



 **IPKey**

SOUTHEAST ASIA

PROTECTION OF WELL-KNOWN MARKS IN THE EUROPEAN UNION

Jennifer E. Laygo | Bangkok, Thailand | 15 August 2018

www.ipkey.eu



Funded by the European Union



Directed by the European Commission, IP KEY is implemented by the
European Union Intellectual Property Office (EUIPO)



IPKey

SOUTHEAST ASIA



www.ipkey.eu



Funded by the European Union



Directed by the European Commission, IP KEY is implemented by the European Union Intellectual Property Office (EUIPO)

PROTECTION OF WELL-KNOWN MARKS IN THE EUROPEAN UNION

Jennifer E. Laygo | Bangkok, Thailand | 15 August 2018



OUTLINE

- I. Introduction: Functions of a Trademark**
- II. International Agreements**
- III. Criteria for Determining whether a Mark is Well-Known**
 - WIPO Joint Recommendation (1999)
- IV. Protection of Well-Known Marks in the EU**
 - Relative Grounds for Refusal or Invalidity
 - Rights Conferred by an EU TM

Introduction: Functions of a Trademark

1. Indicate **ORIGIN / IDENTIFY** source as a particular undertaking – prevent consumers from confusion
2. **GUARANTEE QUALITY** – the goods or services be of a quality known to the consumer based on past experience
3. **ADVERTISING** would create an image of the product that could persuade first time consumers to purchase it
4. **INVESTMENT** function – trademarks as a form of property which can be safeguarded against trespass by third parties



Well-Known Marks: International Agreements

Article 6bis, Paris Convention

- Refuse/cancel registration
- Prohibit the use
- Reproduction, imitation, translation
- Liable to create confusion
- Well-known in that country
- Identical or similar goods

Article 16, TRIPS Agreement

- Art. 6bis shall apply to services
- Knowledge of the TM in the relevant sector of the public
- Including promotion of the TM
- Applies to dissimilar registered goods/services: (1) indicate a connection; and (2) interests of registered TM owner likely to be damaged.



Criteria for Determination of Well-Known Marks

1

Degree of Knowledge/ Recognition in the Relevant Sector of the Public

- Such as consumer surveys/opinion polls
- Actual and/or potential consumers; Channels of distribution; Business circles dealing with type of goods/services
- “Relevant sector” of the public > public at large
- Mass consumption products: public at large
- Goods of specific application or exclusively targeted professional or industrial users: limited to the specific purchasers



Criteria for Determination of Well-Known Marks

2

**Duration,
extent and
geographical
area of any
use of the
mark**

- Actual use of the mark in the country where protection as a well-known mark is sought cannot be required BUT use in neighboring territories may be relevant
- Duration not necessarily inferred from term of registration
- Density of population > size of geographical area
- Public awareness of mark > availability of products/goods



Criteria for Determination of Well-Known Marks

3 Duration, extent and geographical area of any promotion of the mark, including advertising/publicity and presentation at fairs or exhibitions

- Promotion as separate criteria from use
- Long, intensive and widespread promotional campaign
- Amount of professional expenditure;
- Nature of the promotional strategy (national/regional) and kind of medium used (print/tv/electronic media/internet)



Criteria for Determination of Well-Known Marks

4

Duration and geographical area of any registrations/applications

- Not required that registrations be in the name of the same person
- Number and duration of registrations and applications are relevant only to the extent that they **reflect use or recognition of the mark**, i.e., if the mark is actually used in the country of registration or was registered with a *bona fide* intention of using it



Criteria for Determination of Well-Known Marks

5

Record of successful enforcement of rights, in particular, extent recognized as well-known

- “Enforcement” construed broadly, includes opposition procedures preventing registration of conflicting marks
- Successful prosecution of complaints outside the courts, including acceptance of cease and desist requests, etc.
- Decisions of judicial or administrative authorities protecting against infringement



Criteria for Determination of Well-Known Marks

6

The value associated with the mark

- Solicitation by 3rd companies for reproduction on their products indicates high degree of attractiveness and economic value
- Licensing, merchandising, sponsoring may also indicate value of the mark

- ❖ Factors are not pre-conditions for determination that mark is well-known
- ❖ Criteria is not an exhaustive list; compliance or non-compliance with any of the factors cannot be considered conclusive



EU: Relative Grounds for Refusal or Invalidity

***“Earlier TM” includes well-known mark under Art. 6bis Paris**

[EUTMR 8(2)(c)]

Covers registered and unregistered well-known marks


Mark Itself	Goods & Services	Additional Element
Identical	Identical	(None needed) [EUTMR 8(1)(a)]*
Identical	Similar	Likelihood of confusion , including likelihood of association, on the part of the public [EUTMR 8(1)(b)]*
Similar	Identical	
Similar	Similar	



EU: Relative Grounds for Refusal or Invalidity

Extended Protection:

- Advertising & investment functions
- Applies to **registered well-known (reputed) marks** (EUTMs or national marks)

Mark Itself	Goods & Services	Additional Element
Identical	 Identical, Similar, or Dissimilar	Earlier applied/registered TM has reputation
Similar		Use w/o due cause = (1) Taking unfair advantage of distinctive character/repute (free riding) (2) Being detrimental to distinctive character (dilution) (3) Being detrimental to repute (tarnishment) [EUTMR 8(5)]



EU: Relative Grounds for Refusal or Invalidity

Upon opposition by the proprietor of a **non-registered trade mark or another sign** used in the course of trade of more than mere local significance, the TM shall not be registered where and to the extent that, pursuant to Union legislation or the law of the Member State governing that sign:

- (a) rights to that sign were **acquired prior to the date of application** for registration of the EU trade mark, or the **date of the priority claimed** for the application for registration of the EU trade mark;
- (b) that sign confers on its proprietor the **right to prohibit the use of a subsequent trade mark**. [EUTMR 8(4)]

❖ **Applicable national law may grant extended protection to a non-registered TM**



EU: Rights Conferred by an EUTM

TM owner can **prevent all third parties not having his consent from using in the course of trade**, in relation to goods or services, any sign:

- Identical with, or similar to, the TM;
- **Any goods or services** (identical, similar, or not similar);
- Where registered TM has a **reputation** in the Member State; and
- Use of that sign **without due cause** takes **unfair advantage** of (**free riding**), or is **detrimental to**, the **distinctive character (dilution) or repute (tarnishment)** of the TM [EUTMR 9(2)(c)]



Dilution: Detriment to Distinctive Character

- “**Dilution**”, “**whittling away**” or “**blurring**” is caused when a *mark’s ability to identify* the goods or services for which it is registered and used as coming from the proprietor of that mark is weakened, since use of the later mark **leads to dispersion of the identity and hold upon the public mind** of the earlier mark.
- when the earlier mark, which used to arouse **immediate association with the goods and services** for which it is registered, is no longer capable of doing so.

Case C 252/07 - Intel Corporation Inc. v CPM United Kingdom Ltd



Dilution: Detriment to Distinctive Character

- Even if an earlier mark with a reputation is **not unique**, the use of a later identical or similar mark may be such as to weaken the distinctive character of that earlier mark
- Proof of detriment to the distinctive character requires **evidence of a change in the economic behaviour of the average consumer** of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or **a serious likelihood** that such a change will occur in the future.

Case C 252/07 - Intel Corporation Inc. v CPM United Kingdom Ltd



Dilution: Detriment to Distinctive Character

- *Increased standard of proof to prove a ‘change in the economic behavior of the consumer’*
- The concept of ‘**change in the economic behaviour of the average consumer**’ lays down an **objective condition**. That change cannot be deduced solely from subjective elements such as consumers’ perceptions.
- The mere fact that consumers note the presence of a new sign similar to an earlier sign is not sufficient of itself to establish the existence of a detriment or a risk of detriment to the distinctive character of the earlier mark within the meaning of Article 8(5) ... in as much as that similarity does not cause any confusion in their minds.

Case C -383/12 P, *Environmental Manufacturing LLP v OHIM*



Dilution: Detriment to Distinctive Character

- A certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public **makes a connection** between the sign and the mark, that is to say, **establishes a link between them even though it does not confuse them.**
- The existence of such a link must, just like a likelihood of confusion, be appreciated globally, **taking into account all factors relevant to the circumstances of the case.**

Case C-408/01 - Adidas-Salomon AG, formerly Adidas AG, Adidas Benelux BV and Fitnessworld Trading Ltd



Dilution: Detriment to Distinctive Character

- A **sufficient degree of knowledge** of that mark that the public, when confronted by the later trade mark, **may possibly make an association between the two TMs**, even when used for **non-similar products or services**, and that the earlier trade mark may consequently be damaged.
- The degree of knowledge required must be considered to be reached when the **earlier mark is known by a significant part of the public concerned** by the products or services covered by that trade mark

Case C-375/97 - General Motors Corporation and Yplon SA





THANK YOU

 @IPKey_EU

