

*How notorious is the well-known trademark
in law and jurisprudence?
A European Perspective*

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ASIPI
20th Work Sessions and Administrative Council
November 26, 2017
Panama City



REPUTATION, WELL-KNOWN, NOTORIOUS, FAMOUS...

DIFFERENT NOTIONS, DIFFERENT SCOPE OF PROTECTION

- Trademark with reputation / Marca Notoria (*marque de renommée* in French)
= Reputed **registered** trademark

➤ National European TM

Article 5.3 (a) – Article 10.2 © - DIRECTIVE (EU) 2015/2436 of December 16, 2015

➤ European TM

Article 8.5 – Article 9.2 © - REGULATION (EU) 2017/1001 of June 14, 2017

Scope of protection: beyond the principle of speciality

- Well-known trademark / Marca notoriamente conocidas (Marca renombradas) (*marques notoires (!)* in French)
= Notorious **non-registered** trademark
- Article 6 bis of the Paris Convention

Scope of protection :

- basic protection before EUIPO: identical / similar products and services
- optional extended protection : dissimilar products and services if unfair advantage [France : **beyond the principle of specialty**]

DIFFERENT REGIMEN, BUT DIFFERENT ASSESSEMENT? NOT REALLY!

- A well-known trademark is usually admitted as being “**better known**” than a reputed trademark
Is that really the case?

- Criteria for a reputed (registered) TM
See **General Motor v Yplon Chevy** (*Judgment of September 14, 1999, C- 375/97*)

Known

- by a **significant part of the public concerned** by the products and services that it covers
- throughout **the entire or a substantial part of the relevant territory**
 - **For a EU TM: 28 countries...**
- Criteria for well-known TM: **Mostly the same criteria although**
 - ➔ **The whole public in general** *versus* “the concerned public”
 - ➔ **The whole territory** *versus* “a substantial part of the territory”

COMMONPLACE FACTORS FOR REPUTED OR WELL-KNOWN TRADEMARKS

Traditional factors

- Seniority of the use
- Intensity of the use
- Geographical extent of use
- Promotional and advertising investments
- Market share held by the prior trade mark

Other factors


- Record of successful enforcement (i.e., decisions rendered by judicial or administrative authorities)
- Certifications and awards
- Licensing, merchandising and sponsoring
- Social Media impact

A HEAVY BURDEN OF PROOF

- Principle: **burden of proof lies on plaintiff's shoulders**
- Evidentiary work is rarely rewarded – the French example
 - **Well-known trademark**
 - ✓ A “premium” category rarely acknowledged
 - ✓ Over **11 years**
 - ❖ **National Office**: 29 denied vs **3 accepted**
 - ❖ **Judicial Courts**: 6 denied vs **2 accepted**
 - **Reputed trademark in France**
 - ✓ No statistics available
 - ✓ Slightly more widely accepted
 - Not surprising – Well-known TM supposed to be “more known” than Notorious TM
- Reputation is not a “forever status”
Notoriety has to be re-established in each new matter
Otherwise **loss of repute** : see MUST (de CARTIER) or CHRISTIAN LACROIX

A FEW SUCCESS STORIES

• Trademark with reputation at a European level

- **NASDAQ** for stock exchange price quotation services
 - ✓ massive use in newspapers / news channels
 - ✓ substantial investments
- **KENZO** for cosmetics, perfume and clothing
 - ✓ “extensive coverage” in the press
 - ✓ volume of sales proved through invoices
- **Adidas’ three-stripe logo** -  for clothing

• Trademark with reputation at national level

BOEING (airplanes), **GIVENCHY** (handbags) **ARIEL** (bleaching preparations)

AN EVEN FEWER SUCCESS FOR WELL-KNOWN TM

- **At a European level**
 - **Cannot be listed for all EU countries – very local assessment**
See the BIMBO case (Case T-277/12)
The **BIMBO** word trademark (non registered) considered as well-known in Spain for packaged sliced bread
- **National Offices – (again) French exemples – 3 cases**
 - **GAUMONT** for production and distribution of films and providing cinema facilities
 - **X-MEN** for printed matter and cinematographic films
 - **CONSTANCE** for HERMES's handbags

IS THERE “SUPER” NOTORIOUS TM, WHICH NEED NOT TO BE PROVEN?

• OBVIOUS FACTS / NOTORIOUS FACTS – WHAT IS THAT?

- Unknown notions in the French legal system:
Judges are prohibited from using their personal knowledge
- But not unknown to other European countries

➤ Austria

- Obvious facts need no proof in civil proceedings (§ 269 ZPO)
- The VIVA case (*The Austrian Supreme Court, Decision of February 16, 2014, 4 Ob 189/ 14v*)
Notoriety is when a fact is known to a large group of people without special expertise.

*Anyone from reliable sources without special knowledge must be able to safely inform about such facts. **These include, above all, the empirical principles of general life experience, geographical facts, historical and political events as well as the current affairs (...)***

*However, in this specific case, **the opposition mark** [▼▲▼▲ - EUTM n°005.061.775] **is even known to those members of the recognizing Senate**, who undoubtedly are not among the circles addressed by the applicant's television station. In these circumstances, a counter-proof is virtually hopeless*

➤ Spain

Artículo 281 Ley de Enjuiciamiento Civil - Objeto y necesidad de la prueba.

4. No será necesario probar los hechos que gocen de notoriedad absoluta y general

IS THERE “SUPER” NOTORIOUS TM, WHICH NEED NOT TO BE PROVEN?

- The European Court of Justice promotes the « well-known facts »

- Well-known facts = facts likely to be known by anyone or which may be learnt from generally accessible sources (*Case T-185/02, Picasso Estate v OHIM*)
 - PICASSO, one of the greatest painter of the XXth century

- Doctrine implemented by the EUIPO Board of Appeals

- **SUPERMAN** case (*Case R 235/2006-2*)

“the sign ‘SUPERMAN’ is particularly well known to the relevant public as being the name of a ‘superhero’, a character known worldwide through comics, films, television and numerous merchandising products (...) The Board is aware that ‘SUPERMAN’, is one of the most famous, perhaps even the most famous, of various ‘superheroes’, whose adventures have been read about in comics and followed in films and television for decades by both children and adults all around the world. The fact that ‘SUPERMAN’ is a well-known character, is a generally known fact, which needs not to be proven (...) When written together and when pronounced as a word, the word ‘SUPERMAN’ creates in the mind of the consumers a particular concept which is very well-known around the world (...)”

- **Nike** case (*Case R 554/2008-2*) -



CONCLUSION

- **Evidencing the notoriety / reputation remains the rule**
 - Before EUIPO/ European Court / National Courts
 - Notorious facts remains the exception
- **“Notorious facts:” A name given to an accepted practice?**
 - ✓ The **HERMES** decisions – Reputation “not challengeable”
 - ✓ **The OLYMPIC GAMES cases**
 - **“Olympic”** = well-known trademark
“neither contested nor questionable”
(Paris First Instance Court, June 13, 2014)
 - **“Olympique”** = well-known trademark without evidence
(Paris First Instance Court, April 10, 2014)



**THANK YOU FOR YOUR
ATTENTION**

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