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THE LEGAL PROTECTION OF WELL-KNOWN TRADEMARKS AND TRADEMARKS WITH A REPUTATION: THE TRENDS OF THE LEGAL REGULATION IN THE EU MEMBER STATES¹

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Abstract. *The scope of the legal protection of unregistered well-known trademarks, registered well-known trademarks and registered trademarks with a reputation as well as the “systematic dilemma” regarding the inter-relation between these legal concepts (Paris Convention, Art. 6bis; TRIPS Agreement, Arts. 16(2) and 16(3); Trade Mark Directive, Arts. 4(2)(d), 4(3), 4(4)(a), 5(2); Regulation on the Community Trade Mark, Arts. 8(2)(c), 8(5), 9(1)(c)) has a long history of diverse analyses, debates, and interpretations. This article makes a comparative analysis of the current trends within the EU Member States on the legal protection of unregistered well-known trademarks and registered rights beyond the principle of speciality (well-known or reputed trademarks). The analysis demonstrates that a number of Member States have already found a solution to the “systematic dilemma”, which is outlined in international and the EU laws. The research establishes that a number of Member*

1 This article covers some of the results of the author’s research under the project “Options for harmonisation of the trademark law in the European Community” organised by the Max Planck Institute for Intellectual Property, Competition and Tax Law, Munich, Germany. The author wishes to express her gratitude to the Institute for the generous and friendly support and the possibility to do research on the above mentioned topic.

States, even though protecting registered trademarks beyond the principle of speciality as stated in Art. 16(3) of the TRIPS Agreement, and Arts. 4(3), 4(4)(a), 5(2) of the Trade Mark Directive, also make it possible to protect unregistered well-known trademarks with respect to different goods and (or) services. This study aims to prove that the conditions for this type of protection are the same (or very similar in their legal content) as it is outlined in the above mentioned provisions of the TRIPS Agreement or the Trade Mark Directive. The research, on which this study is based, enables the author to conclude that the current trends reveal three levels of protection: first, unregistered well-known trademarks within the ambit of the principle of speciality; second, registered well-known or reputed trademarks beyond the principle of speciality; and third, unregistered well-known trademarks beyond the principle of speciality.

Keywords: unregistered well-known trademarks, registered well-known trademarks, trademarks with a reputation.

Introduction

The scope of the legal protection of unregistered well-known trademarks, registered well-known trademarks, and registered trademarks with a reputation and the “systematic dilemma“ regarding the inter-relation between these legal concepts (Paris Convention, Art. 6bis²; TRIPS Agreement, Arts. 16(2) and 16(3)³; Trade Mark Directive (TMD),

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- 2 Paris Convention for the Protection of Industrial Property (of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979). *Official Gazette*. 2001, No. 46-1620. Art. 6bis of the Paris Convention provides that: (1) *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;* (2) *A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested;* (3) *No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.*
 - 3 Agreement on Trade-Related Aspects of Intellectual Property Rights. *Official Gazette*. 2001, No. 46-1620. Art. 16 of the TRIPS Agreement provides that: (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;* (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.*

Arts. 4(2)(d), 4(3), 4(4)(a), 5(2)⁴; Regulation on the Community Trade Mark (CTMR), Arts. 8(2)(c), 8(5), 9(1)(c)⁵) has a long history of various different analyses, debates and interpretations.⁶ Almost all current studies on the subject, however, admit that the

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- 4 First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks (89/104/EEC) [1988] OJ L 40/1 and the current Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks (codified version) [2008] OJ L 299/25. Art. 4 of the Directive “Further grounds for refusal or invalidity concerning conflicts with earlier rights“, para. (2)(d) provides that *earlier trade marks “within the meaning of paragraph 1 means trade marks which, on the date of application for registration of the trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the trade mark, are well-known in a Member State, in the sense in which the words “well-known” are used in Article 6 bis of the Paris Convention.* Art. 4(3) provides that *a trade mark shall furthermore not be registered or, if registered, shall be liable to be declared invalid if it is identical with, or similar to, an earlier Community trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier Community trade mark is registered, where the earlier Community trade mark has a reputation in the Community and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trade mark.* Art. 4(4)(a) provides that *any Member State may, in addition, provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.* Art. 5 „Rights conferred by a trade mark“, part (2) provides that *any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.*
- 5 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark [1993] OJ L 11/1 and the current Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) [2009] OJ L 78/1. Art. 8 of the Regulation “Relative grounds for refusal“, para. (2)(c) provides that *for the purposes of paragraph 1, “earlier trade marks” means trade marks which, on the date of application for registration of the Community trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, 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.* Art. 8(5) provides that: *furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, 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 trade 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.* Art. 9 „Rights conferred by a Community trade mark“, para. (1) (c) provides, that: *a Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the latter has a reputation in the Community and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.*
- 6 Kur, A. *TRIPS and Trademark Law (From GATT to TRIPS – The Agreement on Trade-Related Aspects of Industrial Property Law)*. IIC (Studies in Industrial Property and Copyright Law, Max Planck Institute for Foreign and International Patent, Copyright and Competition Law. Volume 18). Munich, 1996, p. 93–116;

standards provided in the international law, e. g. the provision of Art. 16(3) of the TRIPS Agreement as a *substantive minima* are not an obstacle to provide the same type of protection for unregistered well-known trademarks as well.

At the same time, it could be pointed out that the analysis of the legal regulation (in the EU Member States, the legal protection of unregistered well-known trademarks and registered trademarks (well-known or with a reputation, according to the EU law and terminology)) brings more clarity to the above mentioned questions. The analysis of the legal regulation in the EU Member States shows that some Member States have already found a way to solve the “systematic dilemma”, which pervades international and the EU law.⁷

In their legislation, a number of Member States have already provided a possibility to protect unregistered well-known trademarks beyond the principle of speciality under the same or similar conditions as the registered well-known trademarks or trademarks with a reputation. It could be also pointed out, however, that the *expressis verbis* of the legal regulation in the Member States varies from country to country. In evaluating the current national regulation, it is possible to indicate three levels of the legal protection of well-known trademarks and registered trademarks with a reputation, which currently exist in the EU Member States.

The object of this study is the current trend of the legal regulation related to the protection of well-known trademarks (as a classical concept) and trademarks with a reputation (as a modern concept) in the EU, as well as the relationship between the national regulation and the regulation according to international and the EU law.

The article uses systematic analysis, comparative, analytical and other methods.

Kur, A. *Well-Known Marks, Highly Renowned Marks and Marks Having a (High) Reputation: What's It All About?* IIC (International Review of Industrial Property and Copyright Law). Max Planck Institute for Intellectual Property, Competition and Tax Law. No 2, Volume 23. Munich, 1992, p. 218–236; Mostert, F. V. *Famous and Well-Known Marks*. Butterworths: London, 1997, p. 147–148; Kur, A. *The WIPO Recommendations for the Protection of Well-Known Marks*. IIC (International Review of Industrial Property and Copyright Law) Max Planck Institute for Intellectual Property, Competition and Tax Law. No 7-8, Volume 31. Munich, 2000, p. 824–845; Götting, H.-P. *Protection of Well-Known, Unregistered Marks in Europe and the United States*. IIC (International Review of Industrial Property and Copyright Law). Max Planck Institute for Intellectual Property, Competition and Tax Law. No 4, Volume 31. Munich, 2000, p. 389–408; Senftleben, M. *The Trademark Tower of Babel – Dilution Concepts in International, US and EC Trademark Law*. IIC (International Review of Industrial Property and Copyright Law). Max Planck Institute for Intellectual Property, Competition and Tax Law. No 1, Volume 40. Munich, 2009, p. 44–77; Gervais, D. *The TRIPS Agreement. Drafting History and Analysis*. 3rd ed. Sweet & Maxwell: London, 2008, p. 275–278; Correa, C. M. *Trade Related Aspects of Intellectual Property Rights (A Commentary on the TRIPS Agreement)*. Oxford University Press: New York, 2007, p. 188–193; Stoll, P. T., et al. *WTO-Trade-Related Aspects of Intellectual Property Rights*. Martinus Nijhoff Publishers: Leiden-Boston, 2009, p. 323–330; UNCTAD-ICTSD, *Resource Book on TRIPS and Development*. Cambridge University Press: New York, 2005, p. 238–241; Philips, J. *Trade Mark Law (A Practical Anatomy)*. Oxford University Press: New York, 2003, p. 361–419; Dinwoodie, G. B., et al. *International Intellectual Property Law and Policy*. 2nd edition. LexisNexis: New York, 2008, p. 175–185; Pires de Carvalho, N. *The TRIPS Regime of Trademarks and Designs*. Kluwer Law International: The Hague, 2006, p. 271–291; Weckström, K. *Protection of Trade Marks Having a Reputation: A Comparative Study of Recent Case Law in the EC and the US*. Digipaino: Turku, 2002.

7 English version of the EU Member States Trademark Laws could be found at the Japanese Patent Office website [interactive]. [accessed 12-05-2010]. <http://www.jpo.go.jp/shiryou_e/s_sonota_e/fips_e/mokuj_i_e.htm>. Also some of the laws could be found at the websites of the national patent offices.

1. The Concept of the Legal Protection of Well-Known Trademarks and Trademarks with a Reputation: Three Levels of Protection

To legally protect unregistered well-known trademarks with respect to identical and (or) similar goods and services, Member States in their national legislation are using the wording analogous or similar to the wording of Art. 6*bis* of the Paris Convention and (or) Art. 16(2) of the TRIPS Agreement as well as Art. 4(2)(d) of the TMD. As such, unregistered well-known trademarks can be protected with respect to identical and (or) similar goods and services if there is a likelihood of confusion. This type of protection could be defined as *the first level of protection*.

The second level of protection is applicable to the legal protection of registered trademarks with a reputation beyond the principle of speciality. Member States use in their national legislation either the wording of Art. 16(3) of the TRIPS Agreement or the wording of Art. 4(3), 4(4)(a), 5(2) of the TMD.

Several of the Member States offer protection for registered trademarks beyond the principle of speciality in line with Art. 16(3) of the TRIPS Agreement or Arts. 4(3), 4(4)(a), 5(2) of the TMD, at the same time enabling the protection of *unregistered well-known trademarks* beyond the principle of speciality. The conditions for this type of protection are the same (or similar in their legal content) as specified in the above mentioned provisions of the TRIPS Agreement or the TMD. (a connection (a relationship, a link, etc. between the goods or services and the owner of the registered trademark) provided that the interests of the owner of the registered trademark are likely to be damaged by such a use; or the earlier trademark has a reputation and the use of a later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark). It was mentioned above, that this kind of protection of a well-known trademark beyond the principle of speciality does not depend on the registration. This is defined as *the third level of protection*.

Discussions on the protection of unregistered well-known trademarks beyond the principle of speciality reveal a certain level of convergence between the first and the second levels of protection. For instance, in some Member States, registration *per se* is not yet a precondition for a wider protection of an unregistered well-known trademark. Thus, the modern concept of a trademark with a reputation does not negate the possibility under certain circumstances to protect unregistered well-known trademarks (as a classical concept) also with respect to unrelated goods and (or) services. Furthermore, it is worth mentioning that Art. 3(a)(i) of the WIPO Recommendation Concerning Provisions on the Protection of Well-Known Marks⁸ *inter alia* provides that a Member State should not require as a condition for determining whether if it is well-known that the

8 Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO), 1999. The World Intellectual Property Organization website [interactive]. [accessed 16-06-2010]. <http://www.wipo.int/export/sites/www/about-ip/en/development_iplaw/doc/pub833.doc>.

mark has been used, the mark has been registered or that an application for registration of the mark has been filed in respect of the Member State. At the same time, Art. 4 of the WIPO Recommendation provides guidelines regarding the protection of a well-known trademark both with respect to identical, similar or unrelated goods and (or) services. Therefore, the Member States, where it is possible to protect unregistered trademarks also beyond the principle of speciality (under certain circumstances) are in the same “spirit” as the mentioned tool of international law, though not a binding one.

Protection of unregistered trademarks beyond the principle of speciality could foster the harmonization in the EU, because a few Member States have already provided protection for unregistered well-known trademarks, which exceed the standards required by international and the EU law. However, this is just one side of the coin. Even though the protection for unregistered trademarks for unrelated goods and (or) services is provided, inadequacies still remain in terms of the earlier well-known (unregistered) trademark as grounds to refuse the registration of a later trademark (or as a ground for invalidation) and the protection of the owner’s rights.

It should also be noted that a few Member States, including, for example, Spain and Lithuania, do not seem to have made sufficient efforts to find the best implementation of the provisions of Art. 16(3) of the TRIPS Agreement and Arts. 4(3), 4(4)(a), 5(2) of the TMD. They offered protection *both* for registered well-known trademarks and (registered) trademarks with a reputation.

In contrast, the Slovakian regulation could be a good example how the issues under discussion can be quite clearly resolved by legal regulation.

Art. 4(1)(c) of the Slovakian Trademark Act⁹ states that a sign should not be recognized as a trademark where the Industrial Property Office of the Slovak Republic, on the grounds of opposition filed pursuant to Art. 9, determines that it is:

“(c) identical with or confusingly similar to the trademark with the earlier priority right, which has acquired reputation in the Slovak Republic if the use of such sign for goods and services, which are not similar to those for which the earlier trademark has been registered, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.”

Paragraph 2 of the mentioned article further elaborates that a sign is not to be recognized as a trademark, where the Office, on the grounds of oppositions filed pursuant to Art. 9, ascertains that it is:

“a) identical with or confusingly similar to a sign which, before filing date of the application, had become well-known, following its use in the Slovak Republic or in relation to the territory of the Slovak Republic according to the international treaty, for goods or services of its owner (hereinafter referred to as “unregistered well-known mark”), if this sign is applied for identical or similar goods or services;

b) identical with or confusingly similar to an unregistered well-known mark, if the use of such sign for any goods or services *would indicate connection* between the thus-

9 The Trademark Act of the Slovak Republic (1997) (with amendments and supplements). [interactive]. [accessed 15-04-2010]. <http://www.jpo.go.jp/shiryou_e/s_sonota_e/fips_e/pdf/slovakia/trademark_act.pdf>.

marked goods or services and the owner of the unregistered well-known mark, and if the interests of its owner are likely to be damaged by such use.”

Art. 4(3) provides that “a sign is furthermore not to be recognized as a trademark where the Office, on the basis of oppositions filed pursuant to Art. 9, ascertains that it is identical with or confusingly similar to an earlier Community trademark which has a reputation in the Community if the use of such sign for goods or services which, however, are not similar to those for which the earlier Community trademark with a reputation has been registered would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trademark.”

Therefore, *expressis verbis* of the Slovakian regulation prescribes a possibility for all the three above-mentioned levels of protection (i.e., unregistered well-known trademarks for identical or similar goods or services; registered trademarks with a reputation for unrelated goods and services under the conditions that the use of a later trademark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark; unregistered well-known trademark for any goods or services if the use of a latter trademark would indicate the connection between the thus-marked goods or services and the owner of the unregistered well-known mark, and if the interests of its owner are likely to be damaged by such use).¹⁰

The possibility, however, to enforce the rights of a well-known trademark depends on the condition that the well-known trademark is registered in the Register. If yes, the rights can be enforced regardless of the identity or similarity of the goods or services, provided that the use of that trademark in relation to other goods or services *indicated a connection* between thus marked goods or services and the owner of the registered well-known trademark, and provided that the interests of the owner are likely to be damaged by such a use.¹¹

It should also be pointed out that even before the debates around the EU legislation related to the issue of the trademark protection with respect to identical and (or) similar goods and services were solved by the ECJ in *Davidoff* case¹², the national regulation of Slovakia *expressis verbis* provided a possibility to protect trademarks with a reputation also with respect to identical and similar goods and (or) services.

Art. 25(1) of the Slovakian Trademark Act establishes that “without the authorization of the trademark owner, no one may use a sign that is identical with, or confusingly similar, to his trademark *for identical or similar* goods or services for which the trademark has been registered, nor the sign that is identical with or confusingly similar to his trademark for goods or services, which *are not similar* to goods and services for which the trademark has been registered, but the later trademark has acquired reputation in the Slovak Republic and the use of such sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trademark.” This provision

10 Similar provisions are established in Art. 16 “Invalidation and Revocation of a Trademark” (Paras. 6, 7, 17) of the Slovakian Trademark Act, *supra* note 9.

11 *Ibid.*, Article 26(2).

12 ECJ, 9 January, 2003, Case C-292/00, *Davidoff & Cie SA, Zino Davidoff SA v. Gofkid Ltd.* [2003] ECR I-00389.

in Slovakian regulation, however, relates only to the enforcement of rights rather than being listed among the grounds for the invalidity of a later trademark.

A similar situation also exists in the Czech Republic.¹³ In addition to the provisions of the Czech Trademark Act related with the protection of unregistered well-known trademarks and registered trademarks with a reputation, Sec. 7(1)(d) of this Law provides protection of a reputation of an unregistered well-known trademark as well. The provision states that “the sign applied for shall not be registered in the register upon opposition against the registration of the trade mark in the register filed with the Office by the proprietor of an earlier well-known trade mark, which is identical or similar to the sign applied for if this sign is to be registered for goods or services which are indeed not similar to those goods or services covered by the earlier well-known trade mark, *but the earlier well-known trade mark has a good reputation* in the Czech Republic and the use of that sign *would suggest a relationship* between the goods or services and the proprietor of the earlier well-known trade mark”¹⁴.

The Polish Industrial Property Law¹⁵ states that “a right of protection for a trademark shall not be granted if the trademark is identical or similar to a renowned trademark registered or applied for registration with an earlier priority (provided that the latter is subsequently registered) on behalf of another party for any kind of goods if it without due cause would bring unfair advantage to the applicant or be detrimental to the distinctive character or the repute of the earlier trademark. The above provision shall apply to well-known trademarks accordingly”¹⁶.

An unregistered well-known trademark as such can also be protected beyond the principle of speciality on the existence of the provided conditions. The same principle is applicable to the enforcement procedure. Art. 301 of the Polish Industrial Property Law provides “that unless the trademark is the subject of a right of protection, any party using a well-known trademark on the territory of the Republic of Poland may demand the cessation of the use by another party of the identical or similar trademark in respect of identical or similar goods if such use is likely to mislead the public”. The provision of Art. 296(2)(iii) shall apply accordingly to well-known trademarks with a reputation.¹⁷

A possibility to protect unregistered trademarks for unrelated goods and services is also provided in Estonia. Art. 10(3) of the Estonian Trademarks Act¹⁸, which precludes

13 The Trademark Act of the Czech Republic (2003) (with amendments and supplements). [interactive]. [accessed 15-03-2010]. <http://www.jpo.go.jp/shiryoku_e/s_sonota_e/fips_e/pdf/czech/trademark_act.pdf>.

14 *Ibid.*, Sec. 7(1)(b), (c), (d) and (e).

15 The Industrial Property Act of the Republic of Poland (2000) (with amendments and supplements). [interactive]. [accessed 16-06-2010]. <http://www.jpo.go.jp/shiryoku_e/s_sonota_e/fips_e/pdf/poland_e/e_sangyuu.pdf>.

16 *Ibid.*, Art. 132(2)(iii).

17 *Ibid.*, Art. 296(2)(iii) provides that *infringement of the right of protection for a trademark consists of unlawful use in the course of trade of a trademark identical or similar to a renown trademark registered for any kind of goods, if such use without due cause would bring unfair advantage to the user or be detrimental to the distinctive character or the repute of the earlier trademark*.

18 The Trademarks Act of the Republic of Estonia (2002) (with amendments and supplements). [interactive]. [accessed 15-03-2010]. <http://www.jpo.go.jp/shiryoku_e/s_sonota_e/fips_e/pdf/estonia/trademark_act.pdf>.

legal protection of a later trade mark, as one of the grounds indicate trade marks identical or similar to an earlier registered trade mark or a trade mark, which (1) has been filed for registration or to a trade mark, (2) is known to the majority of the Estonian population and (3) has been granted legal protection for different kinds of goods or services if the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.¹⁹ The same principle applies to the trademark owner's exclusive rights.²⁰ It is clear from the provision, however, that this pertains to the high level of recognition in the public (should be known to the majority of the Estonian population).

Protection of an unregistered well-known trademark is also possible according to the Latvian regulation. Art. 8(1) of the Latvian Trademark Law²¹ stipulates that notwithstanding the provisions of Art. 7 of that Law, a trademark registration may be refused. If registered, the registration may be invalidated under the provisions of this Law if the trademark constitutes a reproduction, an imitation, a translation, or a transliteration, liable to create confusion, of another trademark which, even though unregistered, was well-known in Latvia with respect to identical or similar goods or services on the filing date of the applied for (opposed) registration of the trademark (or the date of priority if priority has been accorded). Paragraph 2 of the mentioned article provides that “in addition to the provisions of Paragraph 1 of this Article, a trademark registration may also be refused or invalidated if the goods or services, in relation to which the trademark registration is applied for, *are not similar* to those of a trademark that is well-known in Latvia provided that consumers may perceive the use of the applied (opposed) trademark in relation to these goods or services *as indicating a connection* between these goods or services and the owner of the well-known trademark and provided that such use may be detrimental to the interests of the owner of the well-known trademark.”

Accordingly, Art. 4(7) of the Latvian Trademark Law, in stipulating the rights to a trademark, states that “notwithstanding the provisions of Para. 6 of this Article, the owner of a trademark that is well-known (within the meaning of Art. 8) in Latvia is entitled to prevent the use in the course of trade of any sign which constitutes a reproduction, an imitation, a translation or a transliteration, liable to create confusion, of the well-known trademark in relation to goods or services that are identical or similar to those covered by the well-known trademark. The owner of a trademark that is well-known in Latvia is entitled to prevent the use in the course of trade of a sign which constitutes a reproduction, an imitation, a translation or a transliteration of the well-known trademark also in relation to goods or services that are not similar to those covered by the well-known trademark provided that consumers may perceive the use of such a sign *as indicating*

19 The Trademarks Act of the Republic of Estonia (2002) (with amendments and supplements). [interactive]. [accessed 15-03-2010]. <http://www.jpo.go.jp/shiryou_e/s_sonota_e/fips_e/pdf/estonia/trademark_act.pdf>. Art. 10(3).

20 *Ibid.*, Art. 14 (1)(3).

21 The Law on Trade Marks and Indications of Geographical Origin of the Republic of Latvia (1999) (with amendments and supplements). [interactive]. [accessed 10-03-2010]. <http://www.jpo.go.jp/shiryou_e/s_sonota_e/fips_e/pdf/latvia_e_e_shouhyou.pdf>.

a connection between these goods or services and the owner of the well-known trademark, and provided that such a use may be detrimental to the interests of the owner of the well-known trademark.”

Protection of unregistered well-known trademarks beyond the principle of speciality is also provided in Denmark.²² According to Sec. 4(2) of the Danish Trade Marks Act, “irrespective of the limitation in Subsec. (1) to goods or services being identical or similar to those covered by the trade mark, the proprietor of the trade mark shall be entitled to prohibit the use of the trade mark also in relation to goods or services which are not identical or similar where the trade mark is well-known in this country and the use would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trade mark”. Sec. 15(3)(ii) provides that “a trade mark shall furthermore not be registered if it is identical with or similar to a “well-known” trade mark, *cf.* Subsec. (2)(iv), and is sought for registered for goods or services which are not similar to those for which the earlier trade mark is well-known provided that the use of the later trade mark may lead to a likelihood of association between the marks and the use will take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.” Protection of the registered trademarks with a reputation is provided in Section 15(3)(i), 15(4)(i) accordingly.²³

Even though protection of registered rights beyond the scope of speciality is provided by both stipulating the content of the trade mark right (Sec. 4 of the Danish Trade Marks Act) and the grounds for a refusal of a later trademark registration (Sec. 15 of the Danish Trade Marks Act), protection of unregistered rights with respect to unrelated goods and (or) services *expressis verbis* is provided only in Section 15 of the Law (e. g. grounds for a refusal of a later trademark).

Similar rules apply for the protection of well-known trademarks in Romania. For instance, Art. 6(e) of the Romanian Law on Marks and Geographical Indications²⁴ states that “except for the reasons indicated in Art. 5(1), a trademark is rejected from registration if it is identical or similar with a trademark notorious (well-known)²⁵ in Romania for products and services different from those to which the trademark refers and of which registration is asked and if by unjustified utilization of the latter one could have a benefit from the distinctive character or from the name of the notorious trademark or this use could bring prejudices to the owner of the notorious trademark”.²⁶ However, regarding

22 The Trade Marks Act of Denmark (as consolidate in 2009). [interactive]. [accessed 16-06-2010]. <http://www.jpo.go.jp/shiryoyou_e/s_sonota_e/fips_e/pdf/denmark/e_shouhyou.pdf>; the website of the Patent and Trademark Office of Denmark <<http://www.dkpto.org/media/189725/the%20consolidate%20trade%20marks%20act%202009.pdf>>.

23 *Ibid.*

24 The Law on Marks and Geographical Indications of the Republic of Romania (1998) (with amendments and supplements) [interactive]. [accessed 10-03-2010]. <http://www.jpo.go.jp/shiryoyou_e/s_sonota_e/fips_e/pdf/romania/trademark_law.pdf>; the website of the Romanian State Office for the Inventions and Trademarks <http://www.osim.ro/index3_files/laws/trademark/mareng.htm>.

25 In another translation of the Law, which is at website of the State Office for the Inventions and Trademarks of the Republic of Romania, the word “notorious” is replaced by the word “well-known”. [interactive]. [accessed 16-06-2010]. <http://www.osim.ro/index3_files/laws/trademark/mareng.htm>.

26 Romanian Law on Marks and Geographical Indications, *supra* note 24, Art. 6(d).

the enforcement of a trademark owner's rights beyond the principle of speciality, the Law deals only with trademarks with a reputation rather than with unregistered well-known trademarks.²⁷

It may be noted that similar rule applies to well-known trademarks (in the enforcement procedure) in France as well. In particular, Art. L713-5 of the French Intellectual Property Code²⁸ states that “any person who uses a mark enjoying repute for goods or services that are not similar to those designated in the registration shall be liable under civil law if such use is likely to cause a prejudice to the owner of the mark or if such use constitutes unjustified exploitation of the mark.” The mentioned article of the Code further states that “its foregoing paragraph shall apply to the use of a mark that is well-known within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property referred to above.”

The Spanish regulation regarding the scope of a well-known trademarks and trademarks with a reputation provides an equal protection *both* for registered well-known trademarks and registered trademarks with a reputation.²⁹ Art. 8 “Registered well-known and reputed trademarks and trade names” of the Law provides that:

“(1) A sign which is identical or similar to an earlier trademark or trade name shall not be registered as a trademark even when the goods or services claimed in the application are not similar to those for which the earlier signs have been registered, where by reason of the *well-known or reputed nature* of the earlier signs in Spain use of the trademark could indicate a *connection* between the goods or services claimed by the application and the owner of the earlier signs or, more generally, where such use without due cause may take unfair advantage of, or be detrimental to, the distinctive character or the well-known nature or the repute of the earlier signs.

(2) For purposes of the present Act, a well-known trademark or tradename shall mean one which, as a result of the volume of sales; of the duration, extent, or geographic scope of use; of the value or prestige attained in the marketplace; or for any other reason is broadly known to the pertinent sector of the public for the goods, services, or activities covered by the said trademark or tradename. Provided the requirements laid down in para. 1 are duly satisfied, the greater the degree of knowledge of the trademark or tradename in the pertinent sector of the public or in other related sectors, the more unrelated in nature may be the goods, services, or activities to which the protection accorded in that paragraph shall extend.

(3) Where trademarks or tradenames are familiar to the public in general, they shall be deemed to be reputed, and the scope of protection shall extend to all goods, services, or activities.”

Thus, both well-known and reputed *registered* trademarks serve (as it is provided in Article 8) as an obstacle to register a later trademark even for unrelated goods and (or)

27 Romanian Law on Marks and Geographical Indications, *supra* note 24, Art. 35(2)(c).

28 The Intellectual Property Code of France (1992) (with amendments and supplements). [interactive]. [accessed 05-03-2010]. <http://www.jpo.go.jp/shiryoku_e/s_sonota_e/fips_e/pdf/france_e/e_chiteki_zaisan.pdf>.

29 The Trademark Act of Spain (2001) (with amendments and supplements). [interactive]. [accessed 02-02-2010]. <http://www.jpo.go.jp/shiryoku_e/s_sonota_e/fips_e/pdf/spain/e_shouhyoku.pdf>.

services (Art. 8(1) of the Law). At the same time, Art. 8(3) repeats again that the scope of protection of a reputed trademark extends to any type of goods and services.

Unregistered well-known trademarks, however, are protected only with respect to identical and (or) similar goods and services (Arts. 6(2)(d), 34(5) of the Spanish Trademark Act).³⁰

At the same time, some inadequacies of translation could also be noticed there. The Spanish version of the Act³¹ uses the concept of “*marcas notorios y renombrados registrados*” (Art. 8, 34(2)(c) as the grounds for the protection beyond the principle of speciality. Article 34(5), when referring to Art. 6*bis* of the Paris Convention, uses the concept of “*notoriamente conocida*”. The concepts “*notorios*” and “*notoriamente conocida*” are similar, however not analogous, thus it is hardly correct to translate both of them in the same way as “well-known”.³²

Nevertheless, even considering the above-mentioned inadequacies of translation, it is obvious from the regulation that the protection beyond the principle of speciality first depends on registration.

The Lithuanian regulation of the legal protection of well-known trademarks is controversial. Art. 7(1)(3) of the Lithuanian Law on Trade Marks³³ states that “the registration of a mark is to be declared invalid if the mark is identical with the mark recognised as well-known in the Republic of Lithuania in the manner prescribed by Art. 9 of that Law, the proprietor of which is another person, or because of its similarity to his mark it is liable to mislead the public.” However, the protection depends on the condition that the later mark may be liable to mislead the public. Consequently, *expressis verbis* of the regulation stipulating the grounds for invalidity leaves the question of application of the principle of speciality for unregistered well-known trademarks open.

As far back as in 2003, the Supreme Court of Lithuania pointed out in its judgment regarding the trademark *Camel*³⁴ that the provision of Art. 7(1)(3) of the Lithuanian Law on Trade Marks, depending on the circumstances of a particular case, can be applied in instances where the goods and (or) services covered by the conflicting trademarks are *both* identical (similar) and unrelated. As it was one of the first cases with the interpretation of the mentioned provision, the Court did not make it very clear when and under what circumstances an unregistered well-known trademark could be protected beyond the principle of speciality. It, nevertheless, should be viewed as positive and progressive

30 The Trademark Act of Spain (2001) (with amendments and supplements). [interactive]. [accessed 02-02-2010]. <http://www.jpo.go.jp/shiryu_e/s_sonota_e/fips_e/pdf/spain/e_shouhyou.pdf>.

31 Spanish version of the Trademark Act could be found at the website of the Patent and Trademark Office of Spain. [interactive]. [accessed 10-03-2010]. <http://www.oepm.es/cs/Satellite?c=Normativa_C&cid=1150364394719&classIdioma=_es_es&pagename=OEPMSite%2FNormativa_C%2FtplContenidoHTML>.

32 „*notorios*” in that context is rather “known” than “well-known”.

33 The Law on Trade Marks of the Republic of Lithuania (2000) (with amendments and supplements). [interactive]. [accessed 01-06-2010]. <http://www.jpo.go.jp/shiryu_e/s_sonota_e/fips_e/pdf/lithuania_e/e_shouhyou.pdf>.

34 The Supreme Court of Lithuania judgment of 15 December 2003, Case No. 3K-3-1191/2003, *Japan Tobacco Inc. (Japan) v. Schrader-Bridgeport International Inc. (United States of America)*. [interactive]. [accessed 01-06-2010]. <<http://www.lat.lt>>.

that the Court already at that time (in 2003) took reference to Arts. 3 and 4(2) of the WIPO Recommendation by emphasizing *inter alia* bad faith as one of the important factors determining the scope of protection of a well-known trademark.

A separate provision of Art. 9 regarding the protection of well-known marks, which relate to the enforcement of rights states that “in addition to the rights specified in Article 38 of this Law³⁵, the proprietor of the mark recognised as well-known in the Republic of Lithuania shall also have the right to prohibit other persons from using, without having his consent, in industrial or commercial activities a sign which constitutes a reproduction, an imitation or a translation, liable to create confusion, of a mark considered to be well-known and used for identical and (or similar) goods” (Art. 9(4)).

Art. 9(5) of the Law repeating the wording of Art. 16(3) of the TRIPS Agreement, also provides that “in addition to the rights specified in Art. 38 of this Law, the proprietor of a registered mark recognised as well-known in the Republic of Lithuania shall also be entitled to prevent third parties not having his consent from using, in the course of industrial or commercial activities, a sign which may be taken for a reproduction, an imitation or a translation, liable to create confusion, of a mark recognised as well-known, in relation to goods and/or services which are not similar to those under the well-known mark provided that use of that mark in relation to those goods or services would indicate a connection between those goods and/or services and goods and/or services under a well-known mark and provided that the interests of the proprietor of the registered well-known mark are likely to be damaged by such use.”

However, Art. 38(1)(3) of the Law at the same time separately deals with the rights of the owner of a trademark with a reputation. The Law provides that the proprietor of a registered mark shall have an exclusive right to prevent all third persons not having his consent from using in the course of trade any sign which is identical or similar to the registered mark in relation to goods and (or) services which are not similar to those for which the mark is registered, where the latter has a reputation in the Republic of Lithuania and where use of that sign without due cause takes unfair advantage of or is detrimental to, the distinctive character or the repute of the mark.

Consequently, the Law repeats in its various provisions both the provision of Art. 16(3) of the TRIPS Agreement and the provision of Art. 5(2) of the TMD. Another issue (or misunderstanding) relates to the EC and national trademarks with a reputation. The problem is that the national legislation indicates only the EC trademarks with a reputation as the grounds for invalidity rather than national trademarks.³⁶ However, as it has already been mentioned regarding the enforcement of rights, the wording of the provision (Art. 38(1)(3) of the Lithuanian Law on Trade Marks) is not restricted to the EC trademarks with a reputation but also covers national reputed trademarks. Such inconsistencies could be viewed as an obvious mistake in the regulation of this issue.³⁷

35 Lithuanian Law on Trade Marks, *supra* note 33, Art. 38 „Rights of the Proprietor of the Mark”.

36 *Ibid.*, Art. 7(1)(7).

37 ECJ, 23 October, 2003, Case C-408/01, *Adidas-Salomon AG, Adidas Benelux BV v. Fitnessworld Trading Ltd.* [2003] ECR I-12537.

Nevertheless, new amendments to the Lithuanian Law on Trade Marks are currently being drafted, thus the legislator will hopefully make the necessary corrections to resolve the “systematic” mistakes outlined above.³⁸

2. Trademarks with a Reputation: Community and National Levels

Referring to the trademarks with a reputation, the majority of Member States extend protection both for Community and national trademarks. Or, as for example, Bulgaria³⁹, simply state that Community marks “shall have effect in the territory of the Republic of Bulgaria and their proprietors shall enjoy the rights under this Law (Art. 72a(2) “Registration and Effects of Community Marks” of the Bulgarian Law on Trademarks and Geographical Indications). Similarly, in Hungary, Art. 76/C(2) “Community Trademarks as Earlier Trademarks” of the Hungarian Trademark Act⁴⁰ provides that for the purposes of Art. 4(1)(c), the earlier Community trademark having a reputation in the European Community shall be taken into consideration in compliance with Art. 9(1)(c) of the Community Trademark Regulation.

However, the regulation is not always clear (as it has already been shown by the example of Lithuanian regulation).

Another relevant example might be Ireland, where both the Community and national trademarks with a reputation are indicated between the relative grounds for refusal of registration of a later trademark.⁴¹ However, regarding the enforcement of rights, the Irish law *expressis verbis* speaks only about trademarks which have a reputation in the State. Section 14(3) “Infringement of registered trade mark” of the Irish Trade Marks Act provides that “a person shall infringe a registered mark if that person uses in the course of trade a sign which is identical with or similar to the trade mark and is used in relation to goods or services which are not similar to those for which the trade mark is registered where the trade mark has a reputation in the State and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark.”

38 At the moment (18/06/2010), the draft of the future amendments to the Law on Trade Marks is under preparation and has not yet been posted at the website of the State Patent Bureau or the Parliament of the Republic of Lithuania.

39 The Law on Marks and Geographical Indications of the Republic of Bulgaria (1998) (with amendments and supplements). [interactive]. [accessed 06-06-2010]. <http://www.jpo.go.jp/shiryuu_e/s_sonota_e/fips_e/pdf/bulgaria_e/e_shouhyou.pdf>; the website of the Patent Office of the Republic of Bulgaria <http://www1.bpo.bg/images/stories/laws/law__marks_july2007.pdf>; Art. 12(2)(iii).

40 The Act on the Protection of Trademarks and Geographical Indications of the Republic of Hungary (1997) (with amendments and supplements). [interactive]. [accessed 02-02-2010]. <http://www.jpo.go.jp/shiryuu_e/s_sonota_e/fips_e/pdf/hungary_e/e_shouhyou.pdf>; the website of the Patent Office of the Republic of Hungary <http://www.mszh.hu/English/jogforras/jogforras_vedj/Trademark_Act_XI_1997_EN_2007jan01.pdf>.

41 The Trade Marks Act of Ireland (1996) (with amendments and supplements). [interactive]. [accessed 17-06-2010]. <http://www.jpo.go.jp/shiryuu_e/s_sonota_e/fips_e/pdf/ireland_e/e_shouhyou.pdf>, Sec. 10 “Relative grounds for refusal” (Subsec. (3)(a) and (b)).

A similar situation is in the Czech Republic. The wording of the Czech Republic Trademark Act (Sec. 7(1)(d) also lists both Community and national trademarks with a reputation among the relative grounds for invalidity⁴² There remain, however, some ambiguities in respect of rights conferred by a trade mark, i.e. this Act does not indicate the type of a trademark (Community or national) (Sec. 8(2)(c) of the Czech Republic Trademark Act).⁴³

Neither does the *expressis verbis* of the Estonian regulation indicate the type of the registered reputed rights (e. g. Community or national) in providing a possibility to protect these rights beyond the principle of speciality.⁴⁴

In Spain there is no clear identification regarding the Community or national trademarks with a reputation (moreover, *expressis verbis* of Art. 8(1) of the Spanish Trademark Act, for example, refers only to reputed earlier signs in Spain).⁴⁵ In Malta, the law also addresses only national trademarks with a reputation (Arts. 6(3), 10(3), 72(2) of the Maltese Trademarks Act).⁴⁶

3. The Importance of the Date in Seeking the Protection of a Well-Known Trademark or a Trademark with a Reputation

A number of the EU Member States *expressis verbis* state in their legislation when a trademark must be recognized as a well-known (or with a reputation).

For example, in Ireland, it is prescribed by the law that “an earlier trademark“ means a trade mark, which at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well-known trade mark.⁴⁷ Analogous or similar provisions are provided in the United Kingdom⁴⁸, Germany⁴⁹, Greece⁵⁰,

42 Czech Republic Trademark Act, *supra* note 13, Sec. 7(1)(d) and (e).

43 *Ibid.*, Sec. 8(2)(c).

44 *Supra* notes 19 and 20.

45 Spanish Trademark Act, *supra* note 29, Art. 8(1).

46 Trademarks Act, to regulate Trademarks, of the Republic of Malta (2000) (with amendments and supplements). [interactive]. [accessed 06-06-2010]. <<http://www.commerce.gov.mt/pdfs/commerce/legislation/Trademarks%20Act.pdf>>, Arts. 6(3), 10(3), 72(2).

47 Irish Trade Marks Act, *supra* note 41, Art. 11(1)(c).

48 United Kingdom Trade Marks Act (1994) (with amendments and supplements). [interactive]. [accessed 02-06-2010]. <http://www.jpo.go.jp/shiryoku_e/s_sonota_e/fips_e/pdf/england_e/e_shouhyou.pdf>, Sec. 6(1)(c).

49 The Law on Trademarks and Other Distinctive Signs of the Federal Republic of Germany (1994) (with amendments and supplements). [interactive]. [accessed 02-03-2010]. <http://www.jpo.go.jp/shiryoku_e/s_sonota_e/fips_e/germany/tl/mokuji.htm>, Sec. 42 “Opposition” (Subsec. (2)(2)).

50 The Trademark Law of the Republic of the Republic of Greece (1994) (with amendments and supplements). [interactive]. [accessed 17-06-2010]. <http://www.jpo.go.jp/shiryoku_e/s_sonota_e/fips_e/pdf/greece/trademark_law.pdf>, Art. 4(2)(c).

Spain⁵¹, Bulgaria⁵², Poland⁵³, Slovakia⁵⁴, Hungary⁵⁵, Malta⁵⁶.

The United Kingdom and Ireland, in their regulation of well-known trademarks, also state that nothing affects the continuation of any *bona fide* use of another (later) trade mark before the trademark became well-known (United Kingdom Trade Marks Act, Sec. 56(3)⁵⁷; Irish Trade Marks Act, Sec. 61(3)⁵⁸. The same provision is also effective in Malta (Maltese Trademarks Act, Art. 50(3))⁵⁹.

Concerning trademarks having a reputation, in Austria, the Trademark Law *inter alia* provides⁶⁰ that “the reputation of the trade mark filed earlier shall be required to have existed at the latest on the day of the application for registration of the subsequent trade mark, or the date of priority or seniority claimed for the registration of the subsequent trade mark or at the time of creation of the other sign.” Similar provisions are also provided in the German Trademark Law⁶¹.

It is also interesting to point out that in Estonia, the legal regulation *expressis verbis* provides that “the recognition of a trade mark as being well-known shall not have any legal effect in later disputes”⁶². In contrast, for example in France, court decisions where a trademark is recognised as well-known can be important evidence in other cases related to the same trademark. Such decisions are binding on the French courts without any need for the mark owner to provide the evidence presented in the earlier decisions. Such earlier decisions must be recent enough to dispel any doubt as to the current well-known character of the mark.⁶³

In the majority of the Member States, however, protection of a well-known trademark is based on a *case-by-case* principle (the same applies to trademarks with a reputation).

51 Spanish Trademark Act, *supra* note 29, Art. 6 „Earlier trademarks“ (Para. 2(d)).

52 Bulgarian Law on Marks and Geographical Indications, *supra* note 39, Art. 12(2)(iii).

53 Polish Industrial Property Law, *supra* note 15, Art. 132(1)(ii).

54 Slovakian Trademark Act, *supra* note 9, Arts. 4(2)(a), 16(7)(a) and (b).

55 Hungarian Trademark Act, *supra* note 40, Arts. 4 “Relative Grounds for Refusal” (Part (2)), 17 “Acquiescence” (Part (5)).

56 Maltese Trademarks Act, to regulate Trademarks, *supra* note 46, Art. 7 “Meaning of ‘earlier trademark’” (Para. (1)(b)).

57 United Kingdom Trade Marks Act, *supra* note 48, Section 56 “Protection of well-known trade marks: Article 6bis” (Para. (2)).

58 Irish Trade Marks Act, *supra* note 41, Section 61 “Protection of well-known trade marks: Article 6bis” (Paras. (2), (3)).

59 Maltese Trademarks Act, to regulate Trademarks, *supra* note 46, Article 50 “Protection of well-known trademarks: Article 6bis” (Parts (2) and (3)).

60 The Trademark Law of the Republic of Austria (1970) (with amendments and supplements). [interactive]. [accessed 01-06-2010]. <http://www.jpo.go.jp/shiryoku_e/s_sonota_e/fips_e/pdf/austria_e/e_shouhyou.pdf>, Sec. 10(2), 30(2).

61 German Law on Trademarks and Other Distinctive Signs, *supra* note 49, Secs. 22 “Exclusion of Claims Due to Legal Validity of Registration of a Later Trade Mark” (Subsec. (1)(1)), 51 “Nullity Due to Earlier Rights” (Subsec. (3)).

62 Estonian Trademarks Act, *supra* note 18, Art. 7 “Recognition of well-known trade marks” (Para. (5)).

63 Soutoul, F.; Bresson, J.-Ph. Inlex IP Expertise. *Well-known and famous trademarks in France*. World Trademark Review January/February, 2008, p. 68–69.

4. The Procedure for Determining if a Trademark is a Well-Known or with a Reputation

The majority of the EU Member States in their legislation do not provide particular provisions, regarding the procedure for determining a trademark well-known (e. g. is that possible to determine a trademark as a well-known *a priori*, or only in connection with the later (infringing) trademark). As a rule, it would be possible only in connection with the later (infringing) trademark, both by the Patent Office and the court.

Estonia and Bulgaria, however, provide detailed provisions in their national trademark laws regarding the procedure for determining if a trademark is well-known. To some extent, this could also apply to Lithuania.

The Estonian Trademark Act provides that “a court shall recognise a trade mark as being well-known at the request of the proprietor of the trade mark. A trade mark shall be recognised as being well-known only in connection with an action or appeal concerning the legal protection of the trade mark.” The law also states that “the Patent Office shall consider a trade mark to be well-known only in connection with the registration procedure of the trade mark or other trade marks. The Industrial Property Board of Appeal shall consider a trade mark to be well-known only in connection with the adjudication of an appeal against a decision of the Patent Office or an application concerning contestation of the legal protection of the trade mark”⁶⁴.

The Lithuanian Law on Trademarks provides that “a mark shall be recognised as well-known in the Republic of Lithuania according to judicial procedure.”⁶⁵ The case law has supplemented this provision by establishing that recognition of a trademark as well-known is only possible in connection with another trademark⁶⁶. This also means that recognition of a trade mark as a well-known is not possible in the opposition procedure.⁶⁷ If the opposition is based on this ground, the Appeals Division of the Patent Bureau has to advise a party to file a claim before the court.

The Estonian regulation provides that the scope of the legal protection of a well-known trade mark is for the form of the trade mark in which it became well-known⁶⁸. A very similar concept has also been developed in Lithuania, but on the basis of the case law. The Supreme Court of Lithuania held in 2000 that when determining a trademark as well-known, a court judgment had to clearly indicate the form of the particular trade-

64 Estonian Trademarks Act, *supra* note 18, Art. 7 “Recognition of well-known trade marks”.

65 Lithuanian Law on Trademarks, *supra* note 33, Art. 9(3).

66 Supreme Court of Lithuania judgment of 23 October 2002, Case No. 3K-3-1222/2002, *Distilleerderijen Erven Lucas Bols B.V.* [interactive]. [accessed 01-03-2010]. <<http://www.lat.lt>>. The claimant *Distilleerderijen Erven Lucas Bols B.V.* initiated the case asking the court to determine the trademark “Metaxa” well-known *a priori*, i.e. rather than in connection with any other particular infringing trademark.

67 Lithuanian Law on Trademarks, *supra* note 33, Arts. 7 “Other Grounds for the Invalidation of Registration” (Part (1)(3), 18 “Opposition” (Para. (1)).

68 Estonian Trademarks Act, *supra* note 18, Art. 12 “Scope of legal protection of trade marks” (Part (1)(1).

mark which was protected as well-known (i.e. to indicate the concrete page of the case file which contains the image of that particular trademark)⁶⁹.

The Supreme Court has emphasised that this rule should be applied to eliminate any possible speculations when enforcing the court decision.

A particular situation can be found France where protection of registered trademarks with a reputation for unrelated goods and (or) services can serve as grounds for action only before the courts. The Trademark Office rejects any opposition, which is either based directly on this provision or indirectly requests the rejection of a trademark application because the earlier trademark with a reputation covers unrelated goods and (or) services⁷⁰. What relates the protection of unregistered well-known trademarks against later trademarks covering identical or similar goods and (or) services, the disputes of this kind can be raised either before the courts or the Trademark Office. However, in practice, oppositions based on this provision are extremely rare.⁷¹

The Bulgarian legislation addresses both the procedure for determination a mark as a well-known and a mark with a reputation⁷². The law provides that a mark shall be determined as a well-known mark or mark with a reputation by Sofia City Court under the ordinary claim procedure and also by the Patent Office.

The Patent Office can determine a mark as a well-known or a mark with a reputation at the request of the proprietor upon the payment of the prescribed fee and the production of written evidence (i.e. *a priori*). The final decision depends on the President of the Patent Office and is based on the opinion of a committee appointed by him. The law also provides that a mark which is determined as a well-known mark or mark with a reputation by the Patent Office shall be published in the Official Bulletin of the Patent Office and shall be recorded in the Register.⁷³

At the same time, the law provides that a mark, which is considered a well-known mark or a mark with a reputation by the Court under the ordinary claim procedure shall not be published in the Official Bulletin of the Patent Office and shall not be recorded in the Register. It also may not be opposed by third parties. Any third party may appeal against the decision of the Patent Office on determining a mark as a well-known mark or a mark with a reputation before the Sofia City Court in accordance with the Code of Administrative Procedure within one month following the publication. A refusal to determine a mark as a well-known mark or mark with a reputation may be appealed before the Sofia City Court in accordance with the Code of Administrative Procedure.

From the legal regulation per se, the relationship between the decision Patent Office to determine a trademark as a well-known (i.e. *a priori*) or to refuse such a request and

69 The Supreme Court of Lithuania judgment of 25 January 2000, Case No. 3K-3-25/2000, *UAB "Birštono mineraliniai vandenys" v. UAB "Naujieji Birštono mineraliniai vandenys"*. [interactive]. [accessed 03-03-2010]. <<http://www.lat.lt>>.

70 Soutoul, F.; Bresson, J.-Ph.; Inlex IP Expertise. Well-known and famous trademarks in France. *World Trademark Review*. 2008, January/February, p. 68–69.

71 *Ibid.*, p. 69.

72 Bulgarian Law on Marks and Geographical Indications, *supra* note 39, Art. 50(a) and (b).

73 *Ibid.*, Art. 5a "State Register of Well-Known Marks and Marks With a Reputation".

the ordinary claim procedure for determining a trademark well-known is not clear. For example, if the Patent Office rejected a request to determine a particular trademark as a well-known, does it mean that the owner of the same trademark is not allowed to initiate a claim procedure in an attempt to defend his rights to the trademark as a well-known trademark? In contrast, if a particular trademark has been determined as a well-known by the Patent Office, does it mean that the owner of a later (infringing) trademark can not contest this fact within a litigation procedure?

Registers of well-known trademark also function in Czech Republic (ex-post character without legal effect) and Finland (ex-ante character without legal effect)⁷⁴.

5. Criteria Prescribed by the Law for Determining a Trademark as Well-Known or with a Reputation

The majority of the EU Member States do not provide any list of specific criteria according which it could be referred to in deciding whether a trademark is well-known (or has a reputation) but refer to Art. 6*bis* of the Paris Convention and (or) Arts. 16(2) or 16(3) of the TRIPS Agreement (or use analogous or similar wording, as well as the wording of Arts. 4(2)(d), 4(3), 4(4)(a), 5(2) of the TMD) in their provisions). For example, United Kingdom (United Kingdom Trade Marks Act, Sec. 6(1)(c), 56)⁷⁵, Ireland (Irish Trade Marks Act, Sec. 11(1)(c), 61)⁷⁶, Benelux (Uniform Benelux Law on Marks, Art. 4(5))⁷⁷, Germany (German Trademark Law, Art. 10(1))⁷⁸, Czech Republic (Czech Republic Trademark Act, Sec. 2(d))⁷⁹, Denmark (Danish Trade Marks Act, Sec. 15(2)(c)(iv))⁸⁰, Greece (Greek Trademark Law, Art. 4(2)(c))⁸¹, Latvia (Latvian Trademark Law, Art. 8(4))⁸², Lithuania (Lithuanian Trade Marks Law, Art. 9(1))⁸³, Spain (Spanish Trademark Act, Art. 6(d), 34(5))⁸⁴, Hungary (Hungarian Trademark Act,

74 Liu, K.-C., et al. *The Use and Misuse of Well-Known Marks Listings*. IIC (International Review of Industrial Property and Copyright Law). Max Planck Institute for Intellectual Property, Competition and Tax Law. No. 6, Volume 40. Munich, 2009, p. 685–697.

75 United Kingdom Trade Marks Act, *supra* note 48, Secs. 6 „Meaning of “earlier trade mark“ (Subsec. (1)(c)), 56 „Protection of well-known trade marks: Article 6*bis*“ (Subsec. (1) and (2)).

76 Irish Trade Marks Act, *supra* note 41, Secs. 11 “Meaning of earlier trademark” (Subsec. (1)(c)), 61 “Protection of well-known trade marks: Article 6*bis*” (Subsecs. (1) and (2)).

77 Uniform Benelux Law on Marks (1971) (with amendments and supplements). [interactive]. [accessed 10-03-2010]. <http://www.jpo.go.jp/shiryou_e/s_sonota_e/fips_e/benelux/ublm/mokuji.htm>, Article 4(5).

78 German Law on Trademarks and Others Distinctive Signs, *supra* note 49, Sec. 10 “Well-Known Trade Marks” (Subsec. (1)).

79 Czech Republic Trademark Act, *supra* note 13, Sec. 2 (d).

80 Danish Trade Marks Act, *supra* note 22, Sec. 15(2)(iv).

81 Greek Trademark Law, *supra* note 50, Art. 4(2)(c).

82 Latvian Trademark Law, *supra* note 21, Art. 8 “A Well-Known Trademark as Grounds for Refusal or Invalidation of a Registration” (Para. (4)).

83 Lithuanian Trade Marks Law, *supra* note 33, Art. 9 „Protection of a Well-Known Mark“ (Para. (1)).

84 Spanish Trademark Act, *supra* note 29, Arts. 6 “Earlier trademarks” (Part (2)(d)), 34 “Rights conferred by a trademark” (Part (5)).

Art. 4(2))⁸⁵, France (French Intellectual Property Code, Art. L711-4(a))⁸⁶, Malta (Maltese Trademarks Act, Art. 7(1)(b), 50(1))⁸⁷, Slovenia (Slovenian Industrial Property Act, Art. 44(d))⁸⁸.

However, even though the WIPO Recommendation for the Protection of Well-Known Marks is a "soft-law", i.e., a non-binding instrument⁸⁹, three Member States – Estonia, Bulgaria and Romania – have provided in their national legislation particular criteria for recognising a trademark as well-known similar to those established in the WIPO Recommendation.⁹⁰

Article 7 "Recognition of well-known trade marks" of the Estonian Trade Mark Act *inter alia* provides that:

"(3) The following shall be taken into consideration upon recognising a trade mark as being well-known:

1) the degree of knowledge of the trade mark in Estonia in the sector of actual and potential consumers of goods analogous to the goods or services to which the trade

85 Hungarian Trademark Act, *supra* note 40, Art. 4 "Relative Grounds for Refusal" (Para. (2)).

86 French Intellectual Property Code, *supra* note 28, Article L711-4 (a).

87 Maltese Trademarks Act, to regulate Trademarks, *supra* note 46, Arts. 7 "Meaning of "earlier trademark" (Part (1)(b)), 50 „Protection of well-known trademarks: Article 6bis“ (Para. (1)).

88 The Industrial Property Act of the Republic of Slovenia (2001) (with amendments and supplements). [interactive]. [accessed 17-06-2010]. The website of the Intellectual Property Office of the Republic of Slovenia <http://www.uil-sipo.si/fileadmin/upload_folder/zakonodaja/ZIL_EN_2006.pdf>, Art. 44 „Relative grounds for refusal“ (Para. (1)(d)).

89 Correa, C.M. *Trade Related Aspects of Intellectual Property Rights (A Commentary on the TRIPS Agreement)*. Oxford University Press: New York, 2007, p. 191; Kur, A. *The WIPO Recommendation for the Protection of Well-Known Marks*. IIC (International Review of Industrial Property and Copyright Law). Max Planck Institute for Intellectual Property, Competition and Tax Law. No 7-8, Volume 31. Munich, 2000, p. 824-845.

90 The WIPO Recommendation, *supra* note 8, Art. 2(1) provides that:

(a) *In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well-known.*

(b) *In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well-known, including, but not limited to, information concerning the following:*

1. *the degree of knowledge or recognition of the mark in the 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 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;*
5. *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;*
6. *the value associated with the mark.*

(c) *The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in subparagraph (b), above.*

mark applies, the sector of persons involved in channels of distribution of such goods or services or in business circles dealing with such goods or services;

2) the duration and extent of the use and promotion of the mark and geographical area of the use of the mark;

3) the registration, use and knowledge of the mark in other countries;

4) the value associated with the mark”.

At the same time subsection (4) of the mentioned article states that a trade mark “shall be recognised as being well-known if the trade mark is known to the majority of persons in at least one of the sectors specified in clause (3)(1) of this section.”

It is not clear, however, from the regulation itself whether these criteria are binding on the court or the Patent Office or are intended to be for guidance only (as it should be). At the same time, it is not clear from the regulation *per se* whether a trademark has to correspond to all four criteria or just one, or a few of them, could also be enough to protect a trademark as well-known.

A very similar situation exists in Bulgaria as well. In addition, the Bulgarian Law on Marks and Geographical Indications provides analogous criteria for determining a mark as a well-known mark or a mark with a reputation.

Article 50a “Determining of a Mark as a Well-Known Mark or a Mark With a Reputation” of the Law provides that:

“(1) The following shall be taken into account when determining whether the mark is a well-known mark or a mark with a reputation:

(i) the extent to which the mark is known or recognized among the part of the community which covers the real or would-be users of the goods or services or the persons engaged in the respective distribution network or the business circles dealing with the goods or services in question;

(ii) duration, extent and geographical area of use of the mark;

(iii) duration, extent and geographical area of public representation of the mark, including advertising, making public and displaying at fairs and/or exhibitions of the goods and/or services in relation to which the mark is used;

(iv) information about the successful enforcement of the rights in the mark, if registered;

(v) value of the mark;

(vi) other circumstances”.

Article 20 of the Romanian Law on Marks and Geographical Indications provides that “the examination of the reasons for rejection provided in Article 6(d) and (e)⁹¹ shall be done in conformity with some criteria, such as:

(a) the degree of distinctivity, initial or acquired, of the notorious trademark in Romania;

(b) time period and time lasting utilization of the notorious trademark in Romania concerning the products and services for which a trademark is requested to be registered;

91 Romanian Law on Marks and Geographical Indications, *supra* note 24.

- (c) time period and time lasting for advertising of the notorious trademark in Romania;
- (d) the geographical area for utilization of the notorious trademark in Romania;
- (e) the degree of acknowledgement of the notorious trademark on the Romanian market by the section of public to whom it addresses;
- (f) the existence of some identical or similar trademarks for the products or services identical or similar, belonging to some other persons not to the one saying that his trademark is notorious.

In order to examine the reasons for rejection based upon the mention criteria, the State Office for Inventions and Trademarks may request documents from the public authorities, public institutions, as well as from other private legal entities, aiming to establish the trademark "notoriety" in Romania (Art. 20(2) of the Law)".

It could be interesting to note that the first (after the country has gained independence in 1990) Lithuanian Law on Trademarks and Service Marks of 1993⁹² provided (Art. 20(5)) that "the holder of a mark, which is considered to be well-known in the Republic of Lithuania, even if it is not registered under this Law, shall have the right to prevent third parties from using in commerce, without his authorization, any sign which constitutes a reproduction, an imitation or a translation of the mark. The concept of a well-known mark shall be established by the State Patent Bureau."

By the Order of its Director General of 1994⁹³, the Patent Bureau established that a trademark could be determined as well-known if it corresponded to all the criteria listed below:

- "1) a trademark should correspond to the requirements of a trademark which are provided in Lithuanian laws;
- 2) a trademark should be recognized by the majority of Lithuanian consumers of the particular goods and (or) services (by at least 70% of randomly selected customers);
- 3) a trademark should be registered, used and known in others States – parties of the Paris Union;
- 4) a trademark should be used in a major part of the Lithuanian territory;
- 5) a trademark should be advertised in Lithuanian press, radio and television;
- 6) a trademark should have a strong distinctive character and should be original and unique in the Lithuanian market;
- 7) a trademark should have been used in Lithuanian market not less than five years before the date for which the status of a well-known mark is claimed."

The main problem related with the criteria listed in the Order was that the determination of a trademark as well-known was bound, rather than intended to be for guidance, with all of these seven criteria. In reality it meant that it was difficult to get protection in

92 English translation of the Law on Trademarks and Service Marks of the Republic of Lithuania (1993) (with amendments and supplements) is available at the website of the Parliament of the Republic of Lithuania. [interactive]. [accessed 10-04-2010]. <http://www3.lrs.lt/pls/inter3/dokpaieska.showdoc_l?p_id=21901>.

93 Pramoninės nuosavybės teisinės apsaugos Lietuvoje norminiai aktai, galiojantys 1998 m. spalio 1 d. *Prekių ir paslaugų ženklai. I Tomas*. Lietuvos Respublikos valstybinis patentų biuras. [Legal acts of Lithuania Regarding the Legal Protection of Industrial Property Law, valid on 1 October, 1998. Trade Marks and Service Marks. Volume 1. The State Patent Bureau of the Republic of Lithuania]. Vilnius, 1998, p. 90.

Lithuanian courts during that time even for famous trademarks. The currently effective Lithuanian legislation⁹⁴, however, fails to provide a list of particular criteria for determining a trademark well-known and, as it has already been mentioned, refers to the wording of the TRIPS Agreement.

Conclusions

The analysis of the current trends regarding the legal protection of well-known trademarks and trademarks with a reputation in the EU Member States shows that the legal regulation of the protection of well-known trademarks and trademarks with a reputation is among the questions which need further harmonization in the EU.

As seen above, a number of Member States already provide in their national legislation a possibility to protect the *reputation* of unregistered well-known trademarks with respect to unrelated goods and (or) services thus exceeding the standards of the TRIPS Agreement and the EU law (Trade Mark Directive and Regulation on the Community Trade Mark). At the same time, it could be pointed out that the approach taken by a number of Member States coincides with the spirit of the WIPO Recommendation.

However, it is clear that the legal dilemma remains unsolved with regard to the standards of the protection of Community trademarks with a reputation provided by the EU Regulation on the Community Trade Mark and the national legislation in a number of Member States. Protection of the *reputation* beyond the principle of speciality at the Community level unambiguously depends on the condition of registration. Thus, national and Community levels of the protection of the *reputation* depend on different (in many cases) standards.

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PLAČIAI ŽINOMŲ IR REPUTACIJĄ TURINČIŲ PREKIŲ ŽENKŲ TEISINĖ APSAUGA: TEISINIO REGULIAVIMO EUROPOS SAJUNGOS VALSTYBĖSE NARĖSE TENDENCIJOS⁹⁵

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Santrauka. *Neregistruotų plačiai žinomų prekių ženklų, registruotų plačiai žinomų prekių ženklų ir registruotų prekių ženklų, turinčių reputaciją, teisinės apsaugos ribos bei šių teisinių kategorijų tarpusavio santykio sisteminė dilema, kuri yra užprogramuota tarptautinės bei Europos Sąjungos teisės reguliavimo expressis verbis (Paryžiaus konvencijos 6bis straipsnis, TRIPS sutarties 16 straipsnio 2 bei 3 dalys, Prekių ženklų direktyvos 4 straipsnio 2 dalies (d) punktas, 4 straipsnio 3 dalis, 4 straipsnio 4 dalies (a) punktas, 5 straipsnio 2 dalis, Reglamento dėl Bendrijos prekių ženklo 8 straipsnio 2 dalies (c) punktas, 8 straipsnio 5 dalis, 9 straipsnio 1 dalies (c) punktas), yra įvairių (ir skirtingų) analizių, debatų bei interpretacijų objektas. Vis dėlto praktiškai visos šiuolaikinės studijos priklauso, jog tarptautinės teisės nuostata (TRIPS sutarties 16 straipsnio 3 dalis) dėl plačiai žinomų prekių ženklų nepanašioms prekėms ir (arba) paslaugoms apsaugos, tokios apsaugos galimybę siejant su plačiai žinomo ženklo registracija, yra minimalus standartas, taigi nėra kliūtis analogišką apsaugą suteikti ir neregistruotiems plačiai žinomiems prekių ženkliams.*

95 Šis straipsnis parengtas remiantis autorės moksliniu tyrimu projekte „Europos Sąjungos prekių ženklų teisės harmonizavimo galimybės“, organizuotame Makso Planko instituto „Intelektinės nuosavybės, konkurencijos ir mokesčių teisė“, (Vokietija). Straipsnio autorė dėkoja Institutui už galimybę stažuotis jame ir atlikti tyrimą minėtuju klausimu.

Šiame straipsnyje pateikiama Europos Sąjungos valstybėse narėse reglamentuojant prekių ženklų (plačiai žinomų bei turinčių reputaciją) teisinę apsaugą nesilaikant specifikacijos principo (tai yra nepanašioms prekėms ir (arba) paslaugoms) vyruojančių šiuolaikinių tendencijų lyginamoji analizė. Atliktas lyginamasis tyrimas byloja, jog dalis Europos Sąjungos valstybių narių savo nacionaliniame reguliavime rado išeitį iš minėtosios sisteminės dilemos, esančios tarptautinės bei Europos Sąjungos teisės nuostatų *expressis verbis*. Kaip matyti iš atlikto tyrimo rezultatu, dalis valstybių narių, nors ir numatydamos registruotų prekių ženklų apsaugą nepanašioms prekėms ir (arba) paslaugoms, kaip tai nurodyta TRIPS sutarties 16 straipsnio 3 dalyje bei Prekių ženklų direktyvos 4 straipsnio 3 dalyje, 4 straipsnio 4 dalies (a) punkte, 5 straipsnio 2 dalyje, taip pat numato ir apsaugą neregistruotų plačiai žinomų prekių ženklų nesilaikant specifikacijos principo (tai yra nepanašioms prekėms ir (arba) paslaugoms). Atliktu tyrimu, kuriuo remiantis parengtas šis straipsnis, yra siekiama pagrįsti, jog nurodytos apsaugos (neregistruotų plačiai žinomų prekių ženklų) sąlygos yra tokios pat (arba savo teisiniu turiniu labai panašios), kaip ir tos, kurios numatytos TRIPS sutartyje bei Prekių ženklų direktyvoje. Atlikus tyrimą galima daryti išvadą, jog iš dabartinių teisinio reguliavimo Europos Sąjungos valstybėse narėse tendencijų matyti, jog nustatyti trys apsaugos lygmenys. Pirma, neregistruotų plačiai žinomų prekių ženklų apsauga remiantis specifikacijos principu (tai yra tik tapačioms prekėms ir (arba) paslaugoms); antra, registruotų plačiai žinomų arba turinčių reputaciją prekių ženklų nepanašioms prekėms ir (arba) paslaugoms (tai yra nesilaikant specifikacijos principo); trečia, neregistruotų plačiai žinomų prekių ženklų, taip pat nesilaikant specifikacijos principo.

Apibendrinant darytina išvada, jog nekvėstionuojant tarptautinės bei Europos Sąjungos teisės normose įtvirtintų nuostatų dalis valstybių narių savo nacionalinėje teisėje įtvirtino neregistruoto ženklo reputacijos apsaugos galimybę nepanašioms prekėms ir (arba) paslaugoms, tačiau tai siejant ne su ženklo registracija per se, bet su ženklo plačiu žinomumu (tai yra atitinkamu ženklo atpažinimo visuomenėje laipsniu).

Straipsnyje taip pat pateikiamas lyginamasis tyrimas, kaip Europos Sąjungos valstybėse narėse reglamentuojami klausimai, susiję su data, aktualia sprendžiant dėl plačiai žinomo arba turinčio reputaciją prekių ženklo apsaugos, kriterijais, į kuriuos atsižvelgiant gali būti sprendžiama dėl prekių ženklo plataus žinomumo ar reputacijos.

Remiantis atliktu tyrimu straipsnyje daroma pagrindinė išvada, jog, viena vertus, nors dalis valstybių narių savo nacionaliniame reguliavime rado puikias išeitis sprendamos tarptautinės bei Europos Sąjungos teisės nuostatose užprogramuotos sisteminės dilemos, susijusios su plačiai žinomų ir reputaciją turinčių prekių ženklų apsauga, problema, antra vertus, tai rodo, su kokiomis didelėmis ir esminėmis problemomis susiduria Europos Sąjungos teisė. Atitinkamos Europos Sąjungos teisės korekcijos yra neišvengiamos.

Reikšminiai žodžiai: neregistruoti plačiai žinomi prekių ženklai, registruoti plačiai žinomi prekių ženklai, prekių ženklai, turintys reputaciją.

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