

Well-Known Mark Registries

November 9, 2005

Sponsoring Committee: Dilution and Well-Known Marks Committee

Resolution

WHEREAS international trademark treaties obligate national governments to provide well-known marks with enhanced protection;

WHEREAS, INTA recognizes that the laws of different nations may lend themselves to different approaches in protecting well-known marks;

WHEREAS, there are countries electing to meet these international obligations by establishing a well-known mark registry;

WHEREAS, there is little experience with the operation of well-known mark registries, and there are no established international guidelines as to the creation and maintenance of such registries; and

WHEREAS, INTA, pursuant to its 1996 resolution on protection of well-known marks and to its 1999 resolution on WIPO Provisions for the Protection of Well-Known Marks, supports the effective protection and enforcement of well-known marks worldwide and is committed to assisting countries in meeting their treaty international obligations;

THEREFORE BE IT RESOLVED, that INTA recommends that countries electing to establish well-known mark registries design and operate them in a manner that affords legal certainty concerning rights in well-known marks and apply the principles of the WIPO Provisions for the protection of well-known marks.

BE IT FURTHER RESOLVED, that INTA recommends that a country electing to establish a well-known mark registry adopt the following practices:

- Publication of the purpose and benefits of the registry.
- Publication of the adopted rules setting forth the criteria and procedures that will be used by the examining authority to determine whether a mark is well-known.
- A set term of 10 years for a well-known mark registration with the opportunity for the mark owner to apply for renewal.
- Procedures for third parties acting in good faith to oppose the placement of a mark on a well-known mark registry and to move for cancellation of a registration on a well-

known mark registry at any time. In drafting procedures, consideration should be given to developing appropriate standing criteria and deadlines for submissions once a proceeding has commenced to ensure that the prosecution of such proceedings is reasonable and expeditious.

- Clarity in the law that, while inclusion on a well-known mark registry may facilitate a trademark-related legal claim, inclusion on the well-known registry is not a prerequisite for bringing a claim; nor should any negative inference be drawn that the mark is not well-known.
- Confidential treatment of financial and other sensitive business information submitted in support of an application for inclusion on a well-known mark registry, with disclosure only to those participating in proceedings related to such application and any resulting registration.
- Assurance that the right of a trademark owner to seek protection of its trademarks under the laws existing in a particular jurisdiction or under international law, including the right to establish in a litigation or other proceeding that its trademark is well-known, shall not be adversely impacted by the fact that its trademark is not included on a well-known mark registry.
- Adequate training of personnel assigned to examine applications for inclusion on a well-known mark registry.

Background

The Dilution and Well-Known Marks Committee is pleased to submit to the Board of Directors for consideration this revised resolution, which reflects the comments that were provided by directors at the board meeting in May when the initial recommendation on this topic was offered. Subsequent to the May board meeting, the committee again contacted counsel in countries in which the government has established a well-known mark registry (whether officially or unofficially) and solicited additional comments from in-house counsel of major brand holders who have made or attempted to make use of such registries.

This second round of inquiries and interviews revealed mixed views regarding well-known mark registries. On the one hand, registries are viewed by some as valuable tools in enforcing trademark rights. For example, the committee learned that in China, government officials will expedite a request for seizure of counterfeit goods if the goods bear a mark that appears on China's well-known mark registry. In Mexico, as in other countries with well-known mark registries, inclusion on the list ensures protection of a mark outside its registered classes. Inclusion on a well-known mark registry, particularly in civil law countries, also may provide a presumption of fame that aids significantly in litigation.

On the other hand, others indicated that well-known mark registries have failed to meet their expectations. In-house counsel described the process as being saddled with unnecessary formalities. One brand owner, for example, expressed frustration with respect to its inability to get on a well-known mark registry, despite the fact that its brand is one of the most well-known in the world. Another brand owner noted that in at least one country with a well-known mark registry, the inclusion on the registry appears to have little or no impact on the protection of well-known marks in that jurisdiction because of the government's lack of enforcement.

Countries are beginning to utilize well-known mark registries in one form or another to meet their international obligations to protect well-known marks. As the committee noted previously in its May report, regional IP associations such as AIM, MARQUES and ECTA are urging WIPO to look closely at the efficacy of well-known mark registries. It is possible that WIPO will eventually add discussion of well-known mark registries to its agenda. INTA should be prepared with a statement that has been sanctioned by its Board of Directors if and when WIPO decides to take up the issue.

As a result of the mixed views among brand owners and practitioners regarding well-known mark registries, rather than taking a position in this debate for or against such registries, the committee recommends instead that INTA take on an advisory role in helping to develop international standards to be used by any country that has elected to establish a well-known mark registry. INTA is in a unique position, because of the composition of its membership and the level of expertise of its members, to assist any country that chooses to adopt a well-known mark registry, so as to ensure that implementation of such a registry is effectuated in a manner that affords legal certainty to the protection of well-known marks in that jurisdiction.

The committee has put forward for the board's consideration a draft resolution containing a list of recommended practices for nations that have established or may establish a well-known mark registry. In many cases these practices address the normative, legal and procedural questions related to well-known mark registries that were raised during the committee's previous analysis, as well as the most recent round of discussions, e.g. what the legal significance should be if the mark is included or not included on a registry; the procedures, criteria and evidentiary requirements for inclusion of mark, and opposition and cancellation procedures.

The recommended list of practices is non-exhaustive and can be expanded as registration authorities and trademark owners gain more experience with registries. Below is a brief explanation of why the committee recommends these practices be included in the resolution.

1. Publication of the purpose and benefits of the registry.

Explanation: It should be clear to mark owners, practitioners, and the public at large how inclusion on the registry may benefit the protection of famous marks and what a particular country intends to be the purpose and legal effect of establishing such a registry.

2. Publication of the adopted rules setting forth the criteria and procedures that will be used by the examining authority to determine whether a mark is well-known.

Explanation: Certainty as to the criteria and procedures for inclusion on a well-known mark registry will benefit famous mark owners, the examining authority/government and the public at large. The development and publication of such rules will assist mark owners and practitioners

in determining whether a particular mark is an appropriate candidate for inclusion on a well-known mark registry and reduce the number of specious applications the examining authority will have to review.

3. A set term of 10 years for a well-known mark registration with the opportunity for the mark owner to apply for renewal.

Explanation: Not all marks retain “well-known” status indefinitely. A set term of 10 years for registration will provide the owner, registration authority, and the public at large an opportunity for review of the status of the mark under established rules and criteria at set periods. The 10-year term is consistent with the term for conventional trademark registrations in the majority of countries around the world.

4. Procedures for third parties acting in good faith to oppose the placement of a mark on a well-known mark registry and to move for cancellation of a registration on a well-known mark registry at any time. In drafting procedures, consideration should be given to developing appropriate standing criteria and deadlines for submissions once a proceeding has commenced to ensure that the prosecution of such proceedings is reasonable and expeditious.

Explanation: In order for well-known mark registries to be effective tools without becoming permanent grants of “well-known” status, the committee recommends that third parties have the opportunity to oppose or cancel registration of a mark that is not (or is no longer) well-known or is otherwise not appropriate for inclusion on the registry (e.g., because it is generic and does not function as a mark or is infringing of prior established rights). To ensure that such proceedings are not used in bad faith to create unfair administrative hurdles to the owners of well-known marks invoking rights granted by law, the committee further recommends the establishment of clear rules and procedures for such proceedings, including standing requirements that take into account the nature of the opposing party and submission deadlines that allow such proceedings to be administered expeditiously, without creating costly and unnecessary delays and other such hurdles.

5. Clarity in the law that, while inclusion on a well-known mark registry may facilitate a trademark-related legal claim, inclusion on the well-known registry is not a prerequisite for bringing a claim; nor should any negative inference be drawn that the mark is not well-known.

Explanation: A well-known mark owner which does not seek or obtain registration on a local well-known mark registry should not be estopped from bringing claims under local laws protecting trademarks. Although inclusion on a country’s well-known mark registry may provide the mark owner with some additional benefits in bringing certain trademark-related claims in that jurisdiction (e.g., a presumption of fame), the mark owner should not be penalized for its failure to be included on the registry and should be able to assert whatever trademark-related claims are available under the local law regardless of the status of its mark on the well-known mark registry. The mark owner should be able to prove fame in any such proceeding.

6. Confidential treatment of financial and other sensitive business information submitted in support of an application for inclusion on a well-known mark registry, with disclosure only to those participating in proceedings related to such application and any resulting registration.

Explanation: For well-known mark registries to be useful tools to well-known mark owners there must be assurances that evidence of fame submitted in support of an application - - which often includes sensitive financial information - - will be treated confidentially. Well-known mark owners may choose not to apply for inclusion on such registries if sensitive information submitted in the application process is available for public review. In order to address this concern, the resolution contemplates making such information available to those participating in proceedings related to an application for a well-known mark registration, but recommends limiting the disclosure of such information to the public at large.

7. Assurance that the right of a trademark owner to seek protection of its trademarks under the laws existing in a particular jurisdiction or under international law, including the right to establish in a litigation or other proceeding that its trademark is well-known, shall not be adversely impacted by the fact that its trademark is not included on a well-known mark registry.

Explanation: Well-known mark owners are entitled to the rights afforded to all mark owners under the local laws, whether or not they have sought or obtained registration on the well-known mark registries. Although registration on a well-known mark registry may provide additional benefits to a mark owner, such registration should not serve to diminish otherwise existing protections. In particular, the fact that a mark owner has not sought to be included on the well-known mark registry of a particular country should not affect its ability to seek or obtain well-known mark status in that jurisdiction (or other jurisdictions) through other vehicles, including, where available, litigation.

8. Adequate training of personnel assigned to examine applications for inclusion on a well-known mark registry.

Explanation: It is important that decisions regarding applications for inclusion on the registries are consistent, well-considered, and in compliance with the published rules. Well-trained examining personnel will be essential to achieving this goal.