



Protection of Well-Known Trade Marks and Measures to Prevent Bad Faith Registrations

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Terminology

Well-Known Marks

Famous Marks

Marks with Reputation







Trademark Functions and Scope of Protection

- Identify commercial origin
 - protection against likelihood of confusion
- Guarantee consistent quality of the products
 - Protection against likelihood of confusion
- Advertising function and investment function
 - Protection against “dilution” (the whittling away of trademark distinctiveness)



Paris Convention Art. 6bis

- (1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, *to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country* as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods ...
- (2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.
- (3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.



Paris Convention Art. 6bis

- The Paris Convention does not specify measures for protection of well-known trademarks or their recognition procedures, leaving room for each signatory country to decide how it wishes to address these matters.
- Most countries do not process applications for recognition of well-known trademarks unless owners of such trademarks have demonstrated a need for such recognition, and most countries do not have a separate or independent application procedure for recognition of well-known trademarks



Paris Convention



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TRIPS Agreement Art. 16

- 2) Article 6*bis* of the Paris Convention (1967) shall apply, *mutatis mutandis*, to **services**. In **determining** whether a trademark is **well-known**, Members shall take account of the **knowledge of the trademark** in the **relevant sector of the public**, including ... as a result of the promotion of the trademark.
- 3) Article 6*bis* of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.



McDonald's Corp. v. Joburgers Drive-Inn Restaurant (SA 1996)



McDonald's had registration in SA but did not use the mark; JB opened its own McDonald's Restaurants, applied for TM registration and petitioned for cancellation of MD's registrations; MD contested JB application and requested that it be enjoined from using the mark in SA

McDonald's marks were found to be well-known marks, thus the use of the marks by Joburgers would cause deception or confusion among South African consumers



McDonald's Corp. v. Joburgers Drive-Inn Restaurant (SA 1996)

- Old SA law
 - TMs were only protected against “passing off” (goodwill in SA)
- New SA law (after SA joined WTO in 1995)
 - Designed to implement TRIPS (& Paris Convention)
 - Protection of well-known marks required
- Question: Are McD’s marks “well-known” in SA?
- Test (per TM Act):
 - Must be known to a substantial number of persons interested in the goods to which the mark relates
 - Relevant population: potential franchisees & potential customers of fast food burgers, etc.



WIPO Joint Recommendation 1999 Art. 2

Factors to consider whether a mark is well-known

- The **degree of knowledge or recognition** of the mark in the relevant sector of the public
- The **duration, extent, and geographical area** of any **use** of the mark
- The **duration, extent and geographical area** of any **promotion** of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies
- The **duration and geographical area** of any **registrations**, and/or any **applications** for registration, of the mark, to the extent that they reflect use or recognition of the mark
- The **record of successful enforcement** of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities
- The **value associated** with the mark



WIPO Joint Recommendation 1999 Art. 2

Factors to consider whether a mark is well-known

- The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant.
- In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed ... above.
- Such additional factors may be relevant, alone, or in combination with one or more of the factors listed ... above.



WIPO Joint Recommendation 1999 Art. 2

Relevant sectors of the public shall include, but shall not necessarily be limited to:

- actual and/or potential consumers of the type of goods and/or services to which the mark applies
- persons involved in channels of distribution of the type of goods and/or services to which the mark applies;
- business circles dealing with the type of goods and/or services to which the mark applies.

Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.

Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.

A Member State may determine that a mark is a well-known mark, even if the mark is not well known or ... known, in any relevant sector of the public of the Member State.



WIPO Joint Recommendation 1999 Art. 3

(1) [Protection of Well-Known Marks] A Member State shall protect a well-known mark against conflicting marks, business identifiers and domain names, at least with effect from the time when the mark has become well known in the Member State.

(2) [Consideration of Bad Faith] *Bad faith may be considered as one factor among others in assessing competing interests in applying Part II of these Provisions.*



WIPO Joint Recommendation 1999 Art. 4

Conflicting Marks

- (a) A mark shall be **deemed** to be in **conflict** with a well-known mark where that **mark**, or an **essential part** thereof, constitutes a **reproduction**, an **imitation**, a **translation**, or a **transliteration**, liable to create confusion, of the **well-known mark**, if the mark, or an essential part thereof, is **used**, is the subject of an application for registration, or is registered, in respect of **goods** and/or **services** which are **identical** or **similar** to the goods and/or services to which the well-known mark **applies**.



WIPO Joint Recommendation 1999 Art. 4

Conflicting Marks

- (a) **Irrespective of the goods and/or services for which a mark is used**, is the subject of an application for registration, or is registered, that mark shall be **deemed** to be in **conflict** with a well-known mark where the **mark**, or an **essential part thereof**, constitutes a **reproduction**, an **imitation**, a **translation**, or a **transliteration** of the **well-known** mark, and where at least one of the following conditions is fulfilled:
- (i) the use of that mark would indicate a **connection** between the goods and/or services for which the mark is used, is the subject of an application for registration, or is registered, and the owner of the well-known mark, and **would be likely to damage** his interests;
 - (ii) the use of that mark is likely to **impair** or **dilute** in an **unfair manner** the **distinctive** character of the well-known mark;
 - (iii) the use of that mark would take **unfair advantage** of the **distinctive character** of the well-known mark.



McCurry Restaurant (KL) SDN BHD v. McDonald's Corp. (Malaysia CA 2009)



CA reversed the HC's ruling, and dismissed McDonald's claim for passing off because there was no misrepresentation

McCurry's signboard would not result in reasonable persons associating McCurry with McDonald's



McDonald's Corp v. Future Enterprises Pte Ltd [2005] 1 SLR 177 (CA)



McDonald's opposed FE's application in class 30. The IPOS and the HC found that the marks were not similar. The CA dismissed McDonald's appeal—appellant wants to monopolise the prefix 'Mc' and 'Mac' in all food and beverages segments albeit the fact that its mark is only registered in class 42 – restaurant and catering services



Future Enterprises v. McDonald's Corp (CA 2007)



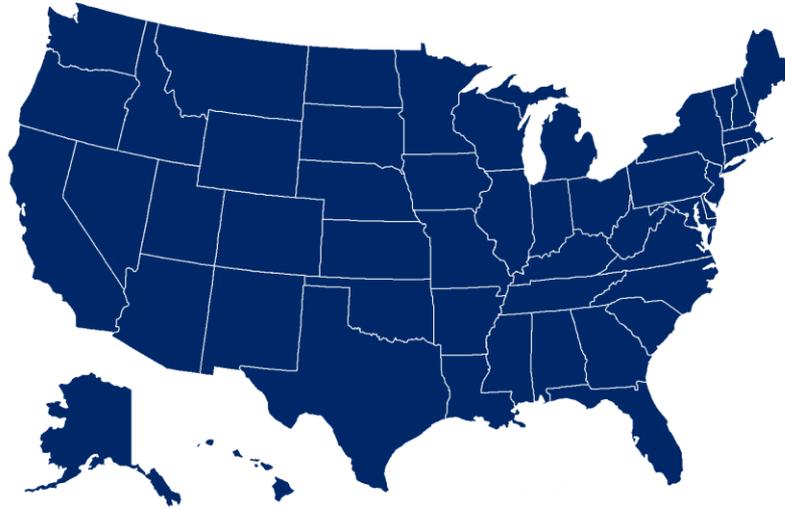
CA in 2007 upheld the decisions of the HC in September 2006 and of IPOS in November 2005 and disallowed registration of FE's trade mark application for the word "MacCoffee" for coffeemix in Class 30. McDonald's had opposed because confusingly similar to its registered mark "McCafe" for coffee in Class 30, under Section 8(2) of the Trade Marks Act.



However, FE may continue to use its earlier registered mark "MacCoffee" on its coffee products



United States Protection of “Famous Marks”



The US protects famous marks via the Federal Dilution Act (1994 as revised in 2006), which is incorporated in the Lanham Act

The US does not have explicit statutory protections for well-known marks



The screenshot shows the top navigation bar of the USPTO website. On the left is the 'uspto' logo and the text 'UNITED STATES PATENT AND TRADEMARK OFFICE'. On the right are links for 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO'. Below these is a search bar with the text 'Search uspto.gov' and a magnifying glass icon. A secondary navigation bar contains 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Find It Fast' button. Below this is a breadcrumb trail: 'Home > IP Policy > Trademark policy > Well-known marks', and 'Share' and 'Print' icons.

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Well-known marks

Article 6bis of the Paris Convention for the Protection of Industrial Property (1967) requires member countries to afford certain protections to well-known marks, regardless of whether they are registered. Specifically, member countries must refuse or cancel the registration, and prohibit the use, of a well-known mark when applied for or used by an unauthorized party for identical or similar goods, when its use or registration would likely cause confusion. Article 16.2 of the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) extends Paris Convention Article 6bis to services and provides that members shall take into account that a mark is well-known to a relevant sector of the public (not the entire country) as well as promotion of the mark (not just use). Article 16.3 of TRIPS extends Art. 6bis protection to well-known marks when used on unrelated goods or services in cases where the well-known mark is registered, if such use indicates a connection to the owner and the well-known mark owner would likely be damaged.

The United States implements these standards by protecting registered as well as unregistered well-known marks, of both domestic and foreign origin, from use and/or registration by unauthorized parties through the operation of Lanham Act §43(a), §43(c), §44(b) and §44(h) and under the Lanham Act §2(a) and 2(d). (15 U.S.C., §1125(a), §1125(c), §1126(b) and (h), and §1052(a) and (d)). U.S. federal law protects a mark against infringement or registration by another party's similar mark for goods or services that are the same, similar, related or even unrelated if there is a likelihood of confusion, whether or not the senior mark is registered.



US Trademark Act (Lanham Act) Section 43(c)

(c) Dilution by blurring; dilution by tarnishment

(1) Injunctive relief

Subject to the principles of equity, the **owner of a famous mark that is distinctive**, inherently or through acquired distinctiveness, **shall be entitled to an injunction against another person who**, at any time after the owner's mark has become **famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark**, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.



US Trademark Act (Lanham Act) Section 43(c)

(2) Definitions

(A) For purposes of paragraph (1), **a mark is famous if it is widely recognized by the general consuming public of the United States** as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

- (i) The **duration, extent, and geographic reach** of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- (ii) The **amount, volume, and geographic extent** of sales of goods or services offered under the mark.
- (iii) The extent of **actual recognition** of the mark.
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.



US Trademark Act (Lanham Act) Section 43(c)

(2) Definitions

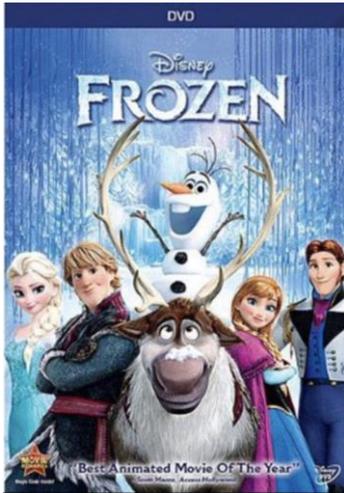
(B) For purposes of paragraph (1), “**dilution by blurring**” is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark. In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

(C) For purposes of paragraph (1), “dilution by tarnishment” is *association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark*.

Example: Disney's Frozen

Current Search: **(frozen Disney)(COMB)** docs: 53 occ: 212



Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead	
1	87982591	6086238	DISNEY FROZEN	TSDR	LIVE
2	87551966		DISNEY FROZEN	TSDR	LIVE
3	87551960		DISNEY FROZEN	TSDR	LIVE
4	87551956		DISNEY FROZEN	TSDR	LIVE
5	87551947		DISNEY FROZEN	TSDR	LIVE
6	87982590	6008615	DISNEY FROZEN	TSDR	LIVE
7	87982443	6008606	DISNEY FROZEN	TSDR	LIVE
8	87982444	6003306	DISNEY FROZEN	TSDR	LIVE
9	87532050		DISNEY FROZEN	TSDR	LIVE
10	87532038		DISNEY FROZEN	TSDR	LIVE
11	87532092	5944624	DISNEY FROZEN	TSDR	LIVE
12	87982033	5927653	DISNEY FROZEN	TSDR	LIVE
13	87532103	5927078	DISNEY FROZEN	TSDR	LIVE
14	87981772	5892325	DISNEY FROZEN	TSDR	LIVE
15	87979548	5699372	DISNEY FROZEN	TSDR	LIVE
16	87979484	5693668	DISNEY FROZEN	TSDR	LIVE
17	87551910	5552174	DISNEY FROZEN	TSDR	LIVE
18	87532105	5552114	DISNEY FROZEN	TSDR	LIVE
19	86790433	4972861	DISNEY FROZEN	TSDR	LIVE
20	86410820	4816352	DISNEY FROZEN	TSDR	LIVE
21	85928899		DISNEY FROZEN	TSDR	DEAD
22	85928892		DISNEY FROZEN	TSDR	DEAD
23	85928816		DISNEY FROZEN	TSDR	DEAD
24	85928809		DISNEY FROZEN	TSDR	DEAD
25	85928903	5059806	DISNEY FROZEN	TSDR	LIVE
26	85928875	4867458	DISNEY FROZEN	TSDR	LIVE
27	85928824	4867457	DISNEY FROZEN	TSDR	LIVE

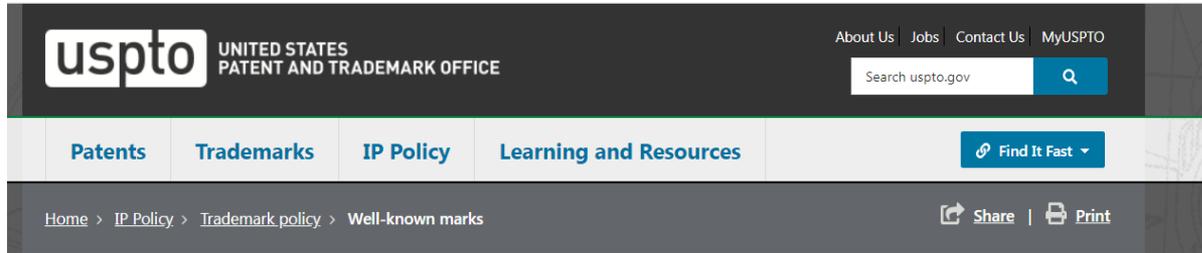
Phase 4 Films used the name “Frozen Land” and redesigned its artwork, packaging and logo to take advantage of the financial success of the Disney Film

Disney filed a lawsuit against Phase 4 films,

The parties settled and Phase 4 Films can no longer use the title “Frozen Land”

Phase 4 was also ordered to pay Disney \$100,000





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Well-known marks

The USPTO uses the usual “likelihood of confusion” test in deciding whether to protect a well-known mark. There is no separate analysis apart from likelihood of confusion or deceptiveness, as to whether a mark is well known or not (**if a mark is not famous**)

The USPTO will refuse registration of, or a third party may seek to oppose or cancel, a mark that conflicts with registered or unregistered well-known marks, foreign or domestic that do not meet the requirements under the Lanham Act.





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Well-known marks

The USPTO does not make a specific determination in examination as to whether a mark is well-known, *it evaluates the strength of the mark in determining the scope of protection to afford a previously registered or unregistered mark against a pending application*

In certain cases the **owner** of a **well known** mark that **rises** to the **level** of being “**famous**” may bring an action against another use of the mark in US federal courts or may seek to oppose or cancel another’s application or registration for the mark on the grounds of **dilution**.



US Cases on Recognition of Foreign Well-Known Marks

Person's (CAFC 1990)

Strict application of territoriality (a Japanese trademark owner's claim to cancel a trademark registration in the US was denied because the firm has no business in the US, even though the U.S. registrant had seen the Japanese products and mark while traveling and modeled its mark on the Japanese mark) (possible case of bad faith?)

Grupo Gigante (9th Cir. 2004)

An unfair competition claim by a foreign trademark owner was allowed but required a showing of secondary meaning and proof that “a *substantial* percentage of consumers in the relevant American market is familiar with the foreign mark.” (creates exception to territoriality for “famous marks”)



US Cases on Recognition of Foreign Well-Known Marks

Punchgini (2d Cir. 2007)

There is no Lanham Act claims where the plaintiff does not own or use a U.S. trademark (Congress hasn't created an exception to territoriality for famous marks)

Belmora LLC v. Bayer Consumer Care AG (4th Cir. 2016)

Preventing unfair U.S. competition by “the deceptive and misleading use” of foreign trademarks is within the “zone of interests: protected by the Lanham Act, and that Bayer adequately pled injuries proximately caused by Belmora's deceptive advertising creating a false connection between the two brands



Empresa Cubana del Tabaco v. Culbro (multiple cases)



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TTABVue. Trademark Trial and Appeal Board Inquiry System v1.9

Cancellation

Number: 92025859 Filing Date: 09/07/2019
Status: Suspended Status Date: 10/22/2019
General Contact Number: 571-272-8500
Interlocutory Attorney: REBECCA J STEMPIEN_COYLE
Paralegal Name: AMY L MATELSKI

Defendant

Name: General Cigar Co., Inc.
Correspondence: JOHN M. NADING
DLA PIPER LLP US
500 EIGHTH STREET NW
WASHINGTON, DC 20004
UNITED STATES
Andrew.Deutsch@dlapiper.com, David.Huff@dlapiper.com, mkrinsky@rbskl.com,
joshua.schwartzman@us.dlapiper.com, carl.lawrence@us.dlapiper.com, john.nading@us.dlapiper.com
Phone: 202-799-4157

Serial #:	73161879	Application File	Assignment	Registration 1147309 #:
Application Status:	Cancellation Pending			
Mark:	COHIBA			

Serial #:	74344349	Application File	Assignment	Registration 1898273 #:
Application Status:	Cancellation Pending			
Mark:	COHIBA			

Plaintiff

Name: Empresa Cubana Del Tabaco d.b.a Cubatabaco
Correspondence: DAVID B. GOLDSTEIN
RABINOWITZ BOHJOW STANDARD KRINSKY & LIEBERMAN PC
14 WALL ST, STE 3002

Cubatabaco filed a cancellation proceeding against General Cigar over the registered trademark COHIBA



Empresa Cubana del Tabaco v. Culbro (multiple cases)



Cubatabaco brought an unfair competition claim against General Cigar for use of the mark “Cohiba” (not in use in the US because of the embargo against Cuba); this litigation has been continuing for several years; *eventually Cubatabaco has been denied relief by the 2d Cir. in 2010 (because of the embargo against Cuba)*



Bad Faith Registrations in the US

Types of bad faith registrations

- Register with no intention of using the mark only “selling” the mark;
- Register with intention of token use of the mark on same or related goods to sustain registration; or
- Register with intention of using the mark on same, related or unrelated goods to trade off of the goodwill of another party



Bad Faith Registrations in the US

Statutory Duty of Good Faith in the US

- Good faith is a requirement for intent to use applications
 - Application can be challenged for absence of lack of intent to use
- Penalties for applicant and representative for bad faith
 - Criminal prosecution for perjury
 - Deleting affected goods from the registration and/or cancelling registration
 - Sanctioning attorney/agent representative



Measures to Prevent Bad Faith Registrations in the US

- Requiring more information/specimens during examination
 - Refusals or challenges based on false suggestion of a connection 2(a)
 - Suggests a connection with a person, living or dead, or institutions, even if the cited mark is not registered
 - Refusals based on the name of a living individual 2(c)
- Transparency During Examination and Beyond
 - Misrepresentation of Source 14(3)
- Information filed by an applicant is public and available on the USPTO website
 - All papers filed with the Board must be served on the other party
 - Board files are public and available on the USPTO website



Bad Faith As Factor for Infringement and Dilution in the US

Courts consider bad faith as a factor in a likelihood of confusion analysis. The Defendant's intent to cause confusion with plaintiff's mark suggests that defendant's actions were highly likely to have had that effect

A list of factors considered in a likelihood of confusion analysis allow courts to balance factors and apply a sliding scale: for example, the more evidence of bad faith, the less evidence is needed to establish similarities in the marks or the goods or services



Bayer Consumer Care AG v. Belmora LLC (TTAB 2014), 92047741 (Fed. Cir. 2014).



- Bayer sought cancellation of Belmora’s registration of FLANAX for analgesic tablets
- Court’s standard was that the petitioner must establish ‘blatant misuse of the mark by respondent in a manner calculated to trade on the goodwill and reputation
- Petitioners showed examples of the defendant referencing plaintiff’s mark when marketing the product saying “we’re the direct producers of FLANAX in the U.S.”
- Petitioners produced an email showing defendant fabricating evidence on the genesis of the mark
- Court found that the Defendant copied Plaintiff’s FLANAX logo as used in Mexico and other elements of the Mexican Packaging and that the Defendant invoked Plaintiff’s reputation in selling its goods



L'Oreal S.A. v. Marcon (TTAB 2012)



Robert Victor Marcon (Applicant) filed for the mark L'OREAL PARIS for aloe vera drinks. L'Oreal S.A. and L'Oreal USA, Inc. (together Opposer) opposed the application on the basis of likelihood of confusion with and dilution of its registered L'OREAL and L'OREAL PARIS marks for cosmetics, and a lack of intent to use in commerce.

The Board found that Applicant has a pattern of filing intent-to-use applications to register various well-known marks, and that it is highly unlikely that adoption of marks was an unintended coincidence. The Board found that bad faith is strong evidence that confusion is likely, as such an inference is drawn from the imitator's expectation of confusion.



Bad Faith Registrations in the US



Example of a Declaration: Application for LOREAL PARIS

BASIS FOR FILING AND GOODS/SERVICES INFORMATION

Intent to Use: Section 1(b)
The Applicant has a bona fide intention to use the mark in commerce on or in connection with the below-identified goods and/or services (15 U.S.C. Subsection 1051(b)).

- (1) International class 005.
- (2) Listing of Goods and/or Services:
 - (a) Perfumes and fragrances;
 - (b) Vitamin, mineral, and herbal supplements, and combinations thereof;
 - (c) Aloe vera drinks;
 - (d) Shaving balms, lotions, creams, and soaps;
 - (e) Topical skin balms, namely: sunscreens, tanning balms, lotions, creams, and combinations thereof;
 - (f) Candles, both plain and scented; and
 - (g) Shaving implements.

Foreign Priority: Section 44(d)
The Applicant has a bona fide intention to use the mark in commerce on or in connection with the below-identified goods and/or services, and asserts a claim of priority based upon a foreign application in accordance with 15 U.S.C. Section 1126(d).



SIGNATURE INFORMATION

The Applicant request registration of the above-identified mark in the United States Patent and Trademark Office on the Principal Register established by Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.) for the above-identified goods and/or services.

The undersigned, being hereby warned that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such wilful false statements may jeopardize the validity of the application or any resulting registrations, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the



applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes Applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in identical form thereof or in such new resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: Robert Victor Marcon

Print Name: Robert Victor Marcon
Date Signed: 8 June 2004
Title: Individual



EU Trademark Regulation 2015/2424

Article 8(5)

Upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be **registered** where it is **identical** with, or **similar** to, an **earlier trade mark**, **irrespective** of whether the **goods** or **services** for which it is applied are **identical** with, **similar** to or not **similar** to those for which the **earlier trade mark** is **registered**, where, in the case of an earlier EU trade mark, the trade mark has a **reputation** in the **Union** or, in the case of an earlier **national trade mark**, the trade mark has a **reputation** in the **Member State** concerned, and where the **use without due cause** of the trade mark applied for would take **unfair advantage** of, or be **detrimental** to, the **distinctive character** or the **repute** of the **earlier trade mark**.



EU Trademark Regulation 2015/2424

Article 9

(2) Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the EU trade mark, the proprietor of that EU trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:

(c) the sign is identical with, or similar to, the EU trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EU trade mark is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EU trade mark.



EUIPO Examining Guidelines (2020 ed.)

The screenshot shows a web browser displaying the EUIPO Examining Guidelines website. The URL in the address bar is <https://guidelines.euiipo.europa.eu/1803468/1788248/trade-mark-guidelines/section-5-trade-marks-wi...>. The page header includes the EUIPO logo, a search bar with the text "Search trade mark guidelines", and navigation options for "Complete Edition", "Trade mark guidelines", "Edition 2020", and "English".

The main content area is titled "Trade mark guidelines" and "Part C Opposition". It features a "Show modifications" toggle switch and icons for information, print, download, email, and navigation. The primary heading is "Section 5 Trade marks with reputation (Article 8(5) EUTMR)".

A left-hand navigation menu lists the following sections:

- 1 Introduction
- + Editor's note and general introduction
- + Part A General rules
- + Part B Examination
- x **Part C Opposition**
 - + Section 0 Introduction
 - + Section 1 Opposition proceedings
 - + Section 2 Double identity and likelihood of c
 - + Section 3 Unauthorised filing by agents of t
 - + Section 4 Rights under Article 8(4) and 8(6)
 - + **Section 5 Trade marks with reputation (A**
 - + Section 6 Proof of use
- + Part D Cancellation
- + Part E Register operations
- + Part M International marks

The main content area lists the following sub-sections:

- **1 Introduction**
- **2 Scope of Applicability**
- **3 Conditions of Application**

The "Parent topic" is identified as [Part C Opposition](#).



Well-Known Mark Protection under EU Law (EUIPO Guidelines)

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Well-known marks that are not registered in the relevant territory cannot be protected under Article 8(5) EUTMR against dissimilar goods. They can only be protected against identical or similar goods if there is a likelihood of confusion pursuant to Article 8(1)(b) EUTMR, to which Article 8(2)(c) EUTMR refers for determining the scope of protection (likelihood of confusion)

However, this is without prejudice to the fact that well-known marks, to the extent that they are not registered, may also be protected under Article 8(4) EUTMR. Therefore, if the relevant national law affords them protection against dissimilar goods and services, such enhanced protection may also be invoked under Article 8(4) EUTMR.

Where well-known marks have been registered, either as EUTMs, or as national marks in one of the Member States, they can be invoked under Article 8(5) EUTMR, but only if they also fulfil the requirements of reputation.



EU Trademark Regulation 2015/2424

Article 8

1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

....

2. For the purposes of paragraph 1, ‘earlier trade mark’ means:

(c) trade marks which, on the date of application for registration of the EU trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the EU trade mark, are well known in a Member State, in the sense in which the words ‘well known’ are used in Article 6bis of the Paris Convention.



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“Although the terms ‘well known’ and ‘reputation’ denote distinct legal concepts, there is a substantial overlap between them, as shown by a comparison of the way in which well-known marks are defined in the WIPO recommendations with the way in which reputation was described by the Court of Justice in ‘General Motors’. In both cases, the assessment is principally based on quantitative considerations regarding the degree of knowledge of the mark among the public, and the thresholds required for each case are expressed in quite similar terms.”



Criteria to Assess Reputation

Quantitative requirement

Degree of knowledge of the earlier mark among the relevant public, how large segment of relevant public knows the mark

Qualitative aspects

Quality, image, prestige, uniqueness, public appeal of the reputed mark

What should be proved?

- Nature of the Use
- Time of use
 - Reputations must be acquired before the date of priority of the contested mark
- Place of Use
 - Must be reputed in the territory where the earlier reputed mark is registered
- Extent of Use
 - Known to a substantial part of the relevant public
 - No minimum percentage





REPUTATION

MEANS OF EVIDENCE

- **company profiles, annual reports, affidavits**
- **market surveys**
- **ranking, recognitions, awards**
- **press articles**
- **statements from third parties**
- **sales turnover, market share**
- **invoices, delivery notes**
- **advertising expenditure**
- **advertising and promotional material**
- **sponsorship of cultural, sports events, merchandising**
- **previous national or EU court decisions, successful enforcement track record**



Criteria to Assess Reputation

To find a “unfair advantage” or “detriment to the reputation” of the existing marks, the **relevant public** must establishing a **link** between the marks:

- The public should be reminded of the earlier mark by seeing the later mark

Factors to consider:

- **similarity of signs**
- **degree of reputation**
- **overlap of public**
- **proximity of the market sectors**



Types of Harm to Reputation

1. Free riding (taking unfair advantage of the reputation or distinctive character of the earlier reputed mark)
2. Dilution by blurring: dilute the distinctiveness of the distinctive character of the earlier reputed mark
3. Dilution by tarnishment: detriment the reputation of the earlier reputed mark



06/07/2012, T-60/10, Royal Shakespeare



Theatre productions

ROYAL SHAKESPEARE

**Non-alcoholic and alcoholic drinks,
providing of food and drinks**

General Court: the EUTM applicant would benefit from the power of attraction, the reputation and the prestige of the earlier trade mark for its products. The Courts found the following:

- Exceptional reputation of the earlier mark
- Certain proximity between the goods and services at issue
- The relevant UK public would be able to make a link when seeing a beer with the contested trade mark in a supermarket or in a bar.



Earlier reputed sign	EUTM application	Case No
Viagra	Viagura	25/01/2012, T-332/10, EU:T:2012:26

While recognising that the primary function of a trade mark was as an indicator of origin, the General Court held that a mark could also serve to transmit other messages, concerning particular qualities or characteristics of the designated goods or services, or the images and sensations projected by the mark itself, such as luxury, lifestyle, exclusivity, adventure or youth. In this sense, a trade mark possessed an intrinsic economic value that was autonomous and distinct to that of the goods or services for which it was registered (para. 57).

The risk of taking unfair advantage encompasses cases of manifest exploitation or parasitism of a mark with reputation, namely the risk of transferring the image of the mark with reputation or the characteristics projected by it to the goods covered by the mark applied for, thus facilitating the marketing of those goods through association with the earlier mark with reputation (para. 59).

The Court concluded that, even if the drinks claimed by the mark applied for would not in reality produce the same benefit as the 'immensely well-known' pharmaceutical for the treatment of erectile dysfunction, what was important was that the consumer, because of the transfer of positive associations projected by the image of the earlier mark, would be inclined to purchase such drinks in the expectation of finding similar qualities, such as an increase in libido (paras 52 and 67).



Section 5 Trade marks with reputation (Article 8(5) EUTMR)

Earlier reputed sign	EUTM application	Case No
Vips	Vips	22/03/2007, T-215/03, EU:T:2007:93

The earlier mark *Vips* has a reputation for restaurants, in particular fast-food chains. However, it was not proven that it also enjoys any particular prestige. The term *Vips* is laudatory in itself and extensively used in this manner. There is no explanation as to how the sales of software products under the mark *Vips* could possibly benefit from their association with a fast-food chain, even if a link were made. Therefore, the Court rules out the risk that use of the mark applied for would take unfair advantage of the distinctive character or repute of the earlier mark.

Dilution established

Earlier reputed sign	EUTM application	Case No
		28/01/2014, R 69/2013-4, CAMEL BRAND (fig.) / CAMEL (fig.) et al.
Reputed for tobacco products	Foodstuffs in Classes 29, 30 and 32	

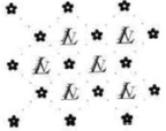
First of all, taking into account the very high similarity between the conflicting marks and the high reputation of the earlier mark, there is a risk that the public will be led to believe that the CAMEL food products originate from, or that the mark is used with the consent of, the opponent. Moreover, the capacity of the reputed CAMEL mark to arouse immediate association with the opponent's business will be diminished by the use of the contested mark. The use of a highly similar mark for food products would be detrimental to the distinctive character of the reputed CAMEL trade mark for tobacco products, making this mark ordinary, which is in essence a diminution of the power of attraction of the mark. This will lead to dispersion of the identity and hold upon the public's mind of the earlier mark. The earlier mark, used to arouse immediate association with the goods for which it is registered, will no longer be capable of doing so. It follows that there is a clear probability of damage to the earlier mark's advertising function as a vehicle for building up and retaining brand loyalty, and that the economic value of the earlier reputed mark will be impaired, in the medium or long term, as a consequence of the use of the contested mark, in the sense that consumers of the goods for which the reputed mark is protected and known will be less inclined to associate it immediately with the undertaking that has built up the trade mark's reputation; this must be considered a change in their economic behaviour (para. 41).



Tarnishment established

Earlier reputed sign	EUTM application	Case No
<p>KAPPA</p> 	KAPPA	12/03/2012, R 297/2011-5, KAPPA / KAPPA et al.
Reputed for sports clothing and footwear	tobacco products, cigarettes, cigars, amongst others	
<p>The contested application was filed for tobacco and related goods in Class 34. Smoking tobacco is universally considered to be an extremely unhealthy habit. For this reason, use of the sign KAPPA for tobacco and related goods is likely to prompt negative mental associations with the respondent's earlier marks or associations, conflicting with and being detrimental to their image of a healthy lifestyle (para. 38).</p>		



Earlier reputed sign	EUTM application	Case No
		<p>06/10/2011, R 2124/2010-1,</p>
<p>Reputed for goods in Classes 18 and 25</p>	<p>Scientific, nautical, surveying, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; amongst others.</p>	<p>LN (fig.) / LV (fig.) et al.</p>
<p>The opponent demonstrated that the prestigious image of its trade marks is linked to the traditional manufacturing method of its fine leather goods, which are handmade by master craftsmen who work only with top-quality raw materials. It is this image of luxury, glamour and exclusivity, combined with the exceptional quality of the product, that the opponent has always striven to convey to the public, as the evidence adduced testifies. This image would be quite incompatible with goods of a strongly industrial and technological nature, such as electric meters, scientific microscopes, batteries, supermarket cash registers, fire-extinguishing apparatus or other instruments, for which the applicant intends to use its trade mark (para. 28).</p> <p>What would be detrimental to the image of its trade marks, which the opponent has carefully fostered for decades, is the use of a trade mark that recalls its own and is applied to goods characterised, in the public's perception, by a significant technological content (whereas a fine-leather article is rarely associated with technology) or as having an industrial origin (whereas fine leather goods are traditionally associated with craftsmanship) (para. 29).</p> <p>The use of a trade mark that is practically identical to a trade mark that the public has come to perceive as synonymous with fine leather goods of excellent manufacture for technical apparatus or electrical tools of all kinds will diminish its attraction, that is, its reputation, amongst the public that knows and values the earlier trade marks (para. 30).</p>		

Bad Faith Registrations in the EU

- The EUTMR considers bad faith as an absolute ground for invalidity of an EUTM, to be relied on either before the Office or by means of a counterclaim in infringement proceedings.
- The relevant point in time for determining whether there was bad faith on the part of the EUTM owner is the time of filing of the application for registration.



Bad Faith Registrations in the EU

Factors to show bad faith

- Identity/confusing similarity of signs
- Knowledge of the use of an identical and confusingly similar sign (not sufficient per se)
 - not required where the EUTM owner wants to block similar mark from entering the market
- The circumstances under which the contested sign was created, the use made of it since its creation and the commercial logic underlying the filing of the application for registration
- The nature of the mark that is applied for
- The degree of inherent or acquired distinctiveness enjoyed by the invalidity applicant's sign and the EUTM owner's sign
- The fact that the national mark on which the EUTM owner has based a priority claim has been declared invalid due to bad faith

Bad Faith Registrations in the EU

Factors that unlikely show bad faith

- Extending the protection of a national mark by registering it as an EUTM
- Bad faith cannot be found on the basis of the length of the list of goods and services set out in the application for registration
- The fact that the owner of several national marks decides to apply for an EUTM for only one and not all of them
- If a sign enjoys a reputation at a national level and the owner applies for an EUTM



Bad Faith Registrations in the EU



T-772/17 Café del Mar

One of the three partners in the company that owned CAFÉ DEL MAR applied for the registration of this EUTM figurative mark for services in Classes 35, 38, 41

An invalidity application based inter alia on bad faith was filed by the two other partners in the company that owned CAFÉ DEL MAR

By registering in his own name a trade mark generating confusion with the earlier sign 'Café del Mar' while he was the representative of one of the companies exploiting said sign and by paying the registration costs with funds from that company, he departed from accepted principles of ethical behaviour or honest commercial and business practices and therefore acted in bad faith.



Protection of Well-Known Marks in Indonesia (Law No. 20 of 2016)

Article 21(1)

An application shall be rejected if the mark is similar in its essential part or in its entirety with

- a well known mark owned by another party for similar goods and/or services; or
- a well know mark owned by another party for dissimilar kind of goods and/or service which meet certain requirements.

(From the Explanation) Criterias are provided to assess whether a mark is well known:

- the knowledge of the public of such mark in the business area concerned;
- the reputation of the mark due to intensive and large scale promotion, investment in several countries by its owner;
- evidence of registration of the mark several countries.



Protection of Well-Known Marks in Indonesia (Regulation No. 67 of 2016)

Article 18

“Public” is the consumers and public in general, who has connection with the production, promotion, distribution, or sales of the goods and/or services bearing the well-known mark

The following should be considered in establishing whether a mark is well-known

- Public knowledge or acknowledgement regarding the mark in related business
- Sales volume and profit gained by the owner from the use of the mark
- Market share controlled by the mark on goods/services distribution in the public
- Coverage of mark use
- Duration of mark use
- Intensity and promotion, including value of investment in promotion
- Registration and application for registration of the mark in other countries
- Enforcement of the trademark and acknowledgement of the mark as a well-known mark by competent authorities
- The value of the mark gained from the reputation and the quality assurance of the products bearing the mark



Protection of Well-Known Marks in Indonesia

Additional resources

The Commercial Court can order an independent institution to conduct surveys with the purpose of establishing whether or not a mark is well known.

Technical Guidelines for Trademark Substantive Examination based on DGIP Decree Number H-09.PR.10 of 2007. The guideline is now on the progress to be revised.

Examiners also use the ASEAN Guidelines for Substantive Examination.



Bad Faith Registrations in Indonesia (Law No. 20 of 2016)

Article 21(3)

“The Application shall be rejected if it is filed by an Applicant acting in bad faith”.

(From the Explanation):

“Applicant not acting in good faith” shall be an applicant who, in registering the mark concerned, is reasonably suspected of having the intent to imitate, copy, or free ride on the mark of another party for the purpose of advancing his/her business interests and create unfair business competition, deceiving, or misleading consumers.

For instance, the application (writing, painting, logo, or a combination of colors) is identical to a mark publicly well-known in the community for many years, is imitated in such a manner that is similar in its essential part of in its entirety with the well-known mark. *This is an example of an applicant not acting in good faith because it can be at least reasonably assessed that there is an element of deliberateness in imitating the well-known mark concerned.*



Bad Faith Registrations Indonesia DGIP Technical Guidelines (Decree H-09.PR.10 of 2007)

An application shall be rejected based on bad faith if it is:

- Similar or copy the entirety of painting created by other people for registered trademark for dissimilar good or services or earlier application;
- Similar or copy the entirety of other registered logo design or earlier application
- Similar or copy the entirety the way or form of writing or other registered copyright or earlier application.



Commercial Court of Central Jakarta No. 45/2005 and Supreme Court No. 12 /2006

GIORDANI

Registered in class 3

GIORDANO

registered in class 18 and 25

The owner of GIORDANO, filed a cancellation action against GIORDANI arguing that GIORDANO is a well-known mark that is registered in 32 countries (previous court decisions found that GIORDANO is well-known in Indonesia (No.395/1999 (Central Jakarta) and Supreme Court Decision No. 285/1999 and No. 21 1998). Giordani refused the claims and argued that GIORDANI is also a well-known mark registered in many countries (however only provided certificate of registration in 3 countries)

The Commercial Court refused all claim, arguing that cancellation was filed after the period of 5 years after the mark is registered. But the Supreme Court reversed and cancelled GIORDANI arguing that GIORDANO trademark is well-known therefore should be protected in Indonesia. The SC also found that GIORDANI was registered in bad faith since it was similar with GIORDANO.



Commercial Court of Central Jakarta 53/2011 and Supreme Court No. 159/2012



IKEMA

IKEA trademark has been registered in many countries since 1943 in 75 countries and has 1300 trademark registrations. Plaintiff have also promoted and marketed products widely using IKEA trademark. Ikea was declared as a well-known trademark based on another countries court decisions (China and Chile) and in Indonesia (3 decisions). IKEMA is registered in Indonesia in class 21.

The Commercial Court rejected all claims from IKEA. However the Supreme Court in decided to cancel IKEMA trademark arguing that IKEMA has similarity with a well-known trademark IKEA that has been registered in many countries.



Commercial Court of Central Jakarta 27/2016 and Supreme Court No. 938/2017

HUGO
HUGO BOSS



Defendant registered ZEGOBOSS trademark in class 25 and 3. Hugo Boss filed for cancellation.

The Commercial Court rejected all claims. However The Supreme Court cancelled defendant's trademark. The SC declared that the marks HUGO BOSS, BOSS dan BOSS HUGO and their variants are well known marks. It also declared that defendant's mark: ZEGOBOSS in class 25 and 3 are similar.

The SC also declared that defendant registered ZEGOBOSS mark in bad faith since it has similarity with Plaintiff's well-known trademark and the registration was on the intention to copy plaintiff's well-known trademark.



Conclusion

- Well-Known Marks are frequently copied in several countries (often in bad faith)
- Trademark law provides a framework to address the protection of well-known marks
- This framework is based on territoriality, but also on recognition of right acquired abroad
- The interpretation of relevant concepts (relevant public, degree of recognition, etc.) still varies territorially
- National IP Offices have precedents and guidelines for examination and oppositions regarding well-known marks
- Courts have developed relevant precedents in this area





THANK YOU

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