

Paris Congress

Minutes Plenary Session III

Q214: Protection against dilution of a trademark

**Tuesday, 5 October 2010
(09.00-10.40 and 11.10-12.30)**

Chair of Session:	Olga SIRAKOVA (BG)
Working Committee Chair:	Robert SACOFF (US)
Working Committee Co-Chairs:	Hikomichi AOKI (JP) Aleli Angela G. QUIRINO (PH)
Working Committee Secretary:	Anne Marie VERSCHUUR (NL)
Responsible Reporter:	Thierry CALAME, Deputy Reporter General

The Chair, Ms Olga SIRAKOVA, welcomed the audience and introduced the panel. The Chair introduced the responsible reporter Mr Thierry CALAME (TC).

TC clarified some general housekeeping matters.

The Chair introduced the Working Committee Chair, Mr Robert SACOFF (RS).

RS introduced the question and summarised the discussion in the working committee.

TC outlined the previous work of AIPPI and the Working Guidelines. He pointed out that the question of whether a mark has to be used as “a mark” and the issues of freedom of speech have been addressed previously by AIPPI.

TC particularly referred to the issues; which type of trademark should be eligible for the protection against dilution and how widespread must the awareness be, i.e. does it suffice to be famous in a niche market or should the mark be known to the general public at large? In a few countries in Latin America any mark has protection against dilution. The working committee also debated whether there should be a registry of famous marks. There was a clear consensus not to have registries but in case registries exist it is necessary to allow challenges. Another

issue that was debated in the working committee was the so called “mental link”. The working committee criticised the requirement in recent ECJ trademark law of an actual or a potential change in the economic behaviour of the consumer. The working committee found the requirement unclear and inappropriate.

The Chair acknowledged TC.

RS introduced the draft resolution. RS then put the Draft Resolution to the debate, proposing to debate the resolution part before discussing the recital part of the Draft Resolution.

Resolution part

1)

a)

No one wished to discuss the paragraph. RS put the paragraph to the vote. The paragraph was carried with an overwhelming majority.

b)

Mr José BARREDA speaking on behalf of the Peruvian Group proposed that the paragraph should clearly refer also to “distributors and retailers”.

TC observed that operators in the distribution channel are included in “the public”.

Mr Charles GIELEN speaking on his own behalf seconded TC’s comment. The relevant public could be everyone in the chain, and includes also distributors and retailers. There is no need for the amendment.

Mr Jorge OTAMENDI speaking on behalf of the Argentine Group spoke against the amendment.

The paragraph was put to the vote. The amendment was denied.

Mr OTAMENDI proposed that the sentence from “i.e. the public concerned” and onwards is eliminated.

TC noticed that the proposed amendment alters the paragraph completely. There are two views in respect of the demographic dimension; the general public and the relevant public for that particular area. In the working committee there was a majority in favour of the relevant public for the particular area.

Mr Cesare GALLI speaking on behalf of the Italian group spoke against the amendment and remarked that it is important to understand that the protection of

the mental link is generated with regard to another sign. A niche market should be sufficient to create a link between the trademark and the new sign.

The amendment was put to the vote. The amendment failed with an overwhelming majority.

Paragraph 1b), as a whole, was put to the vote. The paragraph was carried with substantial majority.

c)

No one wished to discuss the paragraph. The paragraph was put to the vote. The paragraph was carried with substantial majority.

2)

No one wished to discuss the paragraph. The paragraph was put to the vote. Paragraph 2 passed with overwhelming majority.

Mr Chris MORGAN speaking on behalf of the Australian group observed that Paragraph 1 was not voted on in its entirety.

RS acknowledged Mr MORGAN and put Paragraph 1 in its entirety to the vote. Paragraph 1 was carried with a substantial majority.

3)

Mr Jan MONTAGU VLECK speaking on behalf of the British group proposed that the word “from” should be replaced with “prior to” because reputation changes over time.

RS speaking on behalf of the working committee accepted the amendment.

Mr Emmanuel CORNU speaking on behalf of the Belgian group spoke against the amendment.

The amendment was put to the vote. The amendment was carried.

Mr OTAMENDI speaking on behalf of the Argentinean group observed that proprietors of famous trademark risk spending a lot of money to prove that their trademarks are well-known. It is contradictory that proprietors of a well-known trademark should have to prove that the trademark is well-known. If there is a need for proof, the trademark is not well-known.

Mr GIELEN speaking on his own behalf observed that if the trademark is well-known in a niche market, the court may not know the mark.

Paragraph 3 in amended form was put to the vote. Paragraph 3 was carried with an overwhelming majority.

4)

Mr CORNU speaking on behalf of the Belgian group proposed an amendment to Sections 4 and 5 specifying that these sections only apply to brands well-known under *6bis* of the Paris Convention. The current wording gives protection also to those trademarks only known in a niche market.

The amendment was put to the vote. The amendment failed.

Paragraph 4 was put to the vote. Paragraph 4 was carried.

5)

Mr István GÖDÖLLE speaking on behalf of the Hungarian Group proposed an amendment “except in countries where trademarks can be obtained without registration”.

TC spoke against the amendment. The amendment was put to the vote. The amendment failed.

Paragraph 5 was put to the vote. The paragraph was carried with substantial majority.

6)

No one wished to discuss this paragraph. The paragraph was put to the vote. Paragraph 6 was carried with a substantial majority.

7)

No one wished to discuss this paragraph. The paragraph was put to the vote. Paragraph 7 was carried with a substantial majority.

8)

No one wished to discuss this paragraph. The paragraph was put to the vote. Paragraph 8 was carried with an overwhelming majority.

9)

Mr Willem HOYNG speaking on behalf of the Dutch group proposed an amendment to the paragraph “as of the time of instituting the action” to be inserted after “other signs”.

The amendment was put to the vote. The amendment was carried.

Ms Graciela Claudia PEREZ DE INZAURRAGA speaking on behalf of the Argentinean Group suggested that “may” is replaced by “should”.

The amendment was put to the vote. The amendment failed.

Paragraph 9 in its amended form was put to the vote. The paragraph was carried with an overwhelming majority.

- Break-

TC clarified some housekeeping matters.

10)

Mr GIELEN speaking on his own behalf posed the question whether there is any doubt in respect of the meaning of “to the extent available in a country. If there is any doubt as to the meaning he suggested an amendment “to the extent such procedure is available in a country.”

RS speaking on behalf of the working committee accepted Mr GIELEN’s proposal.

The amendment was put to the vote. The amendment was carried by an overwhelming majority.

Paragraph 10 in its amended form was put to the vote. The paragraph was carried by an overwhelming majority.

Noting part

No one wanted to discuss the noting part. The noting part was put to the vote. The noting part was carried by an overwhelming majority.

Considering part

Mr Florent GEVERS speaking on his on behalf observed that there is no reference to the level of reputation in the draft resolution.

RS observed that the issue brought up by Mr GEVERS would be another dimension of the question to get into.

TC pointed out that some national groups state in their reports that the higher the reputation, the higher level of protection. However, there is no clear consensus in the national groups' reports and thus no basis to address the issue in this resolution.

Mr GIELEN speaking on his own behalf observed that the ECJ has already clarified that the higher the reputation, the higher level of protection. He proposes an amendment, a new paragraph stating "The higher the recognition or fame is, the broader the dilution protection".

Mr Alexander VON MÜHLEND AHL speaking on behalf of the German Group supported Mr GIELEN's proposal.

Mr MONTAGU VLECK speaking on behalf of the British group observed that the issue was covered by the paragraph on the mental link. Further, this issue was not discussed in the working committee.

Mr Shane SMYTH speaking on behalf of the Irish Group observed that the amendment is catered for in paragraph 1a) of the resolution part.

Ms Evelyne ROUX speaking on behalf of the French Group proposed an amendment "the level of reputation or fame may be among the factors to consider".

Mr HOYNG speaking on behalf of the Dutch Group supported the speakers from Great Britain and Ireland and added that one always have to take all aspects into consideration.

TC spoke against any amendments as the issue had not been discussed in the working committee.

Mr GALLI speaking on behalf of the Italian Group supported the view of the Irish and British groups.

The question whether to amend at all was put to a vote. The vote was not carried. The Chair pointed out that no further votes were needed as to the proposed amendments.

The considering part was put to the vote. The considering part was carried by an overwhelming majority.

The Resolution in its entirety was put to the vote. The Resolution was carried by an overwhelming majority.

Report from the Special Committee Q160

The Chair introduced Ms Jane MUTIMEAR, Co-Chair of the Special Committee Q160. Ms MUTIMEAR reported on ICANN developments. She particularly referred to the new top level domains.

Minutes written by:

Sara Ulfsdotter

5 September 2010