

Well-Known Mark Protection in the United States of America

March 17, 2011

Sponsoring Committee: Executive Committee of the Board of Directors

Proposed Resolution

WHEREAS, the United States of America is a party to the Paris Convention and to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), which provide for the protection of well-known marks that are neither registered or used in the jurisdiction where protection is sought;

WHEREAS, the United States has not enacted implementing legislation to fulfill its treaty obligations under Article 6bis of the Paris Convention and Article 16(2) of TRIPS, thus raising uncertainty as to the legal basis for a well-known mark doctrine in U.S. federal law;


WHEREAS, the United States has endorsed the World Intellectual Property Organization's 1999 Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks and has entered into bi-lateral agreements requiring that it give effect to the key articles of the Joint Recommendation;

WHEREAS, no federal court of appeals has decisively held that the Paris Convention or TRIPS are self-executing or carry the force of national law; and

WHEREAS, INTA strongly supports and promotes the WIPO Joint Recommendation in its approach to harmonizing and implementing national legislation for the protection of well-known marks;

BE IT RESOLVED, that the International Trademark Association supports the amendment of the trademark law of the United States of America to provide an explicit statutory basis for the protection of trademarks that are determined to be well known in the United States but are not registered or in use in the United States.

Background

Following INTA's filing of an  **amicus brief** in 2007 regarding the well-known mark case in the State of New York, *ITC Ltd. v. Punchgini, Inc.*, a special task force consisting of members of the International Amicus Committee, the Dilution and Well-Known Marks Committee, and the U.S. Legislation Subcommittee was formed in response to an inquiry by the Executive Committee of INTA's Board of Directors as to whether there is an explicit statutory basis in U.S.

federal law for the protection of well-known marks that are not registered or in use in the United States. In December 2008, the task force submitted its recommendations to the Executive Committee which suggested:

1. Consistent with its long-term policy, INTA should support the protection of marks that are well known in the United States, even if those marks are not actually in use in commerce within the meaning of the Lanham Act. Providing explicit statutory protection of well-known marks will ensure compliance by the United States with its treaty obligations under the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights (the “TRIPS Agreement”).
2. The continuing debate reflected in inconsistent court decisions over whether there is a basis under current federal law for the protection of marks that are well known in the United States, but that are nevertheless not in use in commerce, calls for clarifying legislation. Moreover, common law does not provide an adequate remedy for owners of well-known marks that are not used in the United States.
3. Accordingly, amendments to United States trademark law are necessary.

These recommendations were approved by the Executive Committee, and the U.S. Legislation Subcommittee was directed to draft statutory language for insertion into the Lanham Act. In September 2009, the subcommittee proposed language that diverged somewhat from the WIPO Joint Recommendation Concerning Provisions for the Protection of Well-Known Marks. Given that INTA’s policy, advocacy and amicus interventions since 1999 have been based on harmonizing and conforming national trademark law to the Joint Recommendation, the Executive Committee amended the subcommittee’s proposed statutory language to be more closely aligned with the Joint Recommendation. The timing of INTA’s efforts to have such legislation enacted will be determined based on consultations between INTA staff and the Executive Committee.

Therefore, the Executive Committee recommends that the Board approve the above resolution that the Lanham Act be amended to recognize the well-known mark doctrine as a matter of U.S. federal trademark law.