

## **INTA recommendations on the UKIPO consultation related to a technical amendment via a statutory instrument to the well-known trademark provisions in the Trade Marks Act 1994 (TMA)**

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The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and complementary intellectual property (IP) to foster consumer trust, economic growth, and innovation, and committed to building a better society through brands. Mindful of the importance of this matter, INTA had long ago established a full-fledged committee handling matters related to famous and well-known marks. Indeed, the Famous and Well-Known Marks Committee develops and advocates our policy on the balanced protection of famous and well-known marks. It monitors and analyzes developments in treaties, cases, legislation, and regulation in various jurisdictions, and proposes policy recommendations to the Board. Committee work includes writing reports and submissions, and advocacy in conjunction with relevant committees and staff. In line with its mission, INTA is pleased to have the opportunity to provide the United Kingdom Intellectual Property Office (UKIPO) with input on a technical amendment via a statutory instrument to the well-known trademark provisions in the Trademarks Act 1994 (TMA).

- **What are your views on the proposed legislative change?**

INTA welcomes the proposed legislative change and the aim of providing the same remedies to UK brand owners as to nationals of (third party) Convention Countries. There is no rationale for providing broader protection for WKMs of nationals of third party Convention Countries than to UK WKMs, nor is this position in line with the WIPO Joint Recommendations (JR).

- **Do you foresee an increase in Court cases caused by the proposed legislative change?**

The broadening of the WKM provisions will provide UK WKM owners with better access to judicial remedies in situations where their rights have been infringed. This is likely to encourage more enforcement of WKMs. Having said that, INTA considers that reliance on WKM as a stand-alone infringement ground is rare. As such, the legislative change is unlikely to result in a significant increase in the number of cases before the Courts.

- **Will proprietors of well-known trademarks who are UK nationals find the parity of treatment helpful?**

Yes, INTA considers that UK based owners of WKMs will find the parity of treatment helpful.

- **Do you have any views on how the proposed legislative change might impact other areas of trade mark law, such as passing off?**

Passing off can be difficult to establish in situations where the goods or services in issue are dissimilar. The broadening of the WKMs provisions may result in an increased reliance on these provisions in lieu of passing off.

- **Any other comments/thoughts would be greatly appreciated.**

INTA notes that a key aspect of the WIPO JR is the flexibility it provides to Member States in determining what constitutes a WKM. Article 2(1)(c) expressly states that the six factors enumerated in the preceding subparagraphs are guidelines rather than requirements or preconditions. It is important to maintain a significant degree of flexibility in the evaluation of WKM status and to bear in mind that distribution channels, business methods and communication have evolved significantly in the time since the WIPO JR was adopted. We encourage the IPO to consider additional changes to ensure that this flexibility is enshrined in UK law and that the IPO and courts have sufficient guidance, through implementing measures and policy guides, on how to evaluate whether a mark is considered well-known. INTA would be happy to share further information and engage in dialogue with the IPO in this area.

Where the relevant public is concerned, INTA notes that there may be scenarios where WKM status need not be among the “general public” as mentioned in introductory paragraph 2. It is not a condition for the protection against unfair advantage or detriment that an earlier registered mark be known among the general public. INTA submits that it should not be necessary in the case of WKMs either. Whilst the reference to the “general public” is not included in the draft SI, to the extent that the *travaux préparatoires* are made available after the SI has been adopted, it may be prudent to revise paragraph 2 to align with the WIPO JR’s emphasis on the “Relevant Sector of the Public”.

For more information, please contact:

Tat-Tienne Louembe

Chief Representative Officer, Europe and Intergovernmental Organizations

[tlouembe@inta.org](mailto:tlouembe@inta.org)