Protection of Well-Known Marks

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International principles for the protection of well-known marks are contained in the Paris Convention for the Protection of Industrial Property, the Agreement on Trade-Related Intellectual Property Rights (TRIPS Agreement), and the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-known Marks (WIPO Provision). Beginning with the provisions for the protection of well-known marks that are contained in the Paris Convention and in the TRIPS Agreement, the paper describes in detail the last mentioned instrument for setting international standards on the protection of well-known marks, i.e. WIPO Provision.

The international principles for the protection of well-known marks are currently contained in the two major treaties on the protection of industrial property, namely the Paris Convention for the Protection of Industrial Property which is over 100 years old and binds 154 States, and the Agreement on Trade Related Intellectual Property Rights (TRIPS Agreement), which has been adopted in 1995 and binds 134 States. Now, a third instrument for setting international standards on the protection of well-known marks, the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, has joined these treaties.

The Joint Recommendation was adopted at a joint session of the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO (September 20 to 29, 1999).

Five years have elapsed between the first meeting of the WIPO Committee of Experts on Well-Known Marks (November 1995) and the meeting of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) (June 1999) which adopted the provisions on the protection of well-known marks. Six meetings and regional consultations led to a
consensual adoption of these provisions as a Joint Recommendation.

The Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks (WIPO Provision) is the first implementation of WIPO's policy to adapt to the pace of change in the field of industrial property by considering new options for accelerating the development of international harmonized common principles. In this respect, it is important to outline that India has incorporated in its new trademark law (December 1999), some of the WIPO provisions on well-known marks.

This Recommendation is expected to clarify, consolidate and supplement the existing international protection of well-known marks under the Paris Convention and the TRIPS Agreement. It includes detailed provisions regarding the determination of whether a mark is a well-known mark in a Member State (Article 2), and remedies in cases of conflicts between well-known marks and other marks (Article 4), business identifiers (Article 5) or domain names (Article 6). These provisions will facilitate the application of the existing international standards which have to be introduced before entering into the details of the WIPO Provisions.

The Provisions for the Protection of Well-Known Marks that are Contained in the Paris Convention and in the TRIPS Agreement.

Article 6bis of the Paris Convention reads as follows:

"(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."

- Three features of the protection provided for in Article 6bis may be noted:
  - The protection in Article 6bis extends only to trademarks (marks in respect of goods), and does not extend to service marks (used in respect of services). By virtue of Article 16 of Trademark Law Treaty (TLT, 1994, 25 States), however, the provisions of the Paris Convention relating to trademarks were extended to service marks;
  - The protection extends to registration or use in respect of identical or similar goods (in accordance with the principle, known as the "principle of specialty", under which protection for a trademark extends only to the same or similar goods as are covered by the registration or use of the trademark);
  - Article 6bis is silent on what constitutes a well-known mark. The appre-
cation of whether a mark is well-known is left to the "competent authority of the country where the illegitimate registration or use occurs."

- Article 6bis is of major importance for cases where a trademark in a given country does not—or does not yet—enjoy protection on the basis of a registration in that country or on the basis of an international or regional registration having effect in that country.

This does not mean that the application of Article 6bis is excluded if the trademark is registered in the country where protection is sought. However, protection according to Article 6bis does not go beyond what normally is conferred by registration of a trademark, namely, protection against the registration or use of the same or a similar sign for the same or similar goods. Thus, if the trademark is normally registered in the country, there is no need to invoke Article 6bis.

The provisions of Article 6bis of the Paris Convention are confirmed and extended by the TRIPS Agreement.

Relevant Provisions of TRIPS Agreement

The relevant provisions of the TRIPS Agreement concerning protection of well-known marks are Article 16.2 and 3 and read as follows:

"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."

Three features of Article 16.2 and 16.3 of the TRIPS Agreement may be noted:

- Article 16.2 builds on the work of the Trademark Law Treaty (1994) in extending the protection of Article 6bis of the Paris Convention to well-known service marks;

- Article 16.2 of the TRIPS Agreement provides for a non-exhaustive guide to the competent authorities of countries in appreciating whether a mark is well-known. In this respect it provides that, 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.

- Article 16.3 of the TRIPS Agreement provides for protection that extends beyond the normal protection of marks under the principle of specialty. It extends the protection under Article 6bis of the Paris Convention to goods and services, which are not similar to those in respect of which a trademark is registered.
However, the following conditions are required: (1) the use of the allegedly infringing mark in relation to those other goods or services has to indicate a connection between those other goods or services and the owner of the well-known mark, and (2) the interest of the owner of the well-known mark should be likely to be damaged by such use.

This extended protection reflects a distinction which is made in many national laws between, on the one hand, famous marks, which represent that class of well-known marks that are so famous that they require protection against infringing use in respect of any goods or services and, on the other hand, well-known marks, which require protection against infringing registration or use in respect of the same or similar goods and services for which the well-known mark is registered or used.

The WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks

These provisions supplement the Paris and TRIPS standards in that:

(i) they set out a non exhaustive list of factors that a competent authority could take into account in determining whether a mark is well-known;

(ii) they stipulate that a mark shall be considered to be a well-known mark if it is well known in at least one relevant sector of the public of the Member State (Article 2(2)(b));

(iii) they provide that Member States shall not require that a mark has been used or registered or that an application for registration has been filed in that Member State (Article 2(3)(i));

(iv) they require that a well-known mark, which is not registered in the country where protection is sought, be protected against use of an identical or similar mark for dissimilar goods or services. In certain cases, however, a Member State may require that the well-known mark be well known by the public at large (Article 4(1)(b) and (c)); and

(v) they provide for remedies in cases of conflicts between well-known marks and business identifiers (Article 5) or domain names (Article 6).

WIPO Provisions

Determination of whether a Mark is a Well-Known Mark in a Member State (Article 2)

The list of factors for consideration by the competent authorities when determining whether a mark is well-known in a Member State constitutes a major innovation of the WIPO Provisions. Neither the Paris Convention nor the TRIPS Agreement contains such factors. Normally, the question of how to determine whether a mark is well-known is not addressed by legislative provisions but is left to the competent authorities. The situation differs from country to country and the competent authorities could be as different as Industrial Property Offices (during the course of the examination of the trademark) or Courts (in the course of enforcement of the trademark or the defense of the trademark). This is why Article 1(iii) of the WIPO Provisions gives a broad definition of what constitutes a competent authority in defining it as "administrative, judicial or quasi-ju-
dicial authority of a Member state which is competent for determining whether a mark is well-known, or for enforcing the protection of well-known marks.”

It should be noted that the factors only constitute guidelines to assist the competent authority to determine whether the mark is a well-known mark and are not pre-conditions for reaching that determination. Therefore, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well-known.

The first factor listed in the WIPO Provisions is the degree of knowledge or recognition of the mark in the relevant sector of the public. When examining the question of whether a given mark can be considered to be well-known or not, an important factor is the extent to which the public in the country in which protection is sought has knowledge of the mark. This is somewhat called the quantitative approach. Since each mark normally is addressed to a specific group of potential customers and traders, it would be necessary to define the relevant sector of the public to which the mark has to be well-known. This approach has been chosen for example by Article 16.2 of the TRIPS Agreement which stipulates that “in determining whether a mark 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”. In order to apply this approach, (1) account must be taken of the nature of the goods or services to which the mark applies, for example, the relevant sector of a mark for luxury goods is different from the relevant sector of a mark for articles of daily use such as soap or washing powder, and (2) a criterion must be established concerning the required percentage of the relevant sector. Generally, market surveys would be used as means of evidence.

Other factors include the duration, extent and geographical area of: (1) any use of the mark, (2) any promotion of the mark (advertising, publicity, presentation at fairs and exhibitions) or (3) any registrations, and/or any applications for registration of the mark. These factors constitute highly relevant indicators. Use of the mark can be assessed for example in neighbouring territories, in territories in which the same language is spoken or territories which are covered by the same media. However, pursuant to Article 2(3)(a)(1), actual use of a mark in the State in which it is protected as a well-known mark cannot be required.

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 constitutes another factor. Enforcement is intended to be construed broadly, covering evidence of successful enforcement of the right (for example, in neighbouring countries) or opposition procedures in which the owner of a well-known mark has prevented the registration of a conflicting mark.

Finally, the last factor listed in the WIPO Provisions relates to the value associated with the mark. This so-called qualitative approach is innovative. It has always been standard accounting practice not to ascribe any value to marks in the balance sheets of corporations. Likewise, when a corporation acquires another one, the purchase price usually includes a sum for goodwill and, in the case of companies owning a large number of marks, this sum can be more important than the other assets. It is only recently
that this practice of not valuing intellectual property rights, in particular marks, has been questioned and that some corporations have given value to marks and put an appropriate sum in the balance sheet.

The WIPO Provisions precise (Article 2.2) three possible sectors of the public of a Member State which could be considered relevant for making the determination. They consist of consumers, persons involved in channels of distribution, and business circles dealing with the type of goods and/or services to which the mark applies.

The WIPO Provisions also contain a major advance over the protection accorded under the Paris Convention and the TRIPS Agreement in stipulating that a mark shall be considered to be well-known in a Member State when it is determined to be well-known in at least one relevant sector of the public in the Member State. Under the TRIPS Agreement the requirement is simply that knowledge in the relevant sector of the public shall be taken into account. The WIPO Provisions state that a mark is well-known in at least one of the relevant sector of the public—consumers, persons involved in channels of distribution or business circles—then it is enough to conclude that the mark is well-known.

The WIPO Provisions go even further (paragraph (2)(c)) in stipulating that a mark only known in one relevant sector of the public of a Member State may be considered to be well-known. This is not a mandatory provision for the Member States and does not reflect a recognized standard throughout the international community.

Another possibility which already exists in some countries is recognized by paragraph (2)(d): A mark may be considered a well-known mark even if it is not known or well-known in any relevant sector of the public of the Member State. Such provision is particularly appropriate in regional economies where a mark may be well-known in a number of countries but not all, and where the marks are well-known only outside of the State in which the protection is sought.

Member States are however not totally free to establish factors since the WIPO Provisions set out (paragraph 3(a)) three factors whose fulfillment cannot be required, as a condition for determining whether a mark is well known. It should not be requested that the mark has been registered or used (i) in the Member State in which protection is sought, (ii) in any other Member State, or (iii) that the mark be well-known by the public at large.

These restrictions are building on the Paris Convention and TRIPS Agreement in that these two treaties do not stipulate that registration and use of a mark cannot be required in any showing that a given mark is well-known.

As far as the requirement of registration is concerned, a distinction has to be made between the goods and services for which a well-known mark is registered and goods or services which are dissimilar. Article 6bis of the Paris convention is only applicable to identical and similar goods. That article does not contain an explicit prohibition of registration, but it follows from the spirit of this provision that registration of the mark in the country in which the protection is sought cannot be requested. Otherwise the entire provision would be redundant. However, an argument seems to emerge whether a country may request an application for the registration of a presumed well-known mark must be filed in the country in which protec-
tion is sought, before remedies for the protection of that mark (i.e., invalidation of a conflicting registration or prohibition of use) are available, but not before proceedings can be initiated. It is to be noted that Article 6bis of the Paris Convention, the TRIPS Agreement and the WIPO Provisions do not explicitly prohibit that practice.

As regards the protection of a well-known mark against marks which are registered and used in respect of dissimilar goods and services, the WIPO Provisions build on the Paris Convention, which does not provide for such protection at all, and on the TRIPS Agreement, which provides for such protection, subject to the registration of the well-known mark in the country in which protection is sought.

Protection of well-known Marks; Bad Faith (Article 3)

The WIPO Provisions clarify the timing under which a Member State shall protect well-known marks, since the Paris Convention and the TRIPS Agreement are silent on that matter. This article also introduces the concept of bad faith and states that bad faith may be considered as one factor among others in assessing competing interests in applying Articles 4 to 6 to the WIPO Provisions. This is mainly to remind the competent authority that bad faith is one of the most important factors that should always be kept in mind when looking at the protection of well-known marks.

The protection which should be granted to well-known marks in application of the WIPO Provisions is protection against conflicting marks, business identifiers and domain names.

Conflicting marks (Article 4)

In general, this article provides for the remedies which every Member State must make available to the owner of a well-known mark, if such mark is in conflict with another mark.

This article restates the existing protection under the Paris Convention and the TRIPS Agreement, that relief shall be afforded, if the mark constitutes a reproduction, an imitation or a translation. But it adds transliteration. This word is very significant in view of the global nature of the protection and moves away from the common use of the Latin alphabet in the time of the Paris Convention. There now can be conflicts between marks that are written in different alphabets and therefore a transliteration of a well-known mark would also be considered to be an infringement. It also goes beyond the Paris Convention because it envisages protection not only for well-known marks registered or used for goods, but also for well-known service marks.

Another innovation lies in the fact that the protection granted for well-known marks is no longer restricted or used for identical or similar goods and/or services, but is extended to cases where a mark is registered or used in respect of dissimilar goods or services.

This provision has resuscitated a thorough debate because some Member States were not ready to go beyond the TRIPS provisions with respect to the extension of the protection of well-known marks to goods and services which are not similar, where the well-known mark is not registered. Therefore, this provision introduces three alternatives which can be fulfilled in order for the protection to be afforded: (1) the use of the mark should indicate a connection between
the goods and/or services for which the mark is used etc., and the owner of the well-known mark, and would be likely to damage his interests (TRIPS Agreement), (2) the use of the mark is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark (dilution standard), or (3) the use of the mark would take unfair advantage of the distinctive character of the well-known mark. In the discussions in the Standing Committee a compromise was achieved in that a requirement that the mark be well-known to the public at large may be authorized for the officials of the two latter alternatives.

Conflicting Business identifiers (Article 5)

The WIPO Provisions with respect to business identifiers are very similar to those relating to conflicting marks and brings a very similar protection except for example for opposition procedures which do not apply to business identifiers.

Conflicting Domain Names (Article 6)

This article is the first provision in international standards that deals with conflicts between domain names and well-known marks. It must be distinguished from the WIPO Domain Name Process which sets up an administrative dispute resolution procedure, limited to cases of conflicts between well-known marks and domain names in the sphere of domain name registration. This process was mainly oriented towards the private sector and did not involve the Standing Committee on the Law of Trademarks, Geographical Indications and Industrial Designs (SCT). It was meant to solve the problem of abusive registration of domain names (cybersquatting). The purpose of the article on conflicting domain names of the WIPO Provisions on well-known marks is directed to national laws, and the competent authorities of the Member States when such a conflict arises.

The problem relating to conflicting domain names is very different from the cases of conflicting marks or conflicting business identifiers. Domain names as such cannot be classified as a distinctive sign. They can be considered as an internet address and pose the problem of "reverse hijacking" or "good faith" registration of domain names. The WIPO provision therefore solve this problem in stating that a domain name shall be in conflict with a well-known mark—and a relief should be granted—at least where that domain name constitutes a reproduction, imitation, translation or transliteration of the well-known mark and where the domain name has been used in bad faith. Bad faith constitutes the key factor for determining that a domain name is in conflict with the well-known mark. What constitutes bad faith however is left to the Member States to determine, and the SCT is addressing the issue in its work on the use of trademarks and others distinctive signs on the Internet.

As far as the relief that must be granted in the case of conflicting domain names is concerned, the WIPO Provisions state that the owner of the well-known mark shall be entitled to request by a decision of the competent authority that the registrant of the conflicting domain name cancel the registration or transfer it to the owner of the well-known mark.

Joint Recommendation

The Joint Recommendation constitutes WIPO's timely response to rapidly changing
circumstances in the field of intellectual property. Various approaches to the progressive development of international intellectual property law exist. These possibilities were raised in the WIPO Programme and Budget for the 1998-99 Biennium, which states:

"Given the practical imperative for accelerated development and implementation of certain international harmonized common principles and rules in industrial property law, the future strategy for this main program includes consideration of ways to complement the treaty-based approach [...]. If Member States judge it to be in their interests so to proceed, a more flexible approach may be taken towards the harmonization of industrial property principles and rules, and coordination of administration, so that results can be achieved and applied more rapidly, ensuring earlier practical benefits for administrators and users of the industrial property system.” (See document A/32/2-WO/BC/18/2, page 86).

The advantages of choosing a flexible approach can be the following:

- An agreement on specific principles or rules by different countries may not be subject to the long ratification and accession process,

- It can be signed by an industrial property office or other government agency if its subject does not require parliamentary approval (for example, if it concerns not the law itself but implementing regulation),

- These agreed principles would be easier to modify or replace since they do not require a diplomatic conference. This is particularly true considering the quick evolution of the word economy and the techniques (not to mention the Internet),

- It creates no legal obligation for any country since it is not binding.

It is submitted that the practical advantages arising out of an agreement which is less formalistic than an international treaty could outweigh the absence of formal guarantees provided by such a treaty.

Concerning more specifically the WIPO Provisions, it is envisaged that the recommendation adopted by the WIPO and Paris Assemblies could serve as a guideline for the interpretation of existing treaties as well as a model for national or regional legislation in that field. The publication of model or illustrative principles and rules can also be very useful to the competent authorities seeking guidance on how to solve specific problems (similar to the Model Provisions on Protection Against Unfair Competition published in 1996 by WIPO).

It is important to note that the “soft law” approach does not necessarily exclude the treaty approach. The process can start with the adoption of a resolution by the WIPO Assemblies and later move to considering the conclusion of a treaty. If Member States opt for a treaty at a later stage, then there will be, like in all diplomatic conferences, a possibility to rediscuss the provisions.

This gradual approach is even recommended in cases where the conclusion of a treaty seems to be the most desirable objective but its attainment is prevented by difficulties with no bearing on its substance (for example, by disagreement on procedural issues) or because some countries consider that it may be premature at this stage to go directly for a treaty.
Annex


(September 20 to 29, 1999)

Joint Recommendation

The Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO),

Taking into account the provisions of the Paris Convention for the Protection of Industrial Property relative to the protection of well-known marks;

Recommend that each Member State may consider the use of any of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its second session, second part, as guidelines for the protection for well-known marks;

It is further recommended to each Member State of the Paris Union or of WIPO which is also a member of a regional intergovernmental organization that has competence in the area of registration of trademarks, to bring to the attention of that organization the possibility of protecting well-known marks in accordance, mutatis mutandis, with the provisions contained herein.

Provisions follow.

Article 1
Definitions

For the purposes of these Provisions:

(i) “Member State” means a State member of the Paris Union for the Protection of Industrial Property and/or of the World Intellectual Property Organization;

(ii) “Office” means any agency entrusted by a Member State with the registration of marks;

(iii) “competent authority” means an administrative, judicial or quasi-judicial authority of a Member State which is competent for determining whether a mark is a well-known mark, or for enforcing the protection of well-known marks;

(iv) “business identifier” means any sign used to identify a business of a natural person, a legal person, an organization or an association;

(v) “domain name” means an alphanumerical string that corresponds to a numerical address on the Internet.

Part I
Determination of Well-Known Marks

Article 2
Determination of Whether a Mark is a Well-Known Mark in a Member State

(1) [Factors for Consideration] (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 informa-
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.

(2) [Relevant Sector of the Public] (a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

(i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;

(ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;

(iii) 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) [Factors Which Shall Not Be Required] (a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:
(i) 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;

(ii) 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

(iii) that the mark is well known by the public at large in the Member State.

(b) Notwithstanding subparagraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.

Part II
Scope of Protection

Article 3
Protection of Well-Known Marks; Bad Faith

(1) [Protection of Well-Known Marks] A Member State shall protect a well-known mark against conflicting marks, business identifiers and domain names, at least with effect from the time when the mark has become well known in the Member State.

(2) [Consideration of Bad Faith] Bad faith may be considered as one factor among others in assessing competing interests in applying Part II of these Provisions.

Article 4
Conflicting Marks

(1) [Conflicting Marks] A mark shall be deemed to be in conflict with a well-known mark where that mark, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration, liable to create confusion, of the well-known mark, if the mark, or an essential part thereof, is used, is the subject of an application for registration, or is registered, in respect of goods and/or services which are identical or similar to the goods and/or services to which the well-known mark applies.

(b) Irrespective of the goods and/or services for which a mark is used, is the subject of an application for registration, or is registered, that mark shall be deemed to be in conflict with a well-known mark where the mark, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration of the well-known mark, and where at least one of the following conditions is fulfilled:

(i) the use of that mark would indicate a connection between the goods and/or services for which the mark is used, is the subject of an application for registration, or is registered, and the owner of the well-known mark, and would be likely to damage his interests;

(ii) the use of that mark is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark;

(iii) the use of that mark would take unfair advantage of the distinctive character of the well-known mark.

(c) Notwithstanding Article 2(3)(a)(iii), for the purpose of applying paragraph (1)(b)(ii) and (iii), a Member State may require that the well-known mark be well known by the public at large.
(d) Notwithstanding paragraphs (2) to (4), a Member State shall not be required to apply:

(i) paragraph (1)(a) to determine whether a mark is in conflict with a well-known mark, if the mark was used or registered, or an application for its registration was filed, in or in respect of the Member State, in respect of goods and/or services which are identical or similar to the goods and/or services to which the well-known mark applies, before the well-known mark became well known in the Member State;

(ii) paragraph (1)(b) to determine whether a mark is in conflict with a well-known mark, to the extent that the mark was used, was the subject of an application for registration, or was registered, in or in respect of the Member State, for particular goods and/or services, before the well-known mark became well known in the Member State; except where the mark has been used or registered, or the application for its registration has been filed, in bad faith.

(2) [Opposition Procedures] If the applicable law allows third parties to oppose the registration of a mark, a conflict with a well-known mark under paragraph (1)(a) shall constitute a ground for opposition.

(3) [Invalidation Procedures] (a) The owner of a well-known mark shall be entitled to request, during a period which shall not be less than five years beginning from the date on which the fact of registration was made known to the public by the Office, the invalidation, by a decision of the competent authority, of the registration of a mark which is in conflict with the well-known mark.

(b) If the registration of a mark may be invalidated by a competent authority on its own initiative, a conflict with a well-known mark shall, during a period which shall not be less than five years beginning from the date on which the fact of registration was made known to the public by the Office, be a ground for such invalidation.

(4) [Prohibition of Use] The owner of a well-known mark shall be entitled to request the prohibition, by a decision of the competent authority, of the use of a mark which is in conflict with the well-known mark. Such request shall be admissible for a period which shall not be less than five years beginning from the time the owner of the well-known mark had knowledge of the use of the conflicting mark.

(5) [No Time Limit in Case of Registration or Use in Bad Faith] (a) Notwithstanding paragraph (3), a Member State may not prescribe any time limit for requesting the invalidation of the registration of a mark which is in conflict with a well-known mark if the conflicting mark was registered in bad faith.

(b) Notwithstanding paragraph (4), a Member State may not prescribe any time limit for requesting the prohibition of the use of a mark which is in conflict with a well-known mark if the conflicting mark was used in bad faith.

(c) In determining bad faith for the purposes of this paragraph, the competent authority shall take into consideration whether the person who obtained the registration of or used the mark which is in conflict with a well-known mark had, at the time when the mark was
used or registered, or the application for its registration was filed, knowledge of, or reason to know of, the well-known mark.

(6) [No Time Limit in Case of Registration Without Use] Notwithstanding paragraph (3), a Member State may not prescribe any time limit for requesting the invalidation of the registration of a mark which is in conflict with a well-known mark, if that mark was registered, but never used.

Article 5
Conflicting Business Identifiers

(1) [Conflicting Business Identifiers] (a) A business identifier shall be deemed to be in conflict with a well-known mark where that business identifier, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration of the well-known mark, and where at least one of the following conditions is fulfilled:

(i) the use of the business identifier would indicate a connection between the business for which it is used and the owner of the well-known mark, and would be likely to damage his interests;

(ii) the use of the business identifier is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark;

(iii) the use of the business identifier would take unfair advantage of the distinctive character of the well-known mark.

(b) Notwithstanding Article 2(3) (iii), for the purposes of applying paragraph (1) (a) (ii) and (iii), a Member State may require that the well-known mark be well known to the public at large.

(c) A Member State shall not be required to apply subparagraph (a) to determine whether a business identifier is in conflict with a well-known mark, if that business identifier was used or registered, or an application for its registration was filed, in or in respect of the Member State, before the well-known mark became well known in or in respect of the Member State, except where the business identifier was used or registered, or the application for its registration was filed, in bad faith.

(2) [Prohibition of Use] The owner of a well-known mark shall be entitled to request the prohibition, by a decision of the competent authority, of the use of a business identifier which is in conflict with the well-known mark. Such request shall be admissible for a period which shall not be less than five years beginning from the time the owner of the well-known mark had knowledge of the use of the conflicting business identifier.

(3) [No Time Limit in Case of Registration or Use in Bad Faith] (a) Notwithstanding paragraph (2), a Member State may not prescribe any time limit for requesting the prohibition of the use of a business identifier which is in conflict with a well-known mark if the conflicting business identifier was used in bad faith.

(b) In determining bad faith for the purposes of this paragraph, the competent authority shall consider whether the person who obtained the registration of or used the business identifier which is in conflict with a well-known mark had, at the time when the busi-
ness identifier was used or registered, or the application for its registration was filed, knowledge of, or reason to know of, the well-known mark.

Article 6
Conflicting Domain Names

(1) [Conflicting Domain Names] A domain name shall be deemed to be in conflict with a well-known mark at least where that domain name, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration of the well-known mark, and the domain name has been registered or used in bad faith.

(2) [Cancellation; Transfer] The owner of a well-known mark shall be entitled to request, by a decision of the competent authority, that the registrant of the conflicting domain name cancel the registration, or transfer it to the owner of the well-known mark.