

It shall be mentioned in advance that there exists no piece of EU legislation harmonising the law of use marks and/or well-known trade marks on a European level. Rather, European legislation takes trade marks acquired through use into account “only in regard to the relationship between them and trade marks acquired by registration”.⁷⁵³ Hence, one’s attention needs to be turned to national legislation (this work will use the example of German law) and international conventions, most notably the Paris Convention and the TRIPs Agreement, the latter two being incorporated into domestic laws.

5.7.2 Well-Known Marks

Well-known marks, i.e. unregistered (or registered) marks that are widely known in the marketplace, are protected through implementation of the respective provisions of the Paris Convention and the TRIPs Agreement into national laws.

Art. 6^{bis} Paris Convention creates an international minimum standard of protection of well-known marks against registration or use on identical or similar goods and against trade marks which are reproductions, imitations or translations.⁷⁵⁴ This basically corresponds to the level of protection hitherto awarded to registered trade marks only and is therefore of particular importance for unregistered trade marks. Art. 6^{bis} Paris Convention does not require that the sign in question actually be in use in the country concerned, provided that the sign is well-known there (thus, the notoriety of the sign concerned must exist in the country in question but can be based on use in a foreign country). Neither does it define when a mark is well-known in this sense but leaves this question for the national lawmakers and courts to decide. In most countries, a rather high degree of notoriety is required, ranging from 60% to 80%.⁷⁵⁵ Such fame must be the result of a communication

the protection of non-registered trade marks can be found at *Götting*, IIC 2000, 389; *Marx*, *Deutsches, europäisches und internationales Markenrecht*, at no.s 584 et seq.; *Phillips*, *Trade Mark Law: A Practical Anatomy*, pp. 393 et seq.

753 Cf. Recital four of the CTMD. The CTMR, for instance, refers to such unregistered trade marks in Art. 8(2)(c) which deals with relative grounds for refusal of protection based on conflicting earlier rights. According to Art. 8(2)(c) CTMR, registration of a Community trade mark must be denied in case, inter alia, it conflicts with a national mark which is well-known pursuant to Art. 6^{bis} Paris Convention.

754 *Lackert/Perry*, *Building and enforcing intellectual property value* 2008, 63, 64.

755 *Götting*, IIC 2000, 389, 406.

process between seller and target audience as a result of which the mark is perceived as a sign of origin of the respective goods or services.

The later TRIPs Agreement extends the application of the Paris Convention to all WTO Member States pursuant to its Art. 2(1) which specifies that WTO Members “shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967)”. Hence, the TRIPs Agreement incorporates, through its Art. 2, all substantive provisions of the Paris Convention, making them binding on all WTO Members, whether or not they are signatories of the Paris Convention.⁷⁵⁶

Furthermore, Art. 16(2) TRIPs extends the scope of Art. 6^{bis} Paris Convention in a number of ways. For instance, it extends Art. 6^{bis} Paris Convention to protect service marks. Unlike Art. 6^{bis} Paris Convention, Art. 16(2) TRIPs provides some guidance as to under which circumstances a mark is well-known. According to this provision, one shall take into account “the knowledge of the trade mark in the relevant sector of the public, including knowledge in the Member [*i.e. Member State to the WTO, A/N*] concerned which has been obtained as a result of the promotion of the trade mark.”. The mere mention of promotion means that the respective mark need not actually be used to the extent that there are sales of marked goods or services in the respective country.⁷⁵⁷

The priority of well-known marks is more difficult to detect than the one of registered trade marks. Whereas the priority of registered marks depends on the date of application, the point in time at which a mark becomes well-known is decisive for its protection under Art. 6^{bis} Paris Convention (in countries where this provision is held to be self-executing) and the related domestic laws respectively.⁷⁵⁸ Evidence of a trade mark application can be

756 This is named the “Paris Plus Approach”, cf. *Kur*, GRUR Int. 1994, 987, 989.

757 In addition, Art. 16(3) TRIPs extends the application of Art. 6^{bis} Paris Convention to the protection of registered well-known trade marks from unauthorised use of the mark on non-competing, unrelated goods or services provided that this “would indicate a connection between those goods or services and the owner of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use.”. Herewith, the protection of well-known marks is extended beyond similarity, the traditional realm of protection of registered trade marks. Hence, a registered well-known mark is protected from its use on dissimilar goods or services in a manner which blurs or tarnishes its unique drawing power – a central component of the value of the well-known mark in question. This section 5.7 deals with the protection of unregistered marks only. For more on protection of registered trade marks beyond cases of double identity and likelihood of confusion cf. below at 5.12.