

Protecting and managing well-known trademarks

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Well-known international trademarks such as Coca-Cola, Microsoft, IBM and Google surpass the boundary of marks known only in single countries. It is now generally accepted that these well-known marks should be given protection against later registration by third parties – although laws to offer this protection are still being developed. With the right people, processes and technology, well-known marks can be managed to protect the investment in them, and to add strategic and economic value to an organization.

The World Intellectual Property Organization (WIPO) has noted the need to establish criteria for determining whether a trademark is well-known¹. However even when trademarks have the necessary recognition to be deemed well-known, they may not be registered in every country where they are used. If a well-known mark is infringed, or a third party with similar products attempts to register the mark in a country in which it is not already registered, the issuing offices or courts of that country are confronted with complex legal issues.

International protection of well-known trademarks

Well-known marks are protected through implementation of the Paris Convention for the Protection of Industrial Property (1883) as amended (Paris Convention), and Article 16 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)

Paris convention

The need to protect well-known marks was discussed among member countries² of the Paris Convention in the 1920s³, resulting in the Provision of [Article 6 bis](#). The article places its member states under an obligation to reject or cancel the registration, or prohibit the use, of trademarks which are confusingly similar to a well-known mark. This protection only exists for trademarks relating to products, not services. However, countries belonging to the Paris Convention are not prevented from extending the protection to services. The provision of Article 6 bis is considered to be extremely insufficient, and since 1995 WIPO has been advocating the creation of a separate treaty for the protection of well-known and famous trademarks.

TRIPs agreement

[Article 16](#) of the TRIPs agreement is considered to improve on the Article 6 bis of the Paris Convention. Under the terms of the Article:

- well-known trademarks are to be protected for services as well as products. The protection extends beyond just similarity to situations where use of the trademark would indicate a connection between

the product/service and the owner of the well-known trademark, and could cause detriment to the trademark owner

- account must be taken of knowledge of the relevant sector of the public. i.e. the mark needs to be famous in relation to the goods and services where its use is likely to cause confusion

The relationship between TRIPs and the Paris Convention is regulated in [Article 2](#) of TRIPs, which incorporates all substantive provisions of the Paris Convention, and makes these binding on contracting parties who are not members of the Paris Convention.

Defining well-known

There are no particularly helpful definitions of a well-known mark in either Article 6 bis of the Paris Convention or Article 16 of TRIPs. So the interpretation of whether a trademark can be considered well-known is interpreted on an independent, national scale.

In the case of *McDonalds Corporation v Joburger*⁴, the South African courts held that the term *well known* should be tested by reference to whether sufficient people knew the mark well enough to entitle it to protection against deception or confusion: a degree of knowledge similar to that protected by the law of passing off.

The WIPO [Joint Recommendation](#) concerning Provisions on the Protection of Well-Known Marks⁵ was adopted by both the Assembly of the Paris Union for the Protection of Industrial Property, and the General Assembly of WIPO, in September 1999. According to the provision, consideration of a trademark should not be restricted to its degree of prominence amongst relevant consumers in a country, but should also include other parameters. [Article 2](#) of the recommendation states that the following information of relevance when determining whether a mark is well-known in a Member State:

- (1) The degree of knowledge or recognition of the mark in a relevant sector of the public
- (2) The duration, extent and geographical area of any use of the mark
- (3) 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
- (4) The duration and the geographical area of any registrations, and/ or any applications of the mark, to the extent that they reflect use or recognition of the mark
- (5) The record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognised as well known by competent authorities
- (6) The value associated with the mark

Explanatory Notes to the Joint Recommendation state:

'The duration, extent and geographical area of any use of the mark are highly relevant indicators as to the determination whether or not a mark is well known by the relevant sector of the public. Attention is drawn to Article 2 (3) (a) (i), providing that actual use of a mark in the State in which it is to be protected as a well-known mark cannot be required. However, use of the mark in neighbouring territories, in territories in which the same language or languages are spoken, in territories which are covered by the same media (television or printed press) or in territories which have close trade relations may be relevant for establishing the knowledge of that mark in a given state.'

It is possible that well-known marks in one jurisdiction will not be found to be well-known in another. For example, in Australia the trademark Champagne is descriptive merely of an effervescent party drink manufactured by 'methode Champenoise'. In the UK, Champagne means a drink made by 'methode Champenoise' from grapes in the Champagne region of France. The fame of this drink in the UK has enabled representatives of the Champagne Appellation to prevent use of the name Champagne in relation to any drink other than their Champagnes⁶.

The management of well-known trademarks

Protection of well-known trademarks is a key driver of success in the global marketplace. For some organizations this is a colossal task, for example pharmaceutical giant Pfizer has 40,000 live trademarks, including the well known prescription medicines Lipitor and Viagra. Pfizer worked with *Thomson Scientific IP Management Services* to reduce risk, streamline processes and centralize data for its trademark portfolio, helping to ensure that all their trademarks are efficiently registered and maintained, and – crucially – that nothing gets overlooked.

[Learn more about Pfizer's IP management services solution](#)

Summary

The definition and protection of well-known trademarks is still a grey area internationally. Despite general recognition that protection should be given to well-known marks, the national laws implementing the Paris Convention Art 6Bis at present give variable protection depending upon jurisdiction.

References

¹WIPO Memorandum on well-known marks, section I, note 7 supra, at 6

²Currently 140 countries are members of the Paris convention (information from WIPO)

³The term *well-known* was first incorporated into the Paris convention as early as 1925

⁴[McDonalds Corporation v Joburger's Drive-Inn Restaurants and others](#)

⁵WIPO briefing paper

⁶The 'Elderflower Champagne Case' *Tattinger v Allbev Ltd*, (1993) 4 All E.R 75 Court of Appeal