



European Communities Trade Mark Association

Antwerp, March 14, 2005

Concern : Position paper on the creation of a special register for well-known trade marks

1. The Law Committee of ECTA has discussed the position paper of AIM¹. AIM has expressed some concerns regarding the introduction of special registers for well-known trade marks in each country. The practically unanimity of the members of the Law Committee share the concerns expressed by AIM and believe that the establishment of special registers for well-known marks raise a number of difficult open questions and have potentially serious pitfalls.
2. Well-known trade marks are recognized in Art. 6^{bis} of the Paris Convention and in Art. 16 (2) of the TRIPS Agreement, even if the trade mark is not registered or used in the specific country. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) of WIPO discussed the protection of well-known trade marks extensively and hereafter the Assembly of the Member States of WIPO adopted in September 1999, a Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

The ECTA Law Committee endorses fully these WIPO Joint Recommendation. It is worthwhile to note that the WIPO Joint Recommendation does not mention the establishment of special registers for well-known marks. The Joint Recommendation provides a non-exhaustive list of criteria for a mark to be well-known. This list is a helpful guideline for national authorities, in particular courts, in their evaluation whether a mark is well-known.

The Community Trade Mark Regulation (Art. 8 (5), Art. 9), as well as the Trade Mark Harmonization Directive (Art. 5 (2)) grants protection for trade marks with repute against the use of identical or similar marks in relation to goods or services which are not similar to the trade mark with repute. Many marks with repute constitute in most cases marks which are well-known. A review of Frederick Mostert's book on Famous and Well-known Marks makes it apparent that the criteria for

¹ Position paper of the Association des Industries des Marques (European Brand Association) of Septembre 2004.

well-known marks are quite different in the countries around the world. It is therefore hoped that more attention is paid to WIPO's Joint Recommendation for well-known marks to harmonize the laws in the Member States of the Paris Union and TRIPS.

3. The establishment of special registers for well-known marks has certainly some advantages, in particular in the area of enforcement of the well-known mark. We also do not believe that the establishment of registers for well-known marks may be perceived to be contrary to Art. 6^{bis} of the Paris Convention. However, there are many unresolved questions in connection with the establishment of such special registers for well-known trade marks. It is, in particular, unclear which criteria will be applied for the registration of a well-known mark and its removal from the register. A register is rather static, while, in fact, the issue whether a mark is well-known can be moving very fast. The mark can quickly become well-known and its notoriety may decrease or even disappear in a fairly short period. It would be hardly possible and very cumbersome to always up-date the special register for well-known marks. There is the danger that courts and trade mark offices rely too much on the register and apply the principles for well-known marks which are registered more or less automatically.

Concern has also been expressed that there is the danger that the mark which has not been registered in the special register for well-known marks is not considered well-known. The existence of a special register may cause pressure on trade mark holders to obtain the registration to avoid negative consequences for the scope of protection of the mark. It is also not clear how burdensome it will be to obtain a registration of a well-known mark and to maintain it on the register. It is quite likely that substantial evidence has to be submitted, involving considerable efforts and costs.

The majority of the members of the Law Committee believe that the enforcement of well-known marks – at least in Europe – without having special registers has not caused serious problems. There seems to be no urgent need for establishing a special register for well-known marks.

WIPO might consider to put the issue of establishing a special register on the agenda of the SCT, where the pros and cons for such a register might be discussed in depth.

Sincerely yours,



Mireia Curell
First Vice President



Dietrich C. Ohlgart
Chairman of the Law Committee