International Trademark Association

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INTA comments

On the consultation of the Norwegian Ministry of Health and Care Services regarding plain packaging for tobacco products

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The International Trademark Association (INTA) is a global association of trademark owners and professionals dedicated to supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce. INTA's primary strategic direction is to advocate for the vigorous enforcement of strong laws that provide protection for trademarks so that: (1) trademark owners can market their goods and services with confidence and protect consumers from counterfeits and other unauthorized products; and (2) customers and consumers can rely on trademarks to differentiate sources of goods and services in the marketplace.

Our membership includes more than 6,400 trademark owners and professional firms spanning all fields of commerce and industry from more than 190 countries throughout the world, including Norway and all other EU Member States. Headquartered in New York City, INTA also has offices in Shanghai, Brussels and Washington D.C. and representatives in Geneva and Mumbai.

INTA makes this submission on behalf of all its members and speaks only on the potential implications for trademark rights, taking no position on the public health issues with regard to tobacco consumption.

Summary remarks

Trademarks are a vital aspect of the global economy and serve an important function in the European marketplace. Trademarks are used on virtually every type of product to indicate a product's origin and to guarantee the consistency of its quality to consumers. In addition to being an important aspect of the daily life of consumers, trademarks are economically crucial as they facilitate trade and promote innovation and competition. An efficient protection of trademarks is therefore crucial to protect consumers and the business community.

INTA cautions against legislation that prohibits or severely restricts the use of trademarks and prevents them from fulfilling their functions in the marketplace to the detriment of consumers, trademark owners, and competition as such.

Accordingly, INTA is opposed to prohibiting the use of trademarks through full standardization of packaging (i.e. plain packaging) as envisaged in the consultation of the Norwegian Ministry of Health and Care Services. While plain packaging legislation would still allow the use of word marks on packages, it would restrict the use of

such word marks to a prescribed unitary form which does not correspond to their intended registered graphic representation. Furthermore, plain packaging would prevent rights holders from using any of their other registered trademarks as well as other design elements, which in turn could cause consumer confusion or cause uncertainty for consumers in the selection of products for purchase.

INTA has submitted comments[1] outlining its concerns on plain packaging when similar proposals have arisen in other jurisdictions, including Australia, the European Union, Israel, Thailand, Ireland and the United Kingdom.

INTA offers the following further specific observations:

1. Plain packaging as envisaged in the consultation would undermine free movement of goods and common market principles and impair the different functions of trademarks in Norway.

2. Plain packaging as envisaged in the consultation is contrary to international trade agreements, such as the World Trade Organization's Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) and the Paris Convention for the Protection of Industrial Property.

3. Plain packaging as envisaged in the consultation would violate fundamental rights of trademark owners and consumers under Norwegian and European law, including the Norwegian Constitution.

4. Plain packaging as envisaged in the consultation would set a dangerous precedent for other products and industries.

5. Plain packaging as envisaged in the consultation would risk increasing illicit trade.

Specific observations

1. **Plain packaging as envisaged in the consultation would undermine free movement of goods and common market principles and impair the different functions of trademarks in Norway.**

One of the guiding principles of the European Economic Area (EEA), of which Norway is a Member State, is the free movement of goods. Plain packaging as envisaged in the consultation would create the need for trademark owners to provide different packaging in Norway than elsewhere, thereby creating a specific national requirement that substantially impacts upon the free movement of goods within the EEA as a whole.

Moreover, plain packaging implemented at national level will distort inter-brand competition within the EEA market by removing or restricting many of the elements that manufacturers use to differentiate their products from other manufacturers. The proposal reduces package, product and brand differentiation, and restricts manufacturers' ability to innovate across either the product or the packaging.

[1] See at http://www.inta.org/Advocacy/Pages/Testimony.aspx.

This would lead to reduced competition and increased barriers to entry, as it would be increasingly difficult for new brands to enter the market without an ability to differentiate their offering from existing brands. INTA believes that manufacturers should benefit from a normal use of all aspects of their trademark rights in order to compete with one another, and that there should be the same freedom to do so across all EEA Member States.

Reduction of brand differentiation also impacts consumers. Trademarks are not only words, names and logos, but can also be colors or the very shape or design of the package itself (trade dress). Any graphical component that adds to the distinctiveness of a product can be registered as a trademark, thereby playing an integral role in facilitating consumer choice by distinguishing one product they know and trust from products of another entity. The proposal, if adopted, would make it extremely difficult to distinguish one brand from another, thereby seriously limiting consumers' ability to buy the product of their choice.

Furthermore, trademarks indicate the source of goods and/or services and assure consumers of the consistency of a product's quality and proper accountability. This fundamental function could not be effectively fulfilled if registered trademarks were banned from packaging, or if such trademarks were only permitted in a prescribed, standardized form that does not correspond to the intended registered graphic representation of such trademarks.

A deprivation of this function constitutes a violation of the EEA's single market principle and law. The Court of Justice of the European Union (CJEU) has frequently held that trademarks are

> "*an essential element in the system of undistorted competition which the Treaty seeks to establish and maintain. Under such a system, an undertaking must be in a position to keep its customers by virtue of the quality of its products and services, something which is possible only if there are distinctive marks which enable customers to identify those products and services. For the trademark to be able to fulfil this role, it must offer a guarantee that all goods bearing it have been produced under the control of a single undertaking which is accountable for their quality*."[2]

As the CJEU has recognized, trademarks also perform other functions such as those of *communication*[3] designed to *inform consumers*[4], and of *investment*[5]. All these functions are, in the words of the Advocate General Jacobs, "*values which deserve protection as such*"[6], but which would essentially be rendered without protection if the proposal in the consultation were adopted.

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[2] See, *inter alia*, CJEU Case C-10/89, *SA CNL-SUCAL NV v HAG GF AG*, [1990] ECR I-03711, paragraph 13.

[3] See, for example, Case C-487/07, *L'Oreal v. Bellure*, [2009] ECR I-05185, paragraph 58.

[4] Joined Cases C-236/08 to C-238/08, *Google et. al.*, [2010] ECR I-02417, paragraph 91.

[5] See, for example, Case C-487/07, *L'Oreal v. Bellure*, paragraph 58; Joined Cases C-236/08 to C-238/08, *Google et. al.*, paragraph 91; Case C-323/09, *Interflora*, [2011] ECR I-08625, paragraph 39.

[6] Opinion of the Advocate General Jacobs delivered on 29 April 1997, Case C-337/95, Christian Dior, [1997] ECR I-06013, paragraph 41.

2. The proposal is contrary to international trade agreements

The proposal as envisaged in the consultation also violates the trademark provisions of the World Trade Organization's Agreement on Trade Related Aspects of Intellectual Property Rights ("TRIPS") and the Paris Convention[7].

Plain packaging is an unjustifiable encumbrance on the use of trademarks. Article 20 of TRIPS provides that there shall not be an unjustifiable encumbrance "by special requirement" in the use of a trademark. Plain packaging would constitute an encumbrance on the use of the trademark and the issue is, therefore, whether it is justifiable or not. In this respect, Article 8.1 of TRIPS provides some guidance, allowing measures which are "*necessary to protect public health… provided that such measures are consistent with the provisions of* [TRIPS]". However, it has not been demonstrated that plain packaging meets the test under Article 8, meaning that it is *a priori* inconsistent with TRIPS and constitutes an unjustified encumbrance in breach of Article 20. Moreover, the effectiveness of plain packaging on tobacco consumption is not supported by real-life evidence[8].

Plain packaging would be an obstacle to the registration of tobacco trademarks, as there is little value for a trademark proprietor to register a trademark he will be unable to use, knowing that they may ultimately be invalidated or held unenforceable due to non-use. Plain packaging could also result in the invalidation of existing tobacco trademarks, in breach of the Paris Convention and Article 15(4) of TRIPS. Article 7 of the Paris Convention and its equivalent Article 15(4) of TRIPs provide that "the nature of the goods" shall not form an obstacle to the registration of trademarks. However, plain packaging requirements on tobacco products would mean that tobacco trademark owners would be unable to use non-word marks due solely to the nature of the goods, i.e. tobacco products. Trademarks must be used to remain valid and to avoid being subject to cancellation, but this use requirement would effectively mean that existing non-word tobacco trademarks could not *stay* registered as they could not be used. This would also run contrary to the Article 6*quinquies*(B) of the Paris Convention which prohibits trademarks from being either denied registration or invalidated[9].

Plain packaging leads to a failure to provide effective protection to trademark rights, in breach of the Paris Convention. Plain packaging would fail to comply with Article 10*bis* of the Paris Convention, a risk not only to trademark owners but also to consumers. Among other factors that would impede effective national-level enforcement of plain packaging legislation is the existence of massive counterfeit, black market, and grey market trade of consumer goods, including tobacco products.

INTA is concerned that the proposed Norwegian legislation would selectively take away intellectual property rights and ignores the strong protection they are given under the law

[7] See the Opinion of the Committee on Legal Affairs of the European Parliament http://www.europarl.europa.eu/sides/getDoc.do?pubRef=-//EP//NONSGML+COMPARL+PE-510.734+03+DOC+PDF+V0//EN&language=EN

[8] See for instance, the European Commission's impact assessment accompanying the document proposal for a directive of the European Parliament and of the Council: SWD (2012) 452 final, pages 92 and 93.

[9] Except for a definite number of very narrow exceptions, none of which apply here.

regardless of the economic sector to which the proprietor belongs. Any regulation must be proportionate and must respect the basic, fundamental legal principles and rights that apply to all legal products.

This approach is echoed by the international community, as following the implementation of plain packaging in Australia, five countries have commenced dispute settlement proceedings before the WTO over this measure. The proceedings are currently ongoing and many other WTO members have echoed the concerns raised by the complainants[10].

3. The proposal violates fundamental rights of trademark owners and consumers under Norwegian and European law

Firstly, **the proposal would effectively deprive trademark owners of their property rights.** The European Court of Human Rights (ECtHR) has confirmed that intellectual property, including trademarks, is covered by the right of property under the European Convention of Human Rights (ECHR)[11]. Norwegian national law also treats trademark rights as rights of property[12]. Plain packaging as proposed in the consultation would deprive trademark owners of such property, in violation of Article 1 Protocol 1 of the ECHR and also Article 96, sec. 3 of the Norwegian Constitution.

The proposal renders the affected trademarks meaningless. It would deprive trademarks for tobacco products of all their accepted functions, including guaranteeing the identity of origin of the marked goods or services to the consumer or end user which constitutes the essential function of trademarks.[13] The affected trademarks could not carry out any of their functions as they could no longer be *used*.

Trademark use is concerned with the consumer. For example, it is the consumer perception that determines whether a trademark enjoys protection at all, the scope of protection of a trademark, whether there is an infringement of a trademark and whether a trademark has been genuinely used. For instance, the CJEU just recently confirmed that the use of a trademark at trade level was insufficient to prevent a finding that the trademark had become generic.[14]

However, even if it would still be possible to register trademarks and to maintain the registered right, this right would be meaningless. Trademarks would be deprived of all their value. Furthermore, the Norwegian proposal stands in direct conflict with first principles of trademark law: trademarks must be used to justify their continued protection.[15] Section 37 of the Norwegian Trademarks Act imposes this obligation to use on Norwegian trademarks. It is not possible to "opt out" of such compulsory requirement.

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[10] http://www.wto.org/english/tratop_e/dispu_e/find_dispu_cases_e.htm?year=none&subject=G11&agreement=none&member1=none&member2=none&complainant1=true&complainant2=true&respondent1=true&respondent2=true&thirdparty1=false&thirdparty2=false#results

[11] ECtHR, *Anheuser-Busch v. Portugal*, of 11 January 2007, paragraph 72: "*In the light of the above-mentioned decisions, the Grand Chamber agrees with the Chamber's conclusion that Article 1 of Protocol No. 1 is applicable to intellectual property as such.*"

[12] A trademark is considered to be a part of a company's machinery and plant and may be used for mortgaging, Norwegian Mortgages and Pledges Act Art. 3-2.

[13] See for example: CJEU Case C-206/01, *Arsenal Football Club*, [2003] ECR I-10273, paragraph 48.

[14] CJEU Case C-409/12, *Backaldrin Österreich The Kornspitz Company GmbH*.

[15] Sometimes referred to as "use it or lose it" rule.

The proposal would interfere with trademark owners' freedom of expression and consumers' corresponding right to receive information. Article 10 of the ECHR protects the freedom of expression[16]. Trademarks serve a communication function in allowing trademark owners to communicate the qualities of their products by means of their trademarks. Such communication, however, would be prohibited under the proposal, in violation of fundamental rights.

The European Court of Human Rights (ECtHR) has held that the right to freedom of expression also protects commercial free speech. In Germany v European Parliament (Case C-376/98), Advocate General Fennelly noted that the effect of the ECtHR's jurisprudence[17] was that freedom of speech protected "*the provision of information, expression of ideas or communication of images as part of the promotion of a commercial activity and the concomitant right to receive such communications*".

Trademark owners' freedom of expression would be denied by the proposal envisaged in the consultation, as it compels them to carry a message against their will that would entirely supplant the trade dress, logos and other brand imagery, and is intended to be detrimental to the sales of their goods. Plain packaging is not a mere health or safety warning; nor is it intended to prevent false advertising. Instead, plain packaging would completely cover the entire surface area of the package but for one small mention of the brand name. Much less restrictive requirements have been rejected in the United States on freedom of speech grounds in the case of RJ Reynolds Tobacco Co. v. Food and Drug Administration, 696 F.3d 1205, 1208 (D.C. Cir, 2012)[18].

4. The Norwegian Bill sets a dangerous precedent for other products and industries

Intellectual property rights such as trademarks contribute significantly to economic growth. According to an extensive study jointly conducted by the European Patent Office and the Office for Harmonisation in the Internal Market, approximately 50% of industries in the EU are IP-intensive.[19] These industries generate almost 39% of total economic activity (GDP) in the EU, worth EUR 4.7 trillion, and directly support 26% (56 million) of all jobs in the EU. The study found that trademark-intensive industries are responsible for the highest shares of both employment and GDP contribution. The Internal Market and Services Commissioner Michel Barnier said, in reaction to the study: "*I am convinced that intellectual property rights play a hugely important role in stimulating innovation and creativity, and I welcome the publication of this study which confirms that the promotion of IPR is a matter of growth and jobs.*"[20]

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[16] See also Article 40.6.1 of the Irish Constitution.

[17] E.g., Casado Coca v Spain [1994] ECHR 8 and Markt-Intern.

[18] http://www.cadc.uscourts.gov/internet/opinions.nsf/4C0311C78EB11C5785257A64004EBFB5/$file/11-5332-1391191.pdf

[19] European Patent Office and Office for Harmonization in the Internal Market, Intellectual property rights intensive industries: contribution to economic performance and employment in the European Union; Industry-Level Analysis Report, September 2013.

[20] Press Release of the European Commission of 30 September 2013, Intellectual Property Rights: study indicates that roughly 35% of jobs in the EU rely on IPR-intensive industries, available at http://europa.eu/rapid/press-release_IP-13-889_en.htm.

However, the proposal, rather than promoting intellectual property rights, unduly restricts those rights and thereby endangers economic growth and jobs. INTA is concerned that prohibiting the use of trademarks for tobacco products sets a dangerous legislative precedent, including for Norwegian branded products exported abroad.

Initiatives such as the proposal envisaged by the consultation are likely to trigger calls for further regulations restricting or banning the use of trademarks on other products. There are already indications that the Australian plain packaging law has led other countries to consider similar regulations for other industries. South Africa, for example, has already restricted the use of certain trademarks for infant milk.[21] The Indonesian government is currently considering a plain packaging regulation for alcoholic beverages.[22]

There is a real danger that plain packaging requirements on tobacco products may be the harbinger for the global erosion of trademark rights across other industries in violation of fundamental rights of trademark owners and to the detriment of consumers.

5. The Norwegian proposal risks increasing illicit trade

As an intellectual property organisation, INTA is very concerned by the issue of illicit trade regardless of the industry affected. INTA is concerned that overly standardizing or restricting the labelling or packaging of products will facilitate the spread of counterfeit products by making them easier to produce and more difficult to detect.

The illicit trade in tobacco is a major problem in Europe. The EU customs enforcement of IPR Report in 2013, from 31 July 2014, stresses that customs authorities in the EU detained almost 36 million items suspected of violating intellectual property rights in 2013. Figures on tobacco smuggling (number of cases, articles and retail value of original goods) are included in this report[23].

Illicit trade affects not only rights holders and the IP community but also society at large. Indeed, many of the protagonists involved in illicit trade in Europe also commit other IP crime offences and serious non-IP related crime such as smuggling drugs and money laundering. This makes it an issue of much broader societal concern. There is evidence that, following the introduction of plain packaging in Australia in October 2012, illicit trade in cigarettes in Australia has increased by almost 20% between 2012 and 2013.[24]

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In conclusion, the implementation of plain packaging by Norway would set an unsound legislative precedent which would fundamentally change the Norwegian, European and global frameworks for trademarks, which have been developed over hundreds of years

[21] South Africa Department of Health, Regulation relating to foodstuff for infants and young children, No. R. 991, of 6 December 2012.
[22] The Drinks Business*, Indonesia threatens plain alcohol labels*, published on 19 May 2014 by Rupert Millar, available at http://www.thedrinksbusiness.com/2014/05/indonesia-threatens-plain-packaging-on-alcohol-labels/.
[23] http://ec.europa.eu/taxation_customs/customs/customs_controls/counterfeit_piracy/statistics/index_en.htm
[24] *KPMG (2014), Illicit tobacco in Australia, Full Year Report.*

to encourage the creation, protection and use of trademarks, for the benefit of the business community, consumers and the society at large.

INTA submits that the proposal envisaged in the consultation would severely impair the function of trademarks, create a dangerous precedent for other sectors, increase the risk of consumer confusion, violate several international treaty obligations as well as EU laws, and significantly increase the risk of counterfeit products being made available on the market.

Therefore, INTA respectfully opposes the prohibition of the use of trademarks through plain packaging as proposed in the consultation.

INTA stresses that the adoption and implementation of plain packaging in Norway law should be postponed in any event until the WTO has given its decision regarding the challenges (under TRIPS and the Technical Barriers to Trade Agreement) to the Australian law of 2012.

INTA would be happy to answer any questions you may have on these issues. Should you require further information, please contact Ms. Hélène Nicora at hnicora@inta.org.