

# INTA Role and Activity in Promoting Protection of Well-Known Marks

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Chair, Famous and Well-Known Marks – Eastern Europe and Central Asia  
Subcommittee, International Trademark Association (INTA)

# Famous and Well-Known Marks

FAMOUS?



H&M



# INTA Role and Activity in Promoting Protection of Well-Known Marks

- About INTA
- INTA activities in promoting WKM protection
- WKM in Eastern Europe and Central Asia

# About INTA

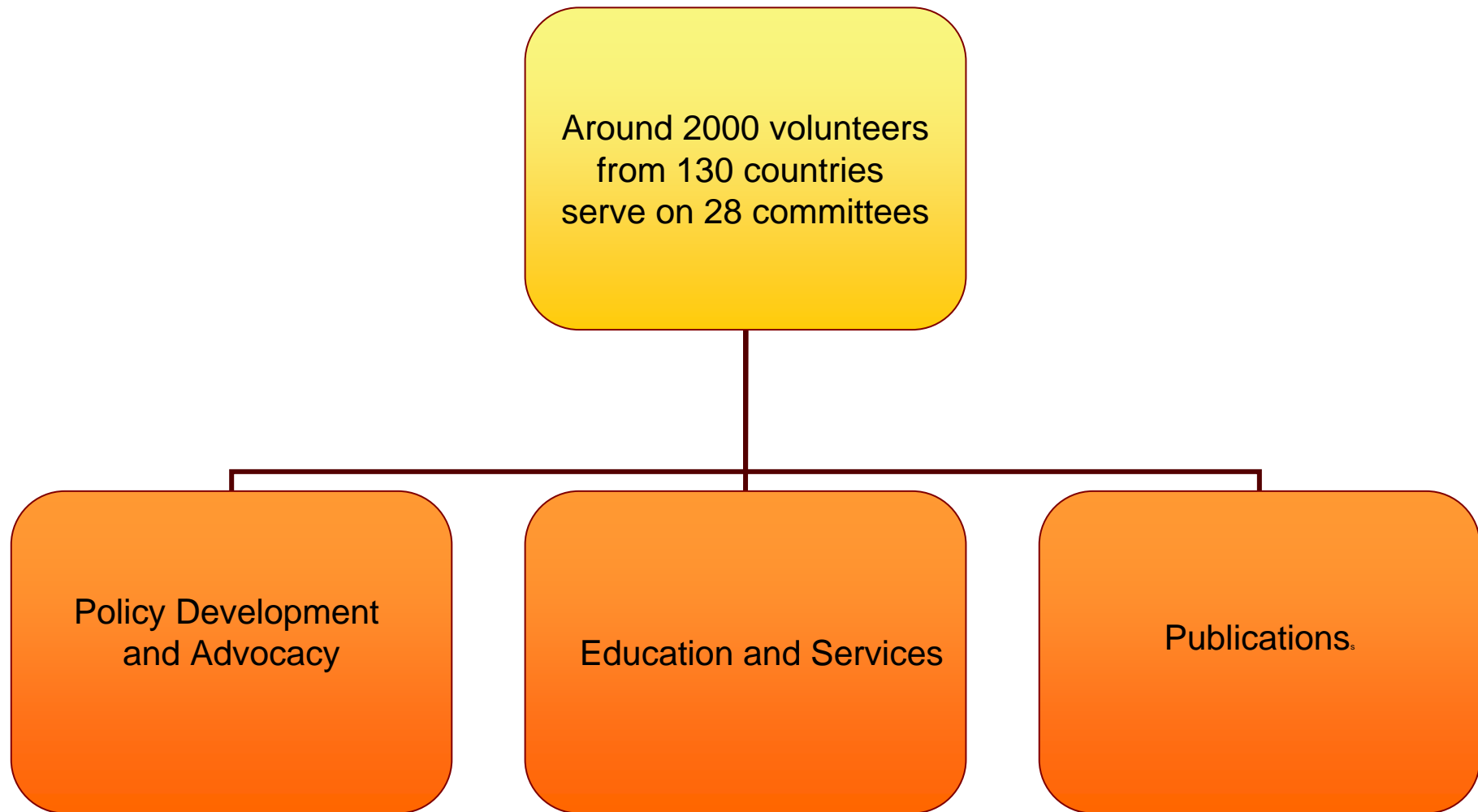
- Association of trademark owners with associated members such as law firms and trademark services firms
- Founded 1878 in New York
- The aim:
  - *to protect and promote the rights of trademark owners,*
  - *to secure useful legislation and*
  - *to give aid and encouragement to all efforts for the advancement and observance of trademark rights.*

# Membership

- Global Presence: New York (HQ), Brussels, Geneva, Shanghai, Mumbai, Washington D.C.
- Over 5,700 Members
- 190 countries
- In Russia:
  - 35 lawyers
  - No trademark owners
  - No professors and students



# Committee Structure



# The FWKM Committee

- Mission: *to evaluate treaties, laws, regulations and procedures relating to the protection of famous and well-known marks*
- Composition: *150 members, among in-house counsels and law firm attorneys from all over the world*
- Divided by region:
  - *East Asia & Pacific*
  - *European Union*
  - *Latin America & Caribbean*
  - *Middle East, Africa & South Asia*
  - *North America*
  - *Eastern Europe & Central Asia*

# INTA Policy

- Expressed in the **RESOLUTIONS** of the Board of Directors
- Prepared by the committees
- [www.inta.org](http://www.inta.org) ⇒ Policy and Advocacy ⇒ Topic Portal ⇒ Board Resolutions

# Board Resolutions

## INTA Board of Directors

President + 36 members

In 2011 – 12 countries represented

- 4 Resolutions regarding WKM
- 2 Resolutions regarding DILUTION

# INTA Board Resolutions

## PROTECTION OF WKM WITHOUT LOCAL REGISTRATION AND USE

if the mark has sufficient local reputation to be considered “well-known”

(Board Resolution 18 September 1996)

# INTA Board Resolutions

## CRITERIA / FACTORS for determining whether mark is WKM

- Amount of recognition of the mark (local and worldwide)
- Degree of inherent or acquired distinctiveness
- Duration of use and advertising (local and worldwide)
- Commercial value attributed to the mark (local and worldwide)
- Geographical scope of use and advertising (local and worldwide)
- Quality image the mark has acquired (local and worldwide)
- Exclusivity of use and registration (local and worldwide)

(Board Resolution 18 September 1996)

# INTA Board Resolutions

## INTA SUPPORTS WIPO Joint Recommendation on WKM

- Factors for determining WKM similar to INTA
- Well-known in relevant sector of the public
- Use and registration not required

(INTA Board Resolution September 15, 1999)

# INTA Board Resolutions

## Conflict with a WKM when:

Goods/services **identical or similar**

+

A mark or its essential element is a reproduction, an imitation, a translation or a transliteration, **liable to create confusion**

# INTA Board Resolutions

## Conflict with a WKM, when:

### Goods/services dissimilar

+

- The use of the mark would indicate a **connection** between the goods/services and the owner of the mark and would likely **damage his interest**  
or
- The use of the mark is likely to **dilute** in an unfair manner the distinctive character of WKM  
or
- The use of the mark would **take unfair advantage of the distinctive character** of the WKM

NOTE: 1) Liable to create confusion not the condition 2) Well-known by the public at large

# INTA Board Resolutions

## WELL-KNOWN MARKS REGISTRIES

### INTA recommends:

- Publication of the purpose and benefits of the registry
- Publication of criteria and procedures to determine whether a mark is WKM
- A 10-year term of registration, with the possibility to renew
- Securing opposition/cancellation procedure for third parties
- Clarity that inclusion in the registry is not a prerequisite for bringing a claim
- Assurance that the right of the trademark owner to seek protection will not be adversely impacted by the fact that its trademark is not included in WKM registry
- Confidential treatment of financial and other sensitive business information
- Adequate training of personnel assigned to examine applications for WKM registration

(INTA Board Resolution of November 9, 2005)

# INTA Board Resolutions

## DILUTION

**Dilution of a famous or well-known mark should be a ground for opposing a trademark application or canceling a trademark registration**

(INTA Board Resolution March 3, 1998)

# INFLUENCING LEGAL PROCESS

- **Governmental cooperation**
  - INTA discussed Madrid Protocol with the Brazilian Government
- **Legislation initiative and analysis**
  - INTA reviewed the proposed Bulgarian Trademark Law and sent comments
- **Judicial intervention**
  - (Amicus Briefs)

# AMICUS BRIEFS

- Matter involving a general principle of the trademark law
- Sufficiently significant to warrant a filing
- Where the filing by INTA is reasonably likely to make a material contribution
- The tribunal specifically requested the view of INTA  
or
- The questions to be addressed directly affect the activities of INTA

# INTA Amicus Brief

## Starbucks Cor. V. Wolfe's Borough Coffee, Inc.

STARBUCK vs. MR. CHARBUCKS coffee

USA Court of Appeals, second Circuit - 2008

**INTA Position:** For a finding of likelihood of dilution, the U.S. Trademark Dilution Revision Act does not require that the marks be very or substantially similar and does not require that the defendant have a bad faith intent to associate its mark with the plaintiff's mark

**Outcome:** The U.S. Second Circuit appeals court agreed with INTA's position on both counts

# INTA Amicus Brief

## Davidoff & Cie S.A. v. N.V. Sumatra Tobacco Trading Company

Davidoff cigarettes

Indonesia Supreme Court 2008

**INTA Position:** INTA argued that use or registration in Indonesia should not be a requirement to determine whether or not the mark was well-known. Two elements should be closely considered: **(i) knowledge of the relevant public and (2) bad faith**

**Outcome:** The Indonesian Supreme Court followed the guidelines advocated by INTA

## Other INTA Activities regarding WKM

### Testimonies and Submissions

- Response to Draft Paper issued by the Supreme People's Court of China regarding interpretation of well-known mark law in Chinese civil trademark infringement cases (2009)

### Reports

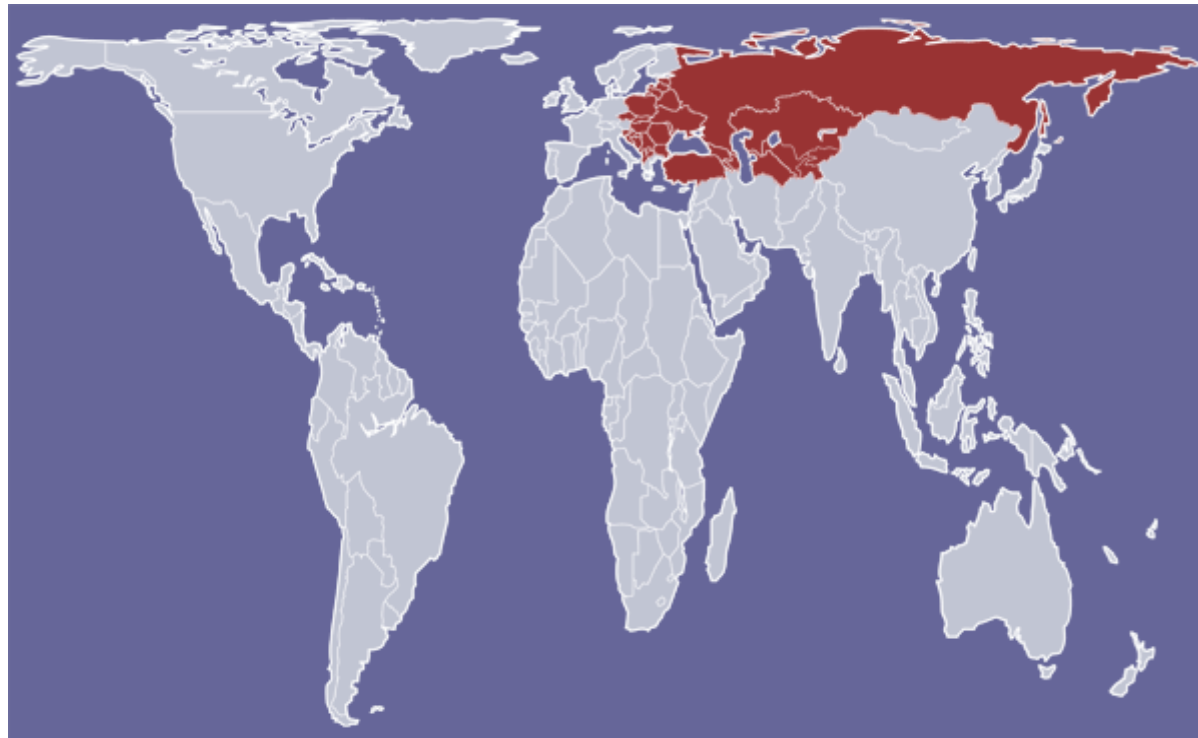
- 2010 report of the North American subcommittee on impact of the Trademark Dilution Revision Act on the treatment of famous trademarks

### Dedicated Topic Portal

[www.inta.org](http://www.inta.org) → Policy and Advocacy → Topic Portal → Famous Marks / Well-known Marks

# WKM in Eastern Europe

Committee analyzed legislation and practice in 18 countries  
**AL,AR,AZ,BY,BA,HR,GE,KZ,KG,MK,MD,ME,RU,RS,TM,UA,UZ**



# Eastern Europe and Central Asia

**Is there a special register of famous / well-known marks**

**?**

**➔ WITH REGISTRY**

RU, BY, KZ, KG, MD, AZ, AR, UZ, TM, TJ, UA

**➔ WITHOUT REGISTRY**

HR, RS, MK, BA, AL, GE

# Eastern Europe and Central Asia

**There is a register**

(RU, BY, KZ, KG, MD, AZ, AR, UZ, TM, UA)



Must one **secure registration** in the special register to assert famous mark status in the context of a trademark office or court litigation

**?**

Yes – except for Ukraine

# Eastern Europe and Central Asia

## There is no special register:

(HR, RS, MK, BA, AL, GE)



In which proceedings can famous mark status be established



- Office Action
- Opposition
- Invalidation
- Infringement action

# Eastern Europe and Central Asia

## Criteria/evidence required to establish famous mark status

?

- Rarely listed in the law
- Sometimes listed in Guidelines or Methodology
- WIPO Joint Recommendations generally apply

# Eastern Europe and Central Asia

Scope of protection: Does a famous mark provide protection for similar goods only, or also for dissimilar goods

?

➔ with respect to registration by a third party

AZ, RU (ex-officio examination) similar goods, others both

➔ with respect to use by a third party

UZ – similar goods, others both

# Eastern Europe and Central Asia

## Some issues and challenges:

- 1) Limited case law and not always published
- 2) High degree of trademark similarity required
- 3) General public vs. relevant public
- 4) Limited scope of protection (only for similar goods)
- 5) Possibility to prevent use, but not registration
- 6) Non-use cancellation
- 7) Conflict with company names
- 8) Options against bad faith registrations
- 9) WKM Registry

# Examples of WKM in Russia

KASPERSKY

*Cartier*

TIFFANY



intel

**NESCAFÉ**

**Heineken**

# Examples of WKM in UKRAINE



ROLEX

GOOGLE

ESCADA

COSMOPOLITAN

YAMAHA

BOUNTY

# Case law

## Russia: AMRO NEVSKOE in IC 29, 30

Invalidation → refused in IC 29, 30

Presidium of the RF Higher Arbitrazh Court



## Case law

# Slovenia: JACK DANIEL'S in IC 25

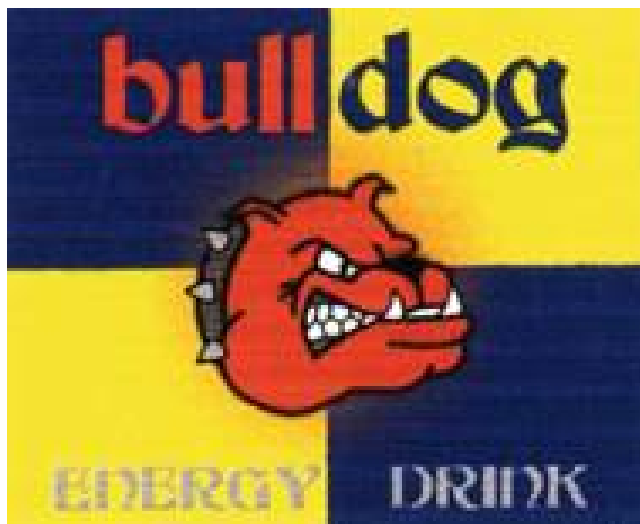
Opposition PTO + Court Litigation



# Case law

## Serbia: RED BULL vs. BULLDOG

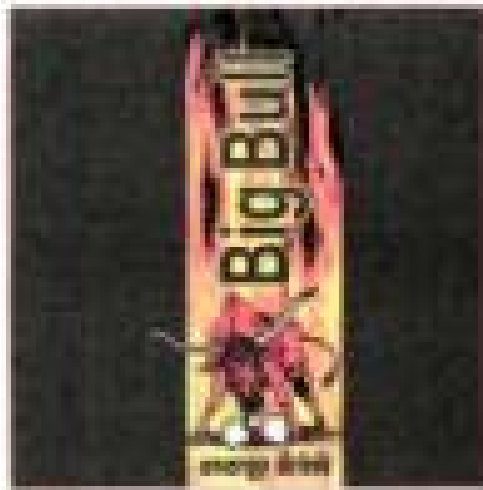
Notice of observation → IR 859936 initially refused for IC 32;  
later invalidated for IC 33 and 43



# Case Law

## Macedonia: RED BULL vs. BIG BULL

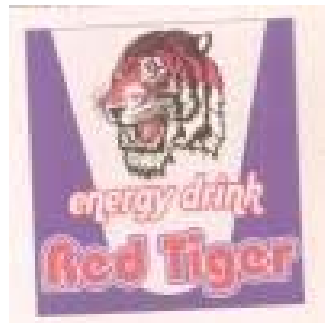
Opposition → PTO refused for energy drinks



# Case Law

## Macedonia: RED BULL vs. RED TIGER

Opposition → PTO refused for energy drinks



# Case Law

## Serbia: TIFFANY in IC 16

IR 501540 notice of observation → PTO refused protection in IC 16



# Case Law

## Croatia: NIKE in IC 3

Opposition IR 652471 → PTO refused in IC 3 (perfumery)



# Case law

## Serbia: VOGUE in IC 14

Notice of observation → PTO refused protection for watches in IC 14



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*Thank you!*

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Moscow

**Cabinet Pavlović**

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