

## QUESTION 100

### **Protection of unregistered but well-known trademarks (Art. 6bis Paris Convention) and protection of highly renown trademarks**

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Q100

Executive Committee of Barcelona, September 30 - October 5, 1990

#### **Question Q100**

#### **Protection of unregistered but well-known trademarks (Art. 6<sup>bis</sup> Paris Convention and protection of highly renowned trademarks**

#### **Resolution**

AIPPI, having considered that

- as a general rule, marks are protected only against use or registration in respect of goods and services which are identical or similar to those for which they are registered or used and in many countries such a protection depends on registration;
- there are marks, however, which deserve a protection which goes beyond the protection described above;
- protection of well-known marks under Art. 6<sup>bis</sup> of the Paris Convention needs to be reviewed in the context of developments in international trade;
- domestic laws often do not provide for sufficient protection of marks which have acquired a reputation;

and having regard to previous resolutions of AIPPI, in particular the Resolution of Berlin in 1963, and to the work undertaken by WIPO adopts the following Resolution:

#### **A) With regard to the question of well-known trademarks (6<sup>bis</sup>)**

To ensure better protection against misappropriation, the protection of well-known marks should conform to the following minimum standards:

- 1) Concept of a well-known mark: A mark which is known to a large part of those involved in the production or trade or use of the goods concerned, and is clearly associated with such goods as coming from a particular source.
- 2) The mark should be well-known in the aforementioned sense in the jurisdiction where protection is sought. However, in deciding whether a mark is well-known, it is right to take into consideration the fact that the mark is well-known internationally.
- 3) No condition of use in the jurisdiction where protection is sought should be required.
- 4) These provisions should apply to service marks *mutatis mutandis*.

#### **B) With regard to marks having a reputation**

- 1) As already stated, trademark law normally gives protection to marks only against use or registration in respect of goods and services which are identical or similar to those for which the mark is registered or used. However, some marks by reason of their reputation have acquired a value not confined to the basic distinguishing function of a mark, so that they should be entitled to protection beyond that scope.
- 2) The owner of such a mark should be able to prevent third parties from taking undue advantage of or causing detriment to the distinctive character or reputation of the mark. The scope of such protection may be dependent upon the nature of the mark and the degree of its reputation. Such protection may be made dependent on registration in the jurisdiction concerned.
- 3) For some marks which have acquired a high reputation in a particular jurisdiction, such that they possess an autonomous attractive power in themselves, protection ought to be given against use or registration for any goods or services without the need to prove any undue advantage or detriment as mentioned above.
- 4) Such marks, to be referred to as "marks having a high reputation" ("*marques de haute renommée*" in French, "*berühmte Marke*" in German) are those which are known to a large part of the public in general and which are of such a nature and repute that there does not appear to be any justification for the use or registration of the mark by others. Since such marks are known to a large part of the public they are also necessarily well known in the sense of chapter A above.
- 5) The protection of marks having a high reputation should apply not only against marks which are identical but also against marks which would be seen clearly to have been derived from the mark concerned.
- 6) The protection of marks having a high reputation should not be dependent upon registration in the jurisdiction concerned.

7) Such greater protection given to marks having a high reputation is to be regarded as exceptional and should be limited to protection against misappropriation by use or registration. Consequently, any registration of such marks should be subject to cancellation on the ground of non-use in the same way as other trade marks; if that were not the case no account would be taken of the possibility of future reduction in the degree of reputation, and such marks could unreasonably inhibit the registration of subsequent marks which are similar but would not be seen clearly as derived from the mark in question.

**C) With regard to trade names and other signs**

- 1) The greater protection given to marks having a high reputation should be applied also to trade names, and other signs identifying businesses, having a high reputation.
- 2) The protection of highly reputed indications of geographical origin may raise different questions and ought to be the subject of further study by AIPPI.

**D) With regard to acts of bad faith**

In many cases, unauthorised use or registration of marks or other signs which are well known or have a reputation is done in bad faith. National courts and legislatures should be particularly concerned to eliminate such acts of bad faith, and the questions as to what constitutes bad faith and what further measures are required should be the subject of further study by AIPPI.

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