

# Protection of Well-Known Marks



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# Well-Known Marks

## Paris Convention Article 6bis

Members must protect well-known marks from infringement whether registered or unregistered.

This obligation is incorporated into Article 16 of the TRIPS Agreement.



# Well-Known Mark Treaty Obligations

## Paris Article 6bis

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.

- refuse registration
- cancel registration
- prohibit use
- where likelihood of confusion
- used on identical or similar goods
- no requirement senior mark be registered, i.e. applies to unregistered senior marks



# Well-Known Mark Treaty Obligations

## 16.2

- **Relevant Sector fame (not nationwide)**

## 16.3

- **For dissimilar goods, senior WKM mark protected if registered.**
- **Junior use indicates connection to senior registered mark.**

## TRIPS Article 16(2) and (3)

Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is well-known, 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.

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.



# TRIPS and Paris Trademark Obligations: Likelihood of Confusion

- 1) same mark + same goods/services = presumption of confusion. (*TRIPS 16.1*)
  - 2) same/similar mark + same/similar goods/services + registered = prohibited if likelihood of confusion (even in translation). (*Paris Art 6bis and TRIPS 16.1 and 16.2*)
  - 3) same/similar mark + same/similar goods/services + unregistered = prohibited if likelihood of confusion (even in translation). (*Paris Art. 6bis and TRIPS 16.2*)
  - 4) same/similar mark + dissimilar goods/services + registered = prohibited if likelihood of confusion (even in translation if indicates a connection and likely to cause damage to the owner). (*Paris Art. 6bis and TRIPS Art 16.3*)
- *Likelihood of confusion encompasses translations of the mark.*
  - *The obligations in #3 and #4 are limited to WKMs.*



# WKM Implementation

Likelihood of Confusion is the simple solution

- If there is likely to be confusion, then use of a mark, whether registered or unregistered, whether in translation, on same, similar, related, unrelated goods/services, can all be addressed. Flexible standard.
- WKM obligations are encompassed into that standard without defining a WKM.
- Scope of protection depends on factors used by examiners and judges.



# US Implementation

- 15 U.S.C. §1052(a);
- 15 U.S.C. §1052(d);
- 15 U.S.C. §1125(a);
- 15 U.S.C. §1125(c) – dilution.



# WKMs in Examination: False Association and Likelihood of Confusion 15 USC 1052

15 USC 1052(a) No trademark . . . shall be refused registration . . . unless it . . . consists of or comprises . . . deceptive matter... or matter which may . . . falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols, or bring them into contempt, or disrepute. (unregistered WKMs and GIs)

15 USC 1052(d) consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant to cause confusion, or to cause mistake, or to deceive . . . (registered WKMs)



# Oppositions and Cancellations

- 15 U.S.C. §1063 and 1064: A party who believes it would be damaged by the issuance of a registration or the continued existence of a registration may institute a proceeding to *oppose or petition to cancel* registration at the Trademark Trial and Appeal Board, on the grounds of Section 2(a) and (d) (WKMs) and Section 43(c) of the Lanham Act (famous marks).
- Opposition/Cancellation system are a key to implementing WKM obligations. Shifts burden from examiners to WKM holders to assert WKM rights.



# Infringement of WKMs – False Association Likelihood of Confusion 15 USC 1125

15 USC 1125 (a)(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation or fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.



# US Implementation

- US does not create or consult WKM registries.

*Why not?*



# WKM Register - Cons

- Additional fees for WKM registration
- Slow and arduous application process
- Favors domestic marks over foreign marks
- Doesn't protect unregistered WKMs
- Subjective criteria (usually without appellate review)
- Usually dispositive of the issue
  - Not rebuttable
  - No list, no claim
- Static list
  - deadwood
  - well-knownness depends on particular facts
- Unreliable result – not usually comprehensive



# The Likelihood-of-Confusion Analysis in Examination

- Factors, originally set forth in *In re Du Pont de Nemours & Co.* 476 F.2d 1357 (C.C.P.A. 1973).
  - Degree to which the marks are similar in appearance, sound, connotation or commercial impression;
  - Similarity, if any, between the goods/services associated with each mark;



# DuPont factors, continued

- Similarity, if any, of the trade channels of the goods/services associated with each mark.
- Whether buyers make purchasing decisions on impulse or on careful reflection.
- The fame, if any, of the first-used mark.
- How many, if any, similar marks are used on or in connection with similar goods or services.
- The nature and extent of *actual* confusion, if any.



# *DuPont* factors, continued

- If no actual confusion has arisen, the length of time, and the conditions under which, confusion was avoided.
- Whether the mark is used on a variety of goods.
- The nature and extent, if any, of interface between the two mark owners.
- The extent to which the party applying to register the mark is entitled to prevent others from using the mark.



# *DuPont* factors, continued

- The extent of potential confusion.
- Any established fact that could be probative of the effect that results from a party's use of the mark.



# Well-Known Marks in Examination

- The *du Pont* factor focusing on the fame of the prior mark plays a dominant role in the process of balancing the *Du Pont* factors in cases featuring a famous or strong mark. *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).
- As the fame of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d 1303 (Fed. Cir. 2002).



# Examination Involving Unregistered Well-known Marks

Under Section 2(d), registration is refused if the mark: "...consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, **or a mark or trade name previously used in the United States by another and not abandoned**, as to be likely, when used on or in connection with the goods of the applicant to cause confusion, or to cause mistake, or to deceive . . ."

In theory it would be possible under the statutory language of Section 2(d) for an examiner to refuse registration on the grounds of an unregistered WKM. However, given the burden of proof for establishing that a mark is well-known, it is not likely the refusal would be upheld by the Trademark Trial and Appeal Board. So, this is typically left for a party to oppose at the opposition stage.



# Examination Involving Unregistered Well-known Marks

An examiner may refuse registration under Section 2(a) of the Lanham Act, 15 USC 1052(a), if a mark falsely suggests a connection with persons, living or dead, institutions, beliefs or national symbols, or brings them into contempt, or disrepute.

An examiner may use Section 2(a) to refuse registration even in cases where the name of the well-known person, institution, beliefs or national symbols are NOT registered.



# Well-Known Marks in Examination

What must an Examiner show to refuse under Section 2(a)?

- (1) the mark is the same as, or a close approximation of, the name or identity of a person or institution;
- (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
- (3) the person or institution named by the mark is not connected with the activities performed by applicant under the mark; and



# Well-Known Marks in Examination

(4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed.



# Well-Known Marks in Examination

It is not necessary to prove intent to identify a party or trade on its goodwill. However, evidence of such an intent could be highly persuasive that the public would make the intended false association.



# Well-Known Marks in Examination

What refusals under Section 2(a) by an Examiner have been upheld? They include:

- APACHE for cigarettes, falsely suggests a connection with the nine federally recognized Apache tribes
- NAFTA for promotion of trade and investment services, falsely suggests connection with the North American Free Trade Agreement;
- SYDNEY 2000 for advertising and business services and communication services, falsely suggests connection with Olympic Games held in 2000



# Well-Known Marks in Examination

What refusals under Section 2(a) by an Examiner have been upheld?

- WESTPOINT for shotguns and rifles falsely suggest a connection with an institution, the United States Military Academy
- NATIONAL INTELLIGENCE ACADEMY for educational and instructional services in intelligence gathering for law enforcement officers falsely suggests a connection with the United States government
- BO BALL for balls since use would be recognized as referring to football and baseball player Bo Jackson



# Well-Known Marks in Oppositions and Cancellations

Opposition/Cancellation system are key to implementing WKM obligations.

What factors are considered by judges in determining whether a mark is well-known?

It's a non-exhaustive list...



# Well-Known Marks – Factors for Judges to Consider

- Degree of distinctiveness
- Duration and extent of use of the mark
- Duration and extent of advertising of the mark
- Extent of geographical trading area
- Channels of trade
- Degree of recognition of the mark in those channels of trade
- Nature and extent of use of same/similar marks by third parties
- Whether the mark is registered



# Well-Known Marks (not) Defined

- Benefits of Avoiding a Statutory Definition of Well-Known Marks:
  - The result of a rigid definition is usually the creation of a rigid list of well-known marks. That, in turn, may lead to undue protection for marks on those lists, thereby undermining the international obligation to protect *all* well-known marks.
  - A mark may be well-known only within a particular area.
  - A particular mark may gain - - or lose - - its well-known quality over time.
  - Difficult to determine which standard a trademark examining operation ought to adopt in determining which marks are well-known, since that operation may have limited resources.



# Recent Cases Involving Well-Known Marks

*Google Inc. v. Pivot Design, Inc.*, Opposition No. 91171124 (April 20, 2007) [not precedential].

Opposer, Google, Inc. filed an opposition against registration of the mark BLOGLE for computer software for searching, compiling, indexing and organizing information.





# Recent Cases Involving Well-Known Marks

What evidence of fame?

- use since 1997 with search engine software
- over 300 million U.S. visitors to website in 2006
- U.S. revenues have risen from over 400 million in 2002 to 7.3 billion dollars in 2006
- "Reader's Choice" survey: Google among the top 5 leading brands worldwide from 2001-2005
- two online dictionary definitions of "Google" as "trademark for a search engine."



# Recent Cases Involving Well-Known Marks

Googles' motion for summary judgment granted on the basis of the fame of opposer's mark, the similarity of the marks, and the "legally-identical nature of the goods involved.



# Recent Cases Involving Well-known Marks

*Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006).

Starbucks filed an opposition against Marshall Ruben's application for LESSBUCKS COFFEE for coffee and retail store services. The Board sustained the opposition, finding that STARBUCK was a famous mark and accorded it a "broad scope of protection" under the fifth *Du Pont* factor.





# Recent Cases Involving Well-known Marks

What evidence?

- \$10 billion in sales and \$150 million in marketing expenditures during 2001-2004;
- 5,000 company-owned and licensed stores throughout the country;
- 11 million consumer transactions per week;
- and 350,000 hits per week at its website. As of 2004, nearly half of all American consumers had visited a Starbucks' location.
- Surveys



# Recent Cases Involving Well-known Marks

“...the Federal Circuit has stated repeatedly that there is no excuse for even approaching the well-known trademark of a competitor inasmuch as “a strong mark...casts a long shadow which competitors must avoid.”” *Starbucks v. Marshall S. Ruben*, 78 USPQ2d 1741 (TTAB 2006), citing, *Kenner Parker Toys Inc.*

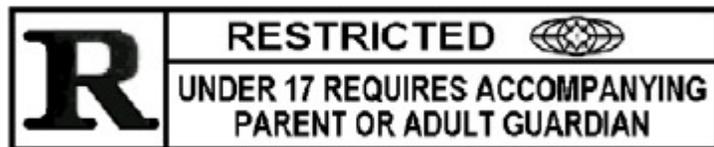
*What did the Board hold? Given fame and similarities in marks and goods, likelihood of confusion!*



# Recent Cases Involving Well-known Marks

*Motion Picture Association of America, Inc. v. Respect Sportswear, Inc.*, Opposition No. 91153141 (April 13, 2007) [precedential].

MPAA owns a certification mark for RATED R that certifies a particular film "is an adult film in some of its aspects and treatment so far as language, violence, nudity and sensuality are concerned, and that because of such elements no one under the age of 17 should be admitted unless accompanied by a parent or guardian."





# Recent Cases Involving Well-known Marks

MPAA filed an opposition against the mark **RATED R SPORTSWEAR** for men's and ladies' clothing (with "SPORTSWEAR" disclaimed).

Evidence of fame:

- More than 20,000 films have been rated by MPAA since 1968, 61 percent were rated "R"
- 1.5 billion movie tickets and 1.3 billion DVDs were sold in the U.S. in 2004
- The MPAA's website receives 150,000 hits each month
- A 2004 survey indicated that 95 percent of those surveyed were familiar with MPAA's rating system



# Recent Cases Involving Well-known Marks

Based on this evidence, the Board found the RATED R mark to be famous for purposes of Section 2(d): “Such fame must be accorded dominant weight in our likelihood of confusion analysis.”

*Board found in favor of MPAA.*



# Dilution

*What is dilution?*



# Famous Marks vs WKMs Dilution vs Infringement

## 15 USC 1125 - Dilution

Injunction is available against “use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, or competition, or of actual economic injury.”

Dilution by blurring/tarnishment – association arising from similarity between a mark or trade name and a famous mark that impairs the distinctiveness/harms the reputation of the famous mark.

**No proof of connection required. Dilution requires use of the senior mark in commerce.**

## TRIPS Article 16.3 – WKM doctrine

“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 the use of that trademark in relations 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.”

**Connection = Likelihood of confusion. Use of senior mark is not required.**



# WKMs vs. Famous Marks for Purposes of Dilution...

- All famous marks are well-known but not all well-known marks are famous...

