Proving that a Mark is Famous or Well-Known

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Preliminary Remarks

Concepts of famous or well-known marks differ by jurisdiction and legal context, such as a ‘well-known mark’ in the Paris Convention Article 6bis and the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement) (Art 16), a mark with ‘reputation’ in EU legislation and European national legislature, and a ‘famous’ mark in the U.S. Lanham Act. These concepts all provide for some degree of extended trademark protection beyond the principles of territorial protection and/or of specialty.

While also adapted for analogous marks with enhanced protection, this checklist is based on the concept of a well-known mark in the sense of the Paris Convention (and TRIPS agreement), which is “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.”

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A. Collect Background Information

1. Identify all jurisdictions where fame needs to be proven.

2. Identify reasons why fame of mark needs to be proven:
   ___ Opposition/invalidation proceedings
   ___ Infringement actions
   ___ Establish enhanced distinctiveness of earlier right
   ___ Establish reputation for actions based on taking unfair advantage or dilution or tarnishment

3. Relevant to each pertinent jurisdiction:
   ___ Is the mark registered in the jurisdiction?
   ___ Has the mark been used in the jurisdiction?
   ___ Does the jurisdiction’s trademark law cover famous or well-known marks?
      ___ Is there any specific definition for a famous or well-known mark under the law?
      ___ Do any definitions in the law distinguish famous marks from well-known marks?
      ___ Are famous /well-known marks protected as such under the trademark statute under a separate category of registration? Is there a published list of famous/well-known marks?
      ___ Is there a special procedure for registration of famous or well-known marks or a separate administrative procedure for their recognition?
      ___ Do particular grounds apply to famous/well-known marks in opposition/cancellation or enforcement actions?
      ___ Is the country a signatory to TRIPS (and Paris Convention)?
         ___ Does the jurisdiction offer TRIPs protection (extending to services and to dissimilar goods/services) to well-known marks not registered in the territory?
         ___ Does the jurisdiction offer protection to well-known marks not used in the territory?
         ___ Are confusion and deception considered?
Are dilution and tarnishment considered?

B. Criteria for Determining Famous or Well-known Marks in Each Jurisdiction.

1. Does the relevant trademark law lay down specific criteria for determining if a mark is a famous / well-known mark?

2. Has the relevant jurisdiction adopted in law or does it accept in practice the recommendations of WIPO on well-known marks?

3. Ascertain particular criteria required or useful to the court:
   ____ Geographical extent of identical or similar registrations by owner of the mark at issue outside the relevant territory
   ____ Registrations by owner of the mark at issue within the territory
   ____ Geographical extent of use of the mark outside the territory
   ____ Extent of use (if any) within the territory
   ____ Date of first use
   ____ Duration of use (in/outside the territory)
   ____ Market share held by the mark
   ____ Volume of sales or turnover
   ____ Advertising costs /size of investment in promoting the mark
   ____ Level of emphasis of mark in advertisements
   ____ Promotional activities, including without limitation at conventions, exhibitions, and fairs
   ____ Unsolicited media attention
   ____ Relevant niches of commerce/business circles and their extent
   ____ Relevant channels of trade and their extent
   ____ Nature of actual and/or potential consumers and their extent
   ____ Extent of recognition of the mark in the relevant sector(s) of the public
   ____ Commercial value attributed to the mark
C. Gathering Evidence

1. Provide detailed instructions regarding gathering evidence/record keeping to appropriate personnel:

   - Finance
   - Marketing
   - Public Relations
   - Others

2. Appoint an individual to supervise record keeping

3. Gather, collate, and store records of the following types of evidence for each pertinent product or service in each relevant jurisdiction and on the Internet for each year since first use:

   - History of adoption
   - Proof of first use
   - Sales figures
   - Amounts spent for marketing and promotion
   - Copies of all advertising and promotional materials
   - Records of all periodicals in which advertisements were placed
   - Copies of all web pages offering or promoting each product/service on the Internet
   - List of registrations and pending applications
   - All instances of successful enforcement of the mark
4. Create and preserve a library of third party or neutral citations:

___ Awards received

___ Records of unsolicited media attention: retain copies of all unsolicited media features on each product/service in each jurisdiction (including internet)

___ Copies of all statements by competent authorities recognizing the mark as well-known

___ Dictionary and encyclopedia entries