

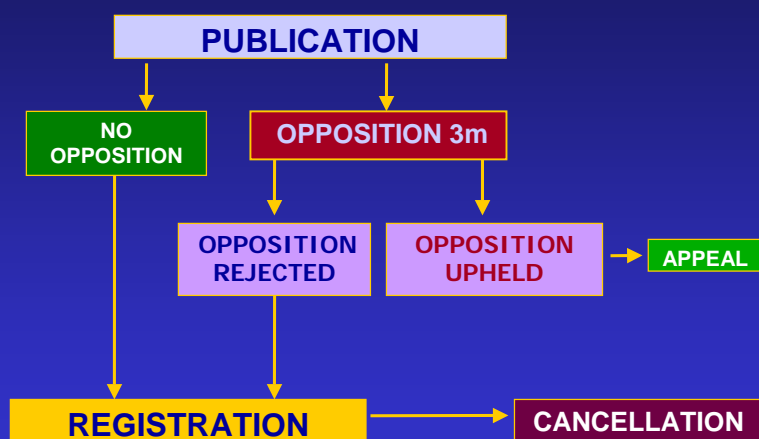


Well-Known & Reputed Trademarks An Overview of OHIM Practice

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Protection of Well-Known & Reputed TMs in the EU OPPOSITION & CANCELLATION





Protection of Well-Known & Reputed TMs in the EU

Relevant Provisions - Notions

Article 8(2)(c) CTMR:

Well-known marks (6 bis PC)

Likelihood of Confusion

Article 8(5) CTMR:

Marks with Reputation

Detriment/Unfair advantage

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Protection of Well-Known & Reputed TMs in the EU

Art 8(2)(c) CTMR

Article 8(2)(c) CTMR Well-known marks

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Protection of Well-Known & Reputed TMs in the EU

WELL-KNOWN MARKS

Art. 8(2)(c) CTMR:

For the purposes of **paragraph 1 [of Article 8]** “earlier trade marks” means marks which, on the date of application of the CTM application are **well-known in a Member State**, in the sense in which the words “**well-known**” are used in **Article 6bis** of the Paris Convention.

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Protection of Well-Known & Reputed TMs in the EU

Article 6 bis (1) PC

“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 trade mark 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.”

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Protection of Well-Known & Reputed TMs in the EU

8(2)(c) CTMR: **Scope of protection**

Reference to Art. 8(1) CTMR:

- Conditions and scope of protection of well-known trade marks:
 - **Against goods identical or similar**
 - **If there is likelihood of confusion**

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WELL-KNOWN: Assessment

OHIM Criteria:

- Degree of knowledge - recognition
- Duration, extent and area of use
- Duration, extent and area of promotion
- Value associated with the mark
- Successful enforcement actions
 - **Very similar to the criteria established by the ECJ in General Motors for reputation (Article 8(5) CTMR)**

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Protection of Well-Known & Reputed TMs in the EU

WELL-KNOWN: Conclusion

Protection of well-known marks in the EU:

- If well known in any Member State
- Even if not registered

Art. 6bis Paris Convention

- Against identical or similar goods
- If there is likelihood of confusion

Art. 8(1) CTM Regulation

- They enjoy enhanced protection:
 - The higher the degree of recognition, the higher the risk of confusion

ECJ in decision "Sabel"



Protection of Well-Known & Reputed TMs in the EU

CANNON FODDER vs. CANNON SPIKE

(Well-known in UK)

(Contested CTMA)

Goods: computer games
Software in cl. 9

Goods: cl. 9, 16 and 28



Article 8(5) CTMR
Marks with reputation



Article 8(5) CTMR:

"... The trade mark applied for shall not be registered, where it is **identical with or similar to the earlier trade mark** and is to be registered for goods or services which are **not similar to those for which the earlier trade mark is registered**, where in the case of an earlier Community trade mark the trade mark has a **reputation in the Community** and, in the case of an earlier national mark, the trade mark has a **reputation in the Member State** concerned and where the **use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark ...**"



Protection of Well-Known & Reputed TMs in the EU

Art. 8(5): Scope of application

- Applies directly to EU, National and international registrations - applications
- Registration or application **formal requirement** unlike in the case of well-known marks
- National registered marks with reputation are protected against later CTM applications **irrespective of whether the national law affords them the same level of protection** (has implemented Article 4(4)(a) TMD or not).

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Protection of Well-Known & Reputed TMs in the EU

Art. 8(5): Requirements

- **Conditions of application:**
 - (1) Earlier mark with **reputation** in the relevant territory
 - (2) Signs **identical** or **similar**
 - (3) Use of CTMA likely to take **unfair advantage** of, or cause **detriment** to, the distinctiveness or repute of the earlier mark
 - (4) Absence of **due cause** by the CTM applicant
 - **Independent, cumulative requirements**
 - **Goods & services dissimilar**

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Protection of Well-Known & Reputed TMs in the EU

Art. 8(5): Evidence of Reputation

Important

Evidence must concern:

- Relevant Trade Mark
- Relevant goods and services
- Relevant territory
- Relevant persons (user)
- Relevant time

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Art. 8(5): Evidence of Reputation

• Means of Evidence (Art. 76 CTMR)

- Sworn or affirmed statements;
- Decisions of National Courts/Authorities;
- Decisions of the Office;
- Opinion polls and market surveys;
- Philanthropic activities;
- Certifications and awards;
- Articles in the press - specialised publications;
- Annual reports - company profiles;
- Invoices and other commercial documents;
- Advertising and promotional material.

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Art. 8(5): Detriment - Unfair advantage (III)

• Forms of Detriment - Unfair advantage:

Alternatively:

- Detriment to distinctiveness (Dilution)
- Detriment to repute (Tarnishing)
- Advantage of distinctiveness (Attractive value)
- Advantage of repute (Quality image)

AG Jacobs in Adidas: Similar categories

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EXAMPLES: Boards of Appeal

R 283/1999-3 (FR)

Earlier Mark

HOLLYWOOD

Chewing gum

CTM application

HOLLYWOOD

Tobacco and smoking articles

- Evidence of high reputation in France
- Special image of youth, freshness, dynamism created by long and widespread advertising
- Detrimental effects of tobacco given

LIKELIHOOD OF TARNISHING

UPHELD

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Protection of Well-Known & Reputed TMs in the EU

EXAMPLES: Opposition Division

OD 3668/2002 (EN)

Earlier Mark

OLYMPIC

Organisation and conduct of sporting events

CTM application

T - - Card - Olympics -

Electronic goods, telecommunications

- Evidence of very high reputation internationally
- Evidence of positive image
- Evidence of very high value and exploitation through sponsoring schemes in similar fields

PROBABILITY OF UNFAIR ADVANTAGE & DETRIMENT

UPHELD

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Protection of Well-Known & Reputed TMs in the EU

EXAMPLES: Opposition Division

OD 81/2000 (EN)

Earlier Mark

OLYMPIC

Organisation and conduct of sporting events

CTM application

Family Club
BELMONT OLYMPIC

Printed matter, advertising, transport, storage of goods

- Evidence of very high reputation internationally
- Evidence of positive image
- Evidence of very high value and exploitation through sponsoring schemes in similar fields

PROBABILITY OF UNFAIR ADVANTAGE & DETRIMENT

UPHELD

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Protection of Well-Known & Reputed TMs in the EU

NASA



vs.

NASA SPORTS INTERNATIONAL

Earlier reputed marks registered
In FR, GB, GR and IT.
(Goods: 9, 12, 16, 18, 25 and 28.)
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Contested CTMA

Services: 41



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Johnson & Johnson vs. JOHNSEN

Earlier UK mark with reputation
In UK

Goods: cl. 9 (contact lenses)

Contested CTMA

Goods: cl.9 and 10



Protection of Well-Known & Reputed TMs in the EU

CTMR: Protection of well-known & reputed marks

"Famous trademarks"



Well-known

NON-REGISTERED

8(2)(c) CTMR

Enhanced protection against similar goods in case of likelihood of confusion

(via Article 8(1)(b) CTMR)

Reputation

REGISTERED

8(1)(b) CTMR

Enhanced protection against similar goods in case of likelihood of confusion

8(5) CTMR

Protection for detriment or unfair advantage also against dissimilar goods

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