

Trademark Issues in Current Negotiations

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- Trademark provisions in FTAs don't mirror existing International standards or US law
- How FTA trademark provisions are TRIPS Plus is not immediately obvious

- Well-known marks
- Domain names
- Geographical Indications
- Non-traditional Marks

Paris Convention, Article 6bis:

(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.

TRIPS, 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 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.”



The Federal Trademark Dilution Act (FTDA)

the owner of a famous mark shall be entitled, subject to principles of equity . . . , to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark.

15 U.S.C. § 1127

Dilution is ...the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of [] competition between the owner of the famous mark and other parties, or [] the likelihood of confusion, mistake, or deception.

GIs = TMs

Article 2: Trademarks, Including Geographical Indications

2. Each Party shall provide that trademarks shall include certification marks. Each Party shall also provide that geographical indications be eligible for protection as trademarks.^[1]
4. Each Party shall provide that the owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs, including geographical indications, for goods or services that are related to those goods or services in respect of which the owner's trademark is registered, where such use would result in a likelihood of confusion.
13. Each Party shall provide that grounds for refusing protection or recognition of a geographical indication include the following:
 - (a) the geographical indication is likely to cause confusion with a trademark that is the subject of good-faith pending application or registration; and
 - (b) the geographical indication is likely to cause confusion with a pre-existing trademark, the rights to which have been acquired through use in good faith in the territory of the Party.

^[1] **Geographical indications** means indications that identify a good as originating in the territory of a Party, or a region or locality in that territory, where a given quality, reputation, or other characteristic of the good is essentially attributable to its geographical origin. Any sign or combination of signs (such as words - including geographical and personal names, as well as letters, numerals, figurative elements and colors, including single colors), in any form whatsoever, shall be eligible to be a geographical indication. The term "originating" in this chapter does not have the meaning ascribed to that term in Article __. (Definitions).

Non-traditional Marks

“Neither Party shall require, as a condition of registration, that signs be visually perceptible, nor may a Party deny registration of a trademark solely on the grounds that the sign of which it is composed is a sound or a scent.”

Domain Names

“In order to address the problem of trademark cyber-piracy, each Party shall require that the management of its country-code top-level domain (ccTLD) provide an appropriate procedure for the settlement of disputes, based on the principles established in the Uniform Domain-Name Dispute-Resolution Policy.”

Inter-American Convention of 1929?

Thank You

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