

A panoramic view of Edinburgh, Scotland, at sunset. The city's historic architecture, including the Edinburgh Castle on the hill and the Belfrage tower, is silhouetted against a sky of orange and yellow. The foreground shows the dense urban fabric of the city.

Bird & Bird

# A comparative view around well known trade marks

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# Legal framework

## *Basis for protection*

### **Paris Convention (1883) – Article 6bis (1) and (2)**

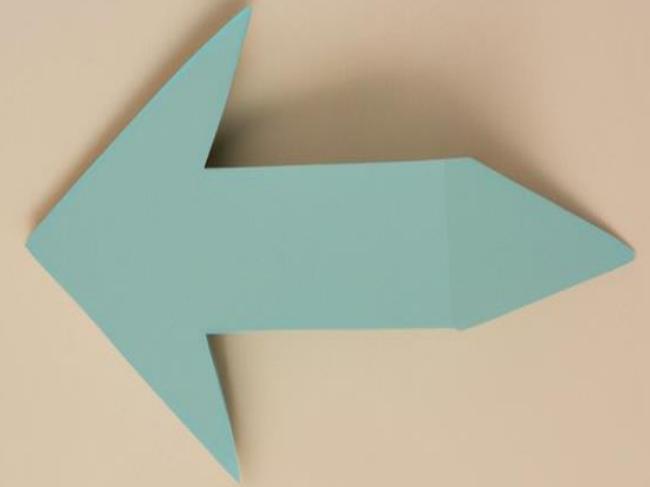
Requires member states to offer protection for well known trade marks, even if the mark is not registered.

### **TRIPS Agreement (1994) – Article 16 (2) and (3)**

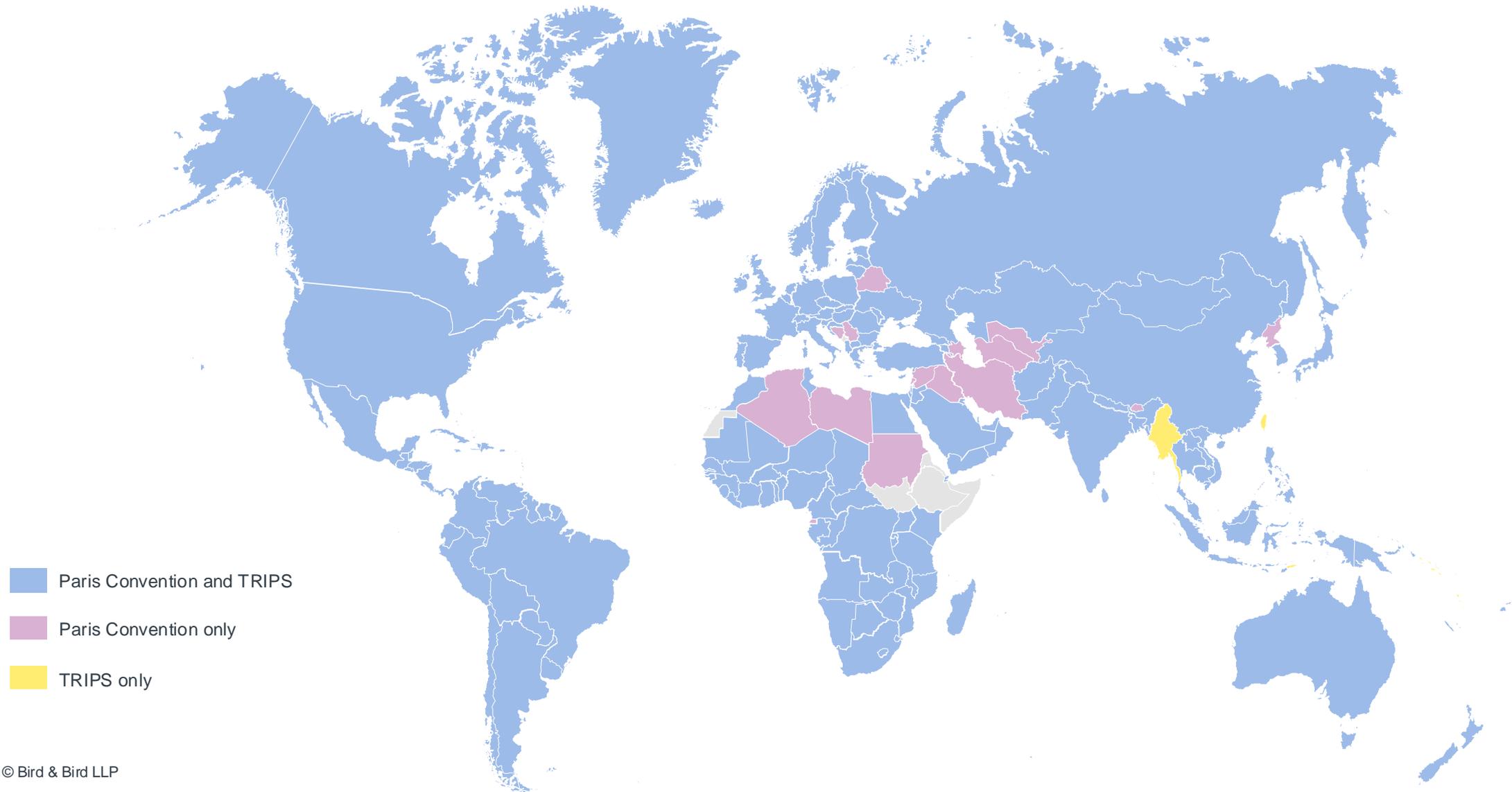
Extends protection to well known services. Provides that assessment of recognition should consider the relevant sector of the public and that recognition can be acquired through promotion. Extends protection against use of the mark on non-similar goods or services for registered trade marks under specific conditions.

### **WIPO's Joint Recommendation (1999)**

Offers guidelines for determining whether a mark qualifies as well known and how to apply related protections.



# Parties to the Paris Convention and TRIPS



# A comparative analysis

*Bird's eye view*

## Terminology

What is a well know trade mark?

## Eligibility criteria

What are the protection requirements?

## Scope of protection

What rights does it confer?



# Understanding the term

## *Statutory definitions*

### India

*Section 2(1)(zg) Trade Marks Act*

"well known trade mark" in relation to any goods or services, [...] a mark which has become so **[well known] to the substantial segment of the public** which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating **a connection** in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services

### China

*Article 13(1) and (2) PRC Trade Mark Law*

If the holder of a trademark that is well known **to the relevant public** believes that its rights have been infringed, it may apply for protection of a **well-known trademark** in accordance with the provisions of this Law.

If the trademark applied for registration for the same or similar goods is a copy, imitation or translation of a **well-known trademark** of another person that is **not registered** in China, which is likely to cause confusion, it shall not be registered and its use shall be prohibited.

### Finland

*Section 4 Finnish Trade Marks Act*

Exclusive rights to a trade mark may be acquired **without registration**, if the trademark **has become established**. A trademark shall be deemed to have become established if it is **generally known in Finland within the relevant consumer group as a distinctive sign** for the goods or services of its proprietor.

# Understanding the term

*Well known to the public at large, very well known*

## Singapore

*Section 2(1) Singapore Trade Mark Act*

Well known trade mark means

- a. any **registered** trade mark that is **well known in Singapore**; or
- b. any **unregistered** trade mark that is **well known in Singapore** and that belongs to a person who
  - is a national of a Convention country; or
  - is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,whether or not that person carries on business, or has any goodwill, in Singapore.

## Australia

*Section 120(4); 185 Trade Marks Act*

In deciding, for the purposes of paragraph (3)(a), whether a trade mark is well known in Australia, one must take account of **the extent to which the trade mark is known within the relevant sector of the public**, whether as a result of the **promotion** of the trade mark or for **any other reason**.

A mark can be registered for goods or services even if the owner has no intention to use it in those classes, provided the mark is **so well known that consumers** would likely assume a **connection**.

# Understanding the term

## *Trade marks with a reputation, famous marks*

### EU

*Article 8(5); 9(2)(c) EUTMR*

... where the earlier **trade mark has a reputation in the Union** and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

... the use of the sign takes unfair advantage of, or is detrimental to, the distinctive character or **the repute of the EU trade mark**.

### Germany

*Section 14(2)(3); 9(1)(3) Trade Mark Act*

... where the sign is identical with, or similar to, the trade mark, irrespective of whether it is used for goods or services which are identical with, similar to, or not similar to those for which the trade mark is protected, where the **trade mark has a reputation in Germany** and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

... if it is similar to an earlier **trade mark with a reputation**... and the use of the later mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

### US

*Section 43(c) Lanham Act*

A mark is **famous** if it is **widely recognized by the general consuming public of the United States** as a designation of source of the goods or services of the mark's owner.

# Eligibility criteria

*Trade mark awareness among the relevant public*

Recognition procedure

Who and when determines that a mark is well known?

Threshold of awareness

What is the relevant audience and what level of recognition is required?

Evidence standards

How to prove recognition?



# Threshold of awareness

## *Benchmark*

### EU

*Judgement of 14 Sep 1999, General Motors, C-375/97*

A trade mark has a reputation when: “it is known **by a significant part of the public** concerned by the products or services covered by that trade mark.”

*Judgement of 13 Dec 2012, Inditex, T-345/08*

Factors relevant to prove reputation: market share, intensity of use, and geographic scope — even without a fixed percentage threshold.

### Germany

Well-known trade marks should normally have **not less than 25%-30% awareness**; 50%+ awareness is normally not required. Trade marks with reputation require **broader** recognition among the general public.

### Italy

Awareness levels of **around 60%** or more are considered strong indicators of reputation. Depending on the context, even **30-40%** may suffice.

### Poland

*Judgement of 16 Jun 2011, VI SA/Wa 617/11*

The requirement of notoriety entails that the mark is **known to more than half of the relevant audience**.

*Judgment of 5 Oct 2017, XXVI GC 624/14*

In the light of the ECJ case law, **no percentage can be assumed in advance**. This seems to be an oversimplification.

# Threshold of awareness

## *Benchmark*

### US

#### *Section 43(c) Lanham Act*

A mark is famous if it is **widely** recognized **by the general consuming public of the United States** as a designation of source of the goods or services of the mark's owner.

*LeCharles Bentley v. NBC Universal, LLC, CV 16-03693 TJH (KSx)*

Recognition in a niche market or among a limited segment of individuals **does not satisfy** the 'widely recognized by the general consuming public of the United States' requirement of 15 U.S.C. § 1125(c)(2)(A).

### Singapore

#### *Section 2(9) Singapore Trade Mark Act*

In deciding whether a trade mark is **well known to the public at large** in Singapore, the Registrar or the Court shall have regard to the following sectors of the public:

- a) **all** actual and potential consumers in Singapore;
- b) **all** persons in Singapore involved in the distribution of the goods or services; and
- c) **all** businesses and companies in Singapore dealing in the goods or services.

### China

为相关公众所熟知的商标 – well known by the relevant public

High level of recognition required but only within the relevant audience.

Standard for well known mark is much higher than that for showing reputation.

### India

#### *Rule 124(2)(b) Trade Marks Rules*

The Registrar shall take into account the knowledge or recognition of the trade mark in the relevant section of the public, including knowledge in India obtained as a result of promotion of the trade mark.

# Threshold of awareness

## *Evidence standards*

### **1. Sales figures**

Sales volume and market share

### **2. Advertising & promotion**

Marketing expenditure and materials

### **3. Duration & extent of use**

First use and geographical spread

### **4. Public opinion surveys**

Consumer recognition or brand awareness studies

### **5. Market research reports**

Third-party research firms

### **6. Trade press & media coverage**

Articles, interviews, features, and editorial mentions

### **7. Enforcement history**

Past decisions, successful oppositions, cancellations, or court judgments

### **8. Distribution network**

Retail locations, outlets, distributors, online sales channels, e-commerce reach

### **9. Licence & franchise agreements**

Royalties or terms that indicate commercial value

### **10. Brand rankings & awards**

Interbrand, Forbes ...

### **11. Consumer engagement**

Social media engagement metrics, customer loyalty programs, membership statistics

### **12. Fairs & exhibitions**

Promotional materials, booths

# Scope of protection

*Rights conferred by well known trade marks*

## Rights

- to oppose registration
- to invalidate a trade mark
- civil claims: injunction, monetary claims, recall, publication of the judgement
- defensive registration
- customs protection
- criminal measures

## Grounds

- double identity
- risk of confusion (identical or similar goods)
- unfair advantage or dilution (dissimilar goods)
- free-riding
- passing off
- unfair competition and consumer protection

# Right to oppose & invalidate

## *Confusion with a well-known trade mark*

### Singapore

*Section 8(4)(b)(i); 8(4)(b)(i) Singapore Trade Mark Act*

A trade mark shall not be registered if

- (i) it is similar to an earlier trade mark that is **well known** in Singapore,
- (ii) the goods or services of the application mark are identical or similar to those for which the earlier mark is well known,
- (iii) the use of the mark would indicate **a connection** with the owner of the earlier well known mark,
- (iv) and is likely to damage the interests of the proprietor.

A trade mark shall not be registered if

- (i) it is similar to an earlier trade mark that is **well known to the public at large** in Singapore,
- (ii) and the use would cause **dilution** in an unfair manner or take unfair advantage of the distinctive character of the earlier mark.

### Australia

*Section 60 Trade Marks Act*

The registration of a trade mark may be opposed on the ground that because of the **reputation** of another trade mark in Australia, **a likelihood of deception or confusion** would arise if the applicant's trade mark were used.

### China

*Article 13(2) PRC Trade Mark Law*

If the trademark applied for registration for the same or similar goods is a copy, imitation or translation of a well-known trademark of another person that is not registered in China, which is likely to **cause confusion**, it shall not be registered and its use shall be prohibited.

# Civil claims

## *Dilution*

### **Australia**

#### *Section 120(3) Trade Marks Act*

A person infringes a registered trade mark if:

- a) the trade mark is well known in Australia; and
- b) the person uses as a trade mark a sign that is substantially identical with, or deceptively similar to, the trade mark in relation to:
  - i. goods or services that are unrelated to the registered goods/services; and
- c) because the trade mark is well known, the sign would be likely to be taken as indicating a connection between those unrelated goods/services and the registered owner; and
- d) for that reason, the registered owner's interests are likely to be adversely affected.

### **China**

#### *Article 13(3) PRC Trade Mark Law*

If the trademark applied for registration for non-identical or dissimilar goods is a copy, imitation or translation of a well-known trademark already registered in China by another person, **misleading the public and causing possible damage to the interests of the registrant** of the well-known trademark, it shall not be registered and its use shall be prohibited.

# Civil claims

## *Moral damage, unfair competition*

### **Spain**

*Article 43.2 Trade Marks Act*

Compensation shall include not only the value of the loss suffered but also the profits that the injured party failed to obtain due to the infringement, as well as the costs incurred to prevent or mitigate the infringement, including reasonable investigation expenses. It may also include **compensation for the moral damage** caused to the holder of the infringed right.

### **France**

*Article L.716-4-10 French Intellectual Property Code*

To determine the amount of damages, the court shall consider separately: [...]

The **moral prejudice** suffered by the holder of the right.

### **Germany**

*Section 4 (3) Act Against Unfair Competition*

Unfairness shall have occurred where a person

3. offers goods or services by **taking advantage of the reputation of a mark**, trade name, other distinguishing mark, or the designation of origin of a competitor.

### **Spain**

*Article 12 Unfair Competition Law*

The **exploitation** in one's own market of the advantages of the industrial, commercial, or **professional reputation** acquired by another in the market shall be considered unfair.

# Civil claims

## *Commentary, parody, artistic works*

### United Kingdom

*Section 30; 30A Copyright, Designs and Patents Act*

Fair dealing with a work **for the purpose of criticism or review** does not infringe any copyright in the work, provided that it is accompanied by a sufficient acknowledgment and the work has been made available to the public.

Fair dealing with a work for **the purposes of caricature, parody, or pastiche** does not infringe copyright in the work.

### Australia

*Section 41; 41A Copyright Act*

A fair dealing with a work **for the purpose of criticism or review** does not constitute an infringement of the copyright in the work.

A fair dealing with a work **for the purpose of parody or satire** does not constitute an infringement of copyright.

### Singapore

*Section 55A(3) Singapore Trade Mark Act*

Despite section 55, the proprietor of a well-known trade mark is **not entitled** to restrain by injunction the use in Singapore of the trade mark if such use

- a) constitutes fair use in comparative commercial advertising or promotion;
- b) is for a non-commercial purpose; or
- c) is for the purpose of news reporting or news commentary.

# Defensive trade marks

## *Australia*

### *Section 185 Trade Marks Act*

If, because of **the extent to which a registered trade mark has been used** in relation to all or any of the goods or services in respect of which it is registered, it is likely that its use in relation to other goods or services will be taken to indicate **a connection** between those other goods or services and the registered owner of the trade mark, the trade mark may, on the application of the registered owner, be registered **as a defensive trade mark** in respect of any or all of those other goods or services.

A trade mark may be registered **as a defensive trade mark** in respect of particular goods or services even if the registered owner **does not use** or intend to use the trade mark in relation to those goods or services.



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# Thank you Tapadh leibh

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