

## Question Q214

**National Group:** Latvian National Group

**Title:** Protection against the dilution of a trade mark

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**Date:** 15 April 2010

### Questions

#### I. Analysis of current law and case law

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

1. Do the laws of your country provide for protection against dilution of a trademark? If so, which laws?

The Law on Trademarks and Indications of Geographical Origin (hereinafter – the Latvian Trademark Law) does not contain a clear provisions for protection against dilution of a trademark.

Nevertheless as the Latvian Trademark Law is in line with the TRIPs Agreement and the EU Directives and Regulations, there are provisions which provide for protection against dilution of a trademark.

Article 8 of the Latvian Trademark Law prescribed that the owner of a trademark, that is well-known in Latvia, is entitled to prevent the use, in the course of trade, of a sign which constitutes a reproduction, an imitation, a translation or a transliteration of the well-known trademark, also in relation to goods or services, that are not similar to those covered by the well-known trademark, provided that consumers may perceive the use of such a sign as indicating a connection between these goods or services and the owner of the well-known trademark, and provided that such use may be detrimental to the interests of the owner of the well-known trademark.

2. Is there a legal definition of dilution in your legislation or case law?

There is no legal definition of dilution neither in our legislation nor in case law.

3.1. Which trademarks are afforded protection against dilution? What are the eligibility criteria? (Please only briefly list the eligibility criteria here; more detailed explanations will be required below).

The trademarks which become well-known are afforded protection against dilution.

In determining whether a trademark is well-known, account shall be taken of the knowledge of this trademark in the relevant group of consumers, including such knowledge in Latvia that has been obtained as a result of the advertising activities or any other circumstances that have contributed to its publicity.

3.2. To be eligible for protection against dilution, does a mark need to be distinctive? If so, does the protection depend upon the mark being inherently distinctive or are marks that have acquired distinctiveness through use also protected?

The degree of protection depends on distinctiveness of well-known mark.

3.3.1 To be eligible for protection against dilution, does a mark need to have a reputation or be well-known or famous? If so, when does a mark have a reputation, when is it well-known or when is it famous? Are the factors mentioned in paragraph 15 and 22 above relevant for determining whether a mark has a reputation, is well known or famous? For what point in time does this have to be assessed?

The Latvian Trademark Law does not contain terms of "trademark with a reputation" and "famous trademark". Therefore our legislation contain provision regarding "well-known trademarks". The factors mentioned in paragraph 15 is applicable in Latvia, as on 21 January 1993 the Republic of Latvia accedes to "The Convention Establishing the World Intellectual Property Organization(WIPO)".

The factors mentioned in paragraph 22 is applicable as far as they are very closed to those mentioned in the paragraph 15.

The authorities assess whether the trademark is well-known at the time when contested trademark is applied and continue to exist at the time of the proceedings. If the unlawfull use of well-known trademark is stated then the authorities assess whether the trademark is well-known at the time when the unlawfull use is stated.

3.3.2. For a mark to have a reputation or to be considered well known or famous, must it meet a certain knowledge or recognition threshold? If so, what is that threshold? What percentage of population awareness is required? How widespread must the awareness be across the country? If a mark is well known or famous in one country, what effect, if any, does this have with regard to other countries?

In determining whether a trademark is well-known, account shall be taken of the knowledge of this trademark in the relevant group of consumers, including such knowledge in Latvia that has been obtained as a result of the advertising activities or any other circumstances that have contributed to its publicity.

Also account shall be taken of the provisions of Article 6-bis of the Paris Convention on well-

known marks, including the provision on the inadmissibility of a reproduction or imitation of the well-known mark in an essential part of another trademark; the said provisions shall also apply, *mutatis mutandis*, to service marks.

Neither the Latvian Trademark Law nor other regulations contain precisely provisions or guidelines about the amount of threshold to be stated in order to conclude that the trademark become well-known.

The authorities taking into account awareness of Latvian population about trademark. If the mark is well-known in other country, it is taking only as informative evidence and has no big influence in Latvia.

3.3.3. What is the relevant population in determining the knowledge, recognition or fame of the mark, the general public at large or the relevant sector of public? Is recognition or fame in a limited product market ("niche market") sufficient?

The Latvian Trademark Law prescribes that the recognition or fame between relevant group of consumers is sufficient in order to determining that trademark is well-known. Absence of practice does not allow to answer surely whether a limited product market („Niche market“) could be sufficient in order to determining the recognition or fame of a specific products.

3.4. To be eligible for protection against dilution, is it required that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in the country where protection is being sought?

The Latvian Trademark Law does not oblige that well-known trademark should be registered or used or applied in order to determine that it is well-known, therefore we assume that such obligation is not mandatory to be eligible for protection against dilution.

3.5. Are there any other criteria a mark must comply with to be eligible for protection against dilution?

There are no other criteria.

3.6. Is eligibility for protection against dilution a matter of law or an issue of fact? Who bears the burden of proof regarding the eligibility criteria? How does one prove that a mark meets the eligibility criteria? Are sales and advertising figures sufficient or is survey evidence required? Which evidential standard must this proof satisfy?

Each party shall prove the facts upon which they base their claims or objections. Plaintiffs shall prove that their claims are well-founded. Defendants shall prove that their objections are well-founded.

Sales and advertising figures are sufficient. Survey evidences are advisable, but not mandatory.

There are no defined special standards and questions decided by administrative or judicial authority from case to case differ.

3.7. Is there any registry of eligible marks in your country? If so, what is the evidentiary value of registration? Can it be challenged in litigation?

There are no registry of eligible marks.

4. Does your law require the existence of a 'mental association' or 'link' between the earlier trademark and the later trademark? If so, in which circumstances does a 'mental association' or 'link' between the earlier trademark and the later trademark exist? Are the factors mentioned in paragraph 27 and 28 above relevant for assessing the existence of such a 'mental association' or 'link'? Are there other factors to take into account? Is the assessment of a link a question of fact (so something that can be established by market surveys), or is it a question of law to be established by the courts or authorities on the basis of such factors?

The Latvian Trademark Law provides that consumers may perceive the use of such sign as indicating a connection between these goods or services and the owner of the well-known trademark.

In accordance with the provisions of Article 5 of the Civil Procedure Law in applying legal norms, the court shall take into account case law of the European Court of Justice, therefore the factors mentioned in paragraph 27 are relevant for assessing the existence of such „link“.

5. Does such 'mental association' or 'link' between the earlier trademark and the later trademark automatically result in detriment to the earlier trademark's repute or distinctive character? Or does detriment have to be proved over and above the existence of a 'mental association' or 'link'?

The Latvian Trademark Law prescribed that consumers may perceive the use of such a sign as indicating a connection between these goods or services and the owner of the well-known trademark, and provided that such use may be detrimental to the interests of the owner of the well-known trademark. Absence of practice does not allow answering more precisely.

6. Are the same factors taken into consideration to assess the existence of detriment as those already discussed for the link? Are there additional ones?

The Latvian Trademark Law prescribed that consumers may perceive the use of such a sign as indicating a connection between these goods or services and the owner of the well-known trademark, and provided that such use may be detrimental to the interests of the owner of the well-known trademark. Absence of practice does not allow answering more precisely.

7. Must actual dilution be proved or is a showing of likelihood of dilution sufficient? Whose burden of proof is it? How does one prove dilution or likelihood of dilution? Does detriment require evidence of a change in the economic behaviour of the average consumer or that such change in behaviour is likely? If so, what is a change in the economic behaviour of the average consumer? Is reduced willingness to buy goods sold under the earlier mark a change in the economic behaviour? How do you prove a change in the economic behaviour of the average consumer or likelihood of such change in behaviour?

Absence of practice does not allow us provide you with the opinion. However, general

provisions of the Civil Procedure Law provide that each party shall prove the facts upon which they base their claims or objections.

7. What is the extent of protection afforded to marks which are eligible for dilution protection? May the owner of the earlier trademark object

- to the registration of a later trademark?
- to the actual use of a later trademark?
- in respect of dissimilar goods only or also in respect of similar goods?

The owner of the earlier trademark may object against the registration of a later trademark, against the actual use of a later trademark in respect of dissimilar goods or also in respect of similar goods.

8. What are the legal remedies? May the owner of the earlier trademark file an opposition and/or a cancellation action? May he ask for injunctive relief or preliminary injunctive relief? Does your trademark office refuse the registration of a later trademark on grounds of likelihood of dilution?

The owner of the earlier trademark has a right to file an opposition and/or a cancellation action. He has a right to ask for injunctive relief or preliminary injunctive relief.

## **II. Proposals for adoption of uniform rules**

The Groups are invited to put forward proposals for adoption of uniform rules with a view to protecting trademarks against dilution. More specifically, the Groups are invited to answer the following questions:

1. Which trademarks should be eligible for protection against dilution? What should the eligibility criteria be? Should recognition or fame in a limited product market (“niche market”) be sufficient?

Currently the scope of protections is sufficient for protection against dilution of mark

2. Should it be a criteria for being eligible for dilution protection that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in the country?

No.

3. Should there be a registry of eligible marks? If so, what should the evidentiary value of registration be? Should it be possible to challenge it in litigation?

National group does not see reasonable ground for establishing such register currently. But it could be a considerable question when practice increases

3. Should the existence of a ‘mental association’ or ‘link’ between the earlier trademark and the later trademark be an independent requirement for a trademark dilution claim? Currently we do not see a reasonable ground for ‘mental association’ or ‘link’ between the

earlier trademark and the later trademark to be an independent requirement for a trademark dilution claim.

4. Should detriment to the distinctive character or reputation of the earlier mark require evidence of a change in the economic behaviour of the average consumer or that such change in behaviour is likely?

No, not necessary.

5. What should the remedies be for dilution of a mark?

National group considers that currently existing remedies (the owner of the earlier well-known trademark may object against the registration of a later trademark, against the actual use of a later trademark in respect of dissimilar goods and also in respect of similar goods) are sufficient.

National Groups are invited to comment on any additional issue concerning the protection of a mark against dilution.

**Note:** It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and use the questions and numbers for each answer.

### Summary

In Latvia well-known trademark can be eligible for protection against dilution in accordance with the Law on Trademarks and Indications of Geographical Origin of the Republic of Latvia, which is fully harmonized with the recommendations of TRIPs Agreement.

Currently provisions of protection against the dilution of a mark are not actively used in Latvia and there are no significant case or analysis analyzing and estimating practical effort of these remedies.

Latvian group believes that it would be beneficial to harmonize and establish internationally a general framework of criteria to be eligible for protection against dilution and if necessary this should be undertaken through WIPO guidelines.