry has sought evidence of use of sufficient sales of the relevant goods or services rather than evidence on whether the public regards the mark as a badge of origin. However, in *British Sugar*, Jacob J rejected this practice and said that it was key that the evidence showed that the sign was known as a trade mark. Going forward and subject to the ECJ's decisions in the *Philips* and *Arsenal* cases, the Registry may take more account of the remarks about evidence on use of a trade mark *as a mark* from the Courts.
- (d) In the celebrated *Arsenal* case the Defendant is appealing based on a counterclaim for revocation of the relevant trade marks based on non-use. It remains to be seen how his argument that the marks must be revoked for non-use
-

given that the public do not and did not perceive them as trade marks will be viewed.

4. ***IS ANY OF THE FOLLOWING CONSIDERED TO BE USE "AS A MARK"?***

4.1 ***Use on the internet, as a metatag, in linking or framing;***

On the Internet

The principles set out above would apply equally to use on the Internet.

Metatag

As regards metatags, an analogy can be drawn between the use of a trade mark as a badge of allegiance as in the *Arsenal* case and the hidden use of a trade mark in a line of code as a metatag. It can be said that the metatag is not being used by the Internet user as an indication of origin. On the other hand, the search engine uses the metatags to do automatically what the user would do manually in looking for goods or services which the user would generally expect to originate from the owner of the trade mark or metatag. Whether or not an English court would view a hidden use of a trade mark as a metatag as use *as a mark* remains to be seen.

Linking/Framing

If the "link button" on which the user clicks is the trade mark of the owner of the linked site then if it is clear to the user that by clicking on the "link button" they are being taken to the third party site, then that use is unlikely to be use *as a mark*. Instead, it is likely to fall within one or more of the exceptions to the infringement provisions, for example, use in relation to the goods or services of the proprietor (that is, the proprietor's own website). If the "link button" is used in a manner so that the public may regard it as an indication of the operator of the website (on which it is used) then that may amount to use "as a mark".

4.2 ***Use by fanclubs or supporters***

Pending the ECJ decision in the *Philips* and *Arsenal* cases, the question of whether there is infringement by use as "a badge of support", loyalty or affiliation, rather than use "as a mark" remains open.

Following the rationale of the *Trebor Bassett* case it does not necessarily follow that a sign is used "in relation to" the goods in respect of which the trade mark is registered merely because it is affixed to them. Accordingly, irrespective of the ECJ decisions in the *Philips* and *Arsenal* cases, there may remain a proper basis for finding that this form of use (when it is merely incidental) is not truly "in relation to" the goods or services concerned.

4.3 ***Parody***

Whether use in a parody will amount to use *as a mark* will depend on the form and content of the parody.

4.4 ***Comparative Advertising***

Use of a sign in comparative advertising may offer a defence to infringement under section 10(6) Trade Marks Act 1994 irrespective of whether or not use *as a mark* is required in order to fall within the infringement provisions. Section 10(6) which has no equivalent in Council Directive 89/104/EEC excludes from the scope of infringement, use in relation to the goods or services of the proprietor of a registered trade mark. This extends into the area of comparative advertising. There are limitations on the kind of use which is to be protected. Two requirements must be satisfied:

- (a) the use must be in accordance with honest practices in industrial or commercial matters; and
- (b) the use must not without due cause take unfair advantage or be detrimental to the distinctive character or repute of the trade mark.

Under English law the question of whether use in a comparative advertisement is use as a *mark* is somewhat irrelevant. The important question is whether the requirements of the S.10(6) exception to infringement are fulfilled. If the method of analysis set out in *British Sugar* and *Philips* cases is applied then the Defendant has the scope to show that his use of a mark in a comparative advertisement is (pursuant to S.10(6)) not use as a *mark* and does not infringe.

4.5 *If, under the Group's National Regime, use as a mark is confined to the traditional indications of origin or identity, are unconventional uses nevertheless objectionable under trade mark or other laws (eg unfair competition or trade practice laws)?*

- (a) The *British Sugar* and *Philips* line of case law indicates that unconventional uses may (subject to any appropriate exceptions) be objectionable under UK trade mark law.

Passing Off

- (b) Unconventional uses may also amount to passing off. To find a cause of action for passing off the necessary characteristics are:
 - (i) a misrepresentation;
 - (ii) made by a trader in the course of trade;
 - (iii) to prospective customers of his or ultimate consumers of services supplied by him;
 - (iv) which is calculated to injure the business or goodwill of another trader; and
 - (v) which causes actual damage to the business or goodwill of the trader by whom the action is brought (or will probably do so).
- (c) Use as a *mark* is not one of the required characteristics for passing off. The key issue is that a misrepresentation is shown. The majority of cases refer to a situation where the misrepresentation is that the Defendant's goods are those of the Claimant when in fact they are not. Alternatively, the misrepresentation may be that the Defendant is associated in some way with the Claimant. Therefore, the law of passing off may, upon proof of the required elements, enable traders to object to unconventional uses irrespective of the use of the relevant indicia "as marks".

Malicious Falsehood, Trade Libel, Defamation and False Attribution

- (d) Other causes of action including malicious falsehood, trade libel and defamation may be used to object to unconventional uses.
- (e) Malicious falsehood (sometimes called trade libel) concerns false statements maliciously made about a person's trade, the goods which they sell or the services which they provide where those statements cause or are calculated to cause, pecuniary damage to the trader concerned. Defamation is about the protection of a person's reputation. The classic definition is that of Parke J in *Parmiter v*

*Coupland*¹², where he said: "A publication ...which is calculated to injure the reputation of another by exposing him to hatred, contempt or ridicule." But as this definition was widely regarded as inadequate to cover all the cases, the Faulks Committee in their report have recommended that for the purpose of civil cases the following definition of defamation should be adopted¹³ "Defamation shall consist of the publication to a third party of matter which in all the circumstances would be likely to affect a person adversely in the estimation of reasonable people generally"¹⁴. In everyday language, a publication is likely to be defamatory of a person if it makes others think worse of that person. Corporate bodies may be defamed as well as human individuals.

- (f) These causes of action protect the interest that a person has in relation to the views of others, i.e. reputation. In a trade mark context, the relevance lies in the fact that rival traders sometimes want to say rude, uncomplimentary or denigratory things about their competitors. They may do this in a manner which does not use the company's trade mark as a *mark* but may still be objectionable under one or more of these causes of action.
- (g) Further, under S.84 Copyright Designs and Patents Act 1988 a person has a right to take action to prevent a literary, dramatic, musical or artistic work being falsely attributed to him as author. In the case of *Clark v Associated Newspapers Limited*¹⁵ parodies of the well known diaries of the Plaintiff were held to falsely attribute their authorship to the Plaintiff.

4.6 If use "as a mark" in the traditional sense is required to establish infringement, are "well-known", "famous", "notorious" or "reputed" marks used on dissimilar goods and services protected?

Where there is no similarity of goods or services, there can be infringement (under Section 10(3) Trade Marks Act 1994) but only where the registered mark has a reputation. Whether the mark has a reputation is a question of fact; it is not necessary that the mark should be "well-known" within the meaning of Article 6 bis of the Paris Convention and the reputation need not be in the whole of the UK.

There is a requirement that the use is "without due cause" which seems to involve the absence of any objective justification for the use complained about. The use must also take unfair advantage of or be detrimental to the distinctive character or repute of the registered mark.

There is no requirement to show a likelihood of confusion.¹⁶

To date we have had no Court guidance on how this provision will be interpreted in scenarios where it is accepted that there is no use *as a mark* in relation to identical or similar goods/services to those of the trade mark registration. However, the proprietor of the registration would not be precluded from arguing (in, for example, the poster and sunglasses example set out above) that there is infringement under Section 10(3) which applies where there is no identity or even similarity of goods or services.

A common international standard for the necessary level of repute of the mark before protection against use on dissimilar goods/services and/or against dilution would help with international harmonisation.

¹² (1840) 6 M & W 105 at 108.

¹³ Cmnd 5909 para 65.

¹⁴ *Neill/Rampton, Duncan & Neill on Defamation*, 2. Ed., Butterworths, London, 1983, 7.01 – 7.07.

¹⁵ Lightman J Transcript, 21 January 1998.

¹⁶ Typhoo case [2000] FSR 767.

SUMMARY

In the UK, it is possible to apply for and be granted a registered trade mark without any use having been made of the mark. Where there are our grounds (related to the application itself) for objecting to the registration of a mark, those objections may be overcome by evidence showing that the mark has acquired a distinctive character. It may be difficult to show the necessary amount of distinctive character without proving use *as a trade mark*.

Similarly, to defeat an application for cancellation on the ground of non-use, the evidence must be of use *as a trade mark*.

The question of whether use *as a trade mark*, is required to establish infringement has been referred by the English Court to the ECJ. A decision is awaited. Prior to this referral, under English law, infringing use was not restricted to use *as a trade mark*. Instead, the use had to be fairly capable of being regarded as "in relation to" the goods or services in question and the defendant had the scope to show that his use was not *as a mark* and therefore did not infringe pursuant to one or more of the relevant exceptions to infringement.

Where use is *as a mark* will depend on the facts. In principle there should be no difference in this assessment between acquisition, maintenance and infringement of rights.

The principles set out above will apply to use on the Internet. There is no specific case law guidance on use in metatags or as part of linking or framing. Use by fan clubs or supporters may amount to use as "a badge of support" rather than *as a mark*. How use in a parody is assessed will depend on the form and content of that parody. Under English law, the important question in relation to a comparative advertisement is whether the requirements of a specific exception to infringement (which extends into the area of comparative advertising) are satisfied.

Unconventional use of a mark in the UK may also amount to passing off, malicious falsehood, defamation or give rise to an action for false attribution.

Reputed marks used on dissimilar goods are protected in limited circumstances.

RÉSUMÉ

Au Royaume-Uni, il est possible de déposer une marque de fabrique sans qu'il y ait eu utilisation antérieure de la marque. Lorsqu'il existe des motifs d'opposition à l'enregistrement d'une marque, les objections peuvent être surmontées par la preuve du caractère distinctif de la marque. Cependant, il peut s'avérer difficile de démontrer le caractère distinctif d'une marque sans en démontrer l'usage en tant que marque de fabrique.

De même, afin de s'opposer à une demande d'annulation pour non-usage il est nécessaire de prouver l'usage de la marque comme marque de fabrique.

Le fait de savoir si l'utilisation en tant que marque de fabrique est nécessaire afin d'établir l'existence d'une contrefaçon est une question qui a été référée par les tribunaux britanniques à la Cour Européenne de Justice, dont la décision est toujours attendue. Avant ce renvoi devant la Cour Européenne de Justice, en droit anglais la contrefaçon n'était pas limitée à la contrefaçon par l'usage d'une marque en tant que marque de fabrique. Il fallait simplement que l'usage puisse être raisonnablement perçu comme portant sur les biens ou les services en question et il était possible au défendeur de démontrer que l'usage n'était pas un usage en tant que marque de fabrique et ne constituait donc pas une contrefaçon conformément à l'une ou plusieurs des exceptions à la contrefaçon.

L'usage d'une marque en tant que marque de fabrique ou non est une question de fait. En principe il ne devrait pas y avoir de différence dans l'appréciation de l'usage d'une marque comme marque de fabrique lors de son acquisition, son entretien ou en cas de contrefaçon.

Les principes évoqués ci-dessus sont également applicables à l'utilisation d'une marque sur internet. Il n'existe pas de jurisprudence portant sur l'usage sur des "metatags" ou lors de la connexion ou du cadrage. L'usage par des fans clubs ou des supporters pourrait constituer un usage en tant que "badge de support" plutôt qu'en tant que marque. L'appréciation de l'usage d'une marque lors d'une parodie dépend de la forme et du contenu de la parodie. En ce qui concerne les publicités comparées, en droit anglais la question de fond est de savoir si tous les éléments de l'une des exceptions à la contrefaçon (qui sont également applicables à la publicité comparative) sont réunis.

L'usage non conventionné d'une marque au Royaume-Uni peut également constituer un acte délictuel de "passing off", de constitution intentionnelle de faux, de diffamation ou peut donner lieu à une action pour fausse attribution.

Les marques réputées utilisées en rapport avec des biens dissemblables ne sont protégées que dans des circonstances limitées.

ZUSAMMENFASSUNG

In Großbritannien ist es möglich, eine Marke anzumelden und registrieren zu lassen, ohne dass es hierzu auch nur irgendeiner Benutzung der Marke bedarf. Einspruchsgründe gegen die Registrierung der Marke (in bezug auf die Markenmeldung) können durch den Beweis widerlegt werden, dass die Marke Unterscheidungskraft erlangt hat. Möglicherweise ist es schwierig ohne den Nachweis der Benutzung der Marke das erforderliche Maß an Unterscheidungskraft aufzuzeigen.

Auch um einen Antrag auf Löschung einer Marke wegen Nichtgebrauchs zu Fall zu bringen, muss der Beweis der Benutzung *als Marke* erbracht werden.

Die Frage, ob es der Benutzung einer Marke *als Marke* bedarf, um eine Verletzung zu begründen, wurde seitens der englischen Gerichte dem Europäischen Gerichtshof übertragen. Eine Entscheidung steht noch aus. Nach englischem Recht war vor dieser Verweisung die Benutzung einer Marke *als Marke* nicht zwingende Voraussetzung für eine Markenrechtsverletzung. Entscheidend war vielmehr, dass die jeweilige Benutzung der Marke allgemein als "in Verbindung mit" der jeweiligen Ware oder Dienstleistung stehend angesehen wurde, und es oblag dem Beklagten nachzuweisen, dass seine Nutzung der Marke nicht eine solche *als Marke* war und deshalb gemäß einer oder mehrerer der einschlägigen Ausnahmen des Verletzungstatbestandes die Marke nicht verletzte.

Wann eine Benutzung *als Marke* vorliegt, hängt von den Einzelfallumständen ab. Prinzipiell sollte kein Unterschied in der Beurteilung dieser Frage im Hinblick auf den Erwerb, die Aufrechterhaltung und die Verletzung von Markenrechten bestehen.

Die hier dargelegten Grundsätze lassen sich auch auf das Internet übertragen. Bislang gibt es noch keine speziell von der Rechtsprechung entwickelten Richtlinien hinsichtlich der Benutzung einer Marke als Metatag, in linking oder framing. Die Benutzung einer Marke durch Fanclubs oder sonstige Anhänger dürfte eher als "Zeichen der Unterstützung" denn als Benutzung *als Marke* einzuordnen sein. Wie der Markengebrauch im Rahmen der Parodie zu bewerten ist, hängt von Form und Inhalt der Parodie ab. Im Bereich der vergleichenden Werbung ist nach englischem Recht die entscheidende Frage, ob die Voraussetzungen einer speziellen Ausnahme vom Verletzungstatbestand (, der sich auf den Bereich der vergleichenden Werbung erstreckt,) erfüllt sind.

Unkonventionelle Benutzungsformen einer Marke können in Großbritannien als Kennzeichenmißbrauch, böswillige Unwahrheit, Verleumdung oder falsche Kennzeichnung auf dem Klagewege verfolgt werden.

Bekannte Marken, die für unähnliche Waren benutzt werden, sind unter eingeschränkten Voraussetzungen geschützt.

29 November 2001