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JOINT RESOLUTION CONCERNING PROVISIONS ON THE PROTECTION OF WELL-KNOWN MARKS

Memorandum by the Director General

1. This document contains a Proposed Joint Resolution Concerning Provisions on the Protection of Well-Known Marks (see Annex I), which is being presented to the Assemblies of the Member States of WIPO pursuant to a decision of the Standing Committee on the Law of Trademarks, Geographical Indications and Industrial Designs (SCT) on June 11, 1999. The history of the discussions leading to adoption by the SCT of the Provisions for the Protection of Well-Known Marks is as follows:

2. The 1994-95 Program of WIPO (item 04(3)) (document AB/XXIV/2) provides for the following:

“Well-Known Marks

The International Bureau will prepare, convene and service meetings of consultants to consider the criteria that should be applied to define what a well-known mark is (which, it is recalled, must be protected as provided in Article 6*bis* of the Paris Convention on the Protection of Industrial Property), and what measures could be taken to make the protection of well-known marks more effective in the world.”

3. The 1996-97 Program of WIPO (Item 03(5)) (document AB/XXVI/2) provides for the following:

“Well-Known and Famous Marks

“The International Bureau will study, with the help of a committee of experts meeting once in each year of the biennium, all questions of relevance to the correct application of Article 6*bis* of the Paris Convention (e.g., whether that Article applies also where the well-known mark is not actually used in the country in which its protection is claimed). It will also study the conditions and scope of protection, in particular, in respect of famous marks, against dilution and/or undue exploitation of the goodwill acquired by such marks. Moreover, it will study the feasibility of setting up, under the aegis of WIPO, a voluntary international information network for the exchange of information among countries concerning marks that one or more of them considers to be well-known or famous.”

“Any proposal for action, beyond the study, will be put before the General Assembly of WIPO.”

4. The Program and Budget for the 1998-99 biennium, approved by the Assemblies of the Member States of WIPO at their Thirty-Second Series of Meetings, from March 25 to 27, 1998, provides, under Sub-program 09.2, for consideration of well-known marks by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (hereafter referred to as the “SCT”), as follows (see document A/32/2-WO/BC/18/2, pages 90 and 91):

“Review and finalization of the provisions on the protection of well-known marks prepared before the biennium.”

“Expected results: If it is found to be appropriate, the adoption of provisions on the protection of well-known marks.”

5. Draft provisions concerning the protection of well-known marks have been considered by the WIPO Committee of Experts on Well-Known Marks at its first session (November 13 to 16, 1995; see documents WKM/CE/I/2 and 3), second session (October 28 to 31, 1996; see documents WKM/CE/II/2 and 3) and third session (October 20 to 23, 1997; see documents WKM/CE/III/2 and 3). The WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) continued the work at its first session (July 13 to 17, 1998; see documents SCT/1/3 and 6), at its second session, first part, (March 15 to 17, 1999; see documents SCT/2/3 and 5) and at its second session, second part (June 7 to 11, 1999; see document SCT/2/8).

6. The provisions dealing with the protection of well-known marks and a related proposed joint resolution were adopted by the SCT, at its second session, second part (June 7 to 11, 1999). The SCT further agreed to recommend the Joint Resolution Concerning Provisions on the Protection of Well-Known Marks, for adoption by the Paris Union Assembly and the WIPO General Assembly in September 1999.

7. The results of the SCT are reflected in the Summary by the Chair and the draft Report of the second session, second part (see documents SCT/2/11 Rev. and SCT/2/12 Prov.).

8. In particular, all members of the SCT joined in a consensus for adoption of the provisions as a whole. However, the following countries did not join the consensus as to the provisions referred to hereafter:

- Argentina in respect of Article 5(2);
- Brazil in respect of Article 2(3)(a)(i), Article 4(1)(b) (ii) and (iii), and 4(1)(c), Article 5(1)(a)(ii) and (iii), and 5(1)(b), and 5(2) and Article 6;
- Chile in respect of Article 4(1)(b);
- Cuba in respect of Article 4(1)(b);
- Mexico in respect of Article 2(2)(b);
- Philippines in respect of Article 2(d); Article 2(3)(a)(i); Article 4(1)(b); Article 4(3)(a); Article 4(3)(b); Article 4(4); Article 4(6) and Article 6;
- Portugal in respect of Article 4(1)(b) and Article 6(2);
- Republic of Korea in respect of Article 4(1)(b)(ii) and (iii);
- Spain in respect of Article 4(1)(b);
- Sweden in respect of Article 2(2)(b) and Article 6(2);
- Uruguay in respect of Article 2(3)(a)(i) and (ii) as well as Article 4(1)(b);
- The Delegation of Egypt stated that its government needed additional time to examine all of the provisions.

9. Concerning the decision to present these provisions as a proposed Joint Resolution, rather than as a proposed treaty, the Program and Budget for the 1998-99 biennium (see document A/32/2-WO/BC/18/2, page viii) addresses, in its introduction, the question of new approaches to the progressive development of international intellectual property law, as follows:

“Countries which agree on specific principles or rules may wish to consider expressing their agreement by signing a Memorandum of Understanding or a similar instrument. This is not subject to the long ratification and accession process, is easier to modify or replace, and 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 regulations). **The WIPO General Assembly (or another Assembly) may also adopt a resolution recommending that Member States and interested intergovernmental organizations implement certain principles and rules:**¹ this creates no legal obligation for any country, but following such a recommendation would produce practical benefits. A further option is the publication, under the responsibility of the Secretariat, of model or illustrative principles and rules that would be available to any legislator or other authority seeking guidance on how to solve specific problems, similar to the Model Provisions on Protection Against Unfair Competition published in 1996.”

“These various approaches would not necessarily exclude each other: the process could, for instance, start with the adoption of a resolution by the WIPO General Assembly and later move to considering the conclusion of a treaty. This gradual

¹ Emphasis added.

approach may be employed when 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).”

10. Under Main Program 09, the Program and Budget for the 1998-99 biennium (see document A/32/2-WO/BC/18/2, page 86) further explains:

“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, as discussed above in the Introduction (p. vii). 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.”

“For instance, projects of an essentially administrative nature could culminate in a Memorandum of Understanding (MoU) or similar instrument, rather than a formal treaty; activities aimed at harmonization of national laws may be advanced through the conclusion by the Standing Committee and adoption by the WIPO General Assembly (or another WIPO Assembly), of a resolution recommending that Member States and interested IGOs adopt and implement these principles and rules; and work requiring a rapid, interim result could, pending further agreements, be achieved through the publication of model principles and rules that would be available to any legislator or other authority seeking guidance on how to solve specific problems, similar to WIPO’s Model Provisions on Protection Against Unfair Competition.”

11. The question of whether the provisions on the protection of well-known marks should be adopted in the form of a recommendation of the WIPO Assemblies or in the form of a Protocol to the Trademark Law Treaty (TLT) was discussed at the first session of the Committee of Experts on Well-Known Marks (November 13 to 16, 1995) and at the first session of the SCT (July 13 to 17, 1998). At that session, the Standing Committee agreed that, in the short term, it should be recommended to the WIPO General Assembly that the Provisions become a Resolution of the WIPO General Assembly once the Committee agreed on a final version of the Provisions, and that, in the long term, it would be preferable for the Provisions to be incorporated into a treaty (see Report of the first session, document SCT/1/6, paragraph 105).

12. The Resolution is therefore presented for adoption by the Assembly of the Paris Union and the General Assembly of WIPO. The Resolution is addressed to the Member States of the Paris Union and of WIPO, which are already bound by an international obligation to protect well-known marks, for example, under the Paris Convention itself or under another international agreement such as the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). In order for the Resolution to have the widest possible coverage, it is suggested that it also mention intergovernmental organizations having competence in the area of trademarks.

13. One hundred and twenty Member States of WIPO have contributed to the work of the Committees during their six meetings (see Annex II). In addition, the International Bureau has conducted, from July 14 to 16, 1999, informal consultations with WIPO regional groups in order to inform all Members States concerning the Provisions on the Protection of Well-Known Marks and the proposed Joint Resolution. These consultations gave Member States the opportunity to obtain further information on any aspect of the joint resolution requiring further clarification before deciding on its adoption at the WIPO Assemblies. Thirty-two States attended these consultations.

14. The WIPO General Assembly and the Assembly of the Paris Union are invited to adopt the Joint Resolution Concerning the Provisions on the Protection of Well-Known Marks.

[Annex I follows]

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ANNEX I

PROPOSED JOINT RESOLUTION
CONCERNING PROVISIONS ON THE
PROTECTION OF WELL-KNOWN MARKS

AS DECIDED BY THE WIPO STANDING COMMITTEE
ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS
AND GEOGRAPHICAL INDICATIONS (SCT), JUNE 11, 1999

TO BE PRESENTED FOR ADOPTION BY
THE WIPO GENERAL ASSEMBLY AND
PARIS UNION ASSEMBLY IN SEPTEMBER 1999

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Joint Resolution

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

Recognizing that protection for well-known marks must be provided, under the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), by Member States of the Paris Union and of WIPO that are bound to apply the relevant provisions of those treaties, and by certain intergovernmental organizations;

Recommend to each such Member State to protect well-known marks in accordance with the provisions contained herein, which were adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) at its Second Session, Second Part; and

Recommend, to each Member State of the Paris Union or of WIPO, which is also a member of an intergovernmental organization that has competence in the area 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.

Article I
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 alphanumeric 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 information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
2. the duration, extent and geographical area of any use of the mark;
3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
4. the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
6. the value associated with the mark.

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

[Annex II follows]

ANNEX II

**List Of Member States Represented at the
Committee of Experts on Well-Known Marks and the
Standing Committee on the Law of Trademarks, Industrial Designs and
Geographical Indications**

Algeria	Guatemala	Poland
Andorra	Honduras	Portugal
Argentina	Hungary	Qatar
Armenia	India	Republic of Korea
Australia	Indonesia	Republic of Moldova
Austria	Iran (Islamic Republic of)	Romania
Bangladesh	Iraq	Russian Federation
Barbados	Ireland	Rwanda
Belarus	Israel	Saudi Arabia
Belgium	Italy	Senegal
Benin	Jamaica	Singapore
Bolivia	Japan	Slovakia
Brazil	Jordan	Slovenia
Brunei Darussalam	Kazakhstan	South Africa
Bulgaria	Kenya	Spain
Burundi	Kyrgyzstan	Sri Lanka
Cameroon	Lao People's Democratic Republic	Sudan
Canada	Latvia	Sweden
Chile	Lebanon	Switzerland
China	Lesotho	Syrian Arab Republic
Colombia	Libyan Arab Jamahiriya	Tajikistan
Costa Rica	Lithuania	Thailand
Côte d'Ivoire	Luxembourg	The Former Yugoslav Republic of Macedonia
Croatia	Madagascar	Trinidad and Tobago
Cuba	Malawi	Tunisia
Czech Republic	Malaysia	Turkey
Democratic People's Republic of Korea	Mali	Turkmenistan
Democratic Republic of the Congo	Malta	Ukraine
Denmark	Mauritius	United Kingdom
Ecuador	Mexico	United Republic of Tanzania
Egypt	Monaco	United States of America
El Salvador	Morocco	Uruguay
Eritrea	Mozambique	Uzbekistan
Estonia	Nepal	Venezuela
Ethiopia	Netherlands	Viet Nam
Finland	New Zealand	Yemen
France	Nigeria	Zimbabwe
Georgia	Norway	
Germany	Oman	
Ghana	Pakistan	(120 States)
Greece	Peru	
	Philippines	