

## Summary Report

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### Question 234

#### **Relevant public for determining the degree of recognition of famous marks, well-known marks and marks with a reputation**

The purpose of this question is to study international and national law in respect of the relevant public for determining the degree of recognition of famous marks, well-known marks and marks with a reputation and to encourage proposals for further harmonization.

National Groups from the following countries (in alphabetical order) have submitted reports: Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Canada, China, Denmark, Egypt, Estonia, Finland, France, Germany, Greece, Hungary, Israel, Italy, Japan, Latvia, Luxembourg, Malaysia, Mexico, The Netherlands, Philippines, Poland, Portugal, Republic of Korea, Romania, Russia, Singapore, South Africa, Spain, Sweden, Switzerland, Trinidad & Tobago, Turkey, UK and USA, in total 39 reports.

Many of the reports provide a detailed and thorough overview and analysis of case law and statutory provisions. Several of the National Groups have moreover given proposals for further harmonisation of the relevant public.

This report summarizes several of the issues discussed in the National Group Reports but does not purport to fully describe the accounts of the different national laws made by the National Groups. For a detailed account of any particular answer, reference is made to the respective National Group Report.

#### **I. Analysis of current law and case law**

The Groups were invited to answer the following questions under their national laws:

***1. How is the relevant public for purposes of determining the degree of recognition of famous, well-known and reputed marks defined in your jurisdiction? Is it the general public at large or a relevant sector of the public that is considered to be the relevant public in determining the knowledge, recognition or fame of a mark?***

##### Relevant sector

In many countries, the relevant public for purposes of determining the degree of recognition is a relevant sector of the public (which as several groups note can, depending on the circumstances, be the public at large), but the criteria may differ depending on whether it concerns a well-known, reputed or other mark.

Regarding reputed marks, most of the EU member states (the EU member states that submitted a report are Austria, Belgium, Bulgaria, Estonia, Finland, France, Germany, Greece, Hungary, Italy, Latvia, Luxembourg, The Netherlands, Poland, Portugal, Romania,

Spain, Sweden and the UK) refer to the *General Motors/Yplon* case of the CJEU which notes that the relevant public is the public concerned by the trademark and thus depends on the goods or services at issue.

The Benelux countries (Belgium, The Netherlands, Luxembourg) remark the following regarding the definition of the public in the context of well-known marks. The Belgian Group notes that for a well-known mark to come within the meaning of art. 6bis Paris Convention, the mark must benefit from a recognition that goes beyond the branch or the circles of the industry concerned. The Luxembourg Group notes that for a trademark to be well-known, it must be known by a very large fraction of the general Benelux public. The Dutch Group notes that before TRIPs came into force the relevant public was the general public at large; in view of art. 16(2) TRIPs the relevant sector must be taken into account though and thus the test applied can be very close to that for reputed marks (as also follows from recent Dutch case law).

The French Group notes that it is unclear whether the relevant public must be construed differently for well-known trademarks and trademarks with a reputation.

The German Group notes that well-known trademarks must enjoy considerable notoriety within the relevant circles of the public concerned, namely 60-70%; for marks with a reputation there are no fixed thresholds, but 8.1% was already deemed sufficient in case law. In general, the threshold for protection is deemed much higher for well-known marks than for marks with a reputation. The Polish Group notes that a mark is generally considered well-known if it is recognized by at least 50% of potential clients, is known in most of the country and has been present on the market for a longer period of time.

Also in Korea the relevant public is the relevant sector of the public; a different degree of recognition is required however for "well-known marks", "famous marks", "marks with a reputation" and "marks known to consumers inside or outside the Republic of Korea", and "marks known to consumers", respectively.

In Russia, the law does not define the relevant public but in the context of determining the degree of knowledge of a mark, the relevant consumers may be questioned.

#### Countries where (also) "public at large" is mentioned

In Argentina, case law concerning well-known marks states that such a mark must be known by the public at large. There is no case law regarding the interpretation of art. 16(2) TRIPs.

In Australia, several terms are used. For "marks with notorious ubiquity" the relevant public is the general public at large, for "well-known marks" it is the relevant sector of the public and for "marks with a reputation in Australia" the reputation must be proved in respect of particular goods and services for which the mark is to be registered.

In Brazil, for highly reputed (or renowned) trademarks, the relevant public is the public at large, while for well-known trademarks it is the consuming public or potential customers of the product or service at issue (thus not the public in general, but the class of consumers in that specific segment).

The Chinese Group reports that there are "common trademarks", "marks with a certain influence" and "well-known marks". In each case the relevant public is the relevant sector of the public, but the level of recognition required is different (regarding the marks mentioned: in increasing order).

The Egyptian Group notes that the case law is split, but that the recent trend is to require recognition by the relevant sector of the public only.

In Japan, there is no legal definition of the "relevant public" and the term is construed based on the purport of each applicable provision. In respect of most (but not all) provisions, this means that it is the relevant sector of the public. In general a famous mark has a higher degree of recognition than a well-known mark.

In Mexico, for well-known (notorious) marks the relevant public is the relevant sector and for famous marks it is the public at large. A famous mark must be registered, for which the provision of information is required, including among other things information on the sector of the public consisting of the actual and potential consumers who identify the trademark with the goods or services covered by the mark (based on a market survey or other means permitted by law).

In Portugal, the relevant public for well-known marks is the general public, while for marks with a reputation it is a limited sector of the public (namely the sector related to the market of the particular goods or services). In Spain, it is the other way around: the relevant public for well-known marks ("*marca notoria*") is the relevant sector of the public for which the goods or services are intended, while for reputed trademarks ("*marca renombrada*") it is the general public at large. The Spanish Group notes that the protection increases with the degree of recognition in the pertinent sector or in other sectors. It moreover notes that the terms used do not coincide with those used in the European Trademark Directive.

In South Africa, the relevant public is not defined but the South African Group reports that it can be assumed that knowledge among the general public is not required.

In Sweden, if a trademark is known to the general public at large, no proof is needed to support the fact that the trademark has extended protection.

In Swiss law, three different "levels" are known. "Famous marks" should be known by the general public at large throughout the entire territory of Switzerland. In order to qualify as "well-known" the mark should be recognized in at least one of the relevant sectors of public and in the entire territory of Switzerland whereas the relevant public for the purposes of qualifying a mark as "reputed" a limited niche market in parts of Switzerland can be sufficient in cases based on unfair competition law.

In Turkey, for famous marks the relevant public is the general public at large. For well-known marks it is the target consumer group of the relevant goods and/or service at issue and for marks with a reputation knowledge by a limited public in the relevant sector is sufficient.

In the USA, a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of the goods or services of the mark's owner. For well-known marks, the relevant public is a limited sector of the public, consisting of those consuming or dealing with the particular goods or services in question.

**2) Please clarify whether your jurisdiction uses several of the terms discussed in sections 22-26. If so, is the "relevant public" construed differently when determining the recognition of famous marks, well-known marks and marks with reputation respectively (and, if applicable, marks subject to another term)? Is the assessment made based on the same criteria?**

Most countries (Finland and Japan being exceptions) report that they use the term "well-known mark". Several Groups indicate that they consider this term equal to another term: in Egypt this is "famous", in Switzerland, Mexico and Germany this is "notorious", in Romania "famous" and "notorious" and in Sweden "has a reputation".

The term "trademark with a reputation" or "reputed trademark" is moreover used in the EU member states (although Romania reports that it is not defined in its national law) and Switzerland (although it is not a technical term).

The term "famous mark" is used in Egypt, Hungary, Japan, the Republic of Korea, Mexico, Romania, Switzerland, Turkey and the USA. In Canada both "famous" and "well-known" marks are used but the criteria are generally the same.

Australian trademark law recognises marks with "notorious ubiquity", "well-known marks" and "marks with a reputation in Australia". In Sweden, the courts sometimes state that a term is "notoriously known" if it is known by the general public at large.

In Brazil, apart from the term well-known trademarks, also the term "highly reputed (or renowned) trademarks" is used.

The Korean Trademark Act contains four articles that require a certain (and each time different) degree of recognition of the trademark. The report mentions a "well-known mark", a "famous mark", a "mark with a reputation" and a "mark that is known to consumers inside or outside the Republic of Korea". In addition, the Unfair Competition Prevention Act refers to a "mark which is known to consumers".

The Japanese Group reports that answering this question is difficult because the terms used in Japanese legal texts and the concepts included in them do not clearly correspond with the terms mentioned in the Working Guidelines. In general, the terms used in legal texts are "widely recognized marks" and "famous marks", while scholars use the terms "well-known" and "famous" (both these terms can be used to refer to "widely recognized marks"). The terms are used in many provisions of the Trademark Act and the Unfair Competition Act and are construed based on the purport or aim of each provision.

In Switzerland also some other terms are used, but only occasionally and not consistently.

For the definition/construction/assessment of the relevant public, reference is made to that stated under I.1.

**3) If the relevant public can be a limited sector of the public please respond (if applicable with reference to statutory provisions and/or case law) to the following questions.**

**a) Please briefly describe the criteria for determining the relevant public. Is consideration taken e.g. to age, gender, geography, culture, groups with special interests, sophistication/skill of the consumer? Is consideration taken to the way the goods or services with the trademark in question are marketed?**

The Groups generally respond that all these factors can indeed be relevant, but that in each case the criteria applied will depend on the goods and/or services at issue.

The EU member states mostly refer to the *General Motors/Yplon* decision, pursuant to which the public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark (and thus, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector). The degree of knowledge required is reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark. In this respect, all the relevant facts of the case must be taken into account (in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.).

Territorially, the condition is fulfilled when a trade mark has a reputation in a substantial part of the territory of a Member State.

The French Group notes that courts have applied the following criteria for determining the relevant public: (i) the professional destination of the products or services, (ii) interest in a particular sector, (iii) the nature of the products, (iv) the technical level of the products, (v) sex, (vi) age, (vii) geographical location, (viii) purchasing power and (ix) the manner in which the goods/services are sold.

The Japanese Group reports that nationwide recognition is required when acquired distinctiveness, a famous trademark or dilution of a famous indication is at issue. In relation to a trademark that is identical or similar to a well-known trademark and used for unfair purposes, recognition among Japanese but also foreign consumers is considered. Also methods of selling goods or services associated with the trademark in question are considered.

In Korea, age and gender can be considered in determining the relevant public when those are related to the main consumer group of the goods/services covered by the mark in question. Geography and how the goods are marketed are usually not considered.

In Mexico, when setting up a market survey (which constitutes important evidence) age, culture, gender and special interests of the real and potential consumers and other sectors of the public associated with the trademark will be considered, as well as how the products or services are offered or delivered.

The Russian Group notes that, when an opinion poll is conducted, for consumer goods usually the "average" consumer will be interviewed, while for products for industrial purposes experts (consumers of the type of goods such as manufacturers and traders) will be interviewed.

***b) Would the relevant public be populated by actual/potential consumers/buyers of the products/services in question only or a larger public? Please explain how the delimitation is made.***

Many Groups respond that the relevant public will consist of actual as well as potential consumers and buyers. In addition, many add that depending on the goods and services concerned others will be included.

The Australian Group notes that regarding a mark with notorious ubiquity the relevant public is the general public, but regard will be had to the mark's reputation in relation to the particular goods and services for which it is used. When assessing whether a mark has acquired a reputation, case law refers to a substantial number of people (but a niche reputation may suffice). Passing off requires a reputation among consumers of the goods and services at issue.

The Austrian Group notes that there is no case law on this but that potential customers should be the key group of the relevant public, while people who do not deal with the goods/services in question at issue should be eliminated.

The Belgian Group notes that case law does not provide for a clear solution for well-known marks. The French Group notes that some decisions refer to a wider public that also includes a public "interested" in relevant sector. In South Africa, the relevant public is populated by the persons "interested" in the goods or services.

In China, the relevant public is populated by a larger public than actual and potential consumers and buyers, in particular also operators who manufacture the goods or provide the services, and the marketing people involved.

The Canadian Group reports that although the relevant public is determined on a case by case basis, in general only it appears that only current and potential customers will be considered to be the relevant public for the purpose for opposition proceedings.

The Dutch Group notes that also the public confronted with the trademark is relevant in the context of reputed marks. For well-known marks this may be more limited (namely the relevant sector), which if interpreted as meaning consumers and potential consumers only (on which there is no clear established case law) seems at odds with the (*vis-à-vis* the Community Trade Mark Regulation) larger scope of protection under the Paris Convention.

The Hungarian, Spanish and Portuguese Groups note that the relevant public may, apart from actual and potential consumers, also involve a larger public depending on the characteristics of the goods and services in question. Also the Latvian Group notes that the relevant public is composed of not only actual and potential consumers but also a larger public. The Italian Group notes that the relevant public may in appropriate cases also include the people involved in the trade thereof. The UK Group notes that besides consumers and buyers also those that distribute and otherwise trade in the goods will be included.

In Japan, it will be a larger public unless it concerns a well-known mark.

In Singapore, besides the actual and potential consumers also the persons involved in distribution and the businesses and companies dealing in the goods or services to which the trademark is applied are included in the relevant public. Also in Turkey other groups, such as business circles and those involved in distribution channels, are taken into account

***c) Could the relevant public be composed of business /professional end consumers?***

The Groups generally respond that this can indeed be the case, but it will depend on the goods and/or services at issue.

The Turkish Group states that the relevant public will include, but shall not solely consist of business/professional end consumers.

***d) Could the relevant public be composed of people in the trade of the goods or services in question, such as distributors, licensees and retailers?***

The Groups generally respond that this can indeed be the case, but that it will depend on the goods and/or services at issue.

The Belgian Group notes that they will only be taken into account if they constitute the end-user target group of the products or services in question.

The Dutch Group notes that the relevant public cannot be composed solely of distributors, licensees, retailers etc., as in principle also the public which eventually will be confronted with the trademark is relevant. In Canada the situation appears to be similar. Other Groups note that the relevant public cannot be limited to people in the trade of the goods/services in question and they will often not even be included in the relevant public.

***e) Could the relevant public be "mixed" in a sense that it is composed of persons involved in trade, professional/business end customers and private end customers?***

The Groups generally respond that this can indeed be the case, but that it will depend on the goods and/or services at issue (and see also above, under I.3.d).

***f) How limited in terms of quantification can the relevant sector of the public be to constitute the relevant public? Is there a clear established "lowest level"?***

The National Groups do not establish a quantified "lower level" (see the percentages mentioned for Switzerland, Germany and Poland in respect of well-known marks under I.1 though; and moreover some other groups, in particular the Turkish and Dutch Group, mention examples - but not hard rules - from case law).

As among others the Belgian Group notes, the CJEU *General Motors/Yplon* judgment in fact states that a particular percentage is not required by the European Trademark Directive for reputed marks.

The US Group notes that the question asks about the lowest level of the relevant public, which the Group assumes to be its numerosity, and not the lowest level of recognition. Having said that, there is no clear lower level; it depends on how many consumers there actually are.

***g) Is it possible to see any differences for different products/industry sectors in respect of the delimitation of the relevant public?***

The Groups generally respond that this can indeed be the case, but that it will depend on the goods and/or services at issue.

***4) Are there any differences between the "relevant public" concept when assessing the recognition of trademarks in respect of e.g. dilution, free riding, or when determining likelihood of confusion in infringement proceedings?***

Several countries (e.g. Argentina, Brazil, Canada, Republic of Korea, Philippines, and Turkey) state that this is not the case. Note that this may be different when marks are involved that are not well-known and the above (or similar) grounds are invoked.

The Australian Group states that it is unclear how the relevant public will be determined in the context of well-known marks.

The EU member states point to the average consumer in the context of the assessment of likelihood of confusion. Moreover, with reference to the INTEL judgment of the CJEU, the Belgian Group notes that for dilution or tarnishment the relevant public consists of the average consumers of the products or services for which the earlier mark is registered, while for parasitism it concerns average consumers for which the posterior mark is registered. The German Group notes that for free-riding (parasitism), in addition also the actual/potential buyers constitute the relevant public insofar as the reputation of the older mark is concerned. Several Groups, including the Dutch Group, note that for the assessment of whether or not there is a reputed or well-known mark as such, there is no difference. It seems important to distinguish between the assessment of whether or not there is such a mark and whether or not there is infringement in a particular case (where another public may be involved) - some Groups may have confused these issues.

Also Switzerland and the Singapore Group mentions dilution and taking unfair advantage on the one hand and likelihood of confusion on the other hand.

The Chinese Group notes that there are no specific provisions in laws or regulations on this.

The Japanese Group notes that in relation to (among other things) likelihood of confusion, the relevant public is a relevant sector while in relation to protection against dilution the relevant public is considered a larger public.

The Mexican Group notes that the concept of "relevant public" is not well developed in the Mexican system. It seems that the "relevant public" is usually equivalent to the "consumer public", which characteristics may differ depending on the trademark's elements.

In Russia, there is no "relevant public concept" in respect of dilution, free riding or likelihood of confusion. The relevant public is relevant in respect of conducting opinion polls to investigate whether a trademark is well-known.

The US Group notes that the question seems to go beyond categories of marks that are famous, reputed, etc. The relevant public for famous mark in dilution is the general consuming public. In the case of free riding or determining the issue of likelihood of confusion, it consists of the actual and potential consumers of the particular product or service in issue. In a traditional infringement case, it consists of the purchasers of the defendant's products or services; in a reverse confusion case, it consists of the purchasers of the plaintiff's product or service.

***5) When does the assessment of the relevant public come into play e.g. in registration matters, proceedings in respect of wrongful use such as free riding, dilution, infringement proceedings, and opposition proceedings?***

Most Groups remark that it comes into play in any situation where a party asserts that a mark is well-known, which can in particular be:

- registration/examination (to prove acquired distinctiveness);
- opposition proceedings (either as a requirement for certain grounds (which are in some countries, such as the Benelux countries, more limited than the grounds that can be invoked in cancellation proceedings though), or to prove enhanced distinctiveness);
- infringement/wrongful use and cancellation proceedings (either as a requirement for certain grounds such as dilution, or to prove enhanced distinctiveness) (NB in the Philippines only the owner of a registered mark can file infringement proceedings);
- sometimes also bad faith and/or unfair competition (in particular Bulgaria, Greece, Japan).

Some Groups (e.g. Austria) remark that it is more (or only) relevant in certain matters or proceedings of the above, such as infringement, cancellation or opposition proceedings.

In Russia, it comes into play when an opinion poll to obtain well-known status is conducted.

***6) Is the relevant public determined by a test, a specific procedure or in some similar manner, or rather on a case-by-case basis? Please give a brief description of how the test or analysis is made.***

Almost all Groups reported that the relevant public is determined on a case-by-case basis.

The Greek Group notes that several criteria are used in order to assess the degree of recognition.



The Mexican Group notes that there is no specific procedure and that the relevant public is determined on a case-by-case basis, but that it is often determined through a market survey.

The Singapore Group notes that a distinction is made between marks that are "well-known to any relevant sector of the public in Singapore" and marks that are "well-known to the public at large" (in which respect reference is made to a definition in the applicable act as well as to case law), whereas in respect of trademark infringement and the determination of a likelihood of confusion, the relevant public depends on the facts of the case (and thus need not be the general public).

The South African Group notes that the test is whether the mark is (i) well-known to persons interested in the goods or services and (ii) known to a substantial number of such persons.

The US Group reports that in dilution cases the relevant public is defined by statute as the general consuming public. In cases of well-known marks, it would likely be defined on a case-by-case basis as the sector of the general public that purchases or deals with the goods and service at issue.

## **II. Proposals for harmonisation**

***Is harmonisation desired? If yes, please respond to the following questions.***

The vast majority of the Groups consider harmonization desirable.

The Hungarian Group states that the Hungarian practice is harmonized with the Community legal practice and that the decisions of the Court of Justice of the EU provide guidelines. The Group sees no need for harmonization in the form of legal acts because of this existing process.

The Latvian Group states that currently harmonization is not desired. The Finnish Group expresses scepticism towards harmonisation as the nature and characteristics of each product and its market might vary substantially. Similarly, the Israeli Group says that although harmonisation in principle is desired it is not always achievable. In light of the many differences of factors relevant for determining the relevant public, harmonisation appears impractical.

Two Groups have not responded to the section on harmonisation.

***1) Is it the general public at large or a particular sector of the public that should be considered as the relevant public in determining the knowledge, recognition or fame of a mark?***

Several Groups note that the relevant public should be a particular sector. The relevant public must be assessed with regard to the products or services at hand (and thus the relevant public can, depending on the situation, be the public at large or a smaller section). The Belgian Group notes that the possibility to take into account a larger or rather a more specialized public, depending on the nature of the goods or services designated by the trademark, is appropriate.

The Chinese Group remarks that the relevant public should equal the public at large for consumer goods or services related to daily life, but that for the rest the relevant public should be more limited. The Philippines Group makes a similar remark.

The Canadian Group notes that the general public at large should not be considered the relevant public in determining the recognition or fame of a mark in a niche industry because that would make recognition of the mark dependent on the knowledge of the general public

with the likely consequence that those marks that enjoy fame only in a discrete or niche industry will be forever found to lack the quality of fame.

However, there is also a number of Groups (Argentina, Australia, Greece, Portugal, Singapore) that distinguishes between marks with various degrees of recognition, in which respect the mark with the highest degree (generally referred to as a "well-known mark", or "fame" in the USA) requires recognition among the general public at large whereas for the other recognition (which some groups remark should involve a lower scope of protection, namely only vis-à-vis identical or related goods or services) among a particular sector will suffice.

The Dutch Group notes that for marks with a reputation the relevant public must consist of the relevant sector of the public. For other categories of marks (in particular the well-known) the Dutch Group recommends that it should be further discussed whether the relevant public should be the public at large or the lower threshold of art. 16(2) TRIPs must be applied (in which respect it should be considered that it may be more favorable for owners of well-known trademarks abroad, but also arguably conflicts with the principles of the Dutch registration system especially if the threshold will be the same or even lower than that for registered marks).

The South African Group states that the current test is appropriate for infringement ex art. 6bis Paris Convention, but that a stricter criterion should be introduced for dilution.

The Spanish Group notes that it is important that the criteria for determining whether a trademark is well-known, reputed or famous are harmonized. The Group also notes that there is a certain dysfunction of the Spanish system with other systems such as the Community system.

***2) Please briefly set out the criteria to be used when establishing the relevant public for determining the degree of recognition of famous marks, well-known marks and marks with reputation.***

To the extent specific criteria are mentioned by Groups, such are mostly a repetition of those mentioned in the Working Guidelines under I.3.a, i.e.: age, gender, geography, culture, groups with special interests, sophistication/skill of the consumer, way of marketing of the goods or service.

In addition, several Groups mention additional criteria such as the nature of the goods or services (e.g. type/function/price), channels of advertising and trade are mentioned, income, special needs of customers, educational background, profession and intended professional market.

The Austrian Group takes the position that there should not be a formal distinction between well-known marks, marks with a reputation and famous marks, but rather that the courts should assess the level of protection on a continual graduation.

The French Group emphasizes that the public must be wider than just real or potential buyers; also interest of the sector is relevant.

The German Group notes that the criteria must be determined in the context of the mark at hand, and must in any event cover the specific goods or services covered by the mark, the extent to which the goods or services are advertised to the general public or a specialized public and whether the owner markets in a specialized sector, but claims to be known by the general public.

The UK Group refers to the Joint Recommendation and furthermore notes that consideration must be given to the target market, the goods and services in issue and whether a niche market is involved. Also the Estonian Group notes that criteria provided by the Joint Recommendation could be used for harmonising the criteria to be used for establishing the relevant public.

As also mentioned under II.1, several Groups state that for well-known marks the relevant public should be the general public at large.

**3) Should the relevant public be construed differently for famous marks, well-known marks or marks with a reputation? If so, please define the terms used and describe what criteria is to be used for the different types of marks.**

Several Groups take the position that this should indeed be the case (though some note that it is not so much the public that is constructed differently, but rather the degree or level of recognition required), in particular when the scope of protection differs. See furthermore II.1. Also some Groups state that this should not be the case though.

The Swiss Group notes that claims based on trademarks that are not registered should be reduced to the absolute essential.

**4) Would it be possible or desired to establish a test or a specific method of establishing the relevant public or should this be done on a case-by-case assessment? How should the test or analysis be made?**

Most Groups take the position that the relevant public must be established on a case-by-case basis.

The Egyptian Group notes that mandatory guidelines are preferable but that the assessment must be done on a case-by-case basis. Also the Spanish Group would welcome some guidelines, but no fixed criteria; the Spanish Group moreover suggests establishing (recommended) criteria for market surveys.

In Russia, important evidence in the context of a procedure for recognition of a well-known trademark consists of the results of an opinion poll conducted among consumers. In this respect, the relevant public is established through specific methods; further guidelines may be desirable although this can be difficult given case-specific circumstances.

The South-African Group finds a case-by-case assessment suitable for actions based on art. 6bis Paris Convention, but deems a checklist as proposed in Resolution Q214 under 1(a) appropriate for protection against dilution.

The US Group notes that a mark is famous for dilution purposes if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In other cases, the relevant public must be assessed on a case-by-case basis.

**National Groups are invited to comment on any additional issues concerning the relevant public for determining the degree of recognition of famous marks, well-known marks and marks with reputation that they deem relevant.**

The Brazilian Group remarks that in Brazil, marks with a reputation are not expressly protected under specific legislation, but are recognized in case law. Harmonization would be welcome to provide criteria for protection.

The Japanese Group notes that every country should explicitly provide for the ability to prevent a well-known or famous mark from being registered or used by someone else in a foreign country.

The Spanish Group notes that its analysis and comments were provided in relation to the off-line market. Consideration of the relevant public in the virtual market, which goes beyond territorial borders, must be tackled though. The Spanish Group suggests studying this area in the context of a possible Q234bis.

The UK Group remarks that it would be preferable if legislators and courts internationally would adopt consistent and clear terminology relating to well-known marks etc. Also the Swiss Group notes that harmonisation in terminology is desired as the current situation where various different expressions are used in different countries is not considered as satisfying.

## **II. Conclusions**

Based on the Group reports it is clear that although the term “well-known” is widely used the qualification of well-known marks in different jurisdictions varies a lot. In addition a number of other terms are used to qualify trademarks with an extended protection of some kind, “famous” and “having a reputation/reputed” being two examples but not the only ones. Harmonisation of terminology thus appears challenging for the Working Committee but attempting to at least find a common understanding of a spectrum of notoriety as the basis for the discussions on harmonisation (also referring to AIPPI's prior work such as the Q214 Resolution) may be the most natural way to start because the definition of the relevant public may vary depending on where on the spectrum the mark is located.

As a next step, the relevant public will need to be defined. This can vary depending on the protection afforded. It can for example be the general public at large for the protection of unregistered trademarks, and the relevant sector of the public (which can depending on the goods or services at issue coincide with the general public at large) for the protection of registered trademarks. Moving forward on this point will likely require discussion within the Working Committee given the answers provided by the Groups.

The Working Committee can furthermore consider to discuss criteria that may be used when establishing the relevant public. Such will likely be less controversial given the Groups' references to the criteria mentioned in the Working Guidelines (and in some cases the Joint Recommendation).

As most groups take the position that the relevant public must be established on a case-by-case basis, this will likely also not be a topic for heated discussion.

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