

# COMPARATIVE ANALYSIS : Protection of well-known marks in Europe, in the USA and in India



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Ahmedabad, India

# PRESENTATION

- Historical Background
- International rules
- 3 levels of protection
- Not binding

# PRESENTATION

- ⦿ **Historical Background**
- ⦿ International rules
- ⦿ 3 levels of protection
- ⦿ Not binding

# Historical background

- ⦿ Defensive marks
- ⦿ Common law protection through passing off

# Defensive marks

## Definition

Defensive trade mark is a form of trade mark used to prevent trade mark infringement. A defensive trade mark can be applied for by a trade mark owner of a well-known trade mark for goods or services that are not intended to be used by that owner

## Advantages

- Easy to prove that a mark is well-known / famous
- Automatic protection

## Disadvantages

- Protection only against identical marks
- Need to register
- See IPAB order in NIRMA vs NIRMAL (13/09/2013)

# Common Law protection (Passing off)

## Conditions

- Goodwill
- Misrepresentation
- Damage

## Advantages

- Protects the registered and unregistered marks
- Broader protection

## Disadvantages

- Products are playing an important role
- Difficult to meet the requirements

# Historical Background

- ⦿ Systems were not fully efficient
- ⦿ Increasing need to find an efficient way to protect the well-known marks

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# International regulations

- Paris Convention: Article 6bis
- TRIPS Agreement: Article 16 (2) and (3)
- WIPO Recommendation

# Paris Convention

## Article 6bis (1) [*Marks: Well-Known Marks*]

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.

# Paris Convention

## 🎯 Conditions

- A reproduction, an imitation, or a translation  
+ extension if essential part
- Liable to create confusion
- Well-known in that country
- Identical or similar goods

# TRIPS Agreement

## Article 16bis (2)

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 16bis (3)

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.

# WIPO Recommendation

## ○ Definition / List of Criteria (Article 2)

- the degree of knowledge or recognition of the mark in the relevant sector of the public;
- the duration, extent and geographical area of any use of the mark;
- the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
- the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
- the value associated with the mark;
- Consumer;
- Channel of distribution;
- Business circles dealing with the product;
- ~~Registration~~
- ~~Broad recognition~~

→ guide, assist but not binding

# WIPO Recommendation

## 🎯 Scope of protection

### ➤ Bad faith (Article 3)

### ➤ Conflicts covered (Article 4)

#### 🎯 (1) Identical / Similar products

#### 🎯 (2) Different products: 3 tests

- (i) the use of that mark would indicate a connection between the goods and/or services for which the mark is used, is the subject of an application for registration, or is registered, and the owner of the well-known mark, and would be likely to damage his interests;
- (ii) the use of that mark is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark;
- (iii) the use of that mark would take unfair advantage of the distinctive character of the well-known mark.

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# 3 Levels of Protection for Well-known TM

## ① Unregistered marks for similar products

- Identical / Similar marks
- Similar products
- Likelihood of confusion

## ② Registered marks regardless of the products / services

- Identical / Similar marks
- Different products
- Different tests:
  - ④ Likelihood of taking unfair advantage of the repute of the mark (EU/IN)
  - ④ Likelihood of connection (EU/IN)
  - ④ Likelihood of being detrimental to the repute of the mark (EU/IN/USA)
  - ④ Likelihood to cause dilution (USA/IN)

## ③ Unregistered marks regardless of the products / services

- Level 2 for unregistered marks



# 3 levels of protection

## ⦿ Principle

- Level 2 in Europe, USA and India

## ⦿ Exceptions

### ➤ Europe

- ⦿ EU legislation grants level 2 (connection + detrimental)

- ⦿ Some national legislations grant level 3:

- Denmark
- Slovakia
- Latvia

### ➤ India

- ⦿ Mix of the different tests in level 2 (dilution, connection detrimental)

- ⦿ Similarity of products taken into consideration (ex: Official list, NIRMA)

- ⦿ Honest concurrent use

# 3 levels of protections

## ⦿ Exception

### ➤ USA

- ⦿ Before 2009: Dilution only for “identical or nearly identical” marks
- ⦿ Since 2009: Decisions recognizing a broader scope
  - Levi Straus & Co. v. Abercrombie & Fitch Trading Co., 633 F.3d 1158 (9th Cir. 2011)
  - Starbucks Corp. v. Wolfe's Borough Coffee, Inc., 588 F.3d 97 (2nd Cir. 2009)
  - Nike, Inc. v. Maher, 100 USPQ2d 1018 (TTAB 2011)

# 3 levels of protection

- Progressing
- Still not harmonized
- Level 2 should be a minimum for each country

# PRESENTATION

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# Not binding

## 🕒 Principle

- **Factors are not compulsory**
  - Case-by-case analysis: same marks, different results
    - 🕒 Between the different systems
    - 🕒 Inside a country or even a court
  - Well-known in relation to some products/services
- Not binding, no automatic protection

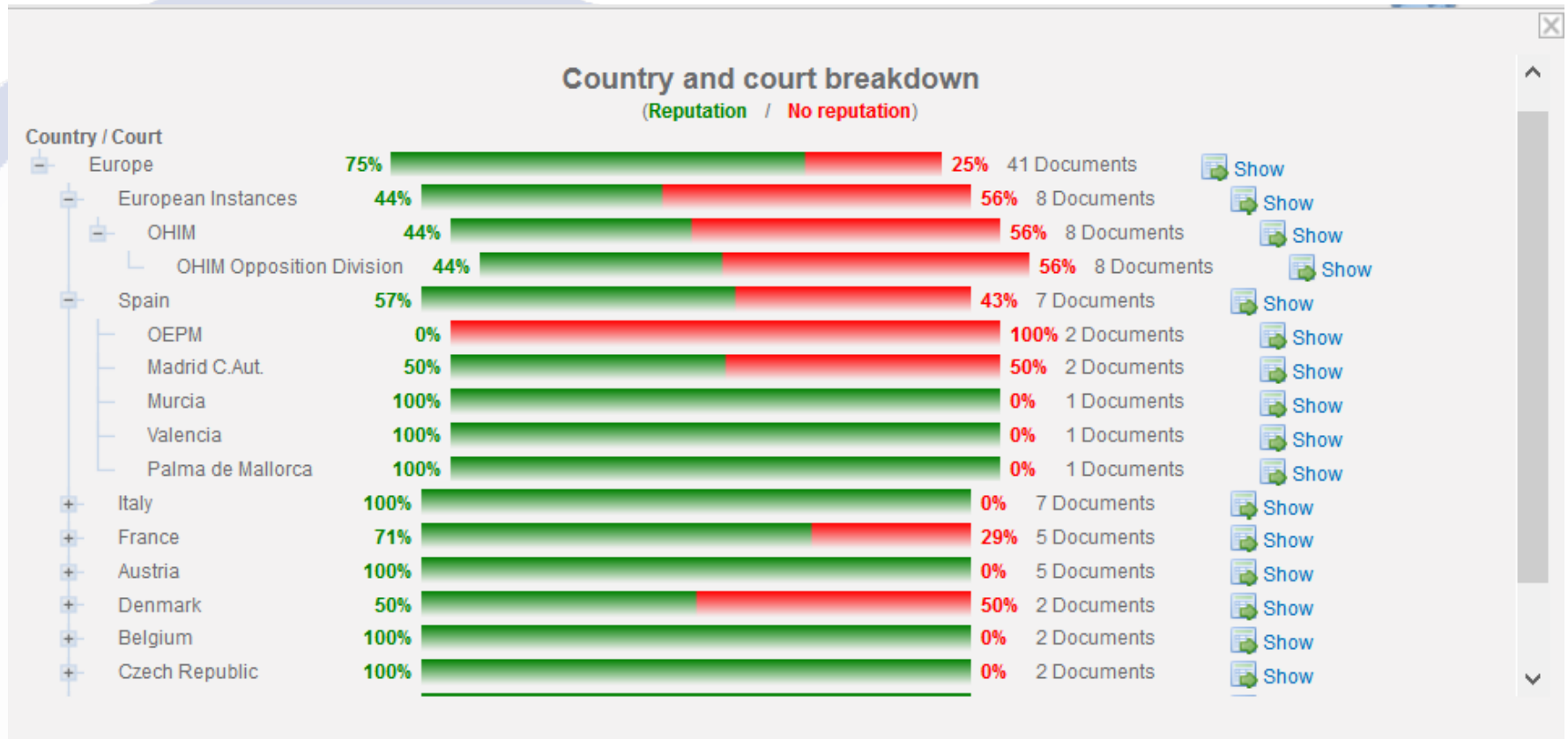
# Not binding

## 🕒 Principle

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# Mark "BOSS" in Europe

Source: www.darts-ip.com



# Not binding

## 🎯 Principle

- Factors are not compulsory
  - Case-by-case analysis: same marks, different results
    - 🎯 Between the different systems
    - 🎯 Inside a country or even a court
  - **Well-know in relation to some products/services**
- Not binding, no automatic protection



# Well-known in relation to some products / services

<http://ipindiaservices.gov.in/tmrpublicsearch/wellknownmarks.aspx>

- 7 O'CLOCK for shaving razors
- AIWA
- BAJAJ
- BATA& BATA FOAM for footwear
- BENZ
- BISLERI
- CARREFOUR
- CARTIER for wide variety of goods including jewellery, watches, perfumes etc.
- CATERPILLAR
- CHARLIE
- DR.REDDY In respect of pharmaceutical products.
- DUNHILL
- ENFIELD BULLET
- EVIAN Mineral Water
- FEDDERS For air conditioners
- WHIRLPOOL For electrical goods
- GLAXO
- HAYWARDS 5000 For alcoholic
- HOLIDAY INN
- HONDA
- HONDA For motor cycles, motor cars etc.
- HORLICKS For food products, malted biscuits, toffees
- Hamdard
- INTIMATE
- Infosys
- Intel
- KANGARO
- KIT KAT
- LETTER\*T IN A CIRCLE House mark
- Logo \*M' in the distinctive style and design of the famous golden arches
- MAHINDRA& MAHINDRA
- MARS for chocolates, confectionery etc.
- NIRMA See also Sl.No.32
- NIRMA for washing & cleaning preparations
- NIVEA
- ODONIL & ODOMOS For mosquito repellants
- OMEGA
- PANADOL & PANADOL EXTRA
- PEPSI
- PHILIPS
- PIZZA HUT Logo in respect business relating to restaurants
- PLAYBOY for magazine and several other goods
- RED BULL
- REVLON
- TACO BELL for Restaurant business
- TATA SEE also TATA CASE
- TELCO
- TOSHIBA
- USHA For sewing machines, electric fans etc.
- VICKS VAPO RUB
- VOLVO for automobiles
- WHIRLPOOL
- WOOLWORTH In respect of clothing etc.
- Yahoo
- Polo (label with device of polo player)
- GE Monogram

# Not binding

## 🎯 Principle

- Factors are not compulsory → Trends by country?
  - Case-by-case analysis: same marks, different results
    - 🎯 Between the different systems
    - 🎯 Inside a country or even a court
  - Well-know in relation to some products/services
- ➔ **Not binding, no automatic protection even if there are some TRENDS**

# Trends by Area

## EU

- 7642 decisions
- 55% recognizing reputation

## USA

- 482 decisions
- 60% recognizing reputation

## Commonwealth (including India)

- 1236 decisions
- 51% recognizing reputation

## India

- 274 decisions
- 86% recognizing reputation

# Not binding: Solutions?

## India

### ➤ Article 11(8) Trademark Act:

Where a trade mark has been determined to be well-known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.






→ Court and Registrar decisions are binding for registration matters

# Not binding: Solutions?

- ⦿ Need to guarantee an automatic protection
- ⦿ Need to inform the future applicants
- ⦿ Well-Known in relation to certain products/services
  - Non-sense
  - Why not a list by area?

# List: Europe








4407 document(s) found

Reference	Date	Parties	Trade marks	Graphical representation	Court (Country/Instance) Level First action type Document type	Available languages Classes Points of Law
de-102_O_68_13 (TM+DM) (1380914:1388192:1899664)	24-09-2013	Coty Germany vs. Chadli Barnat United Business Company International Berlin France Parfums International	JOOP! Cašmir Pamir (Fig.) JOB Homme (Fig.)		LG Berlin (Germany) First instance Infringement Action Main proceedings (Substantive decisions)	View document in: <a href="#">de</a> 03 <a href="#">Points of Law</a>
C-000007486 (TM) (1383443:1390794:1902687)	16-09-2013	Red Bull vs. Jiří Beneš	RED BULL vs. RED WOLF (Fig.)		OHIM Cancellation Division (European Instances) First instance Cancellation proceedings / Invalidity Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 05 32 33 <a href="#">Points of Law</a>
cz-O-489081 (TM) (1391301:1398793:1910985)	12-09-2013	Monster Energy Company vs. LARGE LIFE LIMITED	MONSTER MONSTER RAW MONSTER PROTEIN MONSTER MUSCLE vs. MONSTER BEEF		Úrad Průmyslového Vlastnictví (Czech Republic) Appeal Opposition Action Main proceedings (Substantive decisions)	View document in: <a href="#">cs</a> 05 29 30 32 33 <a href="#">Points of Law</a>
C-000007015 (TM) (1383438:1390789:1902682)	09-09-2013	Toupret vs. Topcret Tecnología EN Revestimientos	TOUPRET vs. TOPCRET		OHIM Cancellation Division (European Instances) First instance Cancellation proceedings / Invalidity Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 02 19 37 <a href="#">Points of Law</a>
002114679 (TM) (1364629:1371795:1881828)	05-09-2013	AUTOMOBILE CLUB DE L'OUËST (ACO) vs. Bodum Außenhandels	24 HEURES DU MANS (Fig.) 24 HEURES vs. 24h Comfort (Fig.)		OHIM Opposition Division (European Instances) First instance Opposition Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 25 <a href="#">Points of Law</a>
001662314 (TM) (1364474:1371637:1881667) P	03-09-2013	Formula One Licensing vs. Miguel López Díaz-Rivavelarde	F1 (Fig.) F1 F1 Formula 1 (Fig.) vs. marko-F1 (Fig.)		OHIM Opposition Division (European Instances) First instance Opposition Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 35 41 42 <a href="#">Points of Law</a>
C-000006858 (TM) (1376326:1383581:1894405)	29-08-2013	Shimano vs. AWA-SHIMA EUROPE	SHIMANO (Fig.) vs. AWA-SHIMA SPI		OHIM Cancellation Division (European Instances) First instance Cancellation proceedings / Invalidity Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 09 22 25 28 <a href="#">Points of Law</a>
002050014 (TM) (1364566:1371730:1881760)						View document in: <a href="#">en</a>

# List: Commonwealth

642 document(s) found










No stats, why?

Reference Date Other references	Parties	Trade marks	Graphical representation	Court (Country/Instance) Level First action type Document type	Available languages Classes Points of Law
in-ipab-206-2013 (TM) (1382541:1389936:1901743) P 20-09-2013 TA/138/2003/TM/DEL	Sharp vs. Sunil Grover	SHARP vs. SHARP		Intellectual Property Appellate Board (IPAB) (India) Appeal Opposition Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 09 <a href="#">Points of Law</a>
au-atmo-2013-67 (TM) (1374961:1382251:1892943) 27-08-2013 Mobileciti Pty Ltd v Glotech Services Limited [2013] ATMO 67	Mobileciti vs. Glotech Services	Mobileciti (Fig.) vs. Mobicity (Fig.)	 vs. 	IP Australia (Australia) First instance Opposition Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 35 <a href="#">Points of Law</a>
in-delhc-CS-157-2010-20130819 (TM) (1338937:1342219:1850376) 19-08-2013 CS(OS) 157/2010	Easygroup Ip Licensing vs. EASYJET AVIATION SERVICES	easyJet vs. EasyJet Aviation Services		Delhi High Court (India) First instance Infringement Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 39 <a href="#">Points of Law</a>
au-atmo-2013-62 (TM) (1374956:1382246:1892938) 12-08-2013 Moroccanoil Israel Ltd v Karan Gogna [2013] ATMO 62	Moroccanoil Israel vs. Karan Gogna	Moroccan Oil (Fig.) Moroccanoil (Fig.) Moroccanoil vs. Moroccan Magic	 	IP Australia (Australia) First instance Opposition Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 03 <a href="#">Points of Law</a>
au-atmo-2013-58 (TM) (1317311:1319633:1826177) 24-07-2013 eBay Inc. v Tradiebay Pty. Limited [2013] ATMO 58	Ebay vs. Tradiebay	Anonymous vs. TRADIEBAY		IP Australia (Australia) First instance Opposition Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 16 35 <a href="#">Points of Law</a>
in-ipab-153-2013 (TM) (1302815:1304694:1809951) 12-07-2013 ORA/205/2009/TM/AMD	Mahesh Chand Dinesh Kumar vs. Mahesh Chand Dinesh Kumar	DINESHKUMAR BIDIWALA (Fig.) vs. Taj bidi (Fig.)	 vs. 	Intellectual Property Appellate Board (IPAB) (India) First instance Cancellation proceedings / Invalidation Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 34 <a href="#">Points of Law</a>
au-atmo-2013-54 (TM) (1317307:1319629:1826173) 09-07-2013 FoodPLUS GmbH v George Sokol [2013] ATMO 54	FoodPLUS vs. George Sokol	GLOBAL.G.A.P. (Colour) vs. GLOBAL GAS		IP Australia (Australia) First instance Opposition Action Main proceedings (Substantive decisions)	View document in: <a href="#">en</a> 33 35 41 42 <a href="#">Points of Law</a>

# List: United States

291 document(s) found

No stats, why?










Reference Date Other references	Parties	Trade marks	Graphical representation	Court (Country/Instance) Level First action type Document type	Available languages Classes Points of Law
CPC Props., Inc. v. Dominic, Inc. fcgd130821461_20130820 (Pennsylvania Eastern District Court 2013) (TM) (1342815:856557:1357775) 20-08-2013 12-4405 12-cv-04405	CPC Properties vs. Dominic	CRAB FRIES vs. Fries (Fig.)	crab (image not available)	Pennsylvania Eastern District Court (United States) First instance Infringement Action Main proceedings (Substantive decisions)	View document in: en 29 <a href="#">Points of Law</a>
Gen. Motors, LLC v. Rapp Chevrolet, Inc. fcgd130522350_20130521 (South Dakota District Court 2013) (TM) (1105563:1107669:1612285) 21-05-2013 12-4209 12-cv-04209 CIV 12-4209-RAL	General Motors vs. Rapp Chevrolet	Chevrolet vs. Chevrolet		South Dakota District Court (United States) First instance Infringement Action Main proceedings (Substantive decisions)	View document in: en 35 <a href="#">Points of Law</a>
Nordstrom, Inc. v. Nomorerack Retail Grp., Inc. fcgd130325C63_20130325 (Washington Eastern District Court 2013) (TM) (879908:886270:1388714) 25-03-2013 12-1853 12-cv-01853 CASE NO. C12-1853-RSM	Nihc Nordstrom vs. Nomorerack Retail Group Nomorerack.com	NORDSTROM RACK NORDSTROM RACK RACK THE RACK (Fig.) vs. NOMORERACK		Washington Eastern District Court (United States) First instance Infringement Action Preliminary proceedings	View document in: en 35 42 <a href="#">Points of Law</a>
Am. Auto. Ass'n, Inc. v. Lodge fcgd121218231_20121218 (California Eastern District Court 2012) (TM) (780572:732261:1276253) 18-12-2012 12-cv-00854 1:12-cv-0854 LJO-BAM	American Automobile Association vs. OAKHURST LODGE Anonymous	AAA vs. AAA		California Eastern District Court (United States) First instance Infringement Action Main proceedings (Substantive decisions)	View document in: en 12 <a href="#">Points of Law</a>
fcgd121127A83_20121127 (Tennessee Eastern District Court 2012) (TM) (765451:717140:1260347) 27-11-2012 11-cv-00092 fcgd121127A83_20121127(765451)	Ford Motor vs. Anonymous HERITAGE MANAGEMENT GROUP	FORD (Fig.) FORD (Fig.) (Fig.) MOTORCRAFT vs. Anonymous	  	Tennessee Eastern District Court (United States) First instance Infringement Action Main proceedings (Substantive decisions)	View document in: en 01 02 03 04 06 07 09 11 12 17 27 34 <a href="#">Points of Law</a>
Coach, Inc. v. Sac A Main fcgd121107253_20121106 (California Eastern District Court 2012) (TM) (746953:698648:1241256) 06-11-2012 12-cv-00840 CASE NO. 1:12-cv-00840-LJO-SMS		CC CC CC CC (Fig.) CC CC CC CC (Fig.) C (Fig.) COACH CC (Fig.) CC (Fig.)	    	California Eastern District Court (United States) First instance Infringement Action Main proceedings (Substantive decisions)	View document in: en 04 06 09 14 16 18 20 24 25 35 <a href="#">Points of Law</a>



# List: China

758 document(s) found

No stats, why?

Reference Date Other references	Parties	Trade marks	Graphical representation	Court (Country/Instance) Level First action type Document type	Available languages Classes Points of Law
cn-(2013)高行终字第956号 (TM) (1401169:1408942:1921584) 12-09-2013	LOTTE (罗蒂) [Ex officio] Lotte Aluminium (乐天铝业) vs. 梁兆东	LOTTE 乐天 vs. 乐天		Beijing High Court (China) Appeal Opposition Action Main proceedings (Substantive decisions)	View document in: zh 11 30 35 37 <a href="#">Points of Law</a>
cn-(2013)高行终字第480号 (TM) (1323020:1325328:1832562) P 20-06-2013	圣象集团 vs. 刘洪祥	圣象 (Fig.) vs. 圣象 SHENGXIANG		Beijing High Court (China) Appeal Opposition Action Main proceedings (Substantive decisions)	View document in: zh 19 25 <a href="#">Points of Law</a>
cn-(2013)一中知行初字第551号 (TM) (1320500:1322811:1829530) 19-06-2013	内蒙古塞飞亚集团 vs. 北京丰民同和国际农业科技发展	塞飞亚 (Fig.) vs. 塞飞亚		Beijing First Intermediate Court (China) First instance Opposition Action Main proceedings (Substantive decisions)	View document in: zh 01 29 <a href="#">Points of Law</a>
cn-(2013)高行终字第27号 (TM) (1323457:1325767:1833077) 19-06-2013	ZIPPO MANUFACTURING (之宝制造) vs. 刘佳	ZIPPO vs. ZIPPO		Beijing High Court (China) Appeal Opposition Action Main proceedings (Substantive decisions)	View document in: zh 04 34 35 <a href="#">Points of Law</a>
cn-(2013)高行终字第634号 (TM) (1323070:1325378:1832612) P ↓ 18-06-2013	Lg (电子) vs. 安徽强力饮料食品	LG (Fig.) vs. 强盛 QIANGLU (Fig.)	 vs. 	Beijing High Court (China) Appeal Opposition Action Main proceedings (Substantive decisions)	View document in: zh 07 09 11 29 <a href="#">Points of Law</a>
cn-(2013)高行终字第626号 (TM) (1323067:1325375:1832609) P ↓ 18-06-2013	Lg (电子) vs. 杨飞	LG (Fig.) vs. 强盛 QIANGLU (Fig.)	 vs. 	Beijing High Court (China) Appeal Opposition Action Main proceedings (Substantive decisions)	View document in: zh 07 09 11 32 <a href="#">Points of Law</a>
cn-(2013)粤高法民三终字第278号 (TM) (1316014:1318318:1879551) P ↓ 13-06-2013	中山华帝燃具 vs. 中山市坂田电器 佛山市顺德区坂田电器实业 葛再辉	华帝 Vantage (Fig.) vs. 华帝		Guangdong High Court (China) Appeal Infringement Action Main proceedings (Substantive decisions)	View document in: zh 07 11 <a href="#">Points of Law</a>
cn-(2013)高行终字第931号 (TM) (1323107:1325415:1832650) 09-06-2013	Daikin Industries (大金工业) vs. 霍一萍	大金 DAIKIN (Fig.) vs. (Fig.)	 vs. 	Beijing High Court (China) Appeal Opposition Action Main proceedings (Substantive decisions)	View document in: zh 09 11 <a href="#">Points of Law</a>

# Thank you

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