

Protection of Well-Known and Famous Trademarks

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Collaborator : Nobuyuki MATSUBARA,
Patent Attorney,
Matsubara, Muraki & Associates

CONTENTS

	Page
1. Introduction	1
2. The Function of Trademarks and Protection Thereof	4
2-1 The General Function of Trademarks	4
2-2 Protecting Goodwill	5
3. The Roles of Trademark Law and Unfair Competition	
Prevention Law	7
4. The Top 100 Globally Well-Known Brands:	
Do you agree with the survey results?	9
4-1 “Business Week”, U.S. magazine	9
4-2 Survey conducted by the NIKKEI Newspaper in Japan	10
(a) Collective ranking of results from surveys targeting both	
business people and general consumers:	11
(b) Business professionals’ ranking of brands	12
(c) General consumers’ ranking of brands	12
5. The Current Legislative Structure for Protecting Well-Known	
and Famous Trademarks	14
5-1 International Conventions	14
(a) Paris Convention	14
(b) TRIPS Agreement	17
(c) WIPO Joint Recommendation concerning Provisions	
on the Protection of Well-Known Marks	20
5-2 EU Council Directive and Community Trademark Regulation;	21
5-2-1 EU Council Directive	21

5-2-2	Community Trademark Regulation	23
5-2-3	Foreign Laws	24
5-3	Japanese Domestic Laws	25
5-3-1	Trademark Law	25
5-3-2	Unfair Competition Prevention Law	31
6.	Criteria for Determining Well-Known and Famous Trademarks	35
6-1	International Guidelines	35
6-2	Japanese Guidelines	43
6-3	Guidelines in Other Countries	45
(a)	United States	45
(b)	South America	47
(c)	Asia	47
6-4	Surveys for Evaluating Well-Known or Famous Trademarks	47
6-5	Is There a Distinction Between “Well-Known” and “Famous”?	48
(a)	Position in the United States, etc.	48
(b)	Distinctions in Japanese Trademark Law and Unfair Competition Prevention Law	50
(c)	EU Council Directive of CTM	51
6-6	Is Registration or Actual Use in One Particular Country Required as a Condition for Protection of Well-Known and Famous Trademarks?	52
7.	Court Decisions in Various Countries	55
7-1	Court Decisions in Japan	55
(a)	“Mitsubishi Construction Company” case (Osaka High Court, April 5, 1966)	55

(b)	“Yashica” case (Tokyo District Court, Aug 30, 1966).....	56
(c)	“CHANEL” case	58
7-2	European Union	59
(a)	“CANON” case	59
7-3	Germany	60
(a)	“MARS” case (German Supreme Court, February 10, 1994).....	60
7-4	United Kingdom	61
(a)	“EVERREADY” case	61
(b)	“TIFFANY” case	62
7-5	Other Jurisdictions	63
(a)	Australian High Court Decision (46 IPR 481)	63
(b)	Thailand Supreme Court Decision	63
(c)	Chile	64
(d)	Israel	64
(e)	Greece	65
(f)	France	66
8.	Dilution Theory	67
8-1	Meaning of “Dilution Theory” as Given	
	by Prof. Thomas McCarthy	67
8-2	Provisions of the Lanham Act.	67
8-3	Analysis by Prof. Lars S. Smith	68
8-4	Blurring and Tarnishing	70
9.	Conclusion	73
	Foot note:	74
	Attachment	75 - 95

Protection of Well-Known and Famous Trademarks

1. Introduction

The Industrial Revolution achieved in the early 20th century caused substantial changes in the social and economic currents of the time on a global scale.

Before this time, the economy had been principally agrarian and it was still cheaper to make than buy many goods, especially foods, clothing and other daily necessities. Accordingly, many families were thus units of production and not consumption, so there was notably little need for trademarks in social and economic life.

From the late 19th century to the early 20th, the advent of electric motors and railways dramatically transformed the economic environment in terms of efficiency based in productivity and the distribution of goods. Culture, as oriented on a society of small entrepreneurs, had previously been suited to production, wherefrom the newer culture, oriented on a society dominated by large corporations, came to epitomize consumption.

Jerre B. Swann, Sr.¹ introduced in his article “Dilution Redefined for the year 2002” (Vol. 92 TMR 587) ² the following ideas:

Frank I. Schechter, the father of dilution theory, observed that a brand’s primary purpose had become “the creation and retention of custom ...necessitating the preservation of its uniqueness” under the

[U.S.] Trademark Act of 1905, however, uniqueness was irrelevant: Brands were enforced only against “colorable imitations” (the term colorable imitation includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive —U.S. Lanham Act § 45) on goods of “the same descriptive properties.” At common law, a brand was sheltered from consumer confusion as well as from the diversion of custom, but given then prevailing precedents, protection was unlikely from a mark’s appropriation for goods of different descriptive properties: “If he does not carry on a trade in iron, but carries on a trade in linen and stamps a lion on his linen, another person may stamp a lion on iron, which was then the law”. At the turn of the century, “if there was no competition, there could be no unfair competition”. Brands, therefore, were virtually defenseless against third party use on unrelated goods. In 1927, in a brief to the Supreme Court, Charles Evans Hughes could cite only eight cases from both English and American jurisprudence where a trademark, arguably, had been held to be infringed by another’s use on a different product. Under then prevailing law, there was legitimate concern as to whether the owner of RITZ CARLTON for hotels would be able to prevent its third party use on coffee.

The real injury from another’s use of a singular mark on different goods is the gradual whittling away or dispersion of the identity.

By the 1960’s Schechter’s basic views had been largely digested into trademark tribunal wisdom: “If the owner of KODAK should permit its use by others on washing powders, shoes, candy bars, or cosmetics

or if the Coca-Cola Company should permit COKE to be used for rain coats, cigarette lighters, golf balls, or jewelry not of its manufacture, it would not take long time for even these giants in the trademark would to be reduced to pigmy size”.

Along with such historical developments, the protection of well-known and/or famous trademarks has gradually and thoughtfully been improved throughout the world making topics regarding free rides and dilution theories a matter of common sense among world trademark professionals.

2. The Function of Trademarks and Protection Thereof

2-1 The General Function of Trademarks

Trademarks possess important functions and are protected as a kind of intellectual property. They act as tools necessary for keeping the goodwill and reputation, as acquired through bona fide use of a trademark, secure and, at the same time, benefiting consumers by assisting in the selection of goods or services, among many sources, of desired quality or taste.

More specifically, a trademark has the following three kinds of functions:

- (1) It should distinguish the origin or source of one's goods and services from those of one's competitors (function indicating source).
- (2) It should serve as a guarantee of quality (function guaranteeing quality).
- (3) It should contribute to establishing goodwill or a reputation for the source and/or quality of the goods or services (function of advertising or association).

A trademark has the above three functions, all of which are mutually interconnected. However, in particular terms, the most important function of trademarks is to distinguish the source or origin of goods or

services. On the other hand, the trademark owner must continue efforts to keep “goodwill” as will naturally be established by maintaining the quality of goods or services as well as the reputation acquired through the use of trademarks.

2-2 Protecting Goodwill

The word “goodwill” is not specifically defined in any Trademark Laws in the world, but it is indeed an important element to be protected under trademark laws, unfair competition laws and the like.

As a result of long and extensive use, a trademark can create and increase goodwill (or trust) for the business owning the said trademark in respect to the goods or services. Once a goodwill has been established, the trademark owner may enjoy very important benefits therefrom; that is, once goodwill is established for a trademark, a positive image clearly remains in the memory of consumers, and the merchandise or services represented by that specific trademark, among any number of competitive options, are apt to be selected or desired again. Similarly, demand also naturally repeats and, as a result, that business’s occupied market share may be maintained so long as the good reputation of trademark is maintained.

On the other hand, it also holds true that one may expect the occurrence of unfair trade activities (such as infringement or unfair competition) by unauthorized parties wishing to profit unjustifiably

through utilization of the good reputation or goodwill already established by a trademark owner. Accordingly, in order to keep the adequate functioning of trademarks and to properly protect the goodwill created through their continuous use effective protective legislation is necessary. The fundamental purpose of Trademark Law and related laws may be speculated as being to protect both the established goodwill of a trademark owner on an exclusive basis and the interests of general consumers and traders in relevant fields of business.

3. The Roles of Trademark Law and Unfair Competition Prevention Law

Legislation for protecting trademarks, trade names, designs and other intellectual properties in each country is respectively based on its own legal system, thereby resulting in the current law system of each country being different from the others. For instance, the Japanese system is quite different from that of common law based countries (U.K., British Commonwealth countries, U.S.A.). As far as trademark law is concerned, Japanese Trademark law takes the principle that applicant first to file is protected, and once registration is granted the registered trademark shall be protected as an exclusive right unless it is cancelled or invalidated. However, in the U.S., for example, the first-used trademark is protected as an exclusive right and a registered trademark is not necessarily protected unless it is continuously used.

Notwithstanding, on the other hand, unregistered but well-known trademarks are protected in Japan, too, under Trademark Law and Unfair Competition Prevention Law. (hereinafter referred to as Unfair Competition Law)

However, as a recent worldwide trend, WIPO as well as the European Union (EU) and other international organizations are trying to lead intellectual property protection systems into international harmony. More specifically, in recent years, there have been remarkable movements in the global framework of intellectual property protection systems. Firstly, there is the adoption of GATT-TRIPS Agreement, including fundamental

provisions to be implemented in each national legislation so as to effectively prohibit the unfair practice of trademarks/designs as well as copyright infringement. Secondly, the Trademark Law Treaty (TLT) was proposed by WIPO to harmonize fundamental subjects for trademark protection and the procedural rules therefore harmonized. Thirdly, the Community Trademark Regulations (CTM) and related amendments were effected in respect to national trademark laws in EU countries so as to facilitate compliance with the EEC Council Directive 89/104/EEC of December 21, 1988, requiring the approximation of laws relating to trademarks among member countries.

4. The Top 100 Globally Well-Known Brands: Do you agree with the survey results?

Several international media are currently conducting annual surveys on globally well-known trademarks and reporting the top 100 highly-valued brands in magazines.

4-1 “Business Week”, U.S. magazine

“Business Week”, a U.S. magazine, reported 2003 survey results on its online website. The following is an extracted list there-from.

Brand Rank	Brand Name	Country	2003 Brand Value (Million \$)
1.	COCA-COLA	U.S.	70.45
2.	MICROSOFT	U.S.	65.17
3.	IBM	U.S.	51.77
4.	GE	U.S.	42.34
5.	INTEL	U.S.	31.11
6.	NOKIA	Finland	29.44
7.	DISNEY	U.S.	28.04
8.	MCDONALD’S	U.S.	24.70
9.	MARLBORO	U.S.	22.18
10.	MERSEDES	Germany	21.35
11.	TOYOTA	Japan	20.78
12.	HEWLETT-PACKARD	U.S.	19.86

13.	CITIBANK	U.S.	18.57
14.	FORD	U.S.	17.07
15.	AMERICAN EXPRESS	U.S.	16.83
16.	GILLETTE	U.S.	15.98
17.	CISCO	U.S.	15.79
18.	HONDA	Japan	15.63
19.	BMW	Germany	15.11
20.	SONY	Japan	13.15

Thereafter, the following trademarks are ranked:

21. NESCAFE, 22. BUDWEISER, 23. PEPSI, 24. ORACLE,
 25. SAMSUNG ELECTRONICS, 26. MORGAN STANLEY,
 27. MERRILL LYNCH, 28. PFIZER, 29. DELL, 30. MERCK
 and others. ³

The survey results in full are attached at the end of this text.

[Attachment 1.]

4-2 Survey conducted by the NIKKEI Newspaper in Japan

NIKKEI Research conducted surveys on brands known by business people and general consumers in Japan. Results are as follows.⁴

(a) Collective ranking of results from surveys targeting both business people and general consumers:

<u>Company name</u>	<u>Total score</u>
1. SONY	841
2. MICROSOFT	810
3. CANON	777
4. INTEL	766
5. Kuroneko Yamato	742
6. TOYOTA	734
7. SEIKO EPSON	719
8. SHACHIHATA	717
9. FUJI FILM	714
10. SHARP	713
11. YAHOO	711
12. TOTO	695
12. KOKUYO	695
12. Matsushita Electric	695
12. NIPPON IBM	695
16. BRIDGE STONE	679
16. HONDA	679
18. ASAHI KASEI	671
18. CASIO	671
20. KAO	669
20. OMRON	669

(b) Business professionals' ranking of brands

<u>Company name</u>	<u>Total score</u>
1. MICROSOFT	865
2. SONY	843
3. CANON	815
4. INTEL	810
5. SEIKO EPSON	753
6. NIPPON IBM	749
7. Yamato Unyu	744
8. TOYOTA	741
9. SHACHIHATA	734
9. YAHOO	734

(c) General consumers' ranking of brands

<u>Company name</u>	<u>total score</u>
1. SONY	823
2. KEWPIE	757
3. Yamato Unyu	740
4. Oriental land (DISNEY)	736
5. AJINOMOTO	732
5. MICROSOFT	732
7. TOTO	729
8. TOYOTA	726

9. CANON	724
10. NISSIN	721

It should be noted that the 4-1 survey was conducted in the United States and the 4-2 survey in Japan.

Furthermore, it may be of interest to know that a survey of readers on corporate images by three regional magazines (Asia week, Fortune Asia and Time Asia) circulated in Asian region by Kyodo News publisher indicated the following brands as being the Top 10:

Microsoft, Nokia, Sony, Singapore Airlines, Citibank, Toyota, Intel, Mercedes-Benz, IBM and VISA.

5. The Current Legislative Structure for Protecting Well-Known and Famous Trademarks

5-1 International Conventions

(a) Paris Convention

The need to protect well-known trademarks was discussed internationally by the member states of the Paris Convention in the 1920's, whereby the provision of Article 6 bis was first incorporated in the Hague text of the Paris Convention in 1925. Thus, the term "well-known trademark" in the Paris Convention has been interpreted as including famous trademarks as well. It is also noted that, in some countries, Article 6 bis is "self-executing" in the sense that an interested party may directly claim protection of a well-known trademark to administrative and judicial authorities.

The provision of Article 6 bis reads as follows:

"ARTICLE 6 bis (Protection of well-known trademarks)

- (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. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

- (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.”

As underlined by the author, Article 6 bis of the Paris Convention is characterized in that:

- (i) Well-known or famous trademarks protected under Article 6 bis (hereinafter referred to simply as “well-known marks”) need not necessarily be registered in the country where protection is sought;
- (ii) Well-known marks to be protected must be well-known in that country:

- (iii) Any trademark identical or similar to a well-known mark and liable to cause confusion in that it constitutes a reproduction, imitation or a translation shall be refused, have its registration cancelled, or shall have use by unauthorized third parties prohibited (hereinafter referred to as a third party's mark);
- (iv) When a third party's mark is used for goods identical or similar to those which a well-known mark covers in registration or actual use;
- (v) Article 6 bis does not cover trademark use for services;
- (vi) Article 6 bis also gives the same protection against unauthorized use of a mark by third parties when the essential part of a well-known mark is reproduced or imitated within a third party's mark;
- (vii) A third party's registration may be cancelled at any point within 5 years from its registration date, but, in the case of bad faith, no statute of limitations is fixed.

It has been emphasized that Article 6 bis provides a limited scope of protection for well-known trademarks, yet this still remains insufficient for meeting current needs regarding the protection of well-known trademarks from confusion, free-rides and dilution;

more specifically, the conditions pointed out in (ii), (iv) or (v) above are insufficient.

However, the Paris Convention is positioned much like a constitution within intellectual property legislation and insufficiencies in Article 6 bis have now been supplemented with Article 16(2) and (3) of the TRIPS Agreement as well as the Joint Recommendation concerning Protection of Well-known Marks⁵ as prepared by WIPO and adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the member states of WIPO, September 20 to 29, 1999. [Attachment 2]

For reference, relevant provisions are cited hereunder.

(b) TRIPS Agreement

The TRIPS Agreement is formally referred to as the “Agreement on Trade-Related Aspects of Intellectual Property Rights, Including Trade in Counterfeit Goods” (effective as from January 1, 1995). As is indicated by its name, the TRIPS Agreement was ratified based on an awareness of the occurrence of serious problems in international trade and commerce, such as with counterfeit goods, due to a lack of harmony in and shortcomings regarding protection systems for

intellectual property rights as implemented in numerous countries. It was made possible after repeated discussions at GATT's (currently WTO) Uruguay Round to improve this situation at the international stage, including undeveloped countries, developing countries and developed countries. Agreement in respect to the protection of well-known and famous trademarks was reached over the provision of Article 16(2) and (3) of this Agreement. In addition, Article 2 of this Agreement declares the basic principle to supplement other International Agreements for Protecting Intellectual Property Rights; like the Paris Convention, for one.

Article 16(2) and (3) reads as follows:

“Article 16 (Rights Conferred)

(2) Article 6bis of the Paris Convention (1967) shall apply, mutatis mutandis, to services. In determining whether a trademark is well-known, account shall be taken of the knowledge of the trademark in the relevant sector of the public, including knowledge in that Member obtained as a result of the promotion of the trademark.

(3) Article 6bis 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.

This provision, Article 16, is characterized by its supplementary role to Article 6bis of the Paris Convention in regard to three points:

- (i) Making the provision of Article 6 bis of the Paris Convention apply to service marks as well;
- (ii) Improving criteria to make them more flexible when determining a well-known trademark, or, in other words, taking knowledge of a trademark in relevant sectors of the public into consideration so that determination of well-known trademarks can more closely correspond to actual market conditions and be reflected in a viable environment.
- (iii) Expanding the scope of protection in which article 6bis of the Paris Convention is applied, even in cases of dissimilar goods or services, whereby the goodwill or reputation of the well-known trademark as established by the owner can be protected while especially prohibiting such acts liable to cause confusion, free-rides, or dilution.

It should be noted that since Article 2 of the TRIPS Agreement

requires respective provisions of the Paris Convention be automatically applied to WTO member countries as well, broad national protection can be expected in WTO member countries (a substantial number of countries are member to both the Paris Convention and WTO) in respect to Article 16(2) and (3) of the TRIPS Agreement.

(c) WIPO Joint Recommendation concerning Provisions on the Protection of Well-Known Marks

A great number of countries had no provisions concerning the protection of well-known trademarks in domestic law at the time the establishment of the TRIPS Agreement was discussed internationally, but, after the TRIPS Agreement went into effect, all member countries of WTO as well as the Paris Convention had an obligation to protect all well-known and famous trademark sufficiently.

Under these circumstances, WIPO prepared the above mentioned Joint Recommendation concerning provisions on the protection of well-known marks. It was adopted at the joint assemblies of the Paris Convention Union and WTO, and became effective for countries member to not only the Paris Convention but also the WTO Treaty.

The full text of this Joint Recommendation is attached at the end of this book as [Attachment 2].

5-2 EU Council Directive and Community Trademark Regulation;

5-2-1 EU Council Directive

In the European Union (EU), the First Council Directive 89/104/EEC of December 21, 1988 was issued in order to approximate laws relating to trademarks among member states. In compliance with the Council Directive, each trademark law from all member states was revised thoroughly by adopting the provisions of the Council Directive.

The EU Council Directive provides a special section relating to the protection of well-known trademarks.

Article 4 of the Council Directive reads as follows:

Further grounds for refusal or invalidity concerning conflicts with earlier rights

1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

...

b) If because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trademark.

...

2. 'Earlier trade marks' within the meaning of paragraph 1 means:
- ...
- d) Trade marks which, on the date of application for registration of the trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the trade mark, are well known in a Member State, in the sense in which the words 'well known' are used in Article 6 bis of the Paris Convention.
3. A trade mark shall furthermore not be registered or, if registered, shall be liable to be declared invalid if it is identical with, or similar to, an earlier Community trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier Community trade mark is registered, where the earlier Community trade mark has a reputation in the Community and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trade mark.
4. Any member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:
- a) The trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the

earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

It is worthy to emphasize that Article 4 of the above Council Directive includes a clause for reasonably protecting well-known trademarks from the latest cases of unfair acts, such as those taking unfair advantage of, or carrying detrimental impact to, the distinctive character or repute of earlier well-known trademarks, regardless of the identity or similarity of goods or services (Article 4, Paragraph 3).

5-2-2 Community Trademark Regulation

In the Community Trademark Regulation, provisions are included, particularly in Article 8 (Relative grounds for refusal), Paragraphs 1(a)(b), 2(c) and 5, also Article 42 (opposition) and Article 52 (Relative grounds for invalidity), to provide clauses as correspond respectively above.

Furthermore, Rule 16 of the Community Trademark Implementing Rules (Facts, evidence and arguments presented in support of the opposition) also stipulates the same subject.

Each of the above mentioned provisions are attached at the end of

this text in [Attachment 3].

5-2-3 Foreign Laws

The United States and some other countries have a long history in the field of protecting well-known and famous trademarks and numerous court decisions relate thereto. It appears that relief is granted with flexibility in accordance with common law principles, even for new and undecided types of cases.

As was previously mentioned, Article 6 bis of the Paris Convention and Article 16(2) and (3) of the TRIPS Agreement will be incorporated into the domestic laws of nearly all member countries by the end of the year 2000 thus creating a world-wide system for well-known/famous trademark protection.

Singapore, Thailand, Malaysia, and other member countries of WTO have put the provision for protecting famous and well-known trademarks into Trademark Law, and in Southern Free Trade Agreement countries (Mercosur countries), namely Argentina, Uruguay, Paraguay, Brazil and Chile, Trademark Law was amended to supplement provisions for protecting well-known trademarks recently. The same trend was reported to be taking place in Andean countries as well.

5-3 Japanese Domestic Laws

In Japan, a number of laws, particularly Trademark Law, its related laws/regulations and Unfair Competition Law, have been enacted with respect to the protection of well-known and famous trademarks.

Trademark Law was revised many times from 1993 to date and is already considered to be completely compatible with the TRIPS Agreement. In addition, Unfair Competition Law was fully revised in 1994, and its full accommodation of TRIPS Agreement terms has also been completed.

The following provides a brief explanation of provisions relating to the protection of well-known and famous trademarks.

5-3-1 Trademark Law

“Section 4 (Unregistrable trademarks)

Notwithstanding the preceding section, a registration shall not be affected in any case of the following trademarks:

(i) to (ix) Omitted.

(x) trademarks which are well known among consumers as indicating the goods or services as being connected with another person's business, and

trademarks similar thereto, and which are used in respect of such goods or services or similar goods or services;

(xi) to (xiv) Omitted.

(xv) trademarks which are liable to cause confusion with goods or services connected with another person's business (other than the trademarks mentioned in paragraphs (x) to (xiv));

(xvi) to (xviii) Omitted.

(xix) trademarks which are well known among consumers in Japan or abroad as indicating the goods or services as being connected with another person's business, and trademarks identical with or similar thereto, and which are used by the applicant for unfair intention (intention to gain an unfair profit, intention to cause damage to such another person and other unfair intentions - hereinafter the same) (other than the trademarks mentioned in each of the preceding paragraphs) in respect of such goods or services."

"Section 64 (Registrability of defensive marks)

(1) the owner of a trademark may, when his registered trademark in respect of goods has become well-known among consumers as indicating the designated goods as being connected with his business and when the use

of the registered trademark by any other person in respect of goods other than the designated goods covered by the registered trademark and goods similar thereto or services similar to designated goods is likely to cause confusion between such goods or services and the designated goods in connection with his business, obtain a defensive mark registration of a mark identical with the registered trademark with respect to goods or services for which such possibility of confusion exists.

- (2) the owner of a trademark right may, when his registered trademark in respect of services has become well known among consumers as indicating the designated services as being connected with his business and when the use of the registered trademark by any other person in respect of services other than the designated services covered by the registered trademark and services similar thereto or goods similar to the designated services is likely to cause confusion between such services or goods and designated services in connection with his business, obtain a defensive mark registration of a mark identical with the registered trademark with respect to services or goods for which such possibility of confusion exists.”

Provisions which relate to protection of well-known and famous trademarks have existed in Trademark Law in Japan from long ago (more specifically since a law prohibiting the registration of identical or similar trademarks by unauthorized third parties was effected in 1921. Therefore, provisions are believed to have already existed in

Japanese Trademark Law at the time the Hague text of the Paris Convention was introduced in 1925). Conditions for applying these provisions were interpreted rather flexibly so as to prohibit unfair practices in this field for more overall effective use, over time leading to their present form.

The provision of Article 4-1-10 serves to refuse a third party's application or to declare the registration of trademarks identical or similar to earlier well-known ones, for goods or services also identical or similar invalid.

The scope of protection when applying Article 4-1-10 is similar to that provided in Article 6 bis of the Paris Convention or in Article 4(1) and (2) of the Community Trademark Regulation.

The provision of Article 4-1-19 in particular was newly introduced at the time of the 1996 revision of Japanese Trademark Law, considered to be the most progressive provision in trademark legislation throughout the world. This provision is extremely effective in cases of piracy of well-known and famous trademarks recognized even in countries other than Japan. However, when applying this provision, it is necessary to prove that the third party's application was filed in bad-faith (e.g. with an intent to unfairly take advantage).

Article 4-1-19 is a special provision; that is, this provision does not

require the (foreign) true owner to prove that the trademark has been used and well-recognized within the jurisdiction of Japan. Similarly, in the United States and Ireland, there are court decisions which do not require the actual use of a well-known trademark (i.e., service mark) by the trademark owner in the jurisdiction of the courts, such as the “Maxim de Paris” restaurant cases. This is because if the trademark has been well-known or recognized as famous by the public in several countries other than Japan, the fact is, indeed, that the public in Japan has many opportunities to come into contact with it when traveling overseas or through international media such as newspapers, magazines or internet websites.

The provision of Article 4-1-15 is meant to protect well-known and famous trademarks over a broader scope of goods and services (to include dissimilar goods and services) than those in Article 4-1-10. It seems that this provision is similar to the substance of Article 16(3) of the TRIPS Agreement and also to Article 4(5) of the E.U. Council Directive as well as Article 8(5) of the Community Trademark Regulation. It is said that this provision is applicable to famous trademarks and highly renowned (highly well-known) trademarks, regardless of whether or not they are registered in Japan.

Once a trademark is erroneously registered, Article 43 bis gives any party the opportunity to file an opposition thereto and Article 46 allows for interested parties to institute invalidation actions against

it.

The provision of Article 64 (Defensive Trademark Registrations) stipulates the possibility of protecting well-known trademarks as Defensive Trademarks to address use of similar and identical marks applied to goods or services differing from those of the original mark. For instance, where an automobile manufacturer owns a registered trademark for automobiles that has become well-known, that party is entitled to apply for and register the well-known trademark as a Defensive Trademark in respect to other categories of goods or services. Defensive trademark registration may not be cancelled on the grounds of non-use even if the defensive trademark itself is not being used by the owner.

The merits of this registration are:

Firstly, it is lawfully evidenced that the basic registered trademark (for example, covering an automobile, as mentioned above) is recognized as a well-known or famous trademark in Japan, and, secondly, once it is registered as a defensive trademark covering clothing, there is no obligation to use it, so a third party's application or use of an identical or similar trademark for clothing shall be blocked or prohibited.

Accordingly, in the case that a third party commences use of a trademark identical or similar to a defensive trademark covering clothing, the owner of the defensive trademark is entitled to take

action to secure an injunction against such unauthorized use. But, if the same well-known trademark is not registered as a Defensive Trademark, it becomes impossible to take action against infringement under Trademark Law though court action may be pursued under Unfair Competition Law.

5-3-2 Unfair Competition Prevention Law

(hereinafter referred to as Unfair Competition Law)

In current Unfair Competition Law, Articles 2-1-1 and 2-1-2 are extremely effective in protecting well-known and famous trademarks.

Normally, in order to enjoy protection of a trademark (widely known or well-known), only after a trademark owner has registered a trademark under Trademark Law, can action be taken against infringement and claims for an injunction, compensation, damages, and/ or other relief be filed. Further action for criminal measures against infringement on a registered trademark right under Trademark Law may also be taken, except for when the registered right to a trademark does not exist, it is not possible or almost impossible to rely on Trademark Law. However, the owner of a well-known trademark may rely on Unfair Competition Law.

“Article 2. (Definitions)

The term “unfair competition” as used in this Law means any one of the following:

- (1) the act of using an indication of goods, etc. which is identical with or similar to another person’s indication of goods, etc. (meaning the indication of goods or business such as a name, trade name, mark, and goods container or package related to a person’s business; hereinafter the same) which is widely recognized among users, or act of transferring, delivering, displaying for the purpose of transfer or delivery, exporting, importing goods on which such indication of goods, etc. is used, and thereby causing one’s goods or business to be confounded with another person’s;

- (2) the act of using, as one’s indication of goods, etc., an indication of goods, etc. which is identical with or similar to another person’s famous indication of goods, etc., or act of transferring, delivering, displaying for the purpose of transfer or delivery, exporting, or importing goods on which such indication of goods, etc. is used;”

Acts falling under the provisions of Article 2-1-1 and Article 2-1-2 are prohibited as unfair competitive acts under Unfair Competition Law, and well-known and famous trademarks are protected with relief stipulated in Articles 3, 4, 7, 14 & 15 of Unfair Competition Law.

The owner of a well-recognized indication for goods and/or services

(i.e. a well-known trademark, trade name, unique sign for goods or the like) is protected by applying the provision of Article 2-1-1. Requirements for obtaining relief as stipulated in this law (injunction, recovery of damages, measure for recovery of lost reputation etc.) consist of having to prove that (1) the trademark or other indication (sign) for goods or services must be recognized as well-known among consumers and (2) confusion has actually taken place or there is a risk that it may.

On the other hand, Article 2-1-2 stipulates that an owner of a famous trademark or famous indication (sign) for goods or services is eligible to receive the same relief as Article 2-1-1 prescribes if an unauthorized third party intentionally uses that famous indication, trademark or any confusingly similar indication thereto. This provision attempts to provide reasonable protection for famous trademarks or other famous indications, and this provision is also effective in preventing “free rides” and “dilution”. On the other hand, in the case that a locally famous trademark is recognized only in a small part of a region in Japan, relief under this provision may not be easily granted. However, relief under Article 2-1-1 can be granted if confusion is proved in concrete terms by the plaintiff. An owner of a famous trademark attempting to receive relief based on Article 2-1-2, must establish with evidence a case showing that the trademark (or indication of goods or services) has been broadly recognized as famous. However, in applying this provision, there is no need for the owner of a

famous trademark (i.e. plaintiff), to prove that confusion has occurred or such a risk exists, owing to the reason that the subject trademark must be famous (but not necessarily widely known) in Japan.

Relief to be granted for owners of well-known or famous trademarks as stipulated in Articles 2-1-1 and 2-1-2 are as explained below.

- (i) an injunction (including preliminary injunctions) (Article 3)
- (ii) recovery of damages (Article 4)
 - (provision for estimating the amount of damages) (Article 5)
 - (request for a court document ordering that relevant documents be submitted - similar to an Anton Piller Order in common-wealth countries) (Article 6)
- (iii) measures for restoring trust or lost reputation (placing a notice of apology in newspapers) (Article 7)
- (iv) criminal sanctions (imprisonment for up to 3 years and/or a fine of up to 3 million yen) (Article 14)
- (v) criminal sanctions (a fine of 150 million yen) in the case a corporation was involved in the crime (Article 15)

6. Criteria for Determining Well-Known and Famous Trademarks

6-1 International Guidelines

Specific evaluation standards (i.e. criteria) are not clearly indicated in the Paris Convention or the TRIPS Agreement. Article 16(2) of the TRIPS Agreement merely states “WTO members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the member concerned which has been obtained as a result of the promotion of the trademark.”

On the other hand, as introduced before, WIPO continued extremely useful efforts through its Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications and obtained an outline of provisions for protecting well-known trademarks, in which the criteria for determining a well-known trademark are included. This outline was submitted as a joint recommendation before the Assemblies of the Paris Convention and WIPO Organization, after which it was adopted officially at the above joint assembly held from September 20 to 29, 1999. Accordingly, the criteria stipulated in the joint recommendation can be recognized as an official guideline for all member countries of the Paris Convention and WIPO as well as all member countries of WTO.

WIPO Joint Recommendation Concerning Provisions on the Protection
of Well-Known Marks

Article 2 Determination of whether a mark is a well-known mark in a member
state

(1) [Factors for Consideration] (a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. The degree of knowledge or recognition of the mark in the relevant sector of the public;
2. The duration, extent and geographical area of any use of the mark;
3. 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;
4. 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;

5. 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;

6. The value associated with the mark.

(c) The above factors, which are guidelines to assist the competent authority to 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 in sub-paragraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in sub-paragraph (b), above.

(2) [Relevant Sector of the Public] (a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

(i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;

(ii) persons involved in channels of distribution of the type of goods and/or

services to which the mark applies;

- (iii) business circles dealing with the type of goods and/or services to which the mark applies.
 - (b) 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.
 - (c) 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.
 - (d) A Member State may determine that a mark is a well-known mark, even if the mark is not well known or, if the Member States applies subparagraph(c), known, in any relevant sector of the public of the Member State.
- (3) [Factors Which Shall Not Be Required] (a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:
- (i) that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of the Member State;
 - (ii) that the mark is well known in, or that the mark has been registered or that

an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

(iii) that the mark is well known by the public at large in the Member State.

(b) Notwithstanding sub-paragraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.

It is of importance to note the provisions stipulated in paragraph (3) (factors which shall not be required) of the WIPO joint recommendation.

Further, as a relatively important provision, Article 4 (conflicting marks) is also put hereunder:

Article 4 Conflicting Marks

(1) [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.

- (b) 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.
- (c) Notwithstanding Article 2(3)(a)(iii), for the purpose of applying paragraph (1)(b)(ii) and (iii), a Member State may require that the well-known mark be well known by the public at large.
- (d) Notwithstanding paragraphs (2) to (4), a Member State shall not be required to apply:

- (i) paragraph (1)(a) to determine whether a mark is in conflict with a well known mark, if the mark was used or registered, or an application for its registration was filed, in or in respect of the Member State, 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, before the well-known mark became well known in the Member State;
- (ii) paragraph (i)(b) to determine whether a mark is in conflict with a well-known mark, to the extent that mark was used, was the subject of an application for registration, or was registered, in or in respect of the Member State for particular goods and/or services, before the well-known mark became well known in the Member State;

Except where the mark has been used or registered, or the application for its registration has been filed, in bad faith.

- (2) [Opposition Procedures] if the applicable law allows third parties to oppose the registration of a mark, a conflict with a well-known mark under paragraph (1)(a) shall constitute a ground for opposition.
- (3) [Invalidation Procedures] (a) the owner of a well-known mark shall be entitled to request, during a period which shall not be less than five years beginning from the date on which the fact of registration was made known to the public by the office, the invalidation, by a decision of the competent authority, of the registration of a mark which is in conflict with the well-known mark.

- (b) If the registration of a mark may be invalidated by a competent authority on its own initiative, a conflict with a well-known mark shall, during a period which shall not be less than five years beginning from the date on which the fact of registration was made known to the public by the office, be a ground for such invalidation.
- (4) [Prohibition of Use] the owner of a well-known mark shall be entitled to request the prohibition, by a decision of the competent authority, of the use of a mark which is in conflict with the well-known mark. Such request shall be admissible for a period which shall not be less than five years beginning from the time the owner the well-known mark had knowledge of the use of the conflicting mark.
- (5) [No Time Limit in Case of Registration or Use in Bad Faith] (a) notwithstanding paragraph (3), a Member State may not prescribe any time limit for requesting the invalidation of the registration of a mark which is in conflict with a well-known mark if the conflicting mark was registered in bad faith.
- (b) Notwithstanding paragraph (4), a Member State may not prescribe any time limit for requesting the prohibition of the use of a mark which is in conflict with a well-known mark if the conflicting mark was used in bad faith.
- (c) In determining bad faith for the purposes of this paragraph, the competent

authority shall take into consideration whether the person who obtained the registration of or used the mark which is in conflict with a well-known mark had, at the time when the mark was used or registered, or the application for its registration was filed, knowledge of, or reason to know of, the well-known mark.

- (6) [No Time Limit in Case of Registration Without Use] notwithstanding paragraph (3), a Member State may not prescribe any time limit for requesting the invalidation of the registration of a mark which is in conflict with a well known mark, if that mark was registered, but never used.

6-2 Japanese Guidelines

There is no provision stipulating criteria for determining well-known / famous trademarks in the laws, although the Japanese Patent Office issued its own examination standards guideline many years ago which have been amended several times already. The content of the guidelines are almost the same as those stated in the WIPO joint recommendation.

To comment, it is naturally desirable that both fairly long-term use of the trademark and the presence of extensive publicity or the like are necessary. However, since there are cases in which the goods as well as the trademark may become popular and in demand in a short period of time (such as in the case of “Rubik’s Cube” an extremely popular and in

demand product with an ultimately short life cycle) the fact that the goods or services of a particular trademark will be sold only for a short time and possibly marketed through large scale publicity must be taken into account. Therefore it is not easy to stipulate standards pertaining to the term of trademark use for comprehensive application.

The next point is how important a factor the timing is for determining whether a trademark has/will become well-known. In other words, is this the time when a final decision is rendered on examination of a defensive mark application, for opposition procedures or at an invalidation trial case for a registered trademark ?

Finally, evidence is preferable to include: materials showing marketing activities (sales volume, monetary sales amount, etc.); the scale of business activity (company size, number of employees, number of stores, annual turnover etc.); the distribution of posters and advertisements through newspapers, magazines or television; results of storefront surveys; a certificate showing the fact that a public recommendation is granted from a quality goods evaluation association or the like; a certificate provided by a public or governmental organization proving that the trademark has been recognized popular in its area of jurisdiction? There are many possibilities for preparing useful materials proving the trademark has been used for a long time and is commonly recognized as a popular work.

6-3 Guidelines in Other Countries

There are several countries where the detailed criteria for determining well-known and famous trademarks is listed in relevant national law.

(a) United States

To give one example, in the revised provision of Article 43(c)(1) of the Lanham Act, evaluation items, such as those indicated below, are listed and may be considered by a court for determining whether a mark is famous, although the Act does not expressly define what constitutes a “famous mark” in itself.

In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to

- (1) the degree of inherent or acquired distinctiveness of the mark;
- (2) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (3) the duration and extent of advertising and publicity of the mark;
- (4) the geographical extent of the trading area in which the mark is

used;

- (5) the channels of trade for the goods or services with which the mark is used;
- (6) the degree of recognition of the mark in the trading areas and channels of trade use by the mark's owner and the person against whom the injunction is sought;
- (7) the nature and extent of use of the same or similar marks by third parties; and
- (8) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

According to the Professor Lars S. Smith's article,⁶ the ninth circuit court of appeals in the United States ruled that famous marks constitute "those marks with such powerful consumer associations that even non-competing uses can impinge on their value."

Congress provided demonstrative examples of diluting uses of famous marks including DUPONT shoes, BUICK aspirin and KODAK pianos.

(b) South America

In South America, the Catagena Agreement provides specific items for evaluation standards as listed in Article 84.

In Brazil, Industrial Code provides Article 67, which lists the criteria.

In Canada, the revised Trademark Law, Article 5 provides the criteria.

(c) Asia

The Chinese Trademark Office prepared and implemented examination guidelines for determining a well-known trademark.

Taiwan also issued the guideline for determining a well-known trademark.

6-4 Surveys for Evaluating Well-Known or Famous Trademarks

Surveys (questionnaires) inquiring into the opinions of the general public are also conducted as a means of evaluating if a trademark is well-known or famous. Some countries adopt this method so as to evaluate trademarks according to percentage-ratings of their popularity.

For example, in the courts of Germany, evidence by way of survey has been accepted and evaluated favorably. There remains some degree of controversy regarding the fairness of the survey itself, but it appears that fairness is generally maintained in Germany.

As example of percentage guidelines in Germany, if the results of a survey indicate 80% or more of the general public in favor of a trademark, then that trademark may be graded as famous, and if nearly 40% or more of the general public are in favor, that trademark may be graded as well-known. In France, other conditions are also taken into consideration such that if results indicating 20% or more of the general public in favor are obtained, then that trademark may be graded as a well-known trademark. In Italy, survey results indicating 70% more of the general public as in favor are sufficient for grading a trademark as well-known.

6-5 Is There a Distinction Between “Well-Known” and “Famous”?

(a) Position in the United States, etc.

As has been discussed thus far, generally speaking, a distinction between “well-known” and “famous” or between “well-known trademarks” and “famous trademarks” is not very clear in any of the international conventions or treaties, national trademark laws or related laws, or even in papers authored by leading commentators and

practitioners.

However, as was initially pointed out, some goods or services which may be identified with particular trademarks have been continuously and internationally distributed and marketed throughout the world, causing them to become globally identified in connection with a specific source or quality of goods or services.

Such a type of trademark should definitely be regarded as a “famous trademark”.

In this manner, opinions advocating the realistic value of distinguishing between “well-known trademarks” and “famous trademarks” tend to be big.

With respect to this point, the following is a statement made in an article by Mr. Frederic Mostert, the past President of International Trademark Association (INTA), in the above referred “The Trademark Reporter. Vol. 86”.

“the ordinary dictionary meaning of “well-known” according to Merriam Webster is, among others, “widely known” and “known to many”. In the context of trademark law, therefore, a well-known mark can be characterized as a mark which is known to a substantial segment of the relevant public in the sense of being associated with the particular goods or services.

It has often been suggested that a special category of well-known marks, i.e., “famous” marks be recognized. Famous marks are considered to have a higher degree of reputation than well-known marks and therefore deserve a broader scope of protection against unauthorized use on non-competing goods or services.”

(b) Distinctions in Japanese Trademark Law and Unfair Competition Law

It appears that Japanese Trademark Law and Unfair Competition Law distinguish the two terms “famous trademark” and “well-known trademark”, although such used terms are not clearly defined.

For example, Article 4-1-10 of the Trademark Law targets a protection of “well-known or widely known trademarks”, in the scope of identical and similar goods or services.

On the other hand, in the case of Article 4-1-15, the object of this provision is to protect “famous trademarks” from being confused with third party’s trademarks within the scope of dissimilar goods or services, whereby the target of this item should be “famous trademarks”.

Moreover, based on the same purport, since the defensive marks of

Article 64 are also based on the supposition of possible confusion occurring within the scope of dissimilar goods or services, this article is also believed to target at “famous trademarks”.

In Unfair Competition Law, there is a distinction made between “well-known trademarks – well-known indications of goods, services or business” (Article 2-1-1) and “famous trademarks – famous indications of goods, services or business” (Article 2-1-2). Moreover, in the latter case, it is considered to be applicable in preventing free rides and dilution of “famous trademarks” as well. A manner of thinking is similar to that of the United States as previously mentioned, because the target of this kind of protection should be “famous trademarks”.

(c) EU Council Directive of CTM

As mentioned before, EU legislation distinguishes the scope of protection for well-known trademarks and for more highly reputed trademarks (famous trademark).

In Article 4 (further grounds for refusal or invalidity concerning conflicts with earlier rights), paragraph 1 in conjunction with paragraph 2(d) protects an earlier trademark in terms of identity or similarities between goods or services covered, while paragraph 3 (and also paragraph 4(a)) protects an earlier trademark in terms of goods or services which are not similar to those for which the earlier

community trademark is registered.

This manner of distinguishing the scope of protection is provided clearly in relation to the degree of well known-ness; this is similar to practice in Japan, and possibly those in the United States and Canada.

6-6 Is Registration or Actual Use in One Particular Country Required as a Condition for Protection of Well-Known and Famous Trademarks?

The Paris Convention and TRIPS Agreement, as well as national trademark laws in advanced countries, have already recognized the importance of suitable protection for well-known and famous trademarks; however, specific conditions for protection of trademarks are not expressly provided but provided that these well-known and famous trademarks must be protected even if they are not registered.

The question as to whether or not registration and actual use of well-known and famous trademarks in particular countries where such broad protection is sought should be put as a condition for protection in each relevant national law has not been expressly stipulated either in Article 6 bis of the Paris Convention or Article 16(2) and (3) of the TRIPS Agreement.

There are no express indications within Japanese law, but the

existence of trademark registration has been interpreted as not being necessary and actual use is considered to be essential to establish a trademark as well-known or famous in principle. Therefore, actual use somewhere should be necessary, but evaluation of a trademark's popularity shall be conducted on a case-by-case basis.

As has been described before, according to interpretations of Article 4-1-19, for example, trademarks which have been actually used and also recognized as well-known or famous in several countries other than Japan, even if not yet used in Japan, can be used as grounds for rejection of a third party's application covering the same mark under Japanese Trademark Law. Therefore, as far as the trademark is recognized as a well-known or famous mark, actual use within Japanese jurisdiction is not an absolute requirement under Japanese Trademark Law.

Under the Unfair Competition Law in Japan, there is no specific provision regarding this matter, but that this point may be considered and determined on a case-by-case basis in the same manner as the Trademark Law.

In the United Kingdom, Section 56 of the Trademark Act, for instance, stipulates protection for well-known trademarks (in the UK Trademarks Act, only the term "well-known mark" is used in the same manner as Paris convention), but the only condition is that the mark be recognized as well-known trademark in the United Kingdom and at the same time,

the Act clearly states that an actual use in the United Kingdom is not required.

7. Court Decisions in Various Countries

As explained in Chapter 5 above, the recent legislative environment of protecting well-known and famous trademarks has improved remarkably on an international level and recent decisions by courts and National Trademark Offices have been noticeably changing.

7-1 Court Decisions in Japan

There are several land-mark court decisions and the following have been arranged to show the developing process in applying related national laws, and especially the Unfair Competition Law.

- (a) “Mitsubishi Construction Company” case (Osaka High Court, April 5, 1966)

Mitsubishi Real Estate Co., Ltd. (Plaintiff) v. Mitsubishi Construction Co., Ltd. (Defendant)

The defendant adopted and commenced use of “a similarly designed trademark of Three Diamonds” and the name “Mitsubishi Construction Co., Ltd.” for a construction and civil engineering business in the Kobe area. The plaintiff, one of the Mitsubishi Group companies, sued the defendant in 1962 at the Kobe District Court, after which the defendant filed an appeal at the Osaka High Court to

counter the District Court's ruling against it.

The Unfair Competition Law of the time provided three conditional requirements for determining an act of unfair competition: the cited mark of the plaintiff must be well-known in Japan, especially in the Kobe and Osaka areas; the competition with intent must exist between the business of both parties; and the fact that actual confusion with the facilities and business activities of the Plaintiff has occurred or have a real possibility of occurring must be proved.

At that time, to fulfill statutory requirements, the courts in Japan were in a somewhat serious position in considering compliance with the above three conditions, but the Kobe District Court and Osaka High Court prudently made a decision with a rather flexible and reasonable interpretation of the laws. In fact, the court decision regarding this case has been evaluated as a landmark decision on the protection of well-known trademarks and business identifiers under the Unfair Competition Law and related laws of the time.

This court decision has been rated highly as an example of intelligence in the interpretation of law. (This is a symbol of successfully overcoming the first step of difficulty).

(b) "Yashica" case (Tokyo District Court, Aug 30, 1966)

This case is more relevant to cases of trademark dispute and stands

as an example of overcoming the second step in the history of unfair competition law in Japan.

K.K. Yashica (Plaintiff) v. Yashica Cosmetic Co., Ltd. (Defendant)

The defendant, registered as “Yashica” (in Roman and Katakana Characters) for cosmetics under Reg. No. 571745, started use of its mark for cosmetics, etc. in the market. The plaintiff sued the defendant with claims demanding an injunction and a change of the company name and, additionally, filed for a trial to invalidate the defendants’ trademark registration.

The conditions for applying the Unfair Competition Law at the time were the same as seen in the Mitsubishi case. The court found that the term “Yashica” was a coined word and very well-known in relation to the plaintiffs’ goods (cameras and related goods) and business; a competitive situation was affirmed because the shops selling the cosmetics also provided a film corner where developing services on part of a film developer were offered. The actual danger of confusion was admitted, and, furthermore, the Court slightly affirmed that the defendant’s act was one of free riding on Yashica’s reputation.

This case is also evaluated as the landmark decision that had first referred to the concepts of free-riding and dilution.

(c) “CHANEL” case

(Supreme Court, Sep. 10, 1998)

(Matsue Dist. Court, Jan. 26, 1994)

(Tokyo High Court, Sep. 29, 1994)

Chanel (plaintiff) v. Snack Chanel (defendant)

The defendant started a business of several small fast food restaurants under the name of “Snack Chanel” or “Snack Charel”. The plaintiff sued the defendant with claims demanding an injunction in line with the former Unfair Competition Law.

The main issue was whether or not any confusion would occur. One point of doubt existed in the fact that the plaintiff is a world famous fashion goods company whereas each of the defendant’s snack restaurants was no larger than 3–5 employees per shop, making it difficult to estimate any mistaking of one business for the other. This consideration was seriously held by both the District Court and the High Court, and, in order to strictly comply with the Unfair Competition Law of the time, the plaintiff’s claim was dismissed.

In the appeal case before the Supreme Court, the danger of confusion in a broad sense which takes into account the senses of Dilution theory, was affirmed; In other words, the Supreme Court endorsed a view taken by Tokyo District Court on August 30, 1966 in the Yashica case as referred to above.

In connection to this Supreme Court decision, Mr. Christopher Heath of Max Plank Institute, Munich, commented in his article as follows:

“In effect, the courts have thereby interpreted the danger of confusion into a danger of dilution particularly in case where confusion was most unlikely due to the different field of business of the plaintiff and the defendant.”

Note: At present, Article 2(1)(ii) of Unfair Competition Law provides for relief in the case of such situations; that is, the concept of dilution is now clearly included in the current law.

7-2 European Union

(a) “CANON” case

(German Federal Court of Justice)

(European Court of Justice)

Canon K.K (JP) v. Pathe Communication (US)

Canon K.K (JP), the opposition and appellant, asserted that “CANON”, its mark and business name, has been well-known for televisions, filming and recording devices, television transmitting devices and other items in Class 9 and Pathe’s trademark “CANNON”

for video film cassettes should not be registered nor allowed for use. The German Patent Office dismissed Canon's opposition because the respective goods were deemed dissimilar.

Finally, the German Supreme Court referred to the ECJ with a request to indicate a common interpretation of Article 4(1)(b) and 4(4)(a) of the EEC Council Directive. The ECJ then indicated that the "CANON" mark has been recognized as internationally famous, therefore Pathe's "CANNON" should not co-exist, even though the respective goods are not identical or similar.

7-3 Germany

(a) "MARS" case (German Supreme Court, February 10, 1994)

Mars GmbH (plaintiff) v. Harlekin Geschonke GmbH. (defendant)

MARS for chocolate bars etc. v. MARS for condom

The defendant used, without consent, the plaintiff's "MARS" trademark logo as well as the whole trade-dress of the package for its condoms. The plaintiff sued the defendant under the Trademark Law and Unfair Competition Law, whereupon the defendant protested, declaring such to be an infringement on the right to free expression as protected under the Constitution. The Supreme Court concluded that the defendant's use of such trademark and slogan constituted a

trademark infringement because the defendant's goods would mislead others to believe them to be genuine give-away items of the plaintiff. Therefore, after court affirmed that the MARS mark has been well-known and the competitive situation between the parties was affirmed, the defendant's act was prohibited with Article 1 of Unfair Competition Law. In the end, the court denied the complaint under the Constitution. (This decision relates to the theory of dilution; Those wishing for more representative information should refer to cases of "tarnishment").

7-4 United Kingdom

(a) "EVERREADY" case

EVERREADY for battery v. EVERREADY for condom

This case appears similar to the MARS case in Germany and the defendant's use of a well-known mark was prohibited.

In the U.K., this case was dealt with as being one of dilution, wherein the issue of "confusion of origin" is not an essential element for consideration.

The First Council Directive 89/104/EEC of 1988, Article 4(3) stipulates the rules for dealing with the kind of dispute, and the substance of the provision is taken into both the CTM Article 8(5) and

UK Trademark Act Article 5(3).

(b) “TIFFANY” case

Tiffany & Co. (opposer) v. Philip Morris (applicant)

Philip Morris tried to register a “TIFFANY” mark for cigarettes, in relation to which an application was published for opposition. Tiffany & Co. then filed an opposition backed by a great deal of evidence showing its reputation as a well-known mark. Meanwhile, Philip Morris asserted that there was a long period of concurrent use of the same mark in various countries. However, the U.K. Trademark Office finally rejected the application with the reason that Philip Morris’ use would likely deceive or cause confusion, relying on Section 11 of the 1938 Trademark Act.

In Singapore, the same parties fought in respect to the same trademark for the same goods at the High Court and then at the Singapore Court of Appeal. The outcome of the Singapore case was the same as that of the U.K. opposition case, details of which are reported in IP Asia. (June / July 1999, P.28-30)

7-5 Other Jurisdictions

(a) Australian High Court Decision (46 IPR 481)

“NIKE” case

“Nike” for sporting goods (plaintiff) v. “Nike” for fragrance (defendant)

The Australian High Court affirmed that the defendant’s use of “Nike” for fragrance constituted passing-off and as well as misleading and deceptive conduct, because the plaintiff’s trademark “NIKE” has been recognized as a well-known trademark, especially for sporting goods. The defendants’ use of “NIKE” was prohibited.

In Switzerland, a case of the same substance ended with a ruling in favor of NIKE sporting by the Supreme Court on March 24, 1998.

(b) Thailand Supreme Court Decision

“BMW” case (Thai Supreme Court No. 8779/2542)

“BMW” for automobile v. “BMW in Thai characters” used as company name for fire extinguishers. In the case, the Courts (IP & IT Court and Supreme Court) affirmed the likelihood of public confusion

and also affirmed the defendant's act of violating the rights of the plaintiff since the trademark "BMW" has been internationally well-known (Reported in IP Asia Nov. 2000 pp41-43).

(c) Chile

"CALVAN KLEIN" case (Supreme Court, April 5, 2000)

"CALVAN KLEIN" for fashion clothing v. "CALVAN KLEIN" for confectionary.

The Supreme Court ordered cancellation of the defendants' registration of the trademark "CALVAN KLEIN" for confectionary and indicated that the well-known-ness of the plaintiff's trademark in Chile was not essential and its high reputation overseas alone was sufficient. (reported in INTA Bulletin, Nov 1, 2000).

In Chile, it is assumed that the free-riding would be affirmed.

(d) Israel

"CHANEL" case (c.c. 2070/90 Tel-Aviv District Court)

Notwithstanding the fact that "Chanel" handbags are not sold in Israel by Chanel, the Court held that the unauthorized manufacture and sale in Israel of handbags constituting a passing-off of the famous Chanel mark should be prohibited.

“BACARDI” case (opposition at Trademark Office)

Bacardi, manufacturer of famous alcoholic beverages, filed an opposition against application of a “BACARDI” mark for fashion wear (although the goods are different from each other). The Commissioner of Trademark Office concluded that the applicants’ adoption of the other’s famous trademark, even if for different goods, was done in bad faith in order to secure benefits from the goodwill established by the opponent. (reported in World Intellectual Property Report by BNA, vol.11, pp11-12). This case might have affirmed free-riding on other’s well-known trademark.

(e) Greece

“BACARDI” case (application rejected)

A local company filed an application for use of the mark “BACARDI” for clothing but the application was rejected citing a registration of “BACARDI” for alcoholic beverages, which has been registered and already achieved an international reputation. The reasons for refusal were that the registered “BACARDI” has been well-known, making unauthorized use of the same mark likely to cause confusion regardless of differences existing in the goods. In Greece, confusion in broad sense would be affirmed.

(f) France

“COSMOPOLITAN” case

While the Heast Company has owned and used the trademark “COSMOPOLITAN” for stationary, magazines and publications, A. Frinas started to use “COSMOPOLITAN” for clothing and leather goods. Accordingly, the Heast Company sued the defendant. The first instance of the French Court concluded that the plaintiff’s trademark was affirmed as well-known and the defendant’s unauthorized use of same trademark for different goods does constitute infringement. Thereafter, the Court of Appeal concluded that the defendant’s use of same mark was not an infringement but a passing-off so as to reduce the reputation of the plaintiff’s famous trademark (i.e. dilution consideration based on the blurring concept).

8. Dilution Theory

“Dilution Theory” is now a rather popular concept used for the prudent protection of famous or well-known trademarks in the current era, and this term has been used even in the TRIPS Agreement. This concept has been developed more practically in the United States.

Some useful comments on “Dilution Theory” are introduced hereunder:

8-1 Meaning of “Dilution Theory” as Given by Prof. Thomas McCarthy ⁷

According to Prof. A. Thomas McCarthy in his “Trademark and Unfair Competition (4th edition)”, dilution theory grants protection to strong, well-recognized marks, even in the absence of any likelihood of confusion, where the defendant’s use would be such as to diminish or dilute the strong identification value of the plaintiff’s mark though customers may not be confused as to sources, sponsorships, affiliations and/or connections.

8-2 Provisions of the Lanham Act.

In the Lanham Act, Section 45 provides the definition of “dilution” as follows:

The term ‘Dilution’ means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the

presence or absence of: –

- (a) competition between the owner of the famous mark and other parties; or
- (b) likelihood of confusion, mistake or deception.

Further, Section 43(c) provides protection for famous trademarks under the federal courts by way of Dilution theory, the provisional text of which is attached in Attachment 3. Comments by Professor Lars S. Smith are included as H.R. 1295 referring to the wish to add a new section 43(c) to the Lanham Act to create a federal course of action for protecting famous trademarks from unauthorized users attempting to profit on goodwill and established renown, thereby diluting their distinctive quality.

8-3 Analysis by Prof. Lars S. Smith

Prof. Lars S. Smith, an assistant professor of Law at the Louis D. Brandeis School of Law of University of Louisville, further commented in his article “Implementing A Registration System for Famous Trademarks”, Vol. 93 TMR 1097 ~:

Perhaps the most important benefit of the FTDA (Federal Trademark Dilution Act) is that it gives owners of famous marks the right to prevent others from using similar marks on unrelated

products or services, irrespective of whether the other mark will cause actionable confusion among consumers.

Thus, the owner of a famous mark may obtain an injunction against the use of a similar junior mark, even when consumers will not be confused.

Rationales for such a broad scope of federal protection included preventing unfair trade upon the goodwill and fame of a mark and the erosion of consumers' singular and immediate association of the mark with the goods or services of the owner.

Owners of famous marks enjoy a tremendous benefit from federal dilution protection. To obtain relief under traditional trademark infringement grounds, the owner of a famous mark must show that use of the junior mark is likely to cause confusion among consumers as to the source, sponsorship or affiliation of the parties' goods or services (Lanham Act. § 32(1)(a) & 43(b)(1), 15usc § 1114(1)(a), 1125(a)(1) 2002).

When the putative infringer offers goods or services that are unrelated to those offered in connection with the famous mark, proving infringement can be difficult. The mark owner must show that the other traditional likelihood of confusion factors outweigh the fact that the goods and the channels of trade may be wholly dissimilar.

In contrast, the definition of dilution in the Lanham Act expressly excludes a requirement of likely confusion among consumers, thereby significantly reducing the importance of the similarity of the respective goods and services and the non-existence of competition between the parties. If the junior mark is identical or substantially similar to the senior mark, the critical issues in a federal dilution case are whether the senior mark is famous and whether the junior user has caused actual dilution of the senior mark.

8-4 Blurring and Tarnishing

In the article, “General Dilution Standards” by Mr. C. T. Micheletti and Mr. D. Z. Dorfman, authors of “Proving Dilution by Blurring: An Analysis of Dilution by Blurring Factors under the Federal Trademark Dilution Act⁸, the authors presented the meaning of Dilution as follows:

Courts recognize two principal forms of dilution: **tarnishing** and **blurring**. In general, dilution by blurring takes place when the defendants’ use of its mark causes the identifying features of the plaintiffs famous mark to become vague and less distinctive. In other words, blurring occurs when the defendants’ use of its mark causes the public to no longer associate the plaintiffs’ famous mark with its goods or services; the public instead begins associating both the plaintiff and the defendant with the famous mark. Dilution works its harm not by causing confusion in consumers’ minds regarding the source of a good

or service, but by creating an association in consumers' minds between a mark and a different goods or service.

On the other hand, according to *Eli Lilly & Co. vs. Natural Answers, Inc.* 233 F.3d. 456, 466 (7th Cir. 2000), it says that Dilution by tarnishing occurs when a junior marks' similarity to a famous mark causes consumers mistakenly to associate the famous mark with the defendants' inferior or offensive product.

The FTDA protects owners of famous marks against the commercial use of other similar marks if such use begins after the senior mark has become famous and causes dilution of the distinctive quality of the mark. Dilution is defined as the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence competition or of the likelihood of confusion, mistake, or deception. The FTDA provides for injunctive relief and, in the case of a willful violation, damages and/or profits, and destruction of the offending articles.

In applying the statutory language; courts have set out the general elements of a federal dilution claim. A senior-mark owner must first prove that its mark is famous and, in some circuits, distinctive as well. Use of the junior mark must be commercial and must begin after the senior mark has become famous.

Lastly, the senior user must show that the junior use cause dilution

of the distinctive quality of the senior mark.

9. Conclusion

The well-known or famous trademarks are now being reasonably protected under trademark law, unfair competition law and/or anti-dilution law in a substantial number of countries, but it seems that difficulties in getting sufficient protection still remain in cases of non-competing goods or services concerned.

In particular, after ratification of the TRIPS Agreement among WTO union countries, each member country, including developing countries, is actually trying to provide special provisions to protect well-known trademarks for different kinds of goods or services through Trademark Law or other related laws, but actually, in several countries evidence of confusion is still required as a condition for protecting well-known and famous trademarks.

- end -

Foot note:

- 1 partner in the firm of Kilpatrick Stockton LLP. Atlanta, Georgia, former Editor in Chief of the Trademark Reporter.
- 2 Jerse B. Swann, Sr. “Dilution Redefined for the year 2002” (587 Vol. 92 TMR)
- 3 Business Week Online: 2003 Global Brands Scoreboard
<http://bwnt.businessweek.com/brand/2003/index.asp>
- 4 NIKKEI survey results published in the Nihon Keizai Shinbunsha (NIKKEI) dated September 20, 2003 in Japan.
- 5 “WIPO Joint Recommendation concerning Provisions on the Protection of Well-known Marks” was prepared by WIPO and adopted by the joint assemblies of Paris Convention and WIPO in September 20–29, 1999.
- 6 Lars S. Smith “Implementing a Registration System for Famous Trademarks” Vol. 93 TMR 1103.
- 7 A. Thomas McCarthy “Trademarks and Unfair Competition (4th edition)”, §24:70
- 8 C. T. Micheletti and D. Z. Dorfman “Proving Dilution by Blurring: An Analysis of Dilution by Blurring Factors under the Federal Trademark Dilution Act” Vol. 92 TMR 1345

Attachment

Attachment 1. Business Week 2003 Global Brands Scoreboard &
Nikkei Survey

Attachment 2. Joint Recommendation of WIPO

Attachment 3. EU Council Directive 89/104/EEC of December 21, 1988
and Community Trademark Regulation

THE BEST GLOBAL BRANDS

2003 Global Brands Scoreboard

The table that follows ranks 100 global brands that have a value greater than \$1 billion. The brands were selected according to two criteria. They had to be global in nature, deriving 20% or more of sales from outside their home country. There also had to be publicly available marketing and financial data on which to base the valuation.

Data provided by:

Interbrand

Click column heading once to reorder from highest to lowest. Click twice to reorder from lowest to highest.

2003 Brand Rank ▲	Brand Name	2003 Brand Value (\$Mil)	2002 Brand Value (\$Mil)	Change in Brand Value (%)	Parent Company	Country
1	COCA-COLA	70.45	69.64		1 Coca-Cola Company	U.S.
2	MICROSOFT	65.17	64.09		2 Microsoft Corp.	U.S.
3	IBM	51.77	51.19		1 International Business Machines Corp.	U.S.
4	GE	42.34	41.31		2 General Electric Company	U.S.
5	INTEL	31.11	30.86		1 Intel Corp.	U.S.
6	NOKIA	29.44	29.97	-2	Nokia Corp.	Finland
7	DISNEY	28.04	29.26	-4	Walt Disney Company	U.S.
8	MCDONALD'S	24.70	26.37	-6	McDonald's Corp.	U.S.
9	MARLBORO	22.18	24.15	-8	Philip Morris Companies, Inc.	U.S.
10	MERCEDES	21.37	21.01	2	DaimlerChrysler AG	Germany
11	TOYOTA	20.78	19.45	7	Toyota Motor Corp.	Japan
12	HEWLETT-PACKARD	19.86	16.78	18	Hewlett-Packard Company	U.S.
13	CITIBANK	19.57	18.07	3	Citigroup Inc.	U.S.
14	FORD	17.07	20.40	-18	Ford Motor Company	U.S.
15	AMERICAN EXPRESS	16.83	16.29	3	American Express Company	U.S.
16	GILLETTE	15.98	14.96	7	Gillette Company	U.S.
17	CISCO	15.79	16.22	-3	Cisco Systems Inc.	U.S.
18	HONDA	15.53	15.06	4	Honda Motor Company	Japan
19	BMW	15.11	14.42	5	Bayerische Motoren Werke AG	Germany
20	SONY	13.15	13.90	-5	Sony Corp.	Japan
21	NESCAFE	12.34	12.84	-4	Nestlé S.A.	Switzerland
22	BUDWEISER	11.89	11.35	5	Anheuser-Busch Companies, Inc.	U.S.
23	PEPSI	11.78	11.14	6	PepsiCo, Inc.	U.S.
24	ORACLE	11.26	11.51	-2	Oracle Corp.	U.S.
25	SAMSUNG ELECTRONICS	10.85	NA	31	Samsung Corporation	S. Korea
26	MORGAN STANLEY	10.69	11.20	-5	Morgan Stanley	U.S.
27	MERRILL LYNCH	10.62	11.23	-6	Merrill Lynch & Company, Inc.	U.S.
28	PFIZER	10.46	9.77	7	Pfizer Inc.	U.S.
29	DELL	10.37	9.24	12	Dell Corp.	U.S.
30	MERCK	9.41	9.14	3	Merck & Company	U.S.
31	JP MORGAN	9.12	9.69	-6	J.P. Morgan Chase & Company	U.S.
32	NINTENDO	8.19	9.22	-11	Nintendo Company, Ltd.	Japan
33	NIKE	8.17	7.72	6	Nike Inc.	U.S.
34	KODAK	7.83	9.67	-19	Eastman Kodak, Inc.	U.S.
35	SAP	7.71	6.77	14	SAP AG	Germany
36	GAP	7.69	7.41	4	Gap Inc.	U.S.
37	HSBC	75.65.05	NA	NA	HSBC Holdings plc	Britain
38	KELLOGG'S	7.44	7.19	3	Kellogg Company	U.S.
39	CANON	7.19	6.72	7	Canon, Inc.	Japan
40	HEINZ	7.10	7.35	-3	H.J. Heinz Company	U.S.
41	GOLDMAN SACHS	7.04	7.19	-2	Goldman Sachs Group, Inc.	U.S.
42	VOLKSWAGEN	6.94	7.21	-4	Volkswagen AG	Germany
43	IKEA	6.92	6.54	6	Ikea International A/S	Sweden
44	HARLEY-DAVIDSON	6.77	6.27	8	Harley-Davidson, Inc.	U.S.
45	LOUIS VUITTON	6.71	7.05	-5	LVMH Moët Hennessy Louis Vuitton	France
46	MTV	6.28	6.08	3	Viacom, Inc.	U.S.
47	L'OREAL	6.60	5.08	10	L'Oréal SA	France
48	XEROX	6.58	5.31	5	Xerox Corp.	U.S.
49	KFC	5.58	5.35	4	Yum! Brands, Inc.	U.S.
50	APPLE	5.56	5.32	4	Apple Computer, Inc.	U.S.
51	PIZZA HUT	5.31	6.05	-12	Yum! Brands, Inc.	U.S.

52	ACCENTURE	5.30	5.18	2	Accenture Ltd.	U.S.
53	GUCCI	5.10	5.30	-4	Gucci Group N.V.	Italy
54	KLEENEX	5.06	5.04	0	Kimberly Clark Corp.	U.S.
55	WRIGLEY'S	5.06	4.75	7	W.M. Wrigley Jr. Company	U.S.
56	COLGATE	4.69	4.60	2	Colgate Palmolive Company	U.S.
57	AVON	4.63	4.40	5	Avon Products	U.S.
58	SUN MICROSYSTEMS	4.46	4.77	-6	Sun Microsystems, Inc.	U.S.
59	PHILIPS	4.46	4.56	-2	Koninklijke Philips Electronics N.V.	Netherlands
60	NESTLE	4.46	4.43	1	Nestle S.A.	Switzerland
61	CHANEL	4.32	4.27	1	Chanel S.A.	France
62	DANONE	4.24	4.05	5	Groupe Danone	France
63	KRAFT	4.17	4.08	2	Kraft Foods Inc.	U.S.
64	AOL	3.96	4.33	-8	AOL Time Warner, Inc.	U.S.
65	YAHOO!	3.90	3.86	1	Yahoo! Inc.	U.S.
66	TIME	3.78	3.68	3	AOL Time Warner, Inc.	U.S.
67	ADIDAS	3.68	3.69	0	Adidas AG	Germany
68	ROLEX	3.67	3.69	0	Montres Rolex S.A.	Switzerland
69	BP	3.58	3.39	6	BP PLC	Britain
70	TIFFANY & CO.	3.54	3.48	2	Tiffany & Co.	U.S.
71	DURACELL	3.44	3.41	1	Gillette Company	U.S.
72	BACARDI	3.43	3.34	3	Bacardi & Company Limited	Bermuda
73	HERMES	3.42	NA	NA	Hermès International	France
74	AMAZON.COM	3.40	3.18	7	Amazon.com Inc.	U.S.
75	CATERPILLAR	3.36	3.22	5	Caterpillar Inc.	U.S.
76	REUTERS	3.30	4.61	-28	Reuters Group PLC	Britain
77	LEVI'S	3.30	3.45	-5	Levi Strauss & Co.	U.S.
78	HERTZ	3.29	3.36	-2	Ford Motor Company	U.S.
79	PANASONIC	3.26	3.14	4	Matsushita Electric Industrial Company	Japan
80	ERICSSON	3.15	3.59	-12	Telefonaktiebolaget L.M. Ericsson	Sweden
81	MOTOROLA	3.10	3.42	-9	Motorola Inc.	U.S.
82	HENNESSY	3.00	NA	NA	LVMH Moët Hennessy Louis Vuitton SA	France
83	SHELL	2.98	2.81	6	Royal Dutch Petroleum Company	Brit./Nether.
84	BOEING	2.86	2.97	-4	Boeing Company	U.S.
85	SMIRNOFF	2.81	2.72	3	Diageo PLC	Britain
86	JOHNSON & JOHNSON	2.71	2.51	8	Johnson & Johnson	U.S.
87	PRADA	2.53	2.49	2	I.P. Pelletieri d'Italia S.p.A.	Italy
88	MOET & CHANDON	2.52	2.45	3	LVMH Moët Hennessy Louis Vuitton	France
89	NISSAN	2.50	NA	NA	Nissan Motor Co., Ltd.	Japan
90	HEINEKEN	2.43	2.40	1	Heineken N.V.	Netherlands
91	MOBIL	2.41	2.36	2	Exxon Mobil Corp.	U.S.
92	NIVEA	2.22	2.06	8	Beiersdorf AG	Germany
93	STARBUCKS	2.14	1.96	9	Starbucks Corp.	U.S.
94	BURGER KING	2.12	2.16	-2	Diageo PLC	U.S.
95	RL/POLO	2.05	1.89	6	Polo Ralph Lauren Corporation	U.S.
96	FEDEX	2.03	1.92	6	Fedex Corp.	U.S.
97	BARBIE	1.87	1.94	-3	Mattel Inc.	U.S.
98	WALL ST. JOURNAL	1.76	1.86	-10	Dow Jones & Company Inc.	U.S.
99	JOHNNIE WALKER	1.72	1.65	4	Diageo PLC	Britain
100	JACK DANIELS	1.61	1.68	2	Brown-Forman Corp.	U.S.

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WIPO



SCT/3/8

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**STANDING COMMITTEE ON THE LAW OF TRADEMARKS,
INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

Third Session

Geneva, 8 to 12 November, 1999

**JOINT RECOMMENDATION
CONCERNING PROVISIONS ON THE
PROTECTION OF WELL-KNOWN MARKS**

prepared by the International Bureau

1. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), at its second session, second part (June 7 to 11, 1999) agreed to recommend a Joint Resolution Concerning Provisions on the Protection of Well-Known Marks, for adoption by a joint session of the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO (September 20 to 29, 1999).

2. At that joint session, the Paris Union Assembly and the General Assembly of WIPO adopted, on the basis of the recommendation of the SCT, a Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, including the text of the provisions, without modification, as adopted by the SCT. The text of the Joint Recommendation is contained in the Annex to this document.

[Annex follows]

SCT/3/8

ANNEX

**JOINT RECOMMENDATION
CONCERNING PROVISIONS ON THE
PROTECTION OF WELL-KNOWN MARKS**

adopted by

**The Assembly of the Paris Union for the
Protection of Industrial Property**

and

**The General Assembly of the
World Intellectual Property Organization (WIPO)**

at the

**Thirty-Fourth Series of Meetings of the
Assemblies of the Member States of WIPO
September 20 to 29, 1999**

	Page
<i>Joint Recommendation</i>	3
<i>Article 1: Definitions</i>	4

PART I: DETERMINATION OF WELL-KNOWN MARKS

<i>Article 2: Determination of Whether a Mark is a Well-Known Mark in a Member State ..</i>	4
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PART II: SCOPE OF PROTECTION

<i>Article 3: Protection of Well-Known Marks; Bad Faith</i>	6
<i>Article 4: Conflicting Marks</i>	6
<i>Article 5: Conflicting Business Identifiers</i>	8
<i>Article 6: Conflicting Domain Names</i>	9

Joint Recommendation

The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO)

Taking into account the provisions of the Paris Convention for the Protection of Industrial Property relative to the protection of the well-known marks;

Recommend that each Member State may consider the use of any of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its Second Session, Second Part, as guidelines for the protection for well-known marks;

It is further recommended to each Member State of the Paris Union or of WIPO which is also a member of a regional intergovernmental organization that has competence in the area of registration of trademarks, to bring to the attention of that organization the possibility of protecting well-known marks in accordance, *mutatis mutandis*, with the provisions contained herein.

Provisions follow.

Article 1

Definitions

For the purposes of these Provisions:

(i) "Member State" means a State member of the Paris Union for the Protection of Industrial Property and/or of the World Intellectual Property Organization;

(ii) "Office" means any agency entrusted by a Member State with the registration of marks;

(iii) "competent authority" means an administrative, judicial or quasi-judicial authority of a Member State which is competent for determining whether a mark is a well-known mark, or for enforcing the protection of well-known marks;

(iv) "business identifier" means any sign used to identify a business of a natural person, a legal person, an organization or an association;

(v) "domain name" means an alphanumeric string that corresponds to a numerical address on the Internet.

PART I
DETERMINATION OF WELL-KNOWN MARKS

Article 2

*Determination of Whether a Mark is a
Well-Known Mark in a Member State*

(1) [*Factors for Consideration*] (a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
2. the duration, extent and geographical area of any use of the mark;

3. 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;

4. 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;

5. 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;

6. the value associated with the mark.

(c) 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 in sub-paragraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in sub-paragraph (b), above.

(2) [*Relevant Sector of the Public*] (a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

(i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;

(ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;

(iii) business circles dealing with the type of goods and/or services to which the mark applies.

(b) 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.

(c) 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.

(d) A Member State may determine that a mark is a well-known mark, even if the mark is not well known or, if the Member States applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(3) [*Factors Which Shall Not Be Required*] (a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:

(i) that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;

(ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

(iii) that the mark is well known by the public at large in the Member State.

(b) Notwithstanding sub-paragraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.

PART II SCOPE OF PROTECTION

Article 3

Protection of Well-Known Marks; Bad Faith

(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.

Article 4

Conflicting Marks

(1) [*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.

(b) 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.

(c) Notwithstanding Article 2(3)(a)(iii), for the purpose of applying paragraph (1)(b)(ii) and (iii), a Member State may require that the well-known mark be well known by the public at large.

(d) Notwithstanding paragraphs (2) to (4), a Member State shall not be required to apply:

(i) paragraph (1)(a) to determine whether a mark is in conflict with a well-known mark, if the mark was used or registered, or an application for its registration was filed, in or in respect of the Member State, 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, before the well-known mark became well known in the Member State;

(ii) paragraph (1)(b) to determine whether a mark is in conflict with a well-known mark, to the extent that mark was used, was the subject of an application for registration, or was registered, in or in respect of the Member State for particular goods and/or services, before the well-known mark became well known in the Member State;

except where the mark has been used or registered, or the application for its registration has been filed, in bad faith.

(2) [*Opposition Procedures*] If the applicable law allows third parties to oppose the registration of a mark, a conflict with a well-known mark under paragraph (1)(a) shall constitute a ground for opposition.

(3) [*Invalidation Procedures*] (a) The owner of a well-known mark shall be entitled to request, during a period which shall not be less than five years beginning from the date on which the fact of registration was made known to the public by the Office, the invalidation, by a decision of the competent authority, of the registration of a mark which is in conflict with the well-known mark.

(b) If the registration of a mark may be invalidated by a competent authority on its own initiative, a conflict with a well-known mark shall, during a period which shall not be less than five years beginning from the date on which the fact of registration was made known to the public by the Office, be a ground for such invalidation.

(4) [*Prohibition of Use*] The owner of a well-known mark shall be entitled to request the prohibition, by a decision of the competent authority, of the use of a mark which is in conflict with the well-known mark. Such request shall be admissible for a period which shall not be less than five years beginning from the time the owner of the well-known mark had knowledge of the use of the conflicting mark.

(5) [*No Time Limit in Case of Registration or Use in Bad Faith*] (a) Notwithstanding paragraph (3), a Member State may not prescribe any time limit for requesting the invalidation of the registration of a mark which is in conflict with a well-known mark if the conflicting mark was registered in bad faith.

(b) Notwithstanding paragraph (4), a Member State may not prescribe any time limit for requesting the prohibition of the use of a mark which is in conflict with a well-known mark if the conflicting mark was used in bad faith.

(c) In determining bad faith for the purposes of this paragraph, the competent authority shall take into consideration whether the person who obtained the registration of or used the mark which is in conflict with a well-known mark had, at the time when the mark was used or registered, or the application for its registration was filed, knowledge of, or reason to know of, the well-known mark.

(6) [*No Time Limit in Case of Registration Without Use*] Notwithstanding paragraph (3), a Member State may not prescribe any time limit for requesting the invalidation of the registration of a mark which is in conflict with a well known mark, if that mark was registered, but never used.

Article 5 *Conflicting Business Identifiers*

(1) [*Conflicting Business Identifiers*] (a) A business identifier shall be deemed to be in conflict with a well-known mark where that business identifier, 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 the business identifier would indicate a connection between the business for which it is used and the owner of the well-known mark, and would be likely to damage his interests;

(ii) the use of the business identifier is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark;

(iii) the use of the business identifier would take unfair advantage of the distinctive character of the well-known mark.

(b) Notwithstanding Article 2(3)(iii), for the purposes of applying paragraph (1)(a)(ii) and (iii), a Member State may require that the well-known mark be well known to the public at large.

(c) A Member State shall not be required to apply paragraph (a) to determine whether a business identifier is in conflict with a well-known mark if that business identifier was used or registered, or an application for its registration was filed, in or in respect of the Member State, before the well-known mark became well known in or in respect of the Member State, except where the business identifier was used or registered, or the application for its registration was filed, in bad faith.

(2) [*Prohibition of Use*] The owner of a well-known mark shall be entitled to request the prohibition, by a decision of the competent authority, of the use of a business identifier which is in conflict with the well-known mark. Such request shall be admissible for a period which shall not be less than five years beginning from the time the owner of the well-known mark had knowledge of the use of the conflicting business identifier.

(3) [*No Time Limit in Case of Registration or Use in Bad Faith*] (a) Notwithstanding paragraph (2), a Member State may not prescribe any time limit for requesting the prohibition of the use of a business identifier which is in conflict with a well-known mark if the conflicting business identifier was used in bad faith.

(b) In determining bad faith for the purposes of this paragraph, the competent authority shall consider whether the person who obtained the registration of or used the business identifier which is in conflict with a well-known mark had, at the time when the business identifier was used or registered, or the application for its registration was filed, knowledge of, or reason to know of, the well-known mark.

Article 6 *Conflicting Domain Names*

(1) [*Conflicting Domain Names*] A domain name shall be deemed to be in conflict with a well-known mark at least where that domain name, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration of the well-known mark, and the domain name has been registered or used in bad faith.

(2) [*Cancellation; Transfer*] The owner of a well-known mark shall be entitled to request, by a decision of the competent authority, that the registrant of the conflicting domain name cancel the registration, or transfer it to the owner of the well-known mark.

[End of Annex and of document]

Trade marks harmonization Directive

First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks

Article 4 Further grounds for refusal or invalidity concerning conflicts with earlier rights

1. A trade mark shall not be registered or, if registered, shall be liable to be declared invalid:

(a) if it is identical with an earlier trade mark, and the goods or services for which the trade mark is applied for or is registered are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

2. "Earlier trade marks" within the meaning of paragraph 1 means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

(i) Community trade marks;

(ii) trade marks registered in the Member State or, in the case of Belgium, Luxembourg or the Netherlands, at the Benelux Trade Mark Office;

(iii) trade marks registered under international arrangements which have effect in the Member state;

(b) Community trade marks which validly claim seniority, in accordance with the Regulation on the community trade mark, from a trade mark referred to in (a) (ii) and (iii), even when the latter trade mark has been surrendered or allowed to lapse;

(c) applications for the trade marks referred to in (a) and (b), subject to their registration;

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

3. A trade mark shall furthermore not be registered or, if registered, shall be liable to be declared invalid if it is identical with, or similar to, an earlier Community trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier Community trade mark is registered, where the earlier Community trade mark has a reputation in the Community and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trade mark.

4. Any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

(a) the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or service which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;

(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;

(c) the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraphs 2 and 4 (b) and in particular:

(i) a right to a name;

(ii) a right of personal portrayal;

(iii) a copyright;

(iv) an industrial property right;

(d) the trade mark is identical with, or similar to, an earlier collective trade mark conferring a right which expired within a period of a maximum of three years preceding application;

(e) the trade mark is identical with, or similar to, an earlier guarantee or certification mark conferring a right which expired within a period preceding application the length of which is fixed by the Member State;

(f) the trade mark is identical with, or similar to, an earlier trade mark which was registered for identical or similar goods or services and conferred on them a right which has expired for failure to renew within a period of a maximum of two years preceding application, unless the proprietor of the earlier trade mark gave his agreement for the registration of the later mark or did not use his trade mark;

(g) the trade mark is liable to be confused with a mark which was in use abroad on the filing date of the application and which is still in use there, provided that at the date of the application the applicant was acting in bad faith.

5. The Member States may permit that in appropriate circumstances registration need not be refused or the trade mark need not be declared invalid where the proprietor of the earlier trade mark or other earlier right consents to the registration of the later trade mark.

6. Any Member State may provide that, by derogation from paragraphs 1 to 5, the grounds for refusal of registration or invalidity in force in that State prior to the date on which the provisions necessary to comply with this Directive enter into force, shall apply to trade marks for which application has been made prior to that date.

Community Trademark Regulation

Article 8 Relative grounds for refusal

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

(a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

2. For the purposes of paragraph 1, 'Earlier trade marks' means:

(a) trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the Community trade mark, taking account, where appropriate, of the priorities claimed in respect of those trade marks:

(i) community trade marks;

(ii) trade marks registered in a Member State, or, in the case of Belgium, the Netherlands or Luxembourg, at the Benelux Trade Mark Office;

(iii) trade marks registered under international arrangements which have effect in a Member State;

(b) applications for the trade marks referred to in subparagraph(a), subject to their registration;

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

3. Upon opposition by the proprietor of the trade mark, a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.

4. *Upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to 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 Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;

(b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

5. *Furthermore, upon opposition by the proprietor of an 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 the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a reputation in the Community and, 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 earlier trade mark.*

Article 42 Opposition

1. *Within a period of three months following the publication of a Community trade mark application, notice of opposition of registration of the trade mark may be given on the grounds that it may not be registered under Article 8:*

(a) by the proprietors of earlier trade marks referred to in Article 8(2) as well as licenses authorized by the proprietors of those trade marks, in respect of Article 8(1) and (5);

(b) by the proprietors of trade marks referred to in Article 8 (3);

(c) by the proprietors of earlier marks or signs referred to in Article 8(4) and by persons authorized under the relevant national law to exercise these rights.

2. *Notice of opposition to registration of the trade mark may also be given, subject to the conditions laid down in paragraph 1, in the event of the publication of an amended application in accordance with the second sentence of Article 44(2).*

3. *Opposition must be expressed in writing and must specify the grounds on*

which it is made. It shall not be treated as duly entered until the opposition fee has been paid. Within a period fixed by the Office, the opponent may submit in support of his case facts, evidence and arguments.

Article 52 Relative grounds for invalidity

1. A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:

(a) where there is an earlier trade mark as referred to in Article 8 (2) and the conditions set out in paragraph 1 or paragraph 5 of that Article are fulfilled;

(b) where there is a trade mark as referred to in Article 8(3) and the conditions set out in that paragraph are fulfilled;

(c) where there is an earlier right as referred to in Article 8(4) and the conditions set out in that paragraph are fulfilled.

2. A Community trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to the national law governing the protection of any other earlier right an in particular:

(a) a right to a name;

(b) a right of personal portrayal;

(c) a copyright;

(d) an industrial property right.

3. A Community trade mark may not be declared invalid where the proprietor of a right referred to in paragraphs 1 or 2 consents expressly to the registration of the Community trade mark before submission of the application for a declaration of invalidity or the counterclaim.

4. Where the proprietor of one of the rights referred to in paragraphs 1 or 2 has previously applied for a declaration that a Community trade mark is invalid or made a counterclaim in infringement proceedings, he may not submit a new applicant for a declaration of invalidity or lodge a counterclaim on the basis of another of the said rights which he could have invoked in support of his first application or counterclaim.

5. Article 51(3) shall apply.

Community Trade Mark Implementing Rules

Rule 16 Facts, evidence and arguments presented in support of the opposition

1. Every notice of opposition may contain particulars of the facts, evidence and arguments presented in support of opposition, accompanied by the relevant supporting documents.

2. If the opposition is based on an earlier mark which is not a Community trade mark, the notice of opposition shall preferably be accompanied by evidence of the registration or filing of that earlier mark, such as a certificate of registration. If the opposition is based on a well-known mark as referred to in Article 8(2)(c) of the Regulation or on a mark having a reputation as referred to in Article 8(5) of the Regulation, the notice of opposition shall in principle be accompanied by evidence attesting that it is well-known or that has a reputation. If the opposition is entered on the basis of any other earlier right, the notice of opposition shall in principle be accompanied by appropriate evidence on the acquisition and scope of protection of that right.

3. The particulars of the facts, evidence and arguments and other supporting documents as referred to in paragraphs 1, and the evidence referred to in paragraph 2 may, if they are not submitted together with the notice of opposition or subsequent thereto, be submitted within such period after commencement of the opposition proceedings as the Office may specify pursuant to Rule 20(2).

4. Managing Intellectual Property, October 2000 P.50 “Protecting well-known trademarks in Mercosur”.

5. Andean Community Decision 344 and Decision 486 of December 1, 2000.

6. Y. Yamamoto: “Explanation of the Unfair Competition Prevention Law-2nd Edition” (Published by J111) PP. 65-67 and PP. 101-108.

7. Provisions of Article 81 of the Catagena Agreement (No. 344)

“For the purpose of determining whether a trademark is famous worldwide the following criteria, amount others, shall be taken into account:

(a) the extent to which it is known to the consumer public as the distinctive mark of the goods or services for which it was adopted;

- (b) the scale and scope of the dissemination and advertising or promotion afforded to the mark;*
- (c) the length of enforceability of the mark and its constant use; and*
- (d) the analysis of the production and marketing of the goods identified by the mark.”*

8. Industrial Property Code in Brazil, Article 67, Regulation 3: Contents of the affidavit showing the supporting facts, which shall be attached to an application for determination of a famous trademark

- “(a) The value of the trademark as an asset of the company as shown in the financial and fiscal books;*
- (b) The advertising expenditures directly related to the trademark on a yearly basis;*
- (c) The extent of domestic and international markets with the estimated number of consumers and company’s market share and position in the sector involved;*
- (d) A list of countries where the trademark has been registered; and*
- (e) The first date of use of the trademark in Brazil accompanies by Substantiating documentation.”*

9. The Provisions of Article of the Canadian Revised Trademark Law (1985) are as indicated below.