Q234 - Relevant public for determining the degree of recognition of famous marks, well-known marks and marks with a reputation

Introduction Plenary Session 5 September 2013

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Background

• The WQ emanates from Protection against the dilution of a trademark, Q214 (Paris Congress)

• The Paris WG discussed whether the general public at large or a relevant sector of public would be the relevant public

• In the WC and the Plenary Session it became clear that the issue of the relevant public required further study and should be made into a separate question
Previous work of AIPPI

• AIPPI has not previously studied topic of this WQ

• Extended protection of famous marks, well-known marks and marks with a reputation dealt with in e.g.:
  – *Trademarks or names with extended protection*, Q29 (1963)
  – *Protection of unregistered but well-known trademarks (Art. 6bis Paris Convention) and protection of highly renowned trademarks*, Q100 (1990)
• General public ./ Relevant sector
• Terms used for marks with an extended protection (Any differences)
• If relevant public = relevant section
  – Criteria used, business/professional end consumers, mixed public, thresholds, when the relevant public assessment comes into play, case-by-case ./ “test”
• Proposals for harmonisation
• The RG has received a total of 39 reports:
Argentina, Australia, Austria, Belgium, Brazil, Bulgaria, Canada, China, Denmark, Egypt, Estonia, Finland, France, Germany, Greece, Hungary, Israel, Italy, Japan, Latvia, Luxembourg, Malaysia, Mexico, The Netherlands, Philippines, Poland, Portugal, Republic of Korea, Romania, Russia, Singapore, South Africa, Spain, Sweden, Switzerland, Trinidad & Tobago, Turkey, United Kingdom and United States of America
Some conclusions

• A wealth of different terms are used for marks with an extended protection - “famous” and “having a reputation/reputed” only being two examples

• “Well-known” is widely used but the qualification of well-known marks in different jurisdictions varies a lot

• Harmonization of terminology - a challenge

• The vast majority of the Groups consider harmonization desirable

• How to define the relevant public?
Some conclusions

• What criteria may be used when establishing the relevant public?

  Joint recommendation Art 2: “[Relevant Sector of the Public]

  (a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

  (i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;

  (ii) persons involved in channels of distribution of the type of goods and/or services to which the mark applies;

  (iii) business circles dealing with the type of goods and/or services to which the mark applies.”

• Most groups take the position that the relevant public must be established on a case-by-case basis