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**Armenian Regulations on Protection of Well-Known Trademarks
and Their Conformity with the International Best Practices**

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Introduction

In the century of business and commerce, the use of trademarks has become a great necessity. Trademarks serve as brand identifiers, they are important both for the customers and for the businessmen. Nowadays, the amount and variety of trademarks have no boundaries. Different international organizations and states sign conventions, multilateral and bilateral treaties, adopt laws in their domestic legislation in order to protect those trademarks.

There is a separate category of trademarks that receive protection thanks to the reputation or fame thereof. Usually, such trademarks are called ‘Famous trademarks’ (as in the US), ‘Well-Known trademarks’ (the most common term, used in most of the states, including the Republic of Armenia), ‘Marks with reputation’ (in the UK), and so on. Although the terms may differ, the idea and the purpose of them are almost the same. As the most common one is the term “Well-Known”, this paper that one will mainly be used. The rights of Well-Known trademarks’ owners are more likely to be infringed or targeted, thus, they are more vulnerable, and require special protection. The protection and the criteria that are required for acquiring the status of Well-Known marks differ from jurisdiction to jurisdiction, and this paper will illustrate the international best practices in regulating and protecting the abovementioned category of trademarks.

The objective of this paper is to discuss the regulations of the Republic of Armenia on the protection of Well-Known trademarks, identify the international best practices and make recommendations for the improvement of the RA regulations. The main issue of this paper is to clarify whether the Armenian legislation is sufficient for the protection of Well-Known trademarks in the RA and whether such protection is in conformity with the international best practices. Furthermore, this paper will be focused on the duration of the ‘well-known’ status of trademarks, what evidence should be brought to receive that recognition, the possibility of making oppositions against the applications to declare the trademark as Well-Known is provided by the RA legislation.

Chapter 1 discusses the international framework of protection of Well-Known trademarks. In particular, this paper speaks about the Paris Convention, the TRIPs agreement, and some other universal or multilateral agreements that are directed to the protection of Well-Known

marks. This Chapter will also concentrate on the international best practices, on how some of the most effective and successful jurisdictions provide protection for those trademarks. It will include regulations on Well-Known or Famous trademarks of various countries, such as the US, Japan, and several EU countries.

Chapter 2 is devoted to the RA regulations on Well-Known trademarks. This Chapter will place emphasis on the protection that is granted for Well-Known marks in this country. It will mention the existing gaps and issues in the Armenian legislation and will provide a thorough comparative analysis of the Armenian regulations and international best practices.

Then, based on the comparative analysis, this Paper will make some recommendations with the purpose to amend or add new provisions to the existing Law.

CHAPTER 1

International Framework of Protection of Well-Known Trademarks

International standards of protection for Famous and/or Well-Known marks have been established through two treaties: through Paris Convention (1883) and the TRIPS Agreement (1967). In order to provide for a worldwide standard on how to implement the requirements under the Paris Convention and the TRIPS agreement, the World Intellectual Property Organization (the WIPO) issued its Joint Recommendation Concerning Provisions on Protecting Well-Known Marks. In addition, International Trademark Association firmly supports this Recommendation in a Board Resolution and strongly encourages nations to adopt its provisions.¹ The abovementioned documents refer to Well-Known marks, they include international standards and guidelines that may be necessary for the protection and recognition of such trademarks. Each of those documents will be discussed separately and thoroughly below.

Paris Convention For the Protection of Industrial Property (1883)

²The Paris Convention includes provisions relating to all the industrial property rights and establishes a set of uniform rules that must be observed by the member country of the Paris Union to provide minimum protection in the domestic legislation of the industrial property rights.³ There are no particular definitions of a well-known mark in the Paris Convention So, the interpretation of whether a trademark can be considered well-known is interpreted on an

¹ International Trademark Association, *International Standards of Protection for Well-Known Marks*, available at: <https://www.inta.org/Advocacy/Pages/FamousMarksWell-knownMarks.aspx> (last visited March 8, 2018)

² * Paris Convention for the Protection of Industrial Property is the oldest and multilateral industrial property treaty. It was signed in Paris on March 20, 1883, entered into force as from July 7, 1884. It has the widest membership with more than 140 member countries.

³ Xia Qing, *Protection of Well-Known Trademarks, The Comparison of Trademark Examination Standards And Trademark Law Systems Between Japan And China*, available at: http://www.jpo.go.jp/torikumi_e/kokusai_e/asia_ip_e/pdf/jpo/2002_china.pdf (last visited March 11, 2018)

independent, national basis. In the case of McDonalds Corporation v Joburger⁴, the South African courts held that the term Well-Known should be tested by reference to whether sufficient people knew the mark well enough to entitle it to protection against deception or confusion: a degree of knowledge similar to that protected by the law of passing off.⁵

A small part of the Convention refers to Well-Known trademarks. The Paris Convention has created separate and special protective regime for Well-Known trademarks. This Convention provides protective principles of Well-Known trademarks in Article *6bis*, as follows: Article *6bis*(1) of the Paris Convention permits the countries of the Paris Union 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 to 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. ⁶ The most significant and strongest point of the protection of Well-Known trademarks, granted by the Paris Convention, is that the protection of such trademarks is secured even without registration in a state.

Article *6bis* first incorporated the concept of a Well-Known trademark in 1925 and has been applying universally. It specifies the principles of protection of Well-Known trademarks in the countries of the Union. In case the unauthorized registration and use of trademarks constitute a reproduction, an imitation or a translation of Well-Known trademarks, the competent authority of the country, where the protection of Well-Known trademarks is sought, has the right to refuse, cancel or prohibit registration of such trademarks. Well-Known trademarks should be widely recognized and used in the country where the protection is sought, in order to receive proper protection. The existence of actual confusion or a risk of confusion is necessary for the protection of Well-Known trademarks as a result of infringement. The Paris Convention does not provide definitions or criteria which will guide to recognize what trademarks can be recognized

⁴ McDonalds Corporation v Joburger's Drive-Inn Restaurants and others, available at: <http://www.saflii.org/za/cases/ZASCA/1996/82.html> (last visited May 1, 2018)

⁵ Vasheharan Kanesarajah Thomson Scientific, *Protecting and Managing Well-Known Marks*, 2007, available at: <http://ips.clarivate.com/m/pdfs/klnl/8418407/wellknownmarks.pdf> (last visited May 1, 2018)

⁶ Paris Convention for the Protection of Industrial Property, March 20, 1883, available at: http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=288514#P151_21198 (last visited March 9, 2018)

as Well-Known ones. It provides protection for Well-Known trademarks just considering trademarks for the identical or similar goods, not including the dissimilar goods or services. So, if Well-Known trademarks are registered for different goods or services by others, the owners of Well-Known trademarks will have no means for objection.⁷

The Convention grants discretion to the member states to determine the period within which the prohibition of use must be requested based on Article 6*bis* (2) of the Convention.⁸

The TRIPS Agreement (1995)

Compared to the Paris Convention, the TRIPS Agreement protects Well-Known trademarks that are already registered.⁹ This agreement does not expand the scope of protection of Well-Known trademarks. Like the Paris Convention, it does not set out the criteria to determine what trademarks can be recognized as Well-Known ones, and therefore, the member states need to have national legislations about it respectively. However, the TRIPS Agreement establishes the detailed substantive minimum standards on the protection of Well-Known trademarks that gives a higher level of protection than the Paris Convention does. The WTO member countries have to perform the obligation of the TRIPS Agreement. Any of the members, especially the developing countries rectified their domestic laws to be in compliance with the requirements of TRIPS. It is expected that the developing countries would finally benefit from the implementation of the TRIPS Agreement.¹⁰

⁷ Xia Qing, *Protection of Well-Known Trademarks, The Comparison of Trademark Examination Standards And Trademark Law Systems Between Japan And China*, available at:

http://www.jpo.go.jp/torikumi_e/kokusai_e/asia_ip_e/pdf/jpo/2002_china.pdf (last visited March 11, 2018)

⁸ Paris Convention for the Protection of Industrial Property, March 20, 1883, available at:

http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=288514#P151_21198 (last visited March 9, 2018)

⁹ *Agreement for Trade-Related Aspects of Intellectual Property Rights, annex to the (Marrakesh) Agreement establishing the World Trade Organization (WTO). TRIPS entered into force for Armenia on January 1, 1995 and is the most important international IPR agreement promoting the harmonization of national regimes of IP rights.

¹⁰ Xia Qing, *Protection of Well-Known Trademarks, The Comparison of Trademark Examination Standards And Trademark Law Systems Between Japan And China*, available at:

http://www.jpo.go.jp/torikumi_e/kokusai_e/asia_ip_e/pdf/jpo/2002_china.pdf (last visited March 11, 2018)

The TRIPS Agreement makes references to the Paris Convention, by stating that in respect of Parts II, III and IV of that agreement, Members of the World Trade Organization are obliged to comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967). According to Article 16.2, “Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is Well-Known, Members shall take into account the knowledge of the trademark in the relevant sector of the public, as well as the knowledge that has been obtained as a result of the promotion of that trademark in the concerned Member state”. As provided by Article 16.3, “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”.¹¹

WIPO Joint Recommendation Concerning Provisions on Protecting Well-Known Marks (1999)

Another document referring to Well-Known trademarks is the “WIPO Joint Recommendation Concerning Provisions on Protecting Well-Known Marks”.¹²

A great number of countries had no provisions concerning the protection of Well-Known trademarks in domestic law by the time of the establishment of the TRIPS Agreement. It was discussed internationally, but, after the TRIPS Agreement went into effect, all member countries Recommendation Concerning Provisions on the Protection of Well-Known Marks. It was adopted at the joint assemblies of the Paris Convention Union and the WTO and became effective for countries that were members to not only the Paris Convention but also the WTO Treaty. The “Joint Recommendation” provides guidelines for determination of whether a mark is

¹¹ Uruguay Round Agreement, *Trade-Related Aspects of Intellectual Property Rights (TRIPS)*, 15 April, 1994. available at: http://www.wipo.int/treaties/en/text.jsp?file_id=305907#part2.2 (last visited March 8, 2018)

¹² *This document was adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO, on September 20 to 29, 1999.

a Well-Known one in a member state, it names a non-exhaustive list of factors which may be required for determining when a mark can be deemed to be in conflict with a Well-Known mark. The Joint Recommendation makes all the criteria optional, so it adds little predictability for future well-known trademark cases. It does, however, provide a ready reference for countries that have not yet clearly included provisions concerning Well-Known marks in their domestic jurisdictions.¹³

According to this Recommendation, for the determination whether a mark is a Well-Known one in a member state, the following factors should be taken into consideration:

(a) In determining whether a mark is well-known, 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:

- *the degree of knowledge or recognition of the mark in the relevant sector of the public;*
- *the duration, extent and geographical area of any use of the mark;*
- *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;*
- *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;*
- *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;*
- *The value associated with the mark.*¹⁴

¹³ Hà Th Nguyt Thu, *Well-Known Trademark Protection, Reference to the Japanese Experience*, available at: http://www.wipo.int/export/sites/www/about-wipo/en/offices/japan/research/pdf/vietnam_2010.pdf (last visited March 11, 2018)

¹⁴ The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO), *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, 1999, available at: <http://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf>, (last visited March 11, 2018)

These factors serve as guidelines to assist the competent authority to determine whether the mark is a Well-Known mark. These factors 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. Also there may be cases when none of the factors may be relevant, and the decision may be based on additional factors that are not listed in the subparagraph above. Such additional factors may be relevant, alone, or in combination with one or more of the factors. WIPO gives an explanation what can be understood by saying ‘relevant sectors of the public’: Relevant sectors of the public shall include, but shall not necessarily be limited to:

- actual and/or potential consumers of the type of goods and/or services to which the mark applies;
- persons involved in channels of distribution of the type of goods and/or services to which the mark applies;
- business circles dealing with the type of goods and/or services to which the mark applies.

(b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.

(c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.

(d) A Member State may determine that a mark is a Well-Known mark, even if the mark is not well known or, if the Member States applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(3) Concerning the factors which shall not be required: “A Member State shall not require, as a condition for determining whether a mark is a Well-Known mark”:

- that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;
- that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

- that the mark is well known by the public at large in the Member State.¹⁵

Although the Paris Convention and the TRIPS Agreement provide protection for Well-Known trademarks and guarantee such protection, they do not have criteria that are decisive for recognition of Well-Known trademarks. Nevertheless, countries set rules for such recognition; in addition, they bring out factors which may be required for such recognition. Those factors serve as a tool for the administrative authorities or judicial bodies of countries in the process of recognizing or granting the status of Well-Known trademarks.

International Trademark Association (1878)

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property to foster consumer trust, economic growth, and innovation. International Trademark Association was founded in 1878 by 17 merchants and manufacturers who saw a need for an organization “to protect” and promote the rights of trademark owners, to secure useful legislation and to give aid and encouragement to all efforts for the advancement and observance of trademark rights.¹⁶

INTA endorses consideration of the following factors as criteria for establishing a “Well-Known” mark:

- the amount of local or worldwide recognition of the mark;
- the degree of inherent or acquired distinctiveness of the mark;
- the local or worldwide duration of use and advertising of the mark;
- the local or worldwide commercial value attributed to the mark;
- the local or worldwide geographical scope of use and advertising of the mark;

¹⁵ The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO), *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, 1999, available at:

<http://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf>, (last visited March 17, 2018)

¹⁶ International Trademark Association, *about INTA*, available at:

<https://www.inta.org/About/Pages/Overview.aspx> (last visited March 20, 2018)

- the local or worldwide quality image that the mark has acquired;
- the local or worldwide exclusivity of use and registration attained by the mark and the presence or absence of identical or similar third-party marks validly registered for or used on identical goods and services..¹⁷

Such factors vary from jurisdiction to jurisdiction. And the subsequent Chapters of this Paper will illustrate the practice of some states, it will mention what national jurisdictions of some countries require for granting the status of a Well-Known trademark, and what protection is provided for trademarks enjoying that advantageous status.

In addition, in the Board Resolution of the association, there are several recommendations, that INTA makes for countries to adopt several practices, the two of which are mentioned below:

- To set term of 10 years for a Well-Known mark registration with the opportunity for the mark owner to apply for renewal.¹⁸
- Set procedures for third parties acting in good faith to oppose the placement of a mark on a well-known mark registry and to move for cancellation of a registration on a well-known mark registry at any time.¹⁹

Legal Regulations on Well-Known Marks in the European Union

Trademark protection in the European Union has developed mainly based on international treaties such as the Paris Convention, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) and the Madrid Agreement. Protection granted to famous marks originates from Article 6*bis* of the Paris Convention and Article 16 of TRIPs, which give

¹⁷ International Trademark Association, *Board Resolutions, Well-Known Marks Protection*, available at: <https://www.inta.org/Advocacy/Pages/WellKnownMarksProtection.aspx> (last visited March 13, 2018)

¹⁸ International Trademark Association, *Model Law Guidelines, A Report on Consensus Points for Trademark Laws*, 2007, available at: www.inta.org/Advocacy/Documents/INTAModelLawGuidelines.doc (last visited May 9, 2018)

¹⁹ International Trademark Association, *Board Resolutions, Well-Known Marks Registries*, available at: <http://www.inta.org/Advocacy/Pages/Well-KnownMarkRegistries.aspx> (last visited May 9, 2018)

additional cover to Well-Known marks, even where they have not been registered. However, there is still no common definition of a ‘well-known’ mark, leading to variations in interpretation and thus protection from country to country.²⁰

One of the advantages of the EU law concerning the Well-Known trademarks is that there is a provision concerning the opposition against the registration of a trademark as Well-Known. To be more precise, the EU Directive 2015/2436/EC²¹ and the EU Community Trademark Regulation (207/2009)²² recognize Well-Known trademarks as relative grounds for refusal – namely, as grounds for opposition. Hence, Article 8(2)(c) of the EU Community Trademark Regulation and Article 5(2)(d) of EU Directive 2015/2436/EC allow opposition based on trademarks which “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”. These articles create the possibility of filing an opposition against a trademark application in the European Union, based on a Well-Known trademark.²³

Concerning the criteria necessary to determine whether the mark is well known or not, the majority of the EU Member States do not provide any list of specific criteria which could be taken into account in making the decision to grant the status. The majority of the EU member states refer to the appropriate articles of the Paris Convention and (or) the TRIPS Agreement. Such instances are the United Kingdom (The United Kingdom Trade Marks Act), Ireland, Benelux, Germany, Czech Republic, Denmark, Greece, Latvia, Lithuania, Spain, Hungary, France, Malta and Slovenia. However, even though the WIPO Recommendation for the Protection of Well-Known Marks is a “soft-law”, i.e., a non-binding instrument, three Member States – Estonia, Bulgaria, and Romania – have provided in their national legislation particular

²⁰ Frédérique Bodson, *European Union: Protecting Well-Known Marks Under International Treaties*, 2016, available at:

<http://www.worldtrademarkreview.com/Magazine/Issue/64/Country-correspondents/Protecting-well-known-marks-under-international-treaties> (last visited: May 2, 2018)

²¹ EU Directive 2015/2436 of the European Parliament and of the Council of 16 December, 2015, available at: <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32015L2436&from=EN> (last visited: May 2, 2018)

²² EU Council Regulation No 207/2009 of 26 February 2009 on the Community Trademark, available at: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:en:PDF> (last visited: May 2, 2018)

²³ Daan Wijnnobel, NLO Shieldmark, *Protecting Well-Known Trademarks in the European Union*, available at: <http://www.iam-media.com/intelligence/IAM-Yearbook/2017/Europe/Protecting-well-known-trademarks-in-the-European-Union> (last visited: May 2, 2018)

criteria for recognizing a trademark as Well-Known similar to those established in the WIPO Recommendation.²⁴ Those practices will be discussed separately below.

Estonia's Trademarks Act was enacted in 2002. In this Act, there is a separate chapter dedicated to Well-Known marks. This Act specifies what should be taken into account for the recognition of the Well-Known status of trademarks. Particularly, Article 7 of the Trademarks Act mentions that (3) the following shall be taken into consideration upon recognizing a trademark as being Well-Known:

- the degree of knowledge of the trademark in Estonia in the sector of actual and potential consumers of goods analogous to the goods or services to which the trademark 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;
- the duration and extent of the use and promotion of the mark and geographical area of the use of the mark;
- the registration, use, and knowledge of the mark in other countries;
- the value associated with the mark²⁵.

(4) It is sufficient for recognizing a trademark as being well known if the trademark is known to the majority of persons in at least one of the sectors specified in clause (3) 1) of this section.²⁵

From this, it can be seen that in the Estonian practice the registration, use, and knowledge of the mark in other countries can also be taken into account. Some countries do not include such criteria in their domestic legislations; on the contrary, they require that the trademark has to be well known in the territory of that particular country. Besides, this Law states that for the recognition of a trademark as Well-Known, being well known to the majority of the public is not required. So, if a trademark is Well-Known to a specific sector, it can get the status of a Well-Known mark.

²⁴ Danguolė Klimkevičiūtė, The Legal Protection of Well-Known Trademarks, and Trademarks with Reputation: The Trends of the Legal Regulation in the EU Member States, available at:

<https://www3.mruni.eu/ojs/societal-studies/article/view/1322/1269> (last visited May 3, 2018)

²⁵ Trade Marks Act of Estonia, 2002 (Consolidated Text of January 1, 2012), available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=258149 (last visited May 3, 2018)

Bulgaria's example is almost the same as it does not differ much from the Estonian scenario. The law regulating the protection on Well-Known marks is the Law on Marks and Geographical Indications of Bulgaria, enacted in 1999 ²⁶.

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 refers to the determination of a Mark as a Well-Known Mark or a Mark With a Reputation, providing that when determining whether the mark is a Well-Known mark or a mark with a reputation, the following shall be taken into account:

- 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;
- duration, extent and geographical area of use of the mark;
- 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;
- information about the successful enforcement of the rights in the mark, if registered;
- value of the mark; and other circumstances". ²⁷

From the first point, it is worth mentioning that the Bulgarian Law provides that for determining whether a trademark can be recognized as Well-Known, the extent to which the mark is known or recognized among the part of the community should be taken into account. The Law mentions that 'the community' covers both the real or potential users of the goods or services. By this, the Bulgarian law expands the circle of the community, to which such goods or services need to be well known. The other important criteria are mentioned in the third point, it brings examples of what evidence can be taken into account while making the decision of recognition of a trademark

²⁶ Law on Marks and Geographical Indications of Bulgaria, available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=125308 (last visited May 3, 2018)

²⁷ Danguolė Klimkevičiūtė, The Legal Protection of Well-Known Trademarks, and Trademarks with Reputation: The Trends of the Legal Regulation in the EU Member States, available at: <https://www3.mruni.eu/ojs/societal-studies/article/view/1322/1269> (last visited May 3, 2018)

as Well-Known. This may bring more certainty for the trademark owners who want to apply for recognizing their marks as Well-Known ones.

Another example is Romania's Regulation. According to Article 20 of the Romanian Law on Marks and Geographical Indications, "the examination of the reasons for rejection... shall be done in conformity with some criteria, such as:

- the degree of distinctiveness, initial or acquired, of the Well-Known mark in Romania;
- the time period and time lasting utilization of the Well-Known mark in Romania concerning the products and services for which a trademark is requested to be registered;
- the time period and time lasting for advertising of the Well-Known mark in Romania;
- the geographical area for utilization of the Well-Known mark in Romania;
- the degree of acknowledgment of the Well-Known mark on the Romanian market by the section of the public to whom it is addressed;
- 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 well known."²⁸

In order to examine the reasons for rejection based upon the mentioned 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 is "Well-Known" in Romania (Article 20(2) of the Romanian Law)²⁹.

Legal Regulations of Well-Known Trademarks in The United States of America

²⁸ Law on Marks and Geographical Indications of Romania, available at: http://www.osim.ro/index3_files/laws/trademark/mareng.htm#Chapter%20I (last visited May 4, 2018)

²⁹ Danguolė Klimkevičiūtė, The Legal Protection of Well-Known Trademarks, and Trademarks with Reputation: The Trends of the Legal Regulation in the EU Member States, available at: <https://www3.mruni.eu/ojs/societal-studies/article/view/1322/1269> (last visited May 4, 2018)

The US jurisdiction does not use the term “Well-Known” trademarks, rather it uses the term “Famous” trademarks. However, the protection that is provided under the US legislation for Famous trademarks is almost equivalent to what other countries grant to Well-Known trademarks in their domestic jurisdictions. The Lanham (Trademark) Act of 1946 is the primary federal trademark statute of law in the United States of America. In particular, Section 43 of the Lanham Act is dedicated to Famous trademarks.

This Act provides factors which could help the courts in determining whether a mark possesses the requisite degree of recognition to be considered as Famous. The factors are the following:

- The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.
- The amount, volume, and geographic extent of sales of goods or services offered under the mark.
- The extent of actual recognition of the mark.
- Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.³⁰

This Act also concentrates on dilution and recognizes two types of dilution, which are dilution by blurring and dilution by tarnishment. The Trademark Dilution Revision Act of 2006 of the Lanham Act (hereinafter; the TDRA) provides a clearer definition of ‘dilution’, which described it as “the lessening of the capacity of a Famous mark to identify and distinguish goods or services”. ‘Blurring’ is the “association arising from the similarity between a mark or trade name and a Famous mark, that impairs the distinctiveness of the Famous mark”. In determining whether a mark has been blurred, Section 2(2)(B) of the Act directs implies that courts may consider “all relevant factors, including” the following:

- The degree of similarity between the mark or trade name and the Famous mark.
- The degree of inherent or acquired distinctiveness of the Famous mark.
- The extent to which the owner of the Famous mark is engaging in the substantially exclusive use of the mark.

³⁰ The Lanham (Trademark) Act of the USA, 1946, §43, available at: <https://www.bitlaw.com/source/15usc/1125.html> (last visited March 7, 2018)

- The degree of recognition of the Famous mark.
- Whether the user of the mark or trade name intended to create an association with the Famous mark.
- Any actual association between the mark or trade name and the Famous mark.”

For tarnishment, the act does not provide a list of factors, but simply defines it as an “association arising from the similarity between a mark or trade name and a Famous mark that harms the reputation of the Famous mark”. Conforming amendments are included to allow for oppositions against trademark applications and cancellation actions against federal registrations. Specific defenses (called ‘exclusions’) are included:

(A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a Famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with

- advertising or promotion that permits consumers to compare goods or services; or
- identifying and parodying, criticizing, or commenting upon the Famous mark owner or the goods or services of the Famous mark owner.

(B) All forms of news reporting and news commentary.

(C) Any non-commercial use of a mark.

The act limits the available remedies to only injunctive relief unless:

(A) the mark or trade name that is likely to cause dilution by blurring or dilution by tarnishment was first used in commerce by the person against whom the injunction is sought after the date of enactment of the Trademark Dilution Revision Act of 2006 ... ; and

(B) in a claim arising under this subsection:

- by reason of dilution by blurring, the person against whom the injunction is sought willfully intended to trade on the recognition of the famous mark; or
- by reason of dilution by tarnishment, the person against whom the injunction is sought willfully intended to harm the reputation of the famous mark.”

Monetary awards under this provision are subject to the discretion of the court and the principles of equity.³¹

Legal Regulations on Well-Known Trademarks in Japan

In Japan, there are two laws that regulate and provide protection for Well-Known trademarks. The first one is the Japanese Trademark Law, and the second one is the Japanese Unfair Competition Prevention Law. These laws provide protection for Well-Known trademarks, without registration. Likewise, there is another valuable document covering the protection of Well-Known trademarks, which is the “Trademark Examination Guideline”. The one includes factors that may be taken into consideration while granting the marks the status of Well-Known trademarks, including the idea of what can be understood under “Well-Known trademark”, and so on. Each of the two documents will be discussed separately below.

According to the Article 4(1)(x), Section 4 of the Japanese Trademark law, “... a registration shall not be affected in any case of the following trademarks: (x) trademarks which are well known among consumers as indicating the goods or services as being connected with another person’s business, and trademarks similar thereto, and which are used in respect of such goods or services or similar goods or services;”³² According to this article, The Patent Office (the PTO) must refuse an application for trademark registration if it is identical with or similar to a Well-Known trademark of another person used for the same or similar goods or services. This

³¹ Oblon Spivak McClelland Maier & Neustadt PC, “*Protection of Famous Trademarks Under New Dilution Act*”, available at:

<http://www.worldtrademarkreview.com/Magazine/Issue/11/Country-correspondents/United-States-Oblon-Spivak-McClelland-Maier-Neustadt-PC> (last visited March 13, 2018)

³² The Japanese Trademark Act, 1959, available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=403346 (last visited March 12, 2018)

article serves to reject a third party's unauthorized application of identical or similar trademark and invalidate its registration in case that designated goods or services are identical or similar to which the well-known trademark has been used by its true owner. The registration of the Well-Known trademark is not required in this situation. This means that a Well-Known trademark is protected from others party's registration even though the trademark rights for it have not been established.³³

As to the Article 32 of the Japanese Trademark Law, the right to use trademarks is based on the 'prior use'. It is considered that this provision primarily aims to secure the right of users of unregistered well-known trademarks to continue to use them in case the relevant trademarks are unanticipated registered.³⁴

Basic concepts, including interpretation and operation, of the application of the Trademark Act of Japan, in the performance of practical duties in trademark examination are summarized in the Trademark Examination Guidelines. These are general guidelines for trademark examination, and are broadly used to deepen trademark applicants' and their representatives' understanding of the practical duties performed at the Patent Office of Japan. The current Trademark Examination Guidelines have been partially revised several times since the first version of the Guidelines was issued.³⁵

According to the Revised Trademark Examination Guidelines (version of April 2007) particularly, according to the Article 4(1)(X) of it, a Well-Known trademark of another person is the following: "a trademark which is identical with, or similar to, another person's trademark which is well known among consumers for indicating goods or services in connection with the

³³ Hà Th Nguyt Thu, *Well-Known Trademark Protection, Reference to the Japanese Experience*, available at: http://www.wipo.int/export/sites/www/about-wipo/en/offices/japan/research/pdf/vietnam_2010.pdf (last visited March 11, 2018)

³⁴ Hà Th Nguyt Thu, *Well-Known Trademark Protection, Reference to the Japanese Experience*, available at: http://www.wipo.int/export/sites/www/about-wipo/en/offices/japan/research/pdf/vietnam_2010.pdf (last visited March 11, 2018)

³⁵ Japan Patent Office, about *Examination Guidelines for Trademarks, 2007*, available at: https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/tt1302-002.htm (last visited March 14, 2018)

person's business, if such a trademark is used in connection with such goods or services, similar goods or services".³⁶

This document provides standards for determining 'fame' which may be necessary for acquiring a status of a Well-Known mark:

- o Commencement, period of use, area of the use, the scope of the goods or services for which it is used and other relevant factors shall be considered.
- o The degree of advertisement, promotion, etc. of the originally registered trademark or its coverage shall be taken into consideration.
- o The size of business enterprise of the right holder of the original registered trademark, its business activities (such as production or sales activities), and the goods handled by the enterprise shall be considered, in addition, the condition of the enterprise shall be reviewed.
- o Whether or not the fame of the originally registered trademark is an indisputable fact (*kenchona jijitsu*) shall be examined by the Patent Office of Japan.³⁷

Regarding the expression "a trademark which is well-known among consumers, indicating goods or services in connection with the person's business", this document provides the following idea:

- As to the consumer's recognition "a trademark which is well-known among consumers" includes not only a trademark which is generally well known among consumers, but also a trademark which is well known among traders in the industry, and also includes a trademark which is known not necessarily throughout the whole country, but in a certain area.
- Concerning the determination on the degree of being well known Part II, Items 2(2) and (3) (Article 3(2)) of the Guidelines apply mutatis mutandis to the judgment on whether

³⁶ Japan Patent Office, *Examination Guidelines for Trademarks*, 2007, Chapter 9, available at: https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/tt1302-002/0309.pdf (last visited March 14, 2018)

³⁷ Japan Patent Office, *Examination Guidelines for Trademarks*, 2007, available at: https://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/tt1302-002/0309.pdf (last visited March 15, 2018)

or not the trademark "is well known among consumers." For example, the judgment is made by sufficiently taking into consideration the following circumstances.

(a) Cases of goods or services with the special form of transaction For example, "medicines and drugs for medical use" and "test, examination or research of drugs" are goods distributed or services provided only in specific markets.

(b) Cases of trademarks that are mainly used in foreign countries.

Trademarks that are mainly used in foreign countries means:

(i) trademarks that are well known in a foreign country,

(ii) goods on which the relevant trademark is used that are exported to several countries, or

(iii) services, bearing the trademark, that are provided in several countries.³⁸

To prove a trademark's being well-known under the provision of this Article, the provisions of Items 3(1) and (2) of Chapter II (Article 3(2)) of the Guidelines are applicable by reference as follows: "Judgment as to whether a trademark has come to gain its distinctiveness through use will be made, taking the following points into consideration". Specifically, the level of consumers' awareness, which will be estimated through a quantitative grasp of the use of a trademark, will be utilized to judge the distinctiveness of a trademark:

- A trademark actually in use and goods or services for which it is used
- The start of its use, the length of its use, or the area where it is used
- The volume of production, certification or delivery and a scale of business (number of stores, an area of business, the volume of sales and so on)
- The method, frequency and contents of advertising
- The number of times of appearance in general newspapers, trade journals, magazines and the internet, and contents thereof
- The outcome of the questionnaire regarding consumers' awareness of the trademark

³⁸ Xia Qing, *Protection of Well-Known Trademarks, The Comparison of Trademark Examination Standards And Trademark Law Systems Between Japan And China*, available at: http://www.jpo.go.jp/torikumi_e/kokusai_e/asia_ip_e/pdf/jpo/2002_china.pdf (last visited March 11, 2018)

(2) The above facts need to be proved by a method using evidence, including:

- Printed matter (newspaper clippings, magazines, catalogs, leaflets, etc.) carrying advertisements, public notices...
- Invoices, delivery slips, order slips, bills, receipts, account books, pamphlets...
- Photographs or something like that showing the use of a trademark
- A certificate by an advertisement agency, broadcasting agency, publisher or printer;
- A certificate by a trade association, fellow traders or consumers
- A certificate by a public organization, etc. (the state, a local public entity, a foreign embassy in Japan, a Chamber of Commerce and Industry, etc.)
- Articles in general newspapers, trade journals, magazines and the internet
- Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark.³⁹

However, due consideration will be given to the objectivity of the questionnaire with respect to the conductor, method, and respondents. A combination of another person's unregistered trademark "well known among consumers" and characters or diagrams are, in principle, considered "similar" to the unregistered well-known trademark including those trademarks even if both parts are integrated to appear as a single mark or to possess interrelated meanings. 16 However, cases when portions of the unregistered trademark constitute part of an established word or when it is clear that the unregistered trademark is considerably different in appearance sound or concept, and then the unregistered trademark will be excluded. In judging whether a foreign trademark is well known in Japan or not, it is necessary to take full consideration evidential documents demonstrating that the said trademark is well-known in that foreign country that the goods on which the trademark is used are exported to other several countries or that services bearing the trademark are provided in several countries, if such documents are available.⁴⁰

³⁹ Hà Th Nguyt Thu, *Well-Known Trademark Protection, Reference to the Japanese Experience*, available at: http://www.wipo.int/export/sites/www/about-wipo/en/offices/japan/research/pdf/vietnam_2010.pdf (last visited March 11, 2018)

⁴⁰ Hà Th Nguyt Thu, *Well-Known Trademark Protection, Reference to the Japanese Experience*, available at: http://www.wipo.int/export/sites/www/about-wipo/en/offices/japan/research/pdf/vietnam_2010.pdf (last visited March 11, 2018)

As to the Japanese Unfair Competition Prevention Law, it was enacted in 1934 in Japan, as a result of becoming a member of the Paris Convention. The main objective of this law is to contribute to the sound development of the national economy by providing measures for prevention of unfair competition. The Unfair Competition Prevention Law is meant not to protect the Well-Known indications as an absolute right, it can only be meant to protect the well-known indications against unfair use. Under this Law if the well-known trademark hasn't been registered as a trademark or a defensive trademark, at least the owner of the widely known indications can be protected to seek the lawful relief from it. This law plays a more significant role in the protection of intellectual property rights. Furthermore, It is noted that the owner of the registered trademark or defensive trademark can take action against the unauthorized third person before the Court under the Trademark Law, this lawsuit belongs to the infringement suit, and the owner of trademark can be easier to use the infringement proceedings to reach his objective.⁴¹

CHAPTER 2

Legal Regulations on Well-Known Trademarks in the Republic of Armenia

The Civil Code of the Republic of Armenia was adopted by the National Assembly in 1998. The RA Civil Code does not have separate provisions on Well-Known marks and on the protection thereof. Only the Article 1171.2 (2), provides that “a trademark is granted legal protection on the basis of its recognition as a Well-Known trademark in accordance with the

⁴¹ Xia Qing, *Protection of Well-Known Trademarks, The Comparison of Trademark Examination Standards And Trademark Law Systems Between Japan And China*, available at: http://www.jpo.go.jp/torikumi_e/kokusai_e/asia_ip_e/pdf/jpo/2002_china.pdf (last visited March 11, 2018)

procedure prescribed by law in the territory of the Republic of Armenia”.⁴² This Article states that Well-Known trademarks do receive legal protection based on their recognition as Well-Known marks, and that such protection is given according to the RA Law on Trademarks.

The “RA Law on Trademarks” (the Law) was adopted on 29 April, 2010. This Law is in force today. Article 7.1(2) of the Law provides that “in the territory of the Republic of Armenia, a trademark shall be granted legal protection by virtue of declaring the trademark as Well-Known in the Republic of Armenia ”.

Article 29 of the Law refers to the scope of legal protection of a Well-Known trademark in the RA. Particularly, it states that:

“A trademark may be recognized as a Well-Known trademark if, as a result of its use, it has become widely recognized in certain social circles in the territory of the Republic of Armenia, for those goods and/or services for which the trademark was used.” One of the shortcomings of this paragraph is that this Law does not specify what can be understood under “certain social circles”. This gap may lead to misinterpretation of the Article.

“A trademark is recognized as a Well-Known trademark in the Republic of Armenia and is legally protected regardless of the fact whether it is registered or not.” This paragraph is in conformity with the Paris Convention, since according to it, Well-Known trademarks can still be protected, even without registration. As a general rule, it is accepted in most of the states.

“The legal protection to a trademark, which is recognized as Well-Known, shall be granted without time limit”. This is controversial, since one may argue that a trademark that has acquired a status of a Well-Known mark may not enjoy the fame or the reputation it enjoys at the moment after a certain period of time. Fame or reputation may be not perpetual. Since these marks are being protected due to their fame and reputation. So, is it fair to grant that protection with a limited period of time? Yes, it is. Such protection needs to be granted for a limited period of time with the possibility of renewal.

⁴² Armenian Legal Information System (“Arlis”), *Civil Code of the Republic of Armenia*, available at <http://www.arlis.am/DocumentView.aspx?DocID=119109> (last visited Feb. 10, 2018)

Article 30 of the same Law mentions that “the proprietor of a trademark that has been recognized as Well-Known in the Republic of Armenia, has the right to prohibit the use, by other persons in the course of their industrial or commercial activities, without the prior authorization of the proprietor of a sign, which constitutes the reproduction, imitation or translation of a trademark recognized as Well-Known, which can cause confusion with the latter and is used in respect of goods that are identical and similar to it”. So, in case there is a reproduction, imitation or translation of a trademark, the use of the conflicting mark can be prohibited by the proprietor of the Well-Known trademark. But, unlike the regulation provided by the US Lanham Act, the RA Law refers only to the cases when the goods and/or services of the conflicting are similar or identical to those of the Well-Known one. This weakens the protection of Well-Known trademarks because the Well-Known mark can be harmed even if the conflicting mark is not used for similar or identical goods or services for which the Well-Known mark is used.

“The proprietor of a trademark that has been recognized as Well-Known in the Republic of Armenia, in addition to the rights established in Article 12 of this Law, has the right to prohibit the use by other persons in the course of their industrial or commercial activities, without his prior authorization of such a sign, which may not be used in respect of goods and/or services of similar types and may be perceived as the reproduction, imitation or translation of a trademark recognized as Well-Known and can cause confusion, if the use of that sign for those goods and/or services implies a correlation between these goods and/or services for which the Well-Known trademark is used, and such a use can cause damage to the interests of the proprietor of the trademark that was recognized as Well-Known”. In case the goods or services of those two marks are not similar to each other, such use can be prohibited by the proprietor of the Well-Known mark owner, only if it is proved that the conflicting mark can cause confusion, and there is likelihood of correlation between the goods and services, and there is risk of damage to the interest of the proprietor of the Well-Known trademark.

“For the realization of the rights prescribed by paragraphs 1 and 2 of this Article, the proprietor of a trademark that has been recognized as Well-Known has the right of applying

to the court. If the opposing trademark, during the period of five years prior to the date of applying to the court, was used continuously and in a reasonable extent in the course of industrial or commercial activities, then this circumstance serves as a basis for the refusal of the claim”. This provision can also be seen in the Paris Convention.

Concerning the recognition of trademarks as Well-Known, Article 31 of the Law provides that an interested party is entitled to the right to send a request to the registering body. However, there is a limitation to apply one request for one mark only.

In his/her request the applicant must show the reproduction and description of the trademark, as well as the date since when the trademark is claimed to be recognized as Well-Known.

“The formal requirements for the application are the following: to the request must be attached

1. documents containing information on the proprietor or user of the trademark;
2. the list of goods and/or services, for which the trademark is used;
3. documents that, in certain social circles testify the level of being the trademark as Well-Known for those goods and/or services for which the particular trademark is used
4. documents testifying information on the date starting of use the trademark and the period of use
5. documents containing information on the geographical territory of using the trademark in the Republic of Armenia
6. the receipt for payment of the state fee established by the Law

Of course, these requirements are of great significance and need to be provided in the request, however, they are too general and unclear. For instance, the third point; ‘documents, that testify the level of being the trademark as Well-Known’, is too general. It would be better to specify, to bring a non-exhaustive list what documents could be brought, i.e. surveys, sales, advertisements, documents showing the scope or the intensity of its use, and so on. Concerning the term ‘in certain social circles’, it would be better to provide an additional

information, in what circles should the mark be well known to meet that requirement.⁴³ There is a Cassation Court case, particularly, ‘*Grand Candy*’ LLC v. ‘*Armel Group*’ CJSC, in which the court explains that certain circles of consumers cannot be the same as all consumers (that was a case of 2006, 4 years earlier than the final version of the RA Law on Trademarks was adopted).⁴⁴

4. A period of two months after receiving the request is granted to the Board Appeals to discuss the request on the recognition of a trademark as Well-Known in the Republic of Armenia and to make a corresponding decision.

5. The registration of a trademark as Well-Known under the RA legislation may be rejected in the following two cases:

- 1) the registration may be rejected if the documents provided in paragraph 3 of this Article are incomplete or unreliable or are not sufficiently convincing that the trademark actually has become widely recognized in certain social circles in the territory of the Republic of Armenia for those goods and/or services, for which it was used; or
- 2) in case a trademark has become widely recognized in certain social circles in the Republic of Armenia for similar goods and/or services after the date of priority of a registered trademark of another person, which is the same or confusingly similar and may mislead the consumers.⁴⁵

To conclude, as seen in the report concerning the compliance of the RA regulations with INTA Board Resolution, the RA Law on Trademarks has the following shortcomings:

⁴³ Intellectual Property Agency, “*The Law of the Republic of Armenia on Trademarks*”, available at: <https://www.aipa.am/en/TrademarkLaw/> (last visited March 20, 2018)

⁴⁴ DataLex, *Court Case* No: 3- 1760(S’), available at: http://datalex.am/?app=AppCaseSearch&case_id=13229323905401881 (last visited March 21, 2018)

⁴⁵ Intellectual Property Agency, “*The Law of the Republic of Armenia on Trademarks*”, available at: <https://www.aipa.am/en/TrademarkLaw/> (last visited March 20, 2018)

- As opposed to regular trademark applications, the Law has no provisions regarding filing oppositions against applications requesting to declare a mark as Well-Known.
- In addition, the Armenian Trademark Law does not have any special cancellation provisions related to Well-Known marks. The decision of the Board of Appeals of the Armenian PTO may be challenged by appealing it to the First Instance Administrative Court, as any other decision of an Administrative Body (authority), in the Republic of Armenia.
- It has no special provision on treatment of financial and other sensitive business information submitted in support of an application for inclusion on a Well-Known mark registry. Therefore, the applicants either do not submit any sensitive information or are aware that such information may become public.
- According to the Law, Well-Known marks are protected perpetually, there is no time limit on the status of Well-Known marks. And there is no renewal or payment of renewal fees.
- The Law on Trademarks has no specific provisions on whether or how can the decisions of the PTO's Board of Appeals (on the declaration of a mark as well-known), be appealed to the Administrative Court.
- The Armenian Trademark Law has no special cancellation provisions for well-known marks. The decision of the Board of Appeals of the Armenian PTO may be challenged by appealing to the Administrative Court, as any other decision of an Administrative Body (authority), in the Republic of Armenia.
- Well-Known marks have a wider scope of protection. In particular, their protection expands to all goods or services, notwithstanding: 1) the classes covered by the initial registration of the mark, or 2) the absence of registration, at all.⁴⁶

The Armenian law requires the following documents/information to be attached to the application:

⁴⁶ Report to the Famous and Well-Known Marks Committee, *Compliance with INTA Board Resolution by Armenia*

- 1) information about the owner or user of the trademark;
- 2) the list of goods and/or services, for which the trademark is used;
- 3) any document showing the level of fame of the trademark for those goods and/or services for which the particular trademark is used;
- 4) the date of first use of the mark and the period of use;
- 5) geographical territory of the use in the Republic of Armenia.⁴⁷

Comparative Analysis of the Armenian Regulations on Well-Known Marks with the International Best Practices

Most of the drawbacks of the RA Law on Trademarks have been presented above. This part of Chapter 2 will compare the Armenian regulations with the international best practices in the regulating the protection of Well-Known marks. Most of the EU Member States refer to the appropriate articles of the Paris Convention and the TRIPS Agreement. The RA Law on

⁴⁷ Intellectual Property Agency, “*The Law of the Republic of Armenia on Trademarks*”, available at: <https://www.aipa.am/en/TrademarkLaw/> (last visited May 2, 2018)

Trademarks mentions what factors can be taken into consideration for determining whether a trademark is “Well-Known”, however, that list very short.

Estonia’s practice shows that i.e. knowledge or use of the mark in other countries can also be taken into account. The RA Law does not mention such evidence.⁴⁸ On the contrary, the RA Law mentions that the geographical territory of the use in the RA can be taken into consideration. The Bulgarian legislation requires public representation of the mark can be taken into account, advertisement, exhibition of goods and services to which the mark is used can also be considered. It mentions that the volume of the mark can also serve as a factor for recognition. The RA law does not mention that in the consuming community potential users of the goods and services can be taken into account, however, the Bulgarian law does. Including the potential users eases and enlarges the circle of people among who the mark needs to be well known or recognized.⁴⁹ Consequently, it becomes easier to get the status of a Well-Known mark. The Romanian Law mentions factors such as the degree of distinctiveness, initial or acquired, of the Well-Known mark; or the time period and time lasting utilization of the Well-Known mark in Romania concerning the products and services for which a trademark is requested to be registered.⁵⁰

As offered by the INTA, states can set a limit of 10 years for enjoying the status of Well-Known, however the RA Law on Trademarks mentions that such status is granted without time limit. Besides, the Armenian Law does not refer to the opposition by the third parties against the registration of a mark as Well-Known. It does not refer to the cancellation of registering a trademark as Well-Known too. However, as seen in the previous chapter, the EU law refers to both the opposition and the cancellation.

Conclusion

⁴⁸ Trade Marks Act of Estonia, 2002 (Consolidated Text of January 1, 2012), available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=258149 (last visited May 10, 2018)

⁴⁹ Law on Marks and Geographical Indications of Bulgaria, available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=125308 (last visited May 10, 2018)

⁵⁰ Law on Marks and Geographical Indications of Romania, available at: http://www.osim.ro/index3_files/laws/trademark/mareng.htm#Chapter%20I (last visited May 10, 2018)

This paper has illustrated the international framework of protection of Well-Known or Famous trademarks. It has shown the solutions that some of the countries have found in protecting those trademarks.

The United States separated a category of Famous trademarks and has provided a detailed regulation on them. It entitles the owner of a Famous mark to an injunction regardless of presence or absence of actual or likely confusion. The United States mentions important factors that should be taken into account while recognizing the ‘Famous’ status of a mark, i.e. duration, extent or geographical reach of the mark, amount or volume of sales, the extent of actual recognition and so on. The US encompasses ‘dilution’ in its legislation, which we cannot see in the Armenian legislation. The Lanham Act also refers to the burden of proof, remedies, injunctive reliefs and so on.⁵¹

The strongest points that can be seen in the protection provided by Japan, are the thorough requirements for recognition of the mark as Well-Known. For instance, the quantity of production, manner or frequency of advertisement, different articles, trade papers, survey results can be taken into account. The evidence that is presented to the JPO can be in the form of printed literature, photos, certificates and so on.⁵²

The EU approach is that it does not go far from the Paris Convention and the TRIPS Agreement, however, the countries of the Union provide a non-exhaustive list of factors which can be taken into consideration for recognizing and thus, registering a trademark as Well-Known.

In conclusion, many states provide broader lists of evidence which can be taken to court to declare the trademark as Well-Known. And as seen from the RA Law on Trademarks and the Report submitted to the Famous and Well-Known Marks Committee of INTA, it is seen that the main drawbacks of the Law are concerning the duration of status of Well-Known marks, the opposition, and the cancellation of registration. It is necessary to include the lacking points to the law and make some amendments in the existing provisions of the RA legislation. Based on the research and study of different international treaties, domestic laws,

⁵¹ The Lanham (Trademark) Act of the USA, 1946, §43, available at: <https://www.bitlaw.com/source/15usc/1125.html> (last visited May 10, 2018)

⁵² The Japanese Trademark Act, 1959, available at: http://www.wipo.int/wipolex/en/text.jsp?file_id=403346 (last visited May 10, 2018)

recommendations of international organizations which were discussed in this paper, several there are recommendations that will help to amend the Armenian regulations on Well-Known trademarks and in part help to make them in conformity with the international best standards:

Recommendations

- The RA Law on Trademarks grants the status of a Well-Known mark without time limit. It is more reasonable to exclude the perpetuity of that status, and set a limit of approximately 10-20 years for such trademarks, with the chance of a renewal of that status, if proved that the mark continues enjoying the fame or being well-known among certain circles of the consuming public.

- It is advisable to make amendments in Article 31 of the RA Law on trademarks, in determining whether a trademark can be considered to be Well-Known, important factors such as the volume of production, advertisement, sales, number of consumers, imports, exports, and many other factors to be taken into account. Those factors will serve as a tool helping the claimants or applicants to understand what needs to be presented for acquiring recognition of Well-Known marks.

- In addition, it is recommended to have a provision that would protect internationally Well-Known or Famous trademarks in the territory of the Republic of Armenia. The RA regulation does not have such provisions. The use of such trademarks in the territory of the RA, intent to use, imports and many other factors could be taken into account as well.

- Another recommendation is having a provision on oppositions by the third parties against the registration of trademarks as Well-Known. Having

oppositions against such registration is accepted in the practice of many countries, and is advisable to have it in the RA legislation as well.

- The RA Law can also include provisions on appealing the decisions on the declaration of a mark as Well-Known to the Administrative Court.

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