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## Q245

### Taking unfair advantage of trademarks: parasitism and free riding

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#### I. Current law and practice

1) Do the laws of your jurisdiction provide for protection against:

a) the taking of unfair advantage of trademarks as defined in these Working Guidelines (see paragraphs 26) and 27) above); and/or

no

Please comment:

Our Industrial Property Law (1.955) prevents the registration of similar signs in order to avoid confusion among consumers, specifically, in connection with the industrial or commercial origin of the product.

Venezuela is also signatory of the Paris Convention; therefore, our legislation should include protection against unfair completion as defined in Article 10bis.

However, recent changes on our legislation substitute the Law for the defense of free competition by which measures against unfair competition as well as product imitation were included. The aforementioned is not included in the new Anti-Monopoly Law.

b) use that you consider similar but outside the scope of the definition in these Working Guidelines?

no

Please comment:

For the questions below, if b. applies either separately or in addition to a., please make that clear in any relevant

answer.

2)	What is this protection called, and is this a definition developed in case law or found in a statutory provision? If such protection is characterised as a form of protection against dilution, please state this and provide any explanation as to the basis for such characterisation.
Not applicable.	

3)	If such protection is available, what is the basis for the protection, e.g. trademark law (distinguishing between unregistered and registered trademarks where relevant), unfair competition, consumer protection law, common law? If multiple causes of action are available, is there an interaction between them, and if so, what?
Not applicable.	

4)	What are the elements of any available cause of action, e.g. the requirement for the trademark to be registered, reputation in the trademark, establishment of a link or association with the trademark, bad faith, change in the economic behaviour of consumers, actual advantage, potential future advantage? How are they proven?
Not applicable.	

5)	Further to question 4):
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a)	what degree of reputation, if any, in the trademark is required?
Not applicable.	

b)	who bears the burden of proof regarding the requirements?
Not applicable.	

c)	must the use at issue cause confusion?
no	
Please comment:	
Not applicable.	

d)	can the protection be invoked in case of both similar and dissimilar goods/services?
no	
Please comment:	
Not applicable.	

e)	are there any other factors, even if not a separate requirement, that may be relevant, and if so, what are they?
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Not applicable.

6) Are there any defences against and/or limitations to the protection?

7) Who bears the burden of proof in relation to any defences and/or limitations? In this context, please also consider the relationship with the element of "unfairness". For example, is it a defence that the use is with "due cause" (see paragraph 31 of the introduction) above and footnote 2) of the introduction? If so, can such use ever be "unfair"? Or is this just a matter of a shifted burden of proof?

The burden of the proof relays on the plaintiff. In case the defendant alleges fair use, parody or freedom of speech, then the burden of the proof relays on the defendant.

8) If a defence exists or only limited protection is available, what rights does that give the free rider? For example, may the free rider simply use the trademark or may the third party obtain a separate trademark registration in respect of the goods and/or services in respect of which the free rider is using the trademark?

9) Can the protection be invoked in:

a) court in civil proceedings;

no

Please comment:

Not applicable.

b) court in other proceedings;

c) opposition proceedings;

no

Please comment:

Not applicable.

d) any other?

no

Please comment:

Not applicable.

10) If the protection can be invoked in multiple proceedings, are there different requirements for different proceedings? If so, please state the requirements.

Not applicable.

## II Policy considerations and proposals for improvements of the current law

11) Should there be protection against:

a) the taking of unfair advantage of trademarks as defined in these Working Guidelines; and/or

no

Why not?:

b) use that is similar but outside the scope of the definition in these Working Guidelines?

no

Why not?:

No. It could conflict with fair use.

12) Is the basis for protection or the cause of action relevant?

no

Why not?:

No. Not applicable

13) Should it be possible to invoke the protection in all types of proceedings mentioned above under 9) above?

no

Why not?:

No. Not applicable

14) How can your current law as it applies to the taking of unfair advantage of trademarks and/or the interpretation thereof (in particular, in case law) be improved?

Not applicable

## III Proposals for harmonisation

15) Is harmonisation in this area desirable?

no

Please comment:

Not in the terms of this working

If yes, please respond to the following questions without regard to your national or regional laws. Even if no, please address the following questions to the extent you consider your national or regional laws could be improved.

16) If your answer to question 11) is no in respect of a. and/or b., is it your view that no such protection should be available anywhere?

The protection against free riding should be covered by the Competition Laws in a case by case basis

17) Should there be harmonisation of the definition of:

a) the taking of unfair advantage of trademarks as defined in these Working Guidelines; and/or

b) use that you consider similar but outside the scope of the definition in these Working Guidelines?

18) What should the basis for protection/cause(s) of action be?

Damage compensation as far as far as the injury is clearly identifiable.

19) What should the requirements for protection be? In your answer, please address at least the following, in addition to any other relevant factors: what level of reputation, if any, in the trademark should be required, and who should bear the burden of proof?

Not applicable

20) What defences against and/or limitations to the protection should be available? Please state the proposed requirements for any defence/limitation, and the effect of any defence/limitation.

Not applicable

21) Who should bear the burden of proof in respect of any defences and/or limitations?

Not applicable

22) In what type(s) of proceedings should it be possible to invoke the protection?

Not applicable

Summary

Please comment on any additional issues concerning the taking advantage of trademarks in the sense of parasitism and free riding you consider relevant to this Working Question.