

Question Q218

National Group: Sweden

Title: **The requirement of genuine use of trademarks for maintaining protection**

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

1. Is genuine use a requirement for maintaining protection? What is the purpose of requiring genuine use? Is it to keep the register uncluttered and to thereby allow for new proprietors to make use of a "limited" supply of possible marks? Is the purpose of requiring genuine use to protect consumers from confusion as to the source of origin of the goods or services? Or are there multiple purposes?

According to Chapter 3 Section 4 of the Swedish Trademarks Act (SFS 2010:1877, "STA"), a registered trademark is open to revocation if the trademark has not been subject to genuine use (for the goods and services included in the registration) within five years from the completion of the registration procedure or for a period of five consecutive years and provided that the trademark owner can not present any proper reason for not using the mark.

The reason for the genuine use requirement is to prevent the trademark register from clogging up with registrations which are not used and which in some cases have never been intended for use but only to prevent third party registrations. The STA preparatory works mention that there is a limited range of "good" trademarks, and that these marks should be used effectively in order to facilitate effective competition.

2. What constitutes genuine use of a trademark?

Genuine use arises when the trademark owner (or a licensee, distributor etc.) uses the trademark for goods/services listed in the registration and the use of the trademark is “real” and not only for the purpose of reserving its right in the trademark *i.e.* the use must be based on commercial considerations and occur in connection with marketing of the relevant goods/services towards the public. Token use is consequently not considered as genuine use.

Genuine use includes also

1. use of the trademark in a form different than the registered trademark provided that the difference only consists of insignificant elements and does not affect the distinctive character of the mark, and
2. the application of the trademark to the goods or its packaging is made in Sweden for export purposes only.

Both use of the trademark on the relevant goods and use of the trademark in connection with marketing or sales may constitute genuine use. Use of the trademark in advertising or catalogues or other marketing activities may constitute genuine use if such marketing takes place in reasonable timely connection with the actual market release of the goods or services which the trademark is registered for.

When determining whether certain use of a trademark is genuine or not, all facts and circumstances relating to the commercial purpose shall be taken into consideration. Relevant circumstances are *e.g.* if the use in question is generally accepted in the line of business as a justified measure to maintain or create a market share, the nature of the goods or services at issue, the characteristics of the market and the extent and frequency of the use. If it is established that a real commercial purpose does exist, also minimal use may be sufficient.

3. Is use “as a mark” required for maintaining protection? Is use as a business name, use in advertising or use on the Internet sufficient? Is use of a mark in merchandising genuine use for the original products? (For instance, is use of the movie title Startrek, registered for clothing and used on the front of a T-Shirt, genuine use of the mark for clothing?)

According to the STA Chapter 3 Section 2, the trademark must be used in connection with the goods or services for which it has been registered in order to avoid the risk of revocation. As clarified in ECJ Case No. C-40/01, “Ansul”, genuine use of a trademark exists where the trademark 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. In other words, the requirement of genuine use means that the trademark must be used for its purpose as a trademark, and not merely as a business name or a personal name.

Use only in advertising or other preparatory marketing activity may be sufficient to meet the genuine use requirement provided that the original goods or services are available on the market to the relevant public within reasonable time, considering the relevant circumstances.

4. What degree of use is required for maintaining protection? Is token use sufficient? Is minimal use sufficient?

There is no determined *de minimi* threshold for when use shall be considered as genuine use. Minimal use may be sufficient when the use serves a real commercial purpose.

So called token use (use only intended to maintain rights conferred by registration) does not constitute genuine use.

5. Is use in the course of trade required? Does use by non profit-organisations constitute genuine use? Does use in the form of test marketing or use in clinical trials constitute genuine use? Does use in form of free promotional goods which are given to purchasers of other goods of the trademark owner constitute genuine use? Does internal use constitute genuine use?

It is necessary to show that the trademark has been used in the course of trade (ECJ case No. C-259/02, “La Mer Technology”). From certain community case law, the term “in the course of trade” may be distinguished primarily from private use, as well as pure internal use within a company.

Use by a non-profit organization can constitute genuine use. The ECJ has stated that a trademark is put to genuine use where a non-profit-making association uses the trademark, in its relations with the public, in announcements of forthcoming events, on business papers and on advertising material and where the association’s members wear badges featuring that trademark when collecting and distributing donations (ECJ case No. C-442/07, “Verein Radetzky-Orden”, paragraph 24).

Use of the trademark in advertising, catalogues and other marketing activities is accepted as genuine use provided that such activities take place reasonably close in time to the goods or services being put on the market (see e.g. the preparatory work to the former Swedish Trademark Act (1960: 644) (the “former STA”), proposition 1992/93:48 p. 99). In the case T 390/85 (“Budweiser”), the Swedish Supreme Court did not consider the genuine use-requirement to be met where the proprietor of a trademark had given away trademarked items free of charge to customers without any subsequent sale of goods within the relevant class and within the five year period. According to OHIM’s decision No. 421/1999, where an opponent was required to show use of its earlier trademark, OHIM stated that clinical trials cannot be considered as use of a trademark.

Use in the form of free promotional goods which are given to purchasers of other goods of the trademark owner does not constitute genuine use (ECJ case No. C-495/07, "Silberquelle").

Internal use does not constitute genuine use. Genuine use of the trademark entails use of the trademark on the market for the goods or services protected by that trademark and not just internal use by the undertaking concerned (see Ansul, paragraph 37).

The answers above are almost exclusively based on decisions by the ECJ or CFI. Except for the Budweiser case, there are no Swedish cases that confirm the above conclusions. However, Swedish trademark law shall be interpreted in accordance with Community law.

6. **What is the required geographic extent of use? Is use only in one part (or a state in the case of confederation) of the country sufficient? Is use of the CTM in only one EU member state sufficient? Is use only in relation to goods to be exported sufficient? Is use in duty free zones considered to be genuine use?**

The STA Chapter 3 Section 2 stipulates that a trademark owner has to put the trademark to genuine use in Sweden. However, the Swedish legislation, preparatory works and case law provide no further clarification regarding the extent of use required. According to Community case law however, a trademark must be present in a "substantial part" of the territory where it is protected (the CFI case T-39/01, "Kabushiki", paragraph 37). The meaning of "substantial part" is uncertain.

A CTM must be used "in the Community" according to Article 15(1) and Article 42(2) CTMR. According to statements issued by the Council and Commission, the genuine use requirement may be satisfied also when the criteria of Article 15 CTMR has been complied with in only a part of the Community, such as in a single Member State or in a part thereof (the Joint Statements by the Council and Commission of 2010/1995, No B. 10 to 15, OJ OHIM 1996, 615). However, the Joint Statements only have interpretative value and are not legally binding. National courts have ruled against the Joint Statements in this regard. To settle the matter the Court of Appeal of The Hague in the Netherlands has submitted the question to the ECJ for a preliminary ruling in the ONEL case (Decision No 2004448 Leno Merken BV v Hagelkruis Beheer BV, 15 January 2010).

The STA Chapter 3 Section 2 stipulates that affixing the trademark to goods or to the packaging thereof in Sweden solely for export purposes may also constitute genuine use in Sweden.

There is no indication that use in duty free zones should not constitute genuine use provided that the use is "real" and not token. We have not found any guidance in case law or otherwise regarding the question whether use in duty free zones is considered to be genuine use

7. Does genuine use have to take place in the exact form in which the mark is registered? Is use in a different form sufficient? What difference is considered permissible? What if (distinctive) elements are added or omitted? Is use of a mark in black and white instead of colour sufficient (in case of marks with a colour claim) and vice versa?

Pursuant to the STA Chapter 3, Section 2, use of a trademark in a form differing in elements which do not alter the distinctive character of the trademark in the form in which it was registered also constitutes use of the mark.

The STA or the preparatory work, give no guidance in respect of the implication of “alter the distinctive character” therefore, the question whether use of a trademark alters the distinctive character of the trademark in the form that it was registered and what differences that should be considered as permissible must be answered through case law.

From a review of the case law it appears that only small deviations are allowed. Please refer to NJA 1991 s 23, “Bergmans”, NJA 1991 s 619, “Max” and NJA 2001 s 265, “Spotlight”. The Supreme Court has found that the use of the trademark GATT written in a plain typeface met the use requirement even though the trademark was registered in a special logo type design (Bergmans). Likewise, the use of the trademark Big Mac has been considered as use of the registered trademark BIGMAC (Max). According to doctrine it is uncertain if the liberal attitude as reflected in the first of these two cases is in accordance with the EC Regulation. The District Court has in case T 4257-09, “V&S” ruled that the use of the trademark constitutes differences of more than only deviations of details of the trademark and had changed the brand's distinctive character (the case was appealed to the Court of Appeal, however, the appeal was not granted). Please also refer to Case 67-06, (“Underground” in this regard. Further, in NJA 2008 s 1033, “Demp” the Supreme Court ruled that use of only the design part (when trademark consisted of word and design) did alter the distinctive character of the trademark in the form in which it was registered.

If, by adding a distinctive element or omit the distinctive element, alters the distinctive character of the trademark in the form in which it was registered, the use will not constitute genuine use.

In general, if the use of a trademark in black and white instead of colour or vice versa alters the distinctive character of the trademark in the form it was registered it will not be considered genuine use, but if it does not alter the distinctive character it will be considered genuine use. In the case R 1546/2008-2, “Simba Toys”, the OHIM Second Board of Appeal ruled that the use of the Rubik's cube, a tree dimensional puzzle, in different colours, should be considered use of the black and white trademark as registered since the cube as used did not display a different distinctive character to the registered trademark. The Board also noted that a trademark registered in monochrome is generally deemed to possess a scope of protection that would include all colour combinations.

8. Does the mark have to be used in respect of all the registered goods and services? What if mark is used in respect of ingredients and spare parts or after sales services and repairs, rather than registered goods and services? What is the effect of use which is limited to a part of the registered goods or services? What is the effect of use limited to specific goods or services?

The STA Chapter 3 Section 4 stipulates that where grounds for invalidation exist only in respect of part of the goods or services for which a trademark has been registered, the registration shall be invalidated only as regards those goods or services. In such situation the registration shall be partially invalidated. Thus, the trademark has to be used in respect of all the registered goods and services in order to remain in force as originally registered.

The STA gives no guidance in respect of how narrow the registered goods and services must be defined in order to avoid later invalidation. According to the preparatory work of the STA this question shall be answered through case law. In case No. T 2856-05, "Arvid Nordquist" Svea Court of Appeals stated that it clearly would be contrary to the purpose of the regulation to maintain the registration for non-alcoholic beverages when the trademark had been used only in respect of coffee. Thus, the registration was invalidated in respect of non-alcoholic beverages but remained in force in respect of coffee. The registration also remained in force in respect of tea, cacao, sugar and chocolate since such goods had been distributed together with the coffee. However, the registration was invalidated as regards to sweets in general.

In CFI case T-126/03, Aladdin, a mark had been registered for a category of goods or services which was sufficiently broad for it to be possible to identify within it a number of sub-categories (which were capable of being viewed independently). According to the Court of First Instance, proof for that the mark had been put to genuine use in relation to a part of those goods or services resulted in protection only for the relevant sub-category or sub-categories.

The fact that a trademark is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same trademark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods. This applies to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services (Ansul). In judgment No. T 1480-10, "FireDos" the Svea Court of Appeals also ruled that after sales services constituted genuine use of a mark.

9. Evidence of use: How does one prove genuine use? Is advertising material sufficient? Are sales figures sufficient? Is survey evidence required? Are the acceptable specimens for proving genuine use different for goods and services? Who has burden of proof for genuine use?

As for evidence, the judicial procedure in Sweden is founded on the principles of free presentation and free evaluation of evidence.

When assessing whether use of the trademark is genuine, regard must be made to all the facts and circumstances relevant to establishing whether the commercial use of the trademark is real in the course of trade (Ansul and La Mer Technology). The assessment must thus be made on a case to case basis, please find below examples of such assessments.

An agreement where a party undertook to take certain actions in order to introduce the relevant service on the Swedish market was not sufficient to prove that the trademark actually had been used for the relevant service on the Swedish market. Further, evidence of a minor advertising campaign (i.e. a letter and an invoice) was not sufficient to prove that the trademark had been genuinely used when no other evidence was presented showing in what way or to what extent the relevant service had been provided on the market (NJA 2005 s. 643, "ENTELCARD").

An order catalog from which the customer could order low-alcohol beer and mineral water was not sufficient to show that the trademark had been genuinely used in respect of low-alcohol beer and mineral water, especially not when no information regarding actual sale of low-alcohol beer and mineral water or marketing of such goods could be represented. Thus, the trademark was invalidated in respect of low-alcohol beer and mineral water (Arvid Nordquist).

Frequent advertisements in a periodical together with a witness statement from which it was evident that the trademark had been used frequently when marketing the relevant services at seminars, meetings and by telephone was sufficient to prove genuine use of a trademark (Svea Court of Appeals Case No. T 2959-09 AAA, "Teamwork", please note that this judgment has been appealed). In the first instance of the same case (Case No. T 16686-07) the Stockholm District Court held that when determining whether genuine use is proved, it should be taken into consideration that providing services cannot be labeled with a trademark in the same manner as goods can be.

The Svea Court of Appeals has considered invoices and minutes of after sales services sufficient to prove genuine use of a trademark (FireDos).

Market researches or survey evidences are not a legal requirement to prove genuine use of a mark, but could be appropriate depending on the circumstances.

Regarding the burden of proof the general rules apply, i.e. the party stating something has the burden of proof for such statement. Thus, the proprietor of the trademark which is in question for invalidation has the burden of proof for genuine use.

10. If the trademark owner has a proper reason for not having put his mark to genuine use, will he be excused? What constitutes a proper reason for non-use? If the non-use is excusable, is there a maximum time limit? If so, is the time limit dependent upon the nature of the excuse?

According to the STA Chapter 3 Article 2 Section 1, a trademark owner will be excused for not using his registered trademark if he has a proper reason ("giltiga skäl") for non-use.

The STA does not state any requirements for what may constitute a proper reason for non-use. According to the preparatory works for the former STA, a proper reason for non-use can, as a basic principle, only be due to circumstances out of the trademark owner's control (Ds 1992:13 s 128 f, changes to the former STA). The preparatory works exemplify that not receiving necessary permission from the authorities, making it impossible for the trademark owner to put the goods/services on the market, may constitute a proper reason.

This basic principle has also been confirmed in case law. In a case from the Svea Court of Appeal the court found that not receiving permission from Apoteket, the Swedish pharmacy which at the time had a monopoly on selling drugs, constituted a proper reason for non-use. (T 8551-08, "Adderma").

The preparatory works further exemplify that not having enough financial resources in order to make use of the registered trademark cannot be a valid reason for excuse.

There is no explicit maximum time limit for excusable non-use, neither in the STA, nor established in Swedish case law. In the referenced case from the Svea Court of Appeal, the Court found that the trademark owner could present a proper reason for non-use for a trademark that had not been used for a period of eight years from the day of the registration.

11. Within which period of time does use have to take place?

The STA Chapter 3 Article 2 Section 1 states that a trademark must be used within five years from the final decision of registration. According to Swedish legislation there is a two months opposition period following after the registration of a trademark. It has been established in a case from the Supreme Court (NJA 2006 s 7, "Blockbuster") that the period of time for use starts at the end of the opposition period. If an opposition has been filed, the period of time for use starts at the termination of the opposition procedure, i.e. when the decision has come into legal force.

According to the corresponding Article 25 a in the former STA, the period of time for use starts at the completion of the registration procedure. The wording of the rule in the present STA has been changed in order to better correspond with Swedish case law, however the change of wording is merely stylistic. The former rule and the present rule are to be interpreted in the same way, i.e. the time period for use starts after the decision of registration has come into legal force.

If a trademark holder stops using the registered trademark, a new five year period starts. In order for a trademark registration to be vulnerable for revocation based on non-use there must have been a period of non-use of at least five consecutive years prior to the initiation of the revocation action.

According to STA Chapter 3 Article 2 Section 4, a registration cannot be revoked if the trademark has been used during the period of time between the expiry of the five year period and the filing of request for revocation.

12. Does use of the mark by licensee or distributor constitute genuine use for maintaining protection? If so, does the license have to be registered? If so, are there any requirements to be met by the trademark holder (the licensor) to maintain the trademark (e.g. quality controls, inspections or retaining a contractual right to control or inspect)?

The STA Chapter 3 Article 2 Section 3 states that use by a third party, such as a licensee, may constitute genuine use as long as the use of the trademark is approved by the trademark owner.

The license does not have to be registered in order for the license to be valid.

If the trademark is used by a third party with the approval of the trademark holder there are not any specific requirements to be met by the trademark holder. There is no Swedish case law on the subject.

13. What are the consequences if a mark has not been put to genuine use? Who may apply for a cancellation and in what circumstances? Is a defendant in opposition proceedings entitled to challenge the opponent and demand proof of genuine use of the earlier mark? If so, under what circumstances?

A trademark that has not been put to genuine use may be cancelled. Anyone may apply for a cancellation of a trademark. According to the former STA only parties affected by the registration could apply for cancellation on a trademark but this requirement has been removed in the present STA.

A trademark registration may be cancelled, if the holder has not made use of the trademark in Sweden for the goods or services which it was registered for five years from the date of issue of registration or within a period of five consecutive years. The registration may not be revoked on grounds of non-use, should there be proper reasons why the trademark has not been used.

The defendant in an opposition proceeding cannot demand proof of genuine use of the earlier trademark. In order to cancel a trademark for non-use, a separate cancellation proceeding must be initiated.

14. Assuming a trade mark owner has not made genuine use of his mark within the prescribed period, can he cure this vulnerable position by starting to use in a genuine way after this period and will he then be safe against requests for cancellation or revocation? Is it allowed to re-register a trade mark that has not been genuinely used in the prescribed period of time?

Non-use may be cured.

The trademark registration may not be revoked if the trademark has been used during the time between the end of the period of five years of non use and the filing of the application for revocation of the trademark registration. However, commencement or resumption of use, after the period of five years of non-use and within three months prior to filing of the application for revocation shall be disregarded, should the measures to begin or resume the use of the trademark be made after the holder becomes aware that an application for revocation may be filed.

In doctrine it has been stated that it should not be possible to re-register a trademark every fifth year. However, there is no legal prohibition against re-registering a trademark that has not been put to genuine use. The Swedish Patent and Registration Office does however not permit registration of a mark identical with an already registered mark on the base that such double registration would circumvent the rule of genuine use, This practice is based on the decision from the Patent Appeal Court 84-02958 INSONEX. Also, OHIM considers a re-filing of an unused mark as bad faith, which therefore could be used as a ground for requesting that a CTM is declared invalid.

II. Proposals for adoption of uniform rules

The Groups are invited to put forward proposals for adoption of uniform rules as concerns the requirement of genuine use for maintaining protection. More specifically, the Groups are invited to answer the following questions:

15. What should the purpose of the uniform rules be? Should the rules address either or both purposes of protecting the consumers from confusion and of keeping the register uncluttered for new/potential trademark registrants?

It is the group's opinion that keeping the register uncluttered for new or potential trademark registrants should be the purpose of the uniform rules.

16. Should there in your opinion be a threshold to the “genuine use”, such as a *de minimis* rule for a trademark? If so, what would be suitable threshold? Should the rule be construed differently for large co-operations than for small businesses?

The group firstly wants to stress the importance of the genuine use requirement. A trademark registration gives the owner a monopoly, an exception from the main rule of free competition. It is important that such exceptions are restricted as much as possible. The tendency in case law is that it is sufficient with very limited use of a trademark in order to fulfill the use requirement. Should this tendency continue, the genuine use requirement will risk not being sufficient restriction to the monopoly a trademark gives its owner. For that reason, a *de minimis* rule could be a way of ensuring that the use requirement functions in accordance with its purpose. The group however believes that it is very difficult to find a level which would suit all cases. What should be considered as reaching the threshold of genuine use needs to be determined on a case by case basis.

According to the group’s opinion it is reasonable to, in the evaluation of whether the use requirement is met in a certain case or not, take into consideration whether the trademark owner is a large or a small business. The group does not suggest a specific rule to this effect, but that it is one of the circumstances taken into consideration. It is reasonable to request that larger businesses provide more extensive proof of the use of the mark than smaller businesses.

17. To what extent should it be possible to use a mark that differs from the representation in the register and maintain protection? Should it even be possible to add or omit elements of a registered figurative mark and maintain the trademark? How should the system ensure that registers are reliable for third parties and yet provide some flexibility for the trademark holder when using the mark in commercial activities?

The group’s opinion is that a trademark owner should be entitled to make certain alterations, especially to its figure trademarks, over time, without having to file new trademark applications every time an alternation is made and without losing its priority based on the first registration. We do agree with the standard set by the Supreme Court that such amendments cannot alter the distinctive character of the trademark. The challenge is to determine what amendments do indeed alter the distinctive character. Recent case law from OHIM and the Swedish courts are very strict and it is the group’s view that a more flexible approach could be taken which would be more adapted to the current commercial needs of trademark owners without making the trademark registers unreliable for third parties. A different side of this issue is which changes to a registered mark the trademark offices are to accept. Also in this regard the Swedish trademark office is, in the group’s view, too strict.

18. Should the requirement of genuine use deemed to be met if the use is limited to one product or service out of several registered? Is it in your opinion reasonable that a trademark holder can “block” an entire product category by using the mark for only one type of product within the category? If not, what kind of standard should be adopted?

It is not reasonable that a trademark holder can “block” an entire product category by using the trademark for only one type of product. On the other hand, a trademark owner should be able to prevent the use and registration of confusingly similar trademarks for confusingly similar goods and services. It should therefore not be a criterion that the trademark is used for each and every goods and services included in the registration.

19. What would be a suitable grace period for genuine use?

Five years is a suitable period in the group’s opinion. There should also be a possibility to prolong the period if the trademark owner has a proper reason for not using the mark.

20. What circumstances should justify non-use? Should different criteria apply for different industry sectors (e.g. pharmaceuticals and other industries where authorities typically require particular market approvals which could delay the use of a trademark)? Should the criteria be more stringent the longer the period of non-use is?

In the group’s opinion, the main rule should be that circumstances which should justify non-use should be circumstances which are out of the trademark owner’s control. The group sees no reason for specifying different criteria which are to apply for different industries. As has been pointed out before, it is very difficult to find a level which would suit all cases. What should be considered as a valid reason for non-use needs to be determined on a case by case basis.

21. Should any use of a trademark by entitled third parties be attributed to the proprietor? Should there be a difference between licensees and independent distributors and will registration of a license be necessary?

The group is of the opinion that any use of a trademark by entitled third parties shall be attributed to the proprietor. There is no reason to make a difference between licensees and independent distributors. Finally, the group does not support that registration of a license should be necessary.

22. Should there be an exception from the genuine use requirement in some cases?

No, the group believes that rules permitting extension of the term within which use has to be made if there are proper reasons for non-use are enough. The rules which give well known trademarks extended protection also provide limitation to the protection of owners of such trademarks. The purpose for the rules should in the group's opinion be, as has been previously mentioned, to keep the register uncluttered. If there are exceptions to the rule, this purpose will not be maintained.

23. Should there be uniform rules addressing the issue whether the cancelled trademark should be eligible for re-registration immediately upon the cancellation decision? Should other parties' interests than those of the new registrant be taken into account, e.g. consumers' interests in avoiding confusion as to the nature and quality of goods and services that might be expected under a particular mark?

It could, in the group's opinion, be reasonable to provide that cancelled trademarks are not eligible for re-registration immediately upon the cancellation decision. A reasonable time period for such prohibition could be at least 6 months, in order to not risk use of the possibility for priority to circumvent the rule, up to 12 months. However, the group would like to stress the difficulties which of course will occur in deciding the appropriate scope of such prohibition.

The main interest to take into account should be the new registrant's interest. Consumers' interests are less important in the group's view.

Summary

According to the Swedish Trademark Act a registered trademark is open to revocation if the trademark has not been subject to genuine use (for the goods and services included in the registration) within five years from the completion of the registration procedure or for a period of five consecutive years and provided that the trademark owner cannot present proper reason for not using the mark.

Genuine use arises when the trademark owner (or a licensee, distributor etc.) uses the trademark for goods/services listed in the registration and the use of the trademark is "real" and not only for the purpose of reserving its right in the trademark. The use must thus be based on commercial considerations and occur in connection with marketing of the relevant goods/services towards the public. Token use is consequently not considered as genuine use.

The Swedish group does not propose the adoption of any new uniform rules, as the group considers relevant EC and Swedish law sufficient. A de minimis rule could be a way of ensuring that the use requirement functions in accordance with its purpose. The group however believes that it is very difficult to find a level which would suit all cases. What should be considered as reaching the

threshold of genuine use needs to be determined on a case by case basis. According to the group's opinion it is reasonable to, in the evaluation of whether the use requirement is met in a certain case, take into consideration amongst other things whether the trademark owner is a large or a small business. Further, in the group's opinion, the main rule should be that circumstances which should justify non-use should be circumstances which are out of the trademark owner's control. It could, in the group's opinion, be reasonable to provide that cancelled trademarks are not eligible for re-registration immediately upon the cancellation decision.

Zusammenfassung

Laut dem Schwedischen Markengesetz kann eine im Register eingetragene Marke gelöscht werden, falls die Marke nach der Beendigung des Eintragungsverfahrens innerhalb eines ununterbrochenen Zeitraums von fünf Jahren nicht wirklich benutzt worden ist (für die Waren oder Dienstleistungen in der Eintragung), und falls der Markeninhaber keinen zufriedenstellenden Verfallsgrund für die Nichtnutzung präsentieren kann.

Wirkliche Benutzung entsteht, wenn der Markeninhaber (oder ein Lizenznehmer, Vertragshändler, etc.) die Marke für die in der Eintragung angegebenen Waren/Dienstleistungen benutzt und die Benutzung "echt" ist und nicht nur aus Gründen der Bewahrung der Marke. Die Benutzung muss also auf kommerzielle Erwägungen gegründet sein und im Zusammenhang von öffentlichem Marketing der aktuellen Waren/Dienstleistungen vorhanden sein. Eine symbolische Benutzung ist also nicht als wirkliche Benutzung zu betrachten.

Die Schwedische Gruppe schlägt keine Annahme von neuen einheitlichen Regeln vor, sondern findet, dass das entsprechende Schwedische Gesetz und das der Europäischen Gemeinschaft ausreichend ist. Eine de minimis Regel könnte ein Weg sein um sicherzustellen, dass die Benutzungsbedingung laut ihrem Zweck funktioniert. Die Gruppe glaubt aber, dass es sehr schwierig ist ein Niveau zu finden, dass für alle Fälle passt. Was entsprechend dem aktuellen Niveau für wirkliche Benutzung zu betrachten ist, muss von Fall zu Fall beurteilt werden. Laut Meinung der Gruppe ist es angemessen, in der Beurteilung ob die Benutzungsbedingung in einem besonderen Fall erfüllt worden ist, u.a. in Erwägung zu ziehen, ob es sich bei dem Markeninhaber um eine grosse oder kleine Gesellschaft handelt. Weiterhin sollte laut Meinung der Gruppe die Hauptregel sein, dass Umstände ausserhalb der Kontrolle des Markeninhabers nicht als Umstände die die Nichtnutzung rechtfertigen, zu betrachten sind. Es könnte laut Meinung der Gruppe angemessen sein zu regeln, dass gelöschte Marken für erneute Eintragung unmittelbar nach der Entscheidung der Löschung nicht zugelassen sind.

Résumé

Conformément à la loi suédoise relative aux marques, une marque déposée est susceptible de faire l'objet d'une déchéance si la marque n'a pas fait l'objet d'un usage sérieux (pour les produits et services visés dans l'enregistrement) dans un délai de cinq ans à compter de la date à laquelle la procédure d'enregistrement est terminée ou pour une période ininterrompue de cinq ans, sauf juste motif pour le non-usage.

L'usage sérieux est caractérisé lorsque le titulaire (ou un licencié, un distributeur, etc.) de la marque fait usage de la marque pour des produits/services visés dans l'enregistrement et lorsque l'usage de la marque est "réel" et non pas réalisé pour les seuls besoins de préservation de son droit sur la marque. L'usage doit ainsi être basé sur des considérations commerciales et apparaître en lien avec la commercialisation au public des produits/services pertinents. Les "token use" ne sont ainsi pas considérés comme un usage sérieux.

Le groupe suédois ne propose l'adoption d'aucune nouvelle règle d'uniformisation, dès lors que le groupe considère que le droit de l'Union et le droit suédois sont suffisants. Une règle *de minimis* pourrait être une voie permettant de s'assurer que la condition d'usage fonctionne conformément à son objet. Cependant le groupe pense qu'il est très difficile de trouver un niveau qui convienne à tous les cas de figure. Ce qui pourrait être considéré comme le seuil de l'usage sérieux doit être déterminé au cas par cas. Conformément à l'opinion du groupe il est raisonnable de prendre en compte, entre autres afin de déterminer si la condition d'usage est remplie ou non, la taille de l'entreprise du titulaire de la marque. En outre, de l'opinion du groupe, la règle principale devrait prévoir que les circonstances justifiant le non-usage devraient être extérieures au contrôle du titulaire de la marque. De l'avis du groupe, il serait raisonnable de prévoir que les marques révoquées ne soient pas susceptibles d'enregistrement immédiatement après la décision de révocation.