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UNIVERSITY OF SOUTHAMPTON

FACULTY OF LAW, ARTS & SOCIAL SCIENCES

School of Law

Well-Known Trade Mark Protection: Confusion in EU and Japan

by

Hiroko Onishi

Thesis for the degree of Doctor of Philosophy

December 2009

UNIVERSITY OF SOUTHAMPTON

ABSTRACT

FACULTY OF LAW, ARTS & SOCIAL SCIENCES

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WELL-KNOWN TRADE MARK PROTECTION: CONFUSION IN EU AND
JAPAN

By Hiroko Onishi

In this thesis concerning the protection of well-known trade marks against confusion in the European Community Trade Mark (CTM) and Japanese trademark systems, the author critically considers the difficulties in comprehensively defining 'well-known trade mark' in the relevant international trade mark instruments.

After critical analysis of various definitions of both 'trade mark' and 'well-known trade mark', she undertakes a comparison of the definitions of the parallel concepts of 'trade mark of repute' and 'syuchi-syohyo', and also undertakes an assessment as to the extent to which these trade marks are protected against confusion and *kondo* in the CTM and Japanese systems, respectively. It is concluded that the protection of well-known trade marks against confusion in the CTM and Japan cannot be said to be completely clear, and the author identifies some areas for legal reform.

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LIST OF ABBREVIATIONS

AC	Appeal Cases (House of Lords)
All ER	All England Report
BoA	Board of Appeal (of the European Communities)
BUJ Sci & Tech L	Boston University Journal of Science and Technology
Bus Law	Business Lawyer
Bus L R D	Business
CA	Court of Appeal, England and Wales
Cal L Rev	California Law Review
Cal W Int'l L J	California Western International Law Journal
Cardozo Art & Ent L J	Cardozo Arts and Entertainment Law Journal
CEC	European Community Cases
CFI	Court of First Instance (of the European Communities)
Ch	Law Report Chancery Division
Ch D	Law Report Chancery Division
Chi-Kent L Rev	Chicago-Kent Law Review
Chi-Kent J Intell Prop	Chicago-Kent Journal of Intellectual Property
CIPA	Chartered Institute of Patent Agent
CIPAJ	Chartered Institute of Patent Agent Journal
CLJ	Cambridge Law Journal
CLR	Commonwealth Law Reports
CMLR	Common Market Law Revive
Colum Bus L Rev	Columbia Business Law Review
Colum L Rev	Columbia Law Review
Comms L	Communication Law
Conn L Rev	Connecticut Law Review
Corp Brief	Corporate Brief
CTM	Community Trade Mark
CTMR	Community Trade Mark Regulation
CMLR	Common Market Law Reports
CTLR	Comminute and Telecommunications Law Review
CW	Copyright World
EBL Rev	European Business Law Review
ECC	European Commercial Case
ECJ	European Court of Justice
ECLR	Electronic Commerce and Law Report
ECR I	European Court Reports (European Court of Justice)
ECR II	European Court Reports (Court of First Instance)
ECTA	European Communities Trade Mark Association
EEA	European Economic Area
EFTA	European Free Trade Association
EIPR	European Intellectual Property Review
Ent LR	Entertainment Law Review
ETMR	European Trade Mark Report
EU Focus	European Union Focus
EWCA	England and Wales Court of Appeal
EWCA Civ	England and Wales Court of Appeal Civil Division

EWHC	England and Wales High Court
Fla L Rev	Florida Law Review
Fordham L Rev	Fordham Law Review
Fordham Int Pro	Fordham Intellectual Property Media, and Entertainment Law Journal
FSR	Fleet Street Report
GATT TRIPS	Agreement of Trade-Related Aspects of Intellectual Property Law
Geo Wash Int'l L & Econ	George Washington Intellection Law and Economics
GI	Geographical Indication
Harv L Rev	Harvard Law Review
HC	High Court
HL	House of Lords
Hous L Rev	Houston Law Review
ICCLR	International Company and Commercial Law Review
IIC	International Review of Industrial Property and Copyright Law
IJL & IT	International Journal of Law & Information Technology
IHL	In-House Lawyer
Ill L Rev	Illinois Law Review
ILT	Irish Law Times
INTA	International Trade Association
Int T L R	International Trade Law and Regulation
Iowa L Rev	Iowa Law Review
IP News	Intellectual Property News
IPQ	Intellectual Property Quarterly
IPR	Intellectual Property Report
ITLQ	International Trade Law Quarterly
JBL	Journal of Business Law
J Intell Prop L	Journal of Intellectual Property Law
JL & Economics	Journal of Law & Economics
JIPLP	Journal of Intellectual Property Law
J Pat Off Soc'y	Japanese Patent Office Society
JPO	Japanese Patent Office
Law & Comtem Probs	Law and Contemporary Problems
Liverpool L R	Liverpool Law Review
LS	Legal Studies
Marq Intell Prop L Rev	Marquette Intellectual Property Law Review
MIP	Managing Intellectual Property
MLR	Modern Law Review
New Eng L Rev	New England Law Review
NLJ	National Law Journal
Nw J of Tech & Intell Prop	Northwestern Journal of Technology and Intellectual Property
OAMI	Spanish language for OHIM
OHIM	Office for Harmonisation in the Internal Market
Paniser IPB	Paisner Intellectual property Briefing
Paris Convention	The Paris Convention for the Protection of Industrial Property (of March 20, 1883)
Pharm LI	Pharmaceutical Law Insight

PLC	Practical Law Companies
Rev Litig	Review of Litigation
RPC	Reports of Patent Cases
Singapore Treaty	Singapore Treaty on the Law of Trademark
SL Rev	Student Law Review
SJ	Solicitors Journal
TLT	Trademark Law Treaty
TLR	Tulan Law Review
TM Bulletin	Trade Mark Bulletin
TMR	Trade Mark Reporter
TW	Trademark World
U Dayton L Rev	University of Dayton Law Review
U Pa Int'l Econ L	University of Pennsylvania Journal of International Economic Law
U Chi L Re	University of Chicago Law Review
USPTO	United States Patents and Trademarks Office
U W Ontario L Rev	University of Western Ontario Law Review
Vande L Rev	Vanderbilt Law Review
Vir L Rev	Virginia Law Review
Wake Forest L Rev	Wake Forest Law Review
Wash U J L &Pol'y	Washington University Journal of Law & Policy
WIPO	World Intellectual Property Organization
WIPR	World Intellectual Property Reporter
WLR	Weekly Law Reports (UK)
WLLR	World Licensing Law Report
WTLR	World Trademark Law Report
WTO	World Trade Organization.
Yale L J	Yale Law Journal
YC & ML	Yearbook of Copyright & Media Law

LIST OF JAPANESE TERMS:

防護商標	<i>bogo syohyo</i>	defensive trademark
防護商標登録	<i>bogo syohyo toroku</i>	Registration of defensive
知的財産	<i>chiteki zaisan</i>	Intellectual Property
知的財産法	<i>chiteki zaisan ho</i>	Intellectual Property Law
著名	<i>chomei</i>	Famous
著名商標	<i>chomei syohyo</i>	Famous trademark
不正競争防止法	<i>fusei kyoso boshi ho</i>	Unfair Competition Law
漢字	<i>kanji</i>	Japanese kanji scripts
混同	<i>kondo</i>	Confusion
混同のおそれ	<i>kondo no osore</i>	Likelihood of confusion
民法	<i>min po</i>	Civil Code
水際規制	<i>mizugiwa kisei</i>	Border control
識別力	<i>shikibetsu ryoku</i>	Distinctiveness
種苗法	<i>syobyo ho</i>	Plant Variety Protection Seed Act
商標	<i>syohyo</i>	Trademark
商標法	<i>syohyo ho</i>	Trademark Law
商標条例	<i>syohyo jyorei</i>	Old Trademark Ordinance
商標審査基準	<i>syohohyo shinsa kijyun</i>	Trademark Examination Guidelines
特許庁	<i>tokkyo cyo</i>	Patent Office

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¹ Corrected translations and emphasis added in the text provided by the author.

² Corrected translations and emphasis added in the text provided by the author.

³ Corrected translations and emphasis added in the text provided by the author.

⁴ Corrected translations and emphasis added in the text provided by the author.

Chapter 1 Introduction

1.1 Introduction

The purpose of this thesis is to examine the hypothesis that well-known trade mark protection against confusion in both the EU Community Trade Mark (the CTM)⁵ and the Japanese trademark⁶ systems is uncertain.

In addressing this hypothesis, it is submitted that the author makes the following contributions to the literature in this thesis:

- (i) a detailed comparative analysis of well-known trade mark protection against confusion in EU and Japan (see Chapter 6, in particular)⁷;
- (ii) the novel use of etymological methodology in the analysis of the relevant Japanese law (see Chapter 2, Section 2.3.3 and Chapter 5, Section 5.3), and;
- (iii) a theoretical contribution in the form of the Definition Model (see Chapter 2, Section 2.2.).

However, in this Introductory Chapter, the author endeavours to undertake the following tasks:

⁵ A Community Trade Mark (hereafter, CTM) is any trade mark, which is registered through the CTM system, which is governed by the Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (hereafter known as the CTMR). The CTM system creates a unified regional trade mark registration system in all EU Member States: therefore, an individual applicant can make a single application, which if successfully registered means that the resulting registered trade mark (the CTM) covers all EU Member States. The CTM system is operated by the Office for Harmonization in the Internal Market (Trade Marks and Designs) – hereafter known as OHIM – which is located in Alicante, Spain. A full text of the CTMR can be found at <http://oami.eu.int/en/mark/aspects/reg/reg4094.htm>. (Last accessed on 12 January 2010).

⁶ The correct term for ‘trademark’ in Japan is 商標 (this is transliterated as *syohyo*, and usually translated as ‘trademark’). ‘*Syohyo*’, and ‘trademark’, are the terms that will be used in this thesis in relation to Japanese trademarks. The Japanese trademark system consists of a national registration system, operated by the Japanese Patent Office (hereafter known as the JPO) which is located in Tokyo, Japan, and is governed by the 商標法: (*Syohyo-ho*: the Japanese Trademark Act No.127 of 1959, last amended by Act No.16 of 2008): hereafter known as the Japanese Trademark Act. A full text of an unofficial translation of this Act is to be found at <http://www.japaneselawtranslation.go.jp/law/detail/?printID=&ft=1&re=02&dn=1&co=01&x=48&y=1&ky=trademark+act&page=5&vm=02>. (Last accessed on 12 January 2010).

⁷ Please note that a detailed comparative analysis of how ‘trade mark’ is defined in the relevant international treaties (see Chapter 2, Section 2.3.1), the EU (Section 2.3.2) and the Japanese Act (see Section 2.3.3) is also undertaken. This comprises a small additional contribution made by this thesis.

- To explain the rationale for engaging in this particular comparative study of well-known trade marks within these two jurisdictions;
- To provide some basic background information on well-known trade marks;
- To set out some of the terminology⁸ used and the etymology relevant to an understanding of the Japanese system, and;
- To provide an account of the methodologies used and structure employed in this thesis.

1.2 Rationale

Choosing a general thesis topic was, for this author, relatively straightforward: a personal enthusiasm for the area of well-known trade marks and belief that this is an area of trade mark law of both policy⁹ and practical¹⁰ importance made topic selection relatively simple.

The choice of specific topic and hypothesis is, perhaps, less traditional. Consideration of confusion was chosen to be the focus of this thesis largely because this author finds this area – the protection of well-known trade marks¹¹ against confusion¹² – interesting. Also, this author submits, consideration of the protection of well-known trade marks against confusion is a more novel study than a consideration of the protection of such marks afforded by dilution-type provisions¹³. Aside from interest and novelty there are, it is submitted, three other arguments for considering the protection of well-known trade marks against confusion:

⁸ As noted in Section 1.4, in this thesis the author employs a number of Japanese transliterated terms, rather than the more commonly-used translated terms, e.g. ‘syohyo’ rather than ‘trademark’. These terms are introduced, and translation provided, where relevant in this thesis. However, recognising that not all readers will be familiar with these transliterated terms, please see List of Japanese Terms at ix.

⁹ See for example Chapter 5, Section 5.2.2 for the policy importance.

¹⁰ See for example *infra* note 26 for the practical importance of well-known and valuable trade marks.

¹¹ See Articles 8(5) and 9(1)(c) of the CTMR, and, Articles 4(1)(10) and (19) of the Japanese Trademark Act.

¹² See Articles 8(1)(b) and 9(1)(b) of the CTMR, and Article 4(1)(15) of the Japanese Trademark Act.

¹³ In the EU trade mark system, this would be Article 8(5) of the CTMR and in the Japanese trademark system the relevant provision would be Article 4(1)(19) of the Japanese Trademark Act. Dilution-style provisions offer protection for well-known trade marks against marks registered for *dissimilar* goods and services in some circumstances, whereas confusion extends protection for ordinary trade marks and well-known trade marks against marks registered for *similar* goods and services.

- (i) *Concept.* It is submitted that there is a conceptual argument to be made here – perhaps by considering well-known trade marks in the context of confusion (a doctrine equally applicable to ‘normal’ trade marks) we can learn more about how well-known trade marks are both different and similar to ‘normal’ trade marks. Whereas focusing on dilution-type doctrines, which only apply to well-known trade marks, would not be so revealing in this regard;
- (ii) *Practicality.* As noted in (i) above, confusion is a doctrine that is applicable both to well-known trade marks and to ‘normal’ trade marks: indeed, confusion in the CTM and Japanese jurisdictions considered in this thesis is the basis upon which well-known trade mark proprietors would base objections to identical or similar marks for identical or similar goods¹⁴. Dilution-type doctrines, which are so often the focus of well-known trade mark discourse¹⁵, in these jurisdictions only apply to disputes relating to dissimilar goods and services. As practicality dictates that at least some well-known trade mark disputes will concern identical or similar goods and services, it is sensible to study the rules applicable to such disputes – as is the case in this thesis, and;
- (iii) *Tradition.* As noted in (ii) above, much well-known trade mark discourse relates to dilution-type provisions. Yet, the first international reference to well-known trade marks (Article 6bis(1) of the Paris Convention) concerns the protection of well-known trade marks against confusion. The focus of this thesis is thus, arguably, quite traditional in nature.

Irrespective of the interest, novelty or other reasons for undertaking this research, the result is a thesis in which, for the relevant jurisdictions, considerable weight is given to conceptualising and analysing¹⁶ the definitions of the EU and Japanese concepts analogous to ‘well-known trade mark’, before engaging in a comparative analysis of the same. Slightly less emphasis (simply for reasons of time and word count) is

¹⁴ See *supra* note 8.

¹⁵ E.g. see Trimmer, B, ‘The Power of Attraction: Do Trade Marks Have an “Image” Problem in the English Courts?’ (2009) 31 *EIPR* 195-201; Senftleben, M, ‘The Trademark Tower of Babel - Dilution Concepts in International, US and EC Trademark Law’ (2009) 40 *IIC* 45-77; and Stephens, K, and Fuller, Z, ‘Trade Marks: ECJ Provides Guidance on What Constitutes Trade Mark Dilution in Europe’ (2008) 37 *CIPAJ* 730-732.

¹⁶ Both directly, by considering the primary and secondary literature on well-known trade marks, and indirectly (by considering some of the literature relating to the definition of ‘trade mark’).

placed on consideration of the extent to which such trade marks are protected against confusion in the CTM and Japanese trade mark systems, respectively. Nevertheless, although the emphasis in this thesis clearly lies on defining (international) EU and Japanese concepts of ‘well-known trade mark’, it is submitted that useful insights as to the nature and role of confusion (and the analogous Japanese concept) are also presented.

At this stage, it would be helpful to set out what is meant by the phrase ‘well-known trade mark’. One commentator has offered the following definition of a well-known trade mark: “...a mark which is widely known in the country concerned, to at least 50% of the potential purchasers of the goods or services...”¹⁷ This definition draws heavily on the WIPO Recommendation¹⁸, but does not (in the view of this author) capture all aspects of this Recommendation relevant to the definition of ‘well-known trade mark’. Therefore, this author proposes her own, fuller, definition of ‘well-known trade mark’:

‘A well-known trade mark is a mark which has acquired the highest level of distinctiveness through use. Whether a mark has obtained this high standard of acquired distinctiveness is to be determined in relation to a range of criteria including: the degree of knowledge or recognition of the mark in the relevant sector of the public¹⁹; the duration, extent and geographical area of any use of the mark²⁰, any promotion of the mark (advertising or publicity and presentation)²¹, any registration or trade mark applications²², and the record of successful enforcement of rights in the mark²³, and finally value of the mark²⁴,

¹⁷ See Tatham, D, ‘WIPO Resolution on Well Known Marks: A Small Step or a Giant Leap?’ (2000) 2 *IPQ* 127-137 at 128.

¹⁸ WIPO, Joint Recommendation Concerning Provisions on Protection of Well-known Marks. Publication 833(E). This Recommendation is important in the context of this thesis as it is one of the more recent and detailed international instruments relating to well-known trade mark and their protection, for further information on the Recommendation, please see Chapter 3, Section 3.2.4. The full text of the WIPO Recommendation is to be found at http://www.wipo.int/export/sites/www/about-ip/en/development_iplaw/pdf/pub833.pdf. (Last accessed on 12 January 2010).

¹⁹ Derived from Article 2(1)(b)(1) of the WIPO Recommendation.

²⁰ *Ibid*, derived from Article 2(1)(b)(2).

²¹ *Ibid*, derived from Article 2(1)(b)(3).

²² *Ibid*, derived from Article 2(1)(b)(4).

²³ *Ibid*, derived from Article 2(1)(b)(5).

²⁴ *Ibid*, derived from Article 2(1)(b)(6).

It should be noted that this definition contains a mixture of quite general criteria and more specific economic thresholds.

Having offered what this author believes to be a clear and workable definition of ‘well-known trade mark’, she would now like to clarify the distinction between ‘well-known trade mark’ and ‘famous mark’. This is despite the fact that the term ‘famous mark’ is not to be found in the legislative context relevant to this thesis (i.e. it is not used in the international, EU and Japanese legal instruments considered in this thesis). It is felt important to clarify what a famous mark is and how it relates to a well-known trade mark as at least one commentator²⁵ has recognised that these terms are sometimes (incorrectly) used interchangeably.

In the view of this author, the well-known/famous mark distinction is most clearly set out by Tatham, who has suggested the following definitions²⁶:

“...*A Famous Mark* is a mark which is *extremely* widely known in the country concerned, to at least *80%* of the potential purchasers of the goods or services for which it is known, and to at least *90%* of the relevant trade circles.

Furthermore, a *famous mark must be a registered mark* at least in its owner’s home territory and have a value calculated by an internationally accepted method, of at least *\$4000 million*”.

“...*A Well-Known Mark* is a mark which is widely known in the country concerned, to at least *50%* of the potential purchasers of the goods or services for which it is known, and to at least *60%* of the relevant trade circles.

Furthermore, a *well-known mark must be a registered mark* at least in its owner’s home territory and have a value calculated by an internationally accepted method, of at least *\$ 2000 million*”. [Emphasis added].

Thus, a famous mark can be seen²⁷ – in the German context at least – to be a sub-category of well-known trade mark²⁸. If this distinction is correct, then this author

²⁵ E.g. as argued by Tatham, *supra* note 13.

²⁶ *Ibid.*

²⁷ See Tatham, *supra* note 13. Thus, according to this commentator, the concept of well-known trade mark is a wider one than that of ‘famous mark’.

considers that it is a distinction that holds little conceptual import for this particular thesis (given that, here, the definition of a famous mark is simply a matter of degree – in essence – a *very* well-known trade mark). Given the facts that (i) the well-known/famous terminology is sometimes confused by commentators and that (ii) the term ‘famous mark’ is not employed in the relevant international, EU or Japanese laws, this author has chosen not to use the term ‘famous mark’, and instead uses the term ‘well-known trade mark’.

At this point, having addressed one point of terminological confusion, it should be noted that there are other areas where terminology can be confusing within the topic of this thesis. For that reason, key terms employed in this thesis are further explained in Section 1.4 below. However, one further area of terminological confusion will be noted here: simply put, the term ‘well-known trade mark’ is not used in the EU or Japanese trade mark systems; instead the terms ‘mark of repute’ and ‘*syuchi-syohyo*’, respectively, are used and are generally seen as being synonymous with ‘well-known trade mark’²⁹. The significance of this will be explored later in this thesis: indeed, one of the intentions of this author in this thesis is to consider whether the EU concept of ‘trade mark of repute’ and the Japanese concept of ‘*syuchi-syohyo*’ are indeed synonymous with the concept of ‘well-known trade mark’.

Nevertheless, despite the terminological uncertainties, this author continues to believe that not only are well-known trade marks of economic importance³⁰, but that the regulation of well-known trade marks has conceptual import for trade mark regulation

²⁸ If correct, this would result in a trade mark taxonomy (from the most general to the most distinctive), of ‘Trade Mark → Well-Known Trade Mark → Famous Mark’.

²⁹ For example, see Article 8(2)(c) of the CTMR, and see Tatham, *supra* note 13 at 128; and Japanese Patent Office (JPO) ‘Examination Guidelines for Trademarks (hereafter the JPO Guidelines)’, Item 9, Chapter 3: Article 4 (1)(3), Part 13: Article 4(1)(15). (see http://www.jpo.go.jp/quick_e/index_sh.htm. (Last accessed on 12 January 2010)). A full text of the JPO Guidelines is to be found at http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/tt1302-002.htm. (Last accessed on 12 January 2010).

³⁰ A number of commentators, for example, Mostert (Mostert, F, W, ‘The Parasitic Use of the Commercial Magnetism of a Trade Mark on Non-Competing Goods’ (1986) 8 *EIPR* 342-348 at 342) recognise that the word mark ‘COCA-COLA’ is a well-known trade mark. Using this example, the brand value of ‘COCA COLA’ has an estimated value of \$ 66,667 million according to the Interbrand Best Global Brand Ranking 2008. *Infra* notes 127 and 532. The full text of this report is to be found at http://www.interbrand.com/best_global_brands.aspx?year=2008&langid=1000. (Last accessed on 12 January 2010). Please note that a critical consideration of the Interbrand Survey is beyond the scope of this thesis.

in general³¹. These beliefs, although tested throughout the process of researching and writing this thesis, remain fundamentally unchanged. What *has* changed over this period is this author's ideas as to *how* well-known trade marks should be regulated – at not only regional (EU) and national (Japan) levels, but also at the international level: this author has been persuaded that the detailed regulation and practice of well-known trade mark protection is and should remain at the local (i.e. national and, where relevant, regional)³² level, rather than the international level³³, but that reform and some harmonisation of the regulation of well-known trade marks would be beneficial³⁴. In particular, this author has been persuaded that there is an argument for the introduction, at the international level, of an accepted, authoritative, clear and comprehensive definition of what constitutes a well-known trade mark³⁵, and, furthermore, that this definition could provide the foundation for the evolution of a more harmonised approach to protection of well-known marks at the local level³⁶.

In this thesis, this author has attempted not only to describe and critically analyse, but to *conceptualise* what the international trade mark regime (incompletely) currently sets out as constituting a well-known trade mark, with the same process being undertaken for the analogous EU and Japanese concepts: the CTM mark of repute³⁷ and the Japanese *syuchi-syohyo*³⁸. Although this author would have liked to undertake a wide-ranging analysis of the extent of well-known trade mark protection, this would have resulted in a thesis in which all aspects of trade mark registration and infringement were considered, and this was simply not a task that could have been undertaken in the appropriate depth whilst utilising a comparative legal approach. Therefore, in order to produce a comparative law thesis of appropriate depth this author has instead elected to research and study a narrower topic, focusing on, and

³¹ Two features of local (national and/or regional) protection of well-known trade marks illustrates, in the view of this author, the conceptual importance of the well-known trade mark. Firstly, although it is usual for trade mark protection to be afforded only after registration, well-known trade marks benefit from protection even when they are not registered. Secondly, when registered, well-known trade marks often benefit from further protection. See Articles 8(5) and 9(1)(c) of the CTMR, and Articles 4(1)(10) and (19) of the Japanese Trademark Act.

³² In fact, there are a variety of ways of expressing 'well-known trade mark'; for instance, the Japanese term of 'well-known trade mark' is *syuchi-syohyo*.

³³ See Chapter 6, Sections 6.2.2, 6.3, and Chapter 7.

³⁴ See Chapter 7.

³⁵ *Ibid.*

³⁶ *Ibid.*

³⁷ See Chapter 4, Sections 4.3 and 4.4.

³⁸ See Chapter 5, Sections 5.3 and 5.4.

comparing, the extent to which marks of repute and *syuchi-syohyo* are protected against, respectively, confusion and *kondo* (see Section 1.4 for an explanation of these terms).

The structure of this thesis can be set out as follows. In this, Chapter 1, background information and the thesis rationale, methodology and structure are presented. In Chapter 2 the definition of ‘trade mark’, as background for the later analysis of the definition of ‘well-known trade mark’, is critically considered. Then, definitions of ‘well-known trade mark’ at the international level are critiqued in Chapter 3. A critical analysis of the following is then undertaken: (i) the definition of ‘mark of repute’ in the CTM system, and the protection afforded to marks of repute against confusion in the CTM system in Chapter 4 and (ii) the definition of ‘*syuchi-syohyo*’ in the Japanese Trademark Act, and the protection afforded to *syuchi-syohyo* against *kondo* in the Japanese Trademark Act in Chapter 5. Thereafter, a critical comparison of the findings within Chapters 4 and 5 is undertaken in Chapter 6, before the concluding chapter, in which some recommendations for reform will be made (Chapter 7).

Further information on the content of this thesis can be found in Section 1.7 below. Now, some basic background information on the international regime relating to well-known marks is provided, specifically a brief historical account of the treatment of well-known trade marks, with emphasis of the modern regulation of such *via* the Trademark Law Treaty (the TLT)³⁹ and the Singapore Treaty on the Law of Trademarks (the Singapore Treaty)⁴⁰.

1.3 Well-known Trade Marks: Background

The hypothesis set out in this thesis is that the protection of well-known trade marks in the EU and Japan against likelihood of confusion and *kondo* (respectively) is uncertain. In order to test this hypothesis, this author believes that it is helpful to begin with a brief treatment of the historical development of well-known trade mark protection.

³⁹ For further analysis see Chapter 2, Section 2.3.1.2.

⁴⁰ For further analysis see Chapter 2, Section 2.3.1.3.

An international legal framework of well-known trade mark protection is widely acknowledged⁴¹ to have developed gradually. The first stage, and starting point, was probably discussions among member states of the Paris Convention (the Paris Convention for the Protection of Industrial Property 1883)⁴² during the 1920s as to the need for well-known trade mark protection, soon after which Article 6bis was introduced into the Paris Convention at the Hague conference in 1925⁴³. Article 6bis itself required that well-known trade marks, irrespective of whether they were registered as national trade marks, be protected by member states of the Convention. As a result, national laws were amended⁴⁴. As will be seen in the critical analysis of this provision in Chapter 3, Article 6bis has a limited application: affording protection to well-known trade mark only for unauthorised third-party use in relation to similar goods.

The second stage in international developments in relation to well-known trade mark protection can be seen as the introduction of Articles 16(1) and (2) GATT TRIPS (the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994)⁴⁵. Although more thoroughly critiqued in Chapter 3, it can be noted here that Articles 16(1) and (2) collectively provide some guidance as to when a mark is ‘well-known’

⁴¹ See for example, Maniatis, S, *Trade Marks in Europe: A Practical Jurisprudence* (London, Sweet & Maxwell, 2009); Tritton, G, *Intellectual Property in Europe* (London, Sweet & Maxwell, 2007) and Phillips, J, *Trade Mark Law: A Practical Anatomy* (Oxford, Oxford University Press, 2003), WIPO, *Introduction to Intellectual Property: Theory and Practice* (London, Kluwer Law International, 1997), Cornish, W, and Llewelyn, D, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (London, Sweet & Maxwell, 2007).

⁴² The Paris Convention for the Protection of Industrial Property (of March 20, 1883). A full text of the Paris Convention is to be found at http://www.wipo.int/export/sites/www/treaties/en/ip/paris/pdf/trtdocs_wo020.pdf. (Last accessed on 12 January 2010).

⁴³ See JPO *Protection of Well-Known and Famous Trademarks* Japan Patent Office Asia-Pacific Industrial Property Center, JIII, 1999). A full text of this is to be found at <http://www.ircc.iitb.ac.in/IPcourse/Dr.%20Ganguli%20IP%20Course/additional%20docs/2-08.pdf>. (Last accessed on 18 January 2010).

⁴⁴ In fact, Japanese Trademark Act was initially amended on this point in advance of this international change. In 1921, Section 2(1)(8) of the *Taisyo 10nen Syohyo ho* (the Trademark Act of 1921) introduced protection for unregistered well-known trade marks in Japan (Section 2(1)(5) of unregistered well-known mark protection). The Japanese trademark regime was then further amended in accordance with the Paris Convention in 1934 (by Act No. 15 of 1934). Please note that current protection of well-known trade marks in Japan is to be found in Article 4(1)(10) of the current law (Act No. 16 of 2008) and this section was itself introduced by an amendment in 1991 (Act No. 65 of 1991).

⁴⁵ See Chapter 2, Section 2.3.1.4, and Chapter 3, Section 3.2.2.

and extend Art6bis to service marks, and, in some circumstances, to unauthorised third-party use in relation to dissimilar goods and services.

Although the first meeting relating to the establishment of what became GATT TRIPS is known to have taken place in March 1987, with TRIPS finally coming into force in 1995 (see Chapter 2, Section 2.3.1.4, and Chapter 3, Section 3.3.2), this author finds it interesting that there was not the perceived need (or opportunity) for the international community to revisit the issue of well-known trade marks for over 60 years.

The third and, to date, final stage in international developments in relation to well-known trade mark protection followed much more quickly: the WIPO Recommendation (the WIPO Joint Recommendation concerning Provisions on the Protection of Well-Known Marks)⁴⁶. Again, a fuller critique of this non-binding instrument can be found in Chapter 3, but it suffices to note here that the WIPO Recommendation sets out common principles and rules to assess the extent to which marks are ‘well-known’.

This author submits that she evidences in Chapter 3 that this international regime of well-known trade mark protection was developed without establishing a clear and comprehensive definition of ‘well-known trade mark’. In fact it should be emphasised that ‘well-known trade mark’ is *not* comprehensively (or, it is also submitted, conceptually) defined at the international level in, respectively, the primary literature⁴⁷ or the pertinent secondary literature⁴⁸. This author considers that this constitutes a deficiency in both the primary and secondary literature of well-known trade marks. The author speculates that this deficiency may be one causal factor in the legal uncertainty at the national (in this thesis – Japan) and the regional (in this thesis – the CTM) regulation of well-known trade marks. Nevertheless, it should be emphasised that the ambit of this thesis is limited to critical analysis and comparison of the definitions and protection against confusion and *kondo*⁴⁹ provided for well-known trade marks in the CTM and Japanese systems, it is not a consideration of the full scope of well-known trade marks.

⁴⁶ The WIPO Joint Recommendation concerning Provisions on the Protection of Well-Known Marks. Doc. 833(E). See *supra* note 14, Chapter 3, Section 3.2.4 for the WIPO Recommendation.

⁴⁷ This key point will be evaluated in Chapters 3, 4, and 5.

⁴⁸ See, e.g. Mostert, F, W, *Famous and Well-known Marks: An International Analysis* (London, Butterworths, 1997).

⁴⁹ See Chapter 5, Section 5.4.

It is understood that a clear theme within both the primary⁵⁰ and the secondary⁵¹ literature on well-known trade marks is that the nexus of protection of such marks is local⁵² and is necessarily somewhat fluid⁵³ in nature. As the previous paragraph implies, this author does personally believe that uncertainty in well-known trade mark protection *may* be problematic, but critical consideration of the merits or otherwise of uncertainty (or, if preferred – flexibility) in well-known trade mark protection is a matter that is beyond the scope of this thesis.

At this point, a brief account of the historical evolution of international trade mark regulation of well-known trade marks is set out (please note that in Chapters 2 and 3 a fuller treatment of the relevant international regime is to be found).

Article 6bis of the Paris Convention⁵⁴ is known as the first international treaty, established in 1889, which urged the signatory nations to set up an infrastructure to promote protection of well-known trade marks⁵⁵. The trade mark provisions of the Paris Convention are based on a set of principles that were intended to secure and protect trade mark rights in international trade⁵⁶ and to offer a certain basis for the future development and evolution of international trade mark law⁵⁷. Although as will be seen in the EU (Chapter 4) and Japan (Chapter 5), this international incentive to

⁵⁰ For example, whilst the Paris Convention, which introduced the principle of the well-known trade mark to the international IP regime (Article 1 of the Paris Convention), offers some principles relating to the special protection of well-known trade marks (see Article 6bis of the Paris Convention) it does not specify any measures for such protection. This is a recurrent theme in the international regulation of well-known trade marks: it is left for the individual signatory states to these various international agreements to develop their own measures to protect well-known trade marks.

⁵¹ See, for example, Mostert, *supra* note 47; Tatham, *supra* note 13; Kur, A, ‘Well-Known Marks, Highly Renowned Marks, and Marks Having a (High) Reputation – What’s It All About?’ (1992) 23 *IIC* 218-231; Kur, A, ‘The WIPO Recommendations for the Protection of Well-Known Marks’ (2000) 31 *IIC* 824-845; Bertrand, A, R, ‘French Trade Mark Law: From the Well-Known Brand to the Famous Brand’ (1993) 15 *EIPR* 142-145; Grinberg, M, ‘The WIPO Joint Recommendation Protecting Well-Known Marks and the Forgotten Goodwill’ (2005) 5 *Chi.-Kent J. Intell. Prop* 1-11.

⁵² See for example, Article 2(1) of the Paris Convention.

⁵³ One leading expert, Mostert, clearly stated in his article that “the recognition and protection of well-known trade marks differ from country to country: the definitions and criteria in this area of trade mark law remain elusive.” See Mostert, F, W, ‘When is a Mark “Well-Known”?’ (1997) 3 *IPQ* 377-383 at 377.

⁵⁴ See Chapter 2, Section 2.3.1.1, and *supra* note 37.

⁵⁵ For example, Phillips, J, *Trade Marks at the Limit* (London, Edward Elgar Publishing, 2006) at 3.

⁵⁶ The Paris Convention requires signatory nations to implement the following: principle of territoriality (Articles 4, 4bis of the Paris Convention), the national treatment principle, the principle of independence of rights (Articles 4bis and 6 of the Paris Convention) and the *telle-quelle* principle (Article 6*quinquies* A(1) of the Paris Convention).

⁵⁷ Phillips, J, *supra* note 51.

provide legal protection of well-known trade marks seems to create each jurisdiction's own interpretation of the laws⁵⁸, thus the specifics of 'well-known trade mark' protection differs at the local level. The fundamental part of well-known trade mark protection, which is provided by the protection by Article *6bis* of the Paris Convention⁵⁹, was consolidated by the later Article 15 of GATT TRIPS⁶⁰.

It is submitted that GATT TRIPS represents a further evolution of well-known trade mark protection. Firstly, it here that service trade marks are specifically recognised as a form of well-known trade marks (Article 16(2) of GATT TRIPS). Secondly, there is further guidance provided, in the form of a knowledge requirement, for the assessment as to whether a particular mark is well-known or not (Article 16(3) of GATT TRIPS). Thirdly, GATT TRIPS further extends the protection of registered well-known trade marks to goods or services which are not similar to those in respect of which the trademark has been registered, provided that its use would indicate a connection between those goods or services and the owner of the registered trade mark, and the interests of the owner are likely to be damaged by such use (Articles 16(2)(3) of GATT TRIPS).

However, it should be noted here that despite the introduction of these principles relating to the protection of well-known trade marks within these two international treaties⁶¹, there is no reference to how such marks should be protected at the local level and, it is submitted, there is also not a clear and comprehensive definition of 'well-known trade mark' at the international level⁶².

Some of the clarity lacking in the Paris Convention and GATT TRIPS is to be found in the WIPO Recommendation, which does include reference to assessment as to

⁵⁸ See Articles 8(5) and 9(1)(c) of the CTMR, and Articles 4(1)(10) and (19) of the Japanese Trademark Act.

⁵⁹ See the full text of Article *6bis* of the Paris Convention, Chapter 2, Section 2.3.1.1

⁶⁰ See Chapter 2, Section 2.3.1.4, and Chapter 3, Section 3.2.2.

⁶¹ See Article *6bis* of the Paris Convention and Article 15(1) of GATT TRIPS.

⁶² For the author's reasoning here, see Chapter 3, Section 3.2.1 for the Paris Convention, and Chapter 3, Section 3.2.2 for GATT TRIPS.

whether a mark is well-known or not⁶³, but the WIPO Recommendation is not legally binding⁶⁴.

Nevertheless, as noted earlier, there is a strong school of thought that uncertainty (or at least fluidity) in the definition and regulation of well-known trade marks is somehow beneficial (or, at the very least, unproblematic). One legal scholar on defining ‘well-known trade mark’ has observed that:

“...we do not know; but we know when we see it”⁶⁵

In addition, one of the leading commentators on well-known trade marks is of the view that:

“...well-known trade mark protection is not a matter of law; it is a matter of fact”⁶⁶.

Thus it could be said that the international development of well-known trade mark regulation has, thus far, been consistent with this school of thought (i.e. that the test for ‘well-known trade mark’ is a factual one, and well-known trade mark status is to be determined on a case-by-case basis⁶⁷). This author does not refute this position, but does query the degree of legal certainty it provides.

So far in this Section, the author has provided some background on the development of the international regime relating to the regulation of well-known trade marks. Now the author will briefly outline why she believes that this is an important topic and why the question of certainty as to the protection of well-known trade marks should be revisited.

⁶³ See Chapter 3, Section 3.2.4.

⁶⁴ It is stated that “...recommended that each Member State may consider the use of any of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)...as guidelines for the protection for well-known marks...” See WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks (SCT/3/8 Annex) at 3. Also, see Phillips, *supra* note 37 at 413 explains that “At present these recommendations are not enforceable propositions of law.”

⁶⁵ Tatham, *supra* note 13.

⁶⁶ See Mostert, F, W, ‘Well-Known and Famous Marks: Is Harmony Possible in the Global Village?’(1996) 86 *TMR* 103-141.

⁶⁷ Indeed, this is very much the position set out in Article 2(1)(c) of the WIPO Recommendation.

It is submitted that the regulation of well-known trade mark protection has gradually gained in import at the international level since Article 6bis of the Paris Convention was introduced in 1925, culminating in the WIPO Recommendation in 1999. Yet, since the Recommendation⁶⁸, it is submitted that there have been no further significant international developments relating to well-known trade mark protection. This appears inconsistent to this author as it has been suggested that the rationale for the Recommendation was that well-known trade mark holders had been the victims of counterfeiting⁶⁹, and had suffered loss as a result of the inappropriate use and protection of well-known trade marks⁷⁰. Nevertheless, since the WIPO Recommendation was adopted in 1999, technology that can be used to exploit such marks⁷¹ has advanced⁷², and thus, this author submits that the technological environment in which (well-known) trade marks exist has changed since 1999⁷³, and will continue to do so. Further, it is submitted, consumers are increasingly becoming similar⁷⁴, and as both the consumer and technological environment for (well-known) trade marks changes, it is submitted that there may be a need to revisit the protection of such marks at the international and local levels.

1.4 Terminology

As noted above, there are some terminological confusions relating to the use of the term ‘well-known trade mark’. Given this, and the fact that the author is engaging in

⁶⁸ The WIPO Recommendation was adopted by the thirty-fourth series of meetings of the Assemblies of the Member States of WIPO in September 20 to 29, 1999.

⁶⁹ More detailed analysis will be provided in Chapter 5, Section 5.2.3, and *infra* note 935. See for example, Wadlow, C, “Including Trade in Counterfeit Goods”: The Origin of TRIPS as A GATT Anti-Counterfeiting Code’ (2007) 3 *IPQ* 350-402.

⁷⁰ Mostert, F, W, *supra* note 62.

⁷¹ Phillips, J, ‘Information Overload and IP Practice’ (2009) 4 *JIPLP* 301.

⁷² For example, methods of communication have drastically changed in recent times with the mass use of social networking web sites, for example ‘FACEBOOK’ (see Sanghera, S, ‘Facebook v Facetime: So What do you do?’ Times 23 August 2007). FACEBOOK is said to have more than 68 million active worldwide users (see, the statistics available at <http://www.facebook.com/press/info.php?statistics>. (Last accessed on 12 January 2010)). As this and other social networking sites can be a forum for both the marketing and abuse of well-known trade marks (see Bond, R, ‘Business Trends in Virtual Worlds and Social Networks – An Overview of the Legal and Regulatory Issues Relating to Intellectual Property and Money Transactions’ (2009) 20 *Ent LR* 121-128), this relatively new medium of mass communication does pose some challenge to well-known trade mark protection.

⁷³ See Maniatis, S, *The Communicative Aspects of Trade Marks: A Legal, Functional and Economic Analysis* (University of London, 1998) at 165.

⁷⁴ *Ibid.*

a comparative study, which necessitates knowledge of certain Japanese trademark terms, it seems appropriate that a fuller explanation of the terminology employed in this thesis be provided. That is the purpose of this Section.

The spelling ‘trade mark’ is used throughout this thesis to refer to trade marks in the EU and international contexts, and also when referring to this area in a generic sense. Hereafter, the equivalent transliterated Japanese term, *syohyo* (商標: the usual English translation of which is ‘trademark’), will be used when referring to trade marks in the Japanese context. Please note that Article 4 of the CTMR⁷⁵ and Article 2 of the Japanese Trademark Act⁷⁶ provide the legal definitions of ‘trade mark’ and ‘*syohyo*’, respectively.

Similarly, the term ‘well-known trade mark’ is used in the generic and international contexts, but not in the EU context: here the equivalent EU term ‘trade mark of repute’ is used. The equivalent transliterated Japanese term is ‘*syuchi-syohyo*’ (周知商標: the usual English translation of which is well-known trademark) and it is this Japanese transliteration – *syuchi-syohyo* – that will be used when referring to well-known trade marks in the Japanese context.

When the EU CTM is considered, the terms ‘confusion’ and ‘likelihood of confusion’ are employed, and the same spellings are used when these concepts are noted in a generic context. The equivalent transliterated Japanese terms are ‘*kondo*’ (混同: usually translated as ‘confusion’) and ‘*kondo no osore*’ (混同のおそれ: usually translated as ‘a likelihood of confusion’). *Kondo* and *kondo no osore* will be the terms used in the Japanese context.

The reader will note that this author has preferred to use Japanese transliterations, rather than translations, of key terms. These Japanese transliterations have been employed by the author as a means of ensuring a consistent approach to Japanese law.

⁷⁵ Article 4 of the CTMR can be paraphrased as follows: trade marks are any graphically-representable signs being capable of distinguishing goods and services of one undertaking from those of another undertaking.

⁷⁶ Article 2 of the Japanese Trademark Act can be paraphrased as follows: *syohyo* includes any characters, signs, three-dimensional marks or combinations of colours which are used for business purposes.

This consistency, it is submitted, lies in two aspects, richness and accuracy: first a transliteration preserves more effectively the etymology, and thus the richness of the implicit meaning(s) of Japanese terms to a non-Japanese speaker (here, please see Section 1.5 below) and second, translation has a greater potential for introducing inaccuracy. Relating to this point on accuracy, it is submitted by this author (and further argued in Chapter 2, Section 2.3.3 that the official (non-authoritative) English translation of the Japanese Trademark Act is inaccurate in parts. In short, this author believes that the practice employed in this thesis of referring to original Japanese phrases in a transliterated form avoids perpetuating mistranslations and inaccuracies, and appears to be the most effective linguistic basis for undertaking a comparative legal analysis in the English language.

1.5 Japanese Etymology

This is a legal, not a linguistic, thesis but as the reader is unlikely to be a fluent Japanese speaker, a note should be made of the importance of Japanese etymology in the sense of the implicit information to be found within Japanese terms, most explicitly within written Japanese. This is important in general because a failure to understand this is a considerable barrier to the non-Japanese speaker's ability to comprehend the meaning of Japanese law⁷⁷, and specifically because these linguistic niceties later play a role in this author's critical analysis of 'yoyo', 'syuchi-syohyo', 'kondo' and 'kondo no osore'.

Perhaps it would be helpful to explain the nature of Japanese writing a little more at this stage. There are three separate writing scripts in modern Japanese. These scripts may be combined, indeed a single Japanese sentence might be written utilising all three scripts. Of these three, *Hira-kana* and *Kata-kana* are alphabet-based (*Hira-kana* is used for native words and *Kata-kana* for words borrowed from other languages): in essence, these two scripts convey sounds to the reader. In contrast, the symbolic *Kanji* script conveys both concepts and implicit meanings, and it is the consideration of key *Kanji* symbols that forms part of the analysis of Japanese law in this thesis.

⁷⁷ The explanation that follows is an expanded version of material originally developed by the author, in collaboration with Caroline Wilson, for the purposes of teaching on the University of Southampton module LLM Comparative Intellectual Property Law.

The difficulties faced by the non-Japanese reader in relation to *Kanji* and English translations of *Kanji*, and the advantage of employing transliterated rather than translated Japanese terms can be illustrated by a simple non-legal example. The term ‘work’ in Japanese is represented by the *Kanji* symbol 仕事⁷⁸. This symbol combines two symbolic elements, the first – 仕 (*shi*) – meaning loyalty and the second – 事 (*goto*) – meaning matters and/or business. Thus 仕事 may be translated as ‘work’, but it also has an implicit meaning relating to professional allegiance, as well as this straightforward English translation: it is this implicit meaning which is obvious to a Japanese reader, but is missing in English translation. Thus, utilising the transliteration *shi goto*, rather than the translation ‘work’, would both preserve (once it was explained) to the non-Japanese speaker the implicit richness of the Japanese *Kanji* symbol, and would be more accurate than the English translation.

Similar linguistic niceties are highlighted, where relevant, in this thesis, see for example Chapter 2, Section 2.2.3.

1.6 Methodology and Jurisdictions

1.6.1 Methodology

The methodology employed in this thesis is mainly that of straightforward comparative legal analysis. The methods employed are based on functionality⁷⁹, and begin with the posing of a *working hypothesis*⁸⁰, then the testing of the utility and practicability of this hypothesis against the results of the legal analysis and comparison undertaken⁸¹. The hypothesis posed in this thesis is that well-known trade mark protection against confusion is uncertain. The author has attempted to state and critically analyse the law as at June 18, 2009. For methodological purposes,

⁷⁸ For completeness, it should be noted that *Hira-kana* or *Kata-kana* can also be used to convey how a *Kanji* symbol should be pronounced – in relation to the *Kanji* symbol for ‘work’, *Hira-kana* [しごと] would be employed.

⁷⁹ See Zweigert, K, and Kötz, H, *An Introduction to Comparative Law* (Oxford, Clarendon Press, 1998) at 31. See further, Hoechke, M, *Epistemology and Methodology of Comparative Law* (Oxford, Hart Publishing, 2004) at 39.

⁸⁰ *Ibid*, Zweigert, K, and Kötz, H, at 30-31.

⁸¹ *Ibid* at 29.

it should be noted at this stage that in relation to this hypothesis, the author has made a number of assumptions, and these are set out in Section 1.7, below.

To aid the background analysis undertaken before the author undertakes her critical comparison of the protection of marks of repute and *syuchi-syohyo* against, respectively, likelihood of confusion and *kondo no osore*, the author has developed a conceptual model of what constitutes a well-known trade mark (the Definition Model⁸²), and employs this Model in the analysis and comparison of definitions of ‘well-known trade mark’. This theoretical work forms part of the methodology of this thesis.

In terms of the legal analysis undertaken, statutory and treaty interpretation is employed as the basic method. Key provisions within the following instruments are analysed and compared: the Paris Convention, GATT TRIPS and additionally, the WIPO Recommendation; the regional regulation (the Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, hereafter known as the CTMR) and the national law of Japan (the Japanese Trademark Act: Act No. 127 of 1959). In relation to the Japanese law, some etymological analysis is employed as an aid to statutory interpretation.

1.6.2 Jurisdictions

The jurisdictional scope of this thesis was also established relatively early on in the research process: as a Japanese native who has studied Law both in Japan and within the EU, a critical comparison of the EU and Japanese trade mark systems was a logical choice. It is also, in the view of this author, a useful (and relatively novel) choice for two reasons. First, there is relatively little secondary material in English on the Japanese trade mark system, and certain aspects of the (unofficial) translation of the Japanese Trademark Act, (商標法: *syohyo ho*⁸³) are misleading, if not inaccurate⁸⁴.

⁸² See Chapter 2, Section 2.2.

⁸³ The Japanese Trademark Act, Act No.127 of 1959 last amended by Act No.16 of 2008.

⁸⁴ As will be discussed in Chapter 2, Section 2.3.3. For example, the concept of distinctiveness is implicit in the *kanji* symbols for ‘trademark’, *syohyo* (商標) in Japan; however, this implicit meaning is not reflected in the unofficial English translation of the Japanese Trademark Act. In undertaking this

Second, this author believes that useful comparisons can be made between the Japanese and EU systems in relation to well-known trade marks, particularly in comparing Article 2 of the Japanese Trademark Act with Article 4 of the CTMR⁸⁵, and, Article 5(1)(10) of the Japanese Trademark Act with Articles 8(1)(c), 8(5), 9(1)(b) of the CTMR⁸⁶.

This author is fully aware that American⁸⁷ dilution theory⁸⁸ has had a great impact on the development of well-known trade mark protection⁸⁹. This is unsurprising as dilution is clearly very important to well-known trade marks, and the dilution doctrine can provide a vital way of protecting such trade marks⁹⁰. As a result, there has been significant analysis, resulting in a considerable literature, of dilution, particularly in the US⁹¹. Although the notion of 'dilution' has gained some recognition under both the EU⁹² and Japanese⁹³ trade mark regimes, as the focus of this thesis is on protection of well-known trade marks against confusion, not dilution, this author feels that it is justifiable that she is not considering the US as part of her thesis.

thesis, the author has had the opportunity to address such issues of etymology, thus making a modest contribution to a better understanding, by non-Japanese speakers, of the Japanese Trademark Act.

⁸⁵ See Chapter 2, Section 2.3.2.

⁸⁶ See Chapter 4, Section 4.3.

⁸⁷ Federal Trademark Dilution Act is codified at 15 USC § 1125 (c) (United States Code Subchapter III § 1125). More recently, The Trademark Dilution Revision Act of 2006 came into force in October 2006.

⁸⁸ This theory has been discussed in detail by commentators from Frank Schechter onwards (Schechter can be said to have been a founding father of dilution theory in his famous illustration of the Belgian 'Odol' case, see Schechter, F, I, 'The Rational Basis of Trademark Protection' (1927) 40 *Harv. L. Rev.* 813-833 at 831-833). Further, dilution has been a long-standing part of US law, the current provisions, following the Federal Trademark Dilution Act, being codified at 15 USC § 1125 (c)(1).

⁸⁹ See for example, Simon, I, 'Dilutive Trade Mark Applications: Trading on Reputation or Just Playing Games?' (2004) 26 *EIPR* 67-74.

⁹⁰ For example, in the US see 15 USC § 1125 (a) and (c). Further, the concept of dilution is quite broad in this jurisdiction: 15 USC § 1125 (c) provides that dilution can occur by 'blurring' and 'tarnishment' as follows: 'dilution by blurring' is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark; and 'dilution by tarnishment' is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.

⁹¹ It should be stressed that the concept of dilution, and thus dilution literature, is beyond the scope of this thesis, although it should also be noted that a considerable volume of US legal literature with relation to dilution can be found. For example, see Schechter, F, I, *supra* note 84; McCarthy, T, J, 'Dilution of a Trademark: European and United States Law Compared' (2004) 94 *TMR* 1163-1181; Pattishall, B, W, 'The Dilution Rationale for Trademark- Trade Identity Protection, its Progress and Prospects' (1997) 67 *TMR* 607-624.; Burstein, S, L, 'Dilution by Tarnishment: the New Cause of Action' (2008) 98 *TMR* 1189-1252; Dinwoodie, G, B, and Janis, M, D, 'Confusion over Use: Contextualism in Trademark Law' (2008) 98 *TMR* 1086-1159. Outside US law, examples of dilution literature include Martino, T, *Trademark Dilution* (Oxford, Clarendon Press, 1996).

⁹² See Chapter 4, Section 4.3. Examples of EU dilution literature include Simon, I, *supra* note 85 and Trimmer, B, *supra* note 11.

⁹³ See Chapter 5, Section 5.3. Examples of Japanese dilution literature include Tamai, K, 'Freeride and Dilution' (1993) 1018 *Jurist* 37-45.

Therefore, in terms of *topic*, excluding the US from the jurisdictional scope of this thesis is justifiable. However, this author does not wish to ignore the influential US nexus entirely. Therefore, at this point some basic background on the US position is provided in Section 1.6.2.1 below.

1.6.2.1 The United States

As has been made clear above, the focus of this thesis is on EU (the CTM system) and Japanese trade mark law pertaining to the protection of well-known marks against confusion and *kondo*, the equivalent Japanese doctrine. However, it is difficult to speak of well-known and/or famous trade mark protection without any reference to the concept of dilution⁹⁴ and, in particular, reference to US dilution doctrine⁹⁵. Hence, the purpose here is to briefly set out the scope and import of US dilution doctrine as an adjunct to (rather than part of) the purpose of this thesis.

Dilution theory itself has been discussed in detail by commentators from Frank Schechter onwards. Indeed, Schechter himself can be said to have been a founding father of dilution theory, following his famous illustration of the Belgian ‘*Odol*’ case⁹⁶. Schechter defined dilution as

“...whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non competing goods. The more distinctive or unique the mark, the deeper is its impress upon the public consciousness, and the greater its need for protection...”⁹⁷

Current US law states that “...the owner of a *famous mark* that is *distinctive, inherently or through acquired distinctiveness*, shall be entitled to an injunction

⁹⁴ For example, see the focus on dilution in Simon, I, ‘The Actual Dilution Requirement in the United States, United Kingdom and European Union: A Comparative Analysis’ (2006) 12 *BUJ Sci & Tech L* 271-309 at 274-27 and Martino, T, ‘Trade Mark Dilution: I Hear You Knocking but You Can’t Come in: *Mead Data Central v Toyota*’ (1990) 12 *EIPR* 141-145.

⁹⁵ Dilution has been a long-standing part of US law, the current provisions, following the Federal Trademark Dilution Act, being codified at 15 USC § 1125 (c)(1).

⁹⁶ See Schechter, F, I, *supra* note 84 at 831-833.

⁹⁷ *Ibid* at 825.

against...*dilution by blurring* or *dilution by tarnishment* of the famous mark...⁹⁸ a possession of outstanding distinctiveness makes ordinary trademarks⁹⁹ famous.”

The Statute provides the following criteria:

“In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to –

- (A) the degree of inherent to acquired distinctiveness of the marks;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in trading areas and channels of trade used by the mark’s owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties...”¹⁰⁰

When a ordinary mark acquire a status of being famous by satisfying the criteria above, the proprietor of the mark is entitled to an injunction against used that ‘causes dilution of the distinctive quality of the mark’¹⁰¹.

Although US law refers to ‘famous’ rather than ‘well-known’ trade marks, it is clear that the status of ‘famous trade mark’ – distinctiveness - is *acquired* through use¹⁰², with the demonstration of acquired distinctiveness supporting a broader scope of protection for the mark: extending to protection from non-competing goods¹⁰³. The concept of a famous mark is also notable, as the definition and non-exclusive criteria provided in the Lamham Act seems to have concerned some legal commentators, for

⁹⁸ See §1125 c (1) of USC.

⁹⁹ The term ‘trademark’ (one word) is applied when the US is discussed.

¹⁰⁰ Section 43(1)(c) of the Lanham Act.

¹⁰¹ *Ibid* Section 43(1)(c) of the Lanham Act, and see Simon, I, *supra* note 85 at 67.

¹⁰² It is traditionally understood that goodwill attached to trade mark can be created only by repeated transactions, however it was suggested that goodwill might be actively created through marketing”. See Wilf, S, ‘Who Authors Trademarks?’ (1999) 17 *Cardozo Arts & Ent.L.J* 1-46 at 17.

¹⁰³ See Mostert, F, *supra* note 49 at 379.

example over the dearth of any conceptual definition of what is ‘fame’¹⁰⁴, although it has been observed that a trade mark cannot be famous unless it is distinctive and it has been argued that distinctiveness is synonymous with fame for the purpose of the FTDA¹⁰⁵.

Even a cursory assessment of the relevant American jurisprudence on ‘distinctiveness’ and ‘fame’ evidences that two different approaches in the literature. For example, one case held that protection against dilution was only available for trade marks which were both famous and distinctive¹⁰⁶, whilst elsewhere it was ruled that there is no separate requirement to find that a trademark is both famous and distinctive¹⁰⁷. Interestingly, it has been suggested that a famous trade mark owner must prove more than a likelihood of damage (actual damage), which would set a slightly higher bar of the burden of proof to the famous trade mark owners¹⁰⁸. Commentators have observed that a higher burden of proof is not helpful, as this does not address how distinctive and famous the mark should be, or what degree of fame, notoriety or recognition the mark should possess to qualify for protection in the Act¹⁰⁹.

To summarise, although US dilution has been criticised as being complex¹¹⁰, it can be summarised thus: it provides providing an extra protection to a famous trade mark owner against such mark being used where: the capacity of a famous mark to identify or distinguish the goods or services in absence of any competitive relationship between famous trademark owners and other parties, or likelihood of confusion, mistake, or deception. Similar protection to US dilution can be found at the international level, i.e. Article 16(3) of GATT TRIPS (no requirement of proof of

¹⁰⁴ Nguyen, X, ‘New Wild West: Measuring and Proving Fame and Dilution under the Federal Trademark Dilution Act’ (2000) 63 *Alb L Rev* 201-240 at 209-212.

¹⁰⁵ McCarthy, T, *McCarthy on Trademarks and Unfair Competition* (Egan Minnesota, Clark Boardman Callaghan, 2008).

¹⁰⁶ See *Nabisco v P F Brands Inc* 191 D 3d 208, 227-8 (2nd Cir 1999).

¹⁰⁷ See *Times Mirror Magazine Inc v Las Vegas Sports News LLC* 212 F 3d 157, 167 (3rd Cir 2000).

¹⁰⁸ See *Moseley et al, dba Victor’s Little Secret v V Secret Catalogue Inc* 537 US 418, 123 Sup Ct 1115 (2003). The case was described that it “revealed some of the flaws and missing links that plagued the statutes and case law precedents that had shaped the legal understanding of dilution...” See Holt, K, and Duvall, S, ‘Chasing Moseley’s Ghost: Dilution Surveys under the Trademark Dilution Revision Act’ (2008) 98 *TMR* 1311-1344.

¹⁰⁹ See Nguyen, X, *supra* note 100 at 212. McCarthy, T, *supra* note 87 at 1168.

¹¹⁰ It is said that “because [dilution] is largely a theoretical and almost ephemeral concept, the legal theory of “dilution” is exceedingly difficult to explain and understand. Misunderstanding is rampant”. See McCarthy, T, *supra* note 101 at 24-166-167.

likelihood of confusion), whereas Article 6bis of the Paris Convention is irrelevant here: only apply with relation to the similar goods.

1.7 Thesis Approach and Structure

The approach to and structure of this thesis was born of two problems: firstly, there is relatively little primary and secondary literature specifically and comprehensively directed to well-known trade marks at the international level, the EU and Japan trademark systems¹¹¹. Secondly (as is noted in Section 1.2 above, and Chapter 6, Section 6.1), in a comparative legal thesis it would be unrealistic to attempt to critically analyse all aspects of the protection of well-known trade marks. Thus this author has elected to consider the specific issue of the protection of well-known trade marks against confusion and the analogous concept of *kondo* in the EU and Japanese trade mark systems, respectively. Therefore, a number of interesting issues outside the scope of the trade mark law per se, including Unfair Competition Prevention Acts and border control issues, are beyond the scope of this thesis.

As stated above, the hypothesis posed in this thesis is that well-known trade mark protection against confusion in both the CTM and the Japanese trademark systems is uncertain. In this thesis, the law as at June 18, 2009 will be considered. In relation to the hypothesis, it is assumed that:

- (i) Well-known trade marks are the purest or strongest category of ‘trade mark’¹¹², thus analysis and consideration of the latter can be used to infer the nature of the former;
- (ii) The essence or heart of what constitutes a trade mark is the criterion of distinctiveness and, thus, *acquired* distinctiveness both distinguishes a well-known trade mark from an ordinary trade mark and goes to the essence or heart of what constitutes a well-known trade mark¹¹³, and;

¹¹¹ See Chapter 3.

¹¹² See Chapter 2.

¹¹³ It should be noted here that there are two types of ‘distinctiveness’: inherent distinctiveness and acquired distinctiveness. It is also important to note here that there is a

- (iii) Following from (i), developing a conceptualisation of the definition of ‘trade mark’ can assist in conceptualising the definition of ‘well-known trade mark’¹¹⁴. Further, that the latter can be of assistance in critically interrogating selected aspects of the protection afforded to well-known trade marks¹¹⁵.

Again, it should be emphasised that the main purpose of this thesis is to critically explore the most appropriate and effective means of protecting well-known trade marks in the EU and Japanese trade mark law against confusion and *kondo* (respectively), and to critically compare the differences therein.

The structure of this thesis is very much dictated by the problems indicated above. Critical analysis and comparison of the extent to which well-known trade marks are protected against confusion and *kondo*, in the view of this author, first required a precise definition of *what* a well-known trade mark is. Unfortunately, this is one of the areas where there is relatively little primary literature¹¹⁶, thus in this matter this author relies not only on direct critical analysis of the scope of the guidance on the definition of ‘well-known trade mark’ at the international level (see Chapter 3), but has first engaged in an indirect analysis, and some theoretical work, as to the scope of the larger concept – what constitutes a *trade mark* (see Chapter 2)? Having engaged in critical analysis of the definitions of ‘trade mark’ and ‘well-known trade mark’ – this work being directed to the end of establishing a working definition and a conceptualisation of ‘well-known trade mark’ – the extent to which such marks are protected against confusion (see Chapter 4) and *kondo* (see Chapter 5) are then critically analysed. This is followed, in Chapter 6, with a critical comparison of the

relationship between distinctiveness and reputation (the latter being seen as dependent on acquired distinctiveness).

¹¹⁴ As per the discussion in Chapter 2, Section 2.3.1.4 trade mark *concept* is defined so as to include both inherent and acquired distinctiveness. Thus trade mark *concept* would be defined as ‘distinctiveness, both inherent and acquired’. To clarify: well-known trade mark *concept* would be defined as ‘a high level of distinctiveness (both inherent and acquired or just acquired distinctiveness)’. See Chapter 3, Section 3.3.

¹¹⁵ Under Articles 8(5) and 9(1)(c) of the CTMR, the protection afforded to ‘trade marks with a reputation’ will be given where the following four conditions have been satisfied: (i) earlier registered trade mark with reputation in the relevant area; (ii) identity or similarity between the applied CTM and the earlier trade marks; (iii) usage of the mark applied for must take an unfair advantage of or be detrimental to the distinctive character or the reputation of the earlier mark; and (iv) such use must be without due course.

¹¹⁶ See Section 1.3.

protection afforded by the EU CTM system and Japanese Trademark Act, with reference to the international regime on well-known trade marks. In Chapter 7, the author's conclusions and recommendations for reform are to be found.

1.8 Summary

To summarise, the main purpose of this thesis is to examine the efficacy of well-known trade mark protection against confusion and *kondo* in the EU and Japan, although brief reference has been made to US dilution doctrine for completeness, further discussion of that topic is beyond the scope of this thesis.

Having set out in Chapter 1 the rationale, scope and approach of this thesis, the next step is to critically explore the definition of 'well-known trade mark' before critically analysing and comparing the extent of protection such marks have against confusion and *kondo* in the CTM and Japanese trademark systems. This critical exploration of the definition of 'well-known trade mark' begins in with a consideration of the definition of the broader notion of 'trade mark' in Chapter 2.

Chapter 2 A Definition of ‘Trade Mark’

2.1 Introduction

The overriding purpose of this thesis is the exploration of the most appropriate and effective means of protecting well-known trade marks and *syuchi-syohyo* in the EU and Japan against confusion and *kondo*. In order to explore what constitutes effective protection, it is first necessary to clarify *what* a well-known trade mark is – this is the purpose of this Chapter and Chapter 3¹¹⁷. It has already been noted that it has been assumed in this thesis that the concepts of ‘trade mark’ and ‘well-known trade mark’ are necessarily related (see Chapter 1, Section 1.7, above), so in this Chapter a critical consideration of the definitions of ‘trade mark’ and ‘syohyo’ is undertaken: please note that the focus here is the direct interpretation of the CTMR and Japanese Trademark Act (critical discussion of case law is not undertaken in this Chapter). However, in the critical consideration of the definition of ‘well-known trade mark’ and ‘syuchi-syohyo’ in the following chapter, Chapter 3, relevant jurisprudence will be critically considered.

It is appropriate to briefly consider here whether the assumption that the concepts of ‘trade mark’ and ‘well-known trade mark’ are necessarily related is logical and reasonable. It is submitted that it is logical because of the fundamental conceptual and practical interconnection that must exist between the broader concept of ‘trade mark’ and the narrower concept of ‘well-known trade mark’. Given that there is relatively little primary literature relating to how well-known trade marks are defined¹¹⁸, using the broader concept (trade mark) to inform the narrower (well-known trade mark) is logical. That this assumption is reasonable can also be supported, as not only is a well-known trade mark clearly, as a matter of law¹¹⁹, a sub-set of trade mark but, as is suggested in Chapter 1, Section 1.7, well-known trade

¹¹⁷ Understanding what a well-known trade mark is *for* – trade mark function – must, logically, have import in this context. However, in the interests of limiting the scope of this thesis, this author has elected to focus on critically analysing the *definitions* rather than *function*. Please see Sections 2.3.1-2.3.3, below.

¹¹⁸ See for example, Tatham, D, H, *supra* note 13.

¹¹⁹ The relevant well-known trade mark provisions here are: Articles 8(5) and 9(1)(c) of the CTMR, Articles 4(1)(10) and (19) of the Japanese Trademark Act.

mark status can only be assumed by a small number of trade marks¹²⁰. It is thus a reasonable assumption that well-known trade mark status is only appropriate for the strongest of trade marks¹²¹.

Although ‘trade mark’ and ‘well-known trade mark’ are considered to be connected concepts, why is it useful to conceptualise what constitutes a *trade mark* in the context of research on *well-known* trade marks? The utility of exploring the definition of ‘trade mark’ as part of considering that of ‘well-known trade mark’ has been argued above. However, it must be conceded that just as there is a relative dearth of primary sources defining ‘well-known trade mark’ – as will be argued in this Chapter, particularly at the international level, discrete, explicit and comprehensive definitions in the primary sources as to what constitutes a trade mark¹²² are not always found. Thus, just using definition(s) of ‘trade mark’ from the primary literature to inform that of ‘well-known trade mark’ was felt, by this author, not to be sufficient. Therefore, in order to enable analysis and comparison of the respective (sometimes incomplete) definitions of ‘trade mark’ in this Chapter and consideration, and thereafter, analysis and comparison of ‘well-known trade mark’ in Chapters 4, 5, and 6, it seems to this author that it is necessary, reasonable and useful to develop a conceptual framework relating to these definitions to aid this process.

The approach to developing a conceptual framework for this thesis taken by this author was one of attempting to break down the concept of ‘well-known trade mark’ into sub-categories: the result is what this author terms the Definition Model. The rationale for developing the Definition Model is to create a frame of reference for critical analysis of, first, the various definitions of ‘trade mark’ and, thereafter ‘well-known trade mark’ to be found in the primary literature. The development of the Definition Model itself also constitutes a small theoretical contribution to the literature and is thus one of the contributions to the literature made by this thesis.

¹²⁰ Here, exemplars of well-known trade mark in Japan are ‘SHISEIDO’; ‘TOYOTA’; and ‘GEKKEIKAN’. These exemplars have legal authority as these are registered under a defensive trademark under Article 64 of the Japanese Trademark Act.

¹²¹ See Chapter 1, Section 1.7.

¹²² See Section 2.3.

The Definition Model developed by this author is used by first *mapping*¹²³ elements of legal definitions of ‘trade mark’ (and then ‘well-known trade mark’) to be found in the international, the EU and the Japanese trade mark system, and conceptualising these. Using the resultant model in critically analysing the definitions offered by each relevant legal instrument in turn not only tests this model, but (crucially) enables consistent critical analysis of ‘trade mark’ in the CTM and ‘syohyo’ in the Japanese system, and ‘well-known trade mark’ at the international level (Chapters 2 and 3), as well as of the definitions of ‘trade mark of repute’ and ‘syuchi-syohyo’ (analysis of which form part of Chapters 4 and 5, respectively). The Definition Model is then simply employed as a tool to enable critical analysis in these Chapters, and then comparison (in the comparison of definitions of ‘trade mark of repute’ and ‘syuchi-syohyo’) in Chapter 6. The Definition Model, as developed by this author, will be described in Section 2.2 below.

The purpose of Chapter 2, therefore, is to explore the definition of ‘trade mark’. The Chapter is structured as follows:

- The Definition Model is proposed and set out, and;
- The legal definition of ‘trade mark’ at the international level, and relevant regional (EU) and national (Japan) levels are critically considered in turn (and some critical comparison undertaken)¹²⁴, utilising the Definition Model.

2.2 Conceptualising what Constitutes ‘Trade Mark’

In order to test the hypothesis of this thesis – that well-known trade mark protection against confusion and *kondo*, respectively, in the CTM and the Japanese trademark systems, is uncertain – it has been argued that it is necessary to define what is meant by ‘well-known trade mark’ (see Section 2.1 above and Chapter 1, Section 1.7). As noted above, the author believes that this necessitates (or, at least benefits from) first

¹²³ A process that (in Chapters 2-5) implicitly tests the Definition Model.

¹²⁴ It may be helpful at this stage to remind the reader of the point of terminology previously noted in Chapter 1, Sections 1.4-1.5: in this thesis the word ‘trade mark’ is used to refer to trade marks in an EU or international context, or in general whilst the equivalent transliterated Japanese term *sho-hyo* (商標; the usual English translation of which is ‘trademark’) is used when referring to trade marks in the Japanese context.

defining what is meant by ‘trade mark’. The starting point chosen by this author is the critical consideration of the definitions of ‘trade mark’ to be found in international, EU and the Japanese Trademark law.

This critical consideration employs (and tests) the Definition Model: a conceptualisation of how ‘trade mark’ (and also ‘well-known trade mark’) can be defined. The starting point of developing the Definition Model was a distinction drawn between a model that conceptualises the statutory definition(s) of ‘trade mark’ into quantitative (what *types* of signs are protected?) and qualitative categories or elements (*concept* – what *is* a trade mark?)¹²⁵. This author has built on, and (it is submitted) improved upon, this distinction to develop the Definition Model. It is submitted that the Definition Model itself constitutes a valuable contribution to the literature. Although a simple model (which itself may be a virtue, as it is a model that can be easily understood not only by trade marks academics and practitioners, but by consumers also), it is a pragmatic one as it concisely captures the ‘legal reality’¹²⁶ of what constitutes a ‘trade mark’ (and also a ‘well-known trade mark’).

The first point at which the Definition Model diverges from the earlier quantitative/qualitative distinction lies in terminology – in the Definition Model the author prefers the more accurate and descriptive terms of *form* and *concept* to ‘quantitative’ and ‘qualitative’.

Thus, the Definition Model sets out that within the definition(s) of well-known trade mark, two elements are recognised: *form* and *concept*. There are also two sub-categories under *form* within the Definition Model, *context* and *type*, as set out below:

- *Form*:
 - (Well-known) trade mark *types*¹²⁷: e.g. word marks, colour marks etc;

¹²⁵ This quantitative/qualitative conceptualisation of the definition of ‘trade mark’ has been developed and used by an academic for comparative trade mark law teaching purposes. (See Wilson, C, the teaching materials for LLM Comparative Intellectual Property Law, most recently; Week 11 materials (2008-9)).

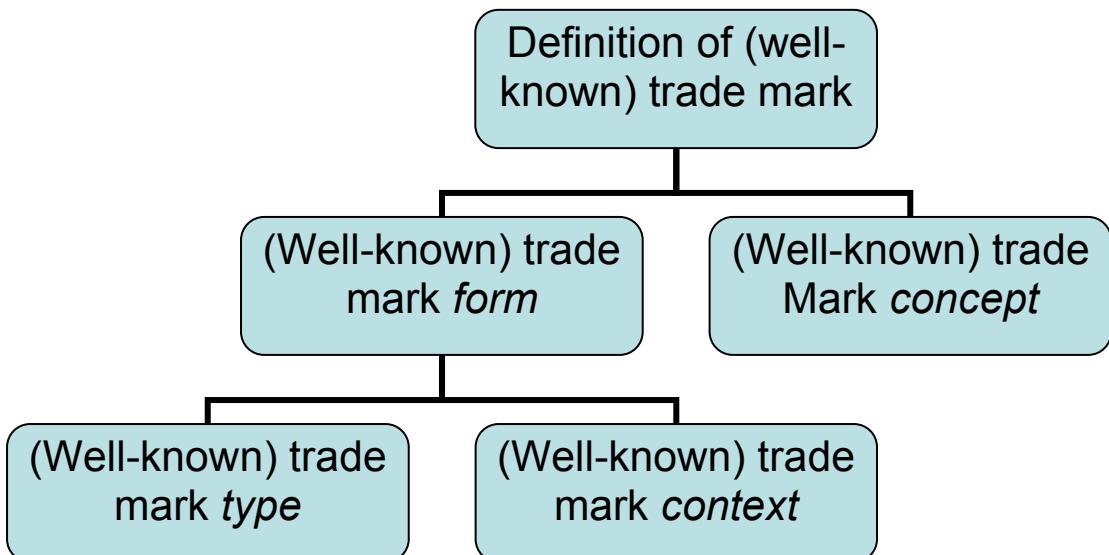
¹²⁶ By being consistent with ‘legal reality’ the author means that it is consistent with both the theoretical literature and the practical nexus of trade mark law.

¹²⁷ That is, the *type* of (in the sense of the categorisation of the perception of) the ‘trade mark’ or ‘well-known trade mark’.

- (Well-known) trade mark *context*¹²⁸: e.g. service marks, use as a domain name etc.
- *Concept*¹²⁹: (Highly) distinctive (well-known) trade marks.

The Definition Model in theory can also be represented in a more visual, diagrammatic form, see Diagram 1, below:

Diagram 1: The Definition Model



¹²⁸ That is, the forum in which the trade mark or well-known trade mark is used (in some cases, this may have some relation to the classes and sub-classes for which the trade mark is registered).

¹²⁹ That is, what *is* a (well-known) trade mark?

In addition to changes in terminology, this author believes that approaching the conceptualisation of ‘trade mark’ from the perspective of dualism (as is the case with the quantitative/qualitative distinction) is misleading: as will be illustrated¹³⁰, the legal regulation of trade mark *form* and *concept* are, in practice, interdependent and overlapping (see Diagram 2): something that is recognised by this author in her application of the Definition Model, and also visually represented in the more detailed representation of this Model in Diagram 2, below.

At this stage, it might be helpful to demonstrate how the Definition Model might be applied in practice. In Sections 2.2.1-2.2.3 below, the Definition Model will be applied to two real-life well-known trade marks for the purpose of illustration, before (from Section 2.3 onwards) we return to the use of this Definition Model in the context of analysing the definition of ‘trade mark’ in law.

2.2.1 The *Form* of ‘Trade Mark’: An Illustration

The Definition Model can be further explained by reference to real-life examples. Take the following well-known¹³¹ trade marks:

- (i) A representation of the word mark¹³²: ‘COCA COLA’,¹³³ and;
- (ii) A representation of the logo¹³⁴ of ‘TOYOTA’.¹³⁵

¹³⁰ See below Diagram 2: The Full Definition Model.

¹³¹ *Supra* note 26 and *infra* note 532. It is submitted that not only are these trade marks well-known, they are also part of very valuable brands – the Interbrand 2008 survey ranked ‘COCA-COLA’ as the most valuable brand, with ‘TOYOTA’ being in sixth position overall. Evidence of these two trade mark being well-known includes (i) the description of ‘COCA-COLA’ as being a well-known mark in a WIPO publication (WIPO, *supra* note 37 at 198) and (ii) the description of the TOYOTA logo as being a well-known trade mark by one of the lawyers involved in the Chinese case of *Toyota Motors vs. Zhejiang Geely* (see Yu-Sheng, Shi, ‘Trademark Infringement and Unfair Competition Case Study: Toyota Motors vs. Zhejiang Geely’ (2003/4) *China Law & Practice* (available at <http://www.chinalawandpractice.com/Article/1692947/Channel/9930/Trademark-Infringement-and-Unfair-Competition-Case-Study-Toyota-Motors-vs-Zhejiang-Geely.html.>) (Last accessed on 12 January 2010).

¹³² A word mark is usually a distinct text-only typographic treatment and thus comprises only text. For example, ‘COCA-COLA’, ‘IBM’, ‘NOKIA’, ‘INTEL’, and ‘MICROSOFT’ are categorised as word marks.

¹³³ See Appendix 2: Illustrations of the Definition Model. ‘COCA-COLA’ is a registered trade mark under the CTM system (registration number 002091569) and in the JPO system it has been also registered as a defensive *syohyo* (registration number 106633).

According to the Definition Model (see Diagram 1 above), there are two main features: *form* and *concept*. *Form* can be further sub-divided into *types* of ‘trade mark’ and the *context* of ‘trade mark’. It should be observed at this point that this author submits that, from a historical perspective, the legal regulation of trade mark *form* might be characterised as having taken an incremental approach: the scope of registrable *forms* in most jurisdictions seems to have expanded over time (to reflect this observation, an open-ended definition of *form* is offered below).

The *form* of the well-known trade marks at issue, it is submitted, is as follows:

- COCA-COLA:

Type – it comprises a word mark and colour combination: the word ‘COCA-COLA’ has been represented in a stylised manner employing the colour red on a white background;
Context – this is a trade mark for a product.

- TOYOTA:

Type – this is a logo, which comprises a figurative element (consisting of a two-dimensional, circular graphic representation of circles) and a colour (silver) element¹³⁴;
Context – this is a trade mark for a product.

The second element of the Definition Model is considered to be *concept*.

This author submits that the dominant element of *concept* lies in distinctiveness: ‘distinctive’ for trade marks and ‘highly distinctive’ for well-known trade marks.

¹³⁴ A logo is a graphical mark and might comprise an ideogram, symbol, emblem or icon. Here examples being  the ‘McDONALDS’ logo; and  the ‘HONDA’ logo.

¹³⁵ See Appendix 2: Illustrations of the Definition Model. The TOYOTA logo has been a registered trademark in the Japan since 1997 (registration number 4039298). In the CTM system, a word mark ‘TOYOTA’ has been registered as a trade mark (registration number 00512780); however, the JPO does not provide any graphic image of this mark available on the website.

¹³⁶ *Ibid.*

Applying the Definition Model to our two well-known trade marks examples above, it is submitted that:

- COCA-COLA:

A highly distinctive nature, which enables consumers to distinguish ‘COCA-COLA’ from the other cola drinks. This highly distinctive nature might be attributed to the fanciful representation of an unusual word ‘COCA-COLA’, perhaps also to the combination of the colours of red and white, and, almost certainly, to the long-term and intensive use and advertising of the mark;

- TOYOTA:

A highly distinctive nature, which enables consumers to distinguish ‘TOYOTA’ cars from those of other competitors. The unique representation of the combination of the word mark ‘TOYOTA’ and the logo might have helped in establishing the highly distinctive nature of the logo, as may have intensive use and advertising.

The author would also like to submit that, when considering the examples of the ‘COCA COLA’ and ‘TOYOTA’ marks, there are additional elements that must have import for the Definition Model, but that do not strictly seem to fit in either *form* or *concept*. These additional elements are *graphic representation* (i.e. the ability to perceive the mark¹³⁷) and *commercial use*¹³⁸. In the view of this author, these two elements (*graphic representation* and *commercial use*) are clearly necessary and pragmatic preconditions to trade mark registration: they can be regarded as absolute preconditions to registration and thus within the context of the Definition Model enable both *form* and *concept*. It is submitted that *graphic representation* and

¹³⁷ There are, respectively, visual recognition (see Article 4 of the CTMR; Article 2 of the Japanese Trademark Act and *graphic representation* (see Article 4 of the CTMR, and Articles 2 and 5 of the Japanese Trademark Act) and criteria within the Japanese and CTM definitions of ‘trade mark’.

¹³⁸ *Commercial use as a precondition* of trade mark law taking the registration system, is explicit within the Japanese Trademark Act (Article 2 of the Japanese Trademark Act), whilst is somewhat implicit in the CTMR (Article 7(3) of the CTMR).

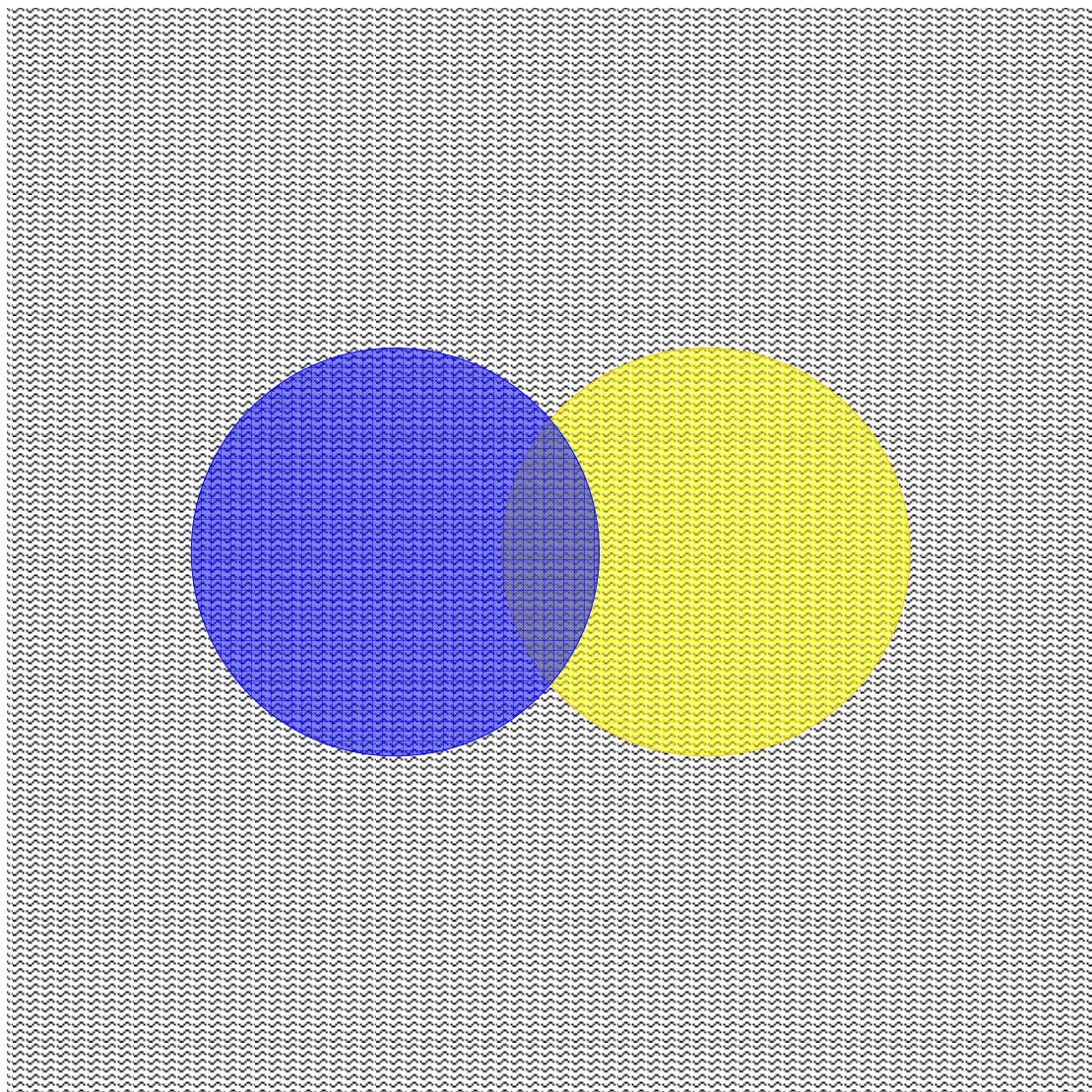
commercial use are not the same (unlike the absolute nature of *graphic representation* and *commercial use*¹³⁹, *form* and *concept* have a more relative nature¹⁴⁰, it is submitted) and they should not be incorporated within *form* and *concept*. Instead, they should be rightly considered as being *preconditions* to registration, and in this way enabling a mark to have *form* and *concept*.

Accounting for this, a full diagrammatic representation of the Definition Model can be said to be as follows:

¹³⁹ Absolute in the sense that trade mark systems require a minimum standard of *graphic representation* (e.g. in the CTM Article 4 (“...being represented graphically...”) and in Japan, Article 5(2) of the Japanese Trademark Act) and *commercial use* (e.g. in the CTM, see Articles 15(1) and 50(1)(a) of the CTMR, and in Japan, see Article 2 of the Japanese Trademark Act and in Japan), the extent of such representation and use does not, in itself, affect the extent of trade mark protection, it is merely a precondition to registration.

¹⁴⁰ It is submitted that these are relative in the sense that the wider the scope of *form* and *concept* (distinctiveness) the wider the scope of, and protection afforded by registration, (respectively, in relation to *form* in the registration of more than one mark and the registration of marks in more classes and sub-classes, and, in relation to *concept*, ultimately in the recognition of well-known trade mark status, and protected in law accordingly.

Diagram 2: The Full Definition Model



Key



Represents trade mark *concept*, i.e. distinctiveness¹⁴¹.



Represents trade mark *form*, i.e. *type* and *context*.



Represents *preconditions* for trade mark registration, i.e. *graphic representation* and *commercial use*.

¹⁴¹ It is submitted that mere distinctiveness is sufficient for ‘trade mark’ but that a high level of distinctiveness is required for ‘well-known trade mark’. For further comments here, please see Chapter 3, Section 3.2.2, and see the *Flexi Air* case, *infra* note 469.

It is submitted that not only is the Definition Model useful in conceptually defining what constitutes a (well-known) trade mark, it also functions as a yardstick to help in categorising and comparing various definitions of '(well-known) trade mark'. In this Chapter, the Definition Model will be employed in Sections 2.3.1-2.3.3 to conceptualise and compare the various definitions of 'trade mark' that can be found in the relevant primary literature.

Before this, some further explanation of the Definition Model is felt to be necessary. Having thus far represented that *form* and *concept* are separate elements within the definition of '(well-known) trade mark', it should be conceded (as is represented in Diagram 2 above), that these two individual elements, *in practice*, are closely related¹⁴² and do interplay or overlap¹⁴³. This correlation or interrelation between *form* and *concept* of '(well-known) trade mark' within the Definition Model is, as noted in the previous sentence, illustrated in Diagram 2. It should also be noted that the Definition Model is *not* meant to serve as a mere description of '(well-known) trade mark' definitions; the Model is meant to be a conceptualisation of the definition of '(well-known) trade mark'.

Now, a written (rather than diagrammatic) full version of the Definition Model is offered – this is presented in such a way so as to incorporate all the elements identified in Diagrams 1 and 2, and provides examples of each element. It is this version of the Definition Model that will be applied in this thesis hereafter:

- *Form* (*type*¹⁴⁴ and *context*¹⁴⁵) and;
- *Concept*¹⁴⁶, with;

¹⁴² So, for example, some *forms* of trade mark may possess more innate distinctiveness than others, something that is recognised by commentators. See for example, Kojima, R, 'Rittai syohyo no toroku yoken: Maglight rittai syohyo jiken' (2008) 58 *Chizai kanri* 25 9; and Aoki, H, 'Protection for three-dimensional Trademarks: an Examination of Maglight case' (2007) 180 *CIPIC Journal* 20.

¹⁴³ See for example, Articles 7 (1)(c), (e)(i), (ii), (iii) of the CTMR; and Article 3(3) of the Japanese Trademark Act.

¹⁴⁴ This includes signs, symbols, characters, letters, numbers, personal names, graphics, shapes of goods including two and three-dimensional marks, packaging, colours and combination thereof, and maybe so-called non-traditional trade marks (sound, olfactory, and tactile marks), and so on.

¹⁴⁵ This can include marks for goods (merchandising marks), service marks, domain names, business identifiers, retailers' marks, retailer's service marks, geographical indications, house marks, collective marks, grade marks, manufacturer marks, certification marks, family marks, coined marks, slogans, stock marks, trade names and so on.

- The *preconditions*¹⁴⁷.

A few further observations on the Definition Model and the definition of ‘trade mark’ are appropriate at this stage, for the sake of completeness.

First, this author would like to briefly consider the scope of the Definition Model. Here it is submitted that the scope of both *type* and *context* has broadened over time: for instance, three-dimensional marks are also a relatively new *type* of trade mark¹⁴⁸ and domain names are also a relatively new *context* for trade marks¹⁴⁹. Therefore, this author submits that the scope of trade mark *form* does not appear to be fixed, taking instead an incremental and thus flexible approach, allowing the scope of ‘trade mark’ *form* to expand over time. In the view of this author, factors that might lead to future expansion of trade mark *form* might include the increasing sophistication of consumers¹⁵⁰ and future technological advances¹⁵¹.

Second, this author would like to submit that recent expansion of both *type* and *context* have resulted at least partly from increased consumer sophistication and technological change. It is beyond the scope of this thesis to provide (non-legal) evidence for this, but it might be suggested that demand for the legal recognition of so-called non-traditional marks (including sound, olfactory, and movement marks) might be regarded as indirect evidence of consumer recognition of the same (following the reasoning that what is commercially valuable must sustain its value

¹⁴⁶ A dominant element of the *concept* of ‘trade mark’ within the Definition Model is submitted to be distinctiveness. This Definition Model fits in the CTM trade mark regime well; since distinctiveness as *concept* of ‘trade mark’ is clearly explicit in the CTMR; the Japanese Trademark Act, on the contrary it is not clearly explicit therein. This author submits that the Definition Model is applicable for the Japanese Trademark Act by the following point: The Japanese term for ‘trademark’ is ‘syohyo’, which contains the implicit meaning of mark being distinctive, therefore, it is valid to argue that the Definition Model is still applicable for the Japanese Trademark Act and the *concept* of ‘trade mark’ is substantively distinctiveness. See Chapter 2, Section 2.3.3.

¹⁴⁷ These are *graphic representation* and *commercial use*.

¹⁴⁸ For example, the Japanese Trademark Act introduced three-dimensional trademarks as a protectable trademark subject matter in 1996 (Act No. 68 of 1996).

¹⁴⁹ It is important to note that domain names neatly illustrate the distinction drawn by this author within the Definition Model between *type* and *concept*. Although domain names may have been explicitly protected as a new *form* of trade mark, the novelty lay in *context* (the use of trade marks in identifying web addresses), not *type* (a domain name is simply a word mark).

¹⁵⁰ It is submitted that such consumers would be able to recognise new *types* of trade mark.

¹⁵¹ It is submitted that – just as the commercialisation of the Web led to the increased importance of, and subsequent explicit trade mark protection for, domain names – future technological developments may result in the recognition (and protection) of novel (commercially valuable) trade mark *forms*.

from consumer demand). Additionally, technologies now in mass use provide the platforms for commercial use of non-traditional marks (e.g. use of movement marks and sound marks on web sites). Therefore, it is inferred by this author that the scope of *form* of ‘trade mark’ within the Definition Model has broadened over time in response to consumer and technological changes.

Now, attention turns to providing an exemplification of trade mark *concept*.

2.2.2 The *Concept* of ‘Trade Mark’: An Illustration

As was described in Section 2.2.1, the Definition Model consists of two factors, *form* and *concept*. The key aspect of *concept* of ‘trade mark’, it is submitted, is that it directly relates to distinctiveness. Also important (although, critical discussion of this is beyond the scope of this thesis) is this author’s submission that the conceptualisation of distinctiveness of ‘trade mark’ to *concept* in the Model does have some relationship to trade mark function¹⁵², and in this way, *concept* (distinctiveness) might be said to be at the heart of any definition of ‘trade mark’.

Employing the same real-life examples of the two well-known trade marks as in Section 2.2.1, it is suggested that:

- *Concept* of ‘COCA-COLA’:

The *concept* of this trade mark lies in its highly distinctive nature to consumers. This particular nature functions firstly to inform consumers of the existence of goods, and ultimately enables consumers to select a ‘COCA-COLA’ drink from among other similar drinks, such as ‘PEPSI-COLA’,¹⁵³ in practice. This process might be affected by various concerns of consumers¹⁵⁴. For example, when a consumer successfully identifies a ‘COCA-COLA’ drink from among others including ‘PEPSI-COLA’ (guarantee of origin) ‘COCA-COLA’ brings other messages, which might inform the consumer of good quality (guarantee of

¹⁵² See Chapter 2, Section 2.4 for a brief introduction of the trade mark functions.

¹⁵³ ‘PEPSI-COLA’ is a registered trade mark under the CTM system (Registration Number 000563163) and in Japan (Registration Number 1353411).

¹⁵⁴ The same process will work for any trade marks. See Chapter 1 Section 1.4.

quality) and/or a positive and young image of the drink (advertising function). A highly distinctive nature in ‘COCA-COLA’, may result from a combination of factors, including the (distinctive) attractive presentation of the words¹⁵⁵, the extensive use of its marks in the market¹⁵⁶ (increasing distinctiveness), and/or the extensive advertising of ‘COCA-COLA’¹⁵⁷.

- *Concept* of the ‘TOYOTA’ logo:

This can, again, be seen to lie in the distinctive nature of the logo, with factors such as the use of a simple logo with a combination of colours contributing to distinctiveness.

As a consequence of enjoying a (high) level of distinctiveness, a well-known trade mark strongly informs consumers as to the origin of the goods or services for which the mark is registered: this is known as the primary function of a trade mark above¹⁵⁸. More importantly, highly distinctive trade marks allow consumers to very effectively distinguish between goods of varying sources at the point of sale¹⁵⁹. This might be regarded as being the ultimate function of a trade mark. Although, as noted above, critical discussion of trade mark function is beyond the scope of this thesis, the author would like to emphasise the truism that without distinctiveness, the existence and purposes of a trade mark becomes meaningless. Therefore it is submitted that not only is distinctiveness the *concept* of ‘trade mark’, it is the essential characteristic of any trade mark.

¹⁵⁵ A graphic representation of ‘COCA-COLA’ is highly attractive to consumers. This might be because of the combination of use of such appealing colour and word font. See Appendix 2: Illustrations of the Definition Model.

¹⁵⁶ For example, it is reported that ‘COCA-COLA’ was first introduced in Japan around 1913 as it is evidenced that the word ‘COCA-COLA’ was quoted in a book published in 1914 (see Takamura, K *Kotei*). The word mark ‘COCA-COLA’ has been registered as a *syohyo* under the Japanese trademark system since 1964. (Registration Number 650399).

¹⁵⁷ The estimated annual advertising expenditure of the COCA-COLA brand is \$2.2 bn in 2007. See http://www.adbrands.net/us/cocacola_us.htm. (Last accessed on 12 January 2010).

¹⁵⁸ See Tritton, G, *supra* note 37 at 255, 256, 257 and 259; and Griffiths, A, ‘The Impact of the Global Appreciation Approach on the Boundaries of Trade Mark Protection’ (2001) 4 *IPQ* 326-360 at 329.

¹⁵⁹ Tritton, *supra* note 37 at 225.

Nevertheless, the ‘TOYOTA’ logo, in practice, might be less distinctive to general consumers than ‘COCA-COLA’¹⁶⁰ (a suggestion that might be supported by the observation that ‘TOYOTA’ logo *per se* is registered as a trade mark under the Japanese system, whilst the ‘TOYOTA’ logo has been registered in combination with the TOYOTA word mark under the CTM system¹⁶¹. In Japan, the word mark and the logo has been registered individually¹⁶², whereas in the EU, the word mark and the logo has been registered in combination with each other¹⁶³ in relation to most of the trade mark classes expect Classes 43¹⁶⁴, 44¹⁶⁵, and 45¹⁶⁶).

The suggestions as to relative distinctiveness in the paragraph above essentially relate to the submission by this author that there is some correlation between *type* (with the suggestion that the word mark ‘COCA COLA’ is more distinctive than the Toyota logo) and distinctiveness, and also the specifics of *context* (here, the nature of the goods – soft drinks and cars). This simply supports the Definition Model overlap between *form* and *concept*¹⁶⁷.

2.2.3 Summary

In Section 2.2 the author has explored, both in abstract and in relation to two real-life examples, the nature and role of *form* and *concept* of ‘trade mark’. She has also identified ways in which *form* and *concept* overlaps.

In particular, employing the Definition Model to the same real-life examples of two well-known trade marks, the *concept* of both ‘COCA-COLA’ and TOYOTA’s logo can be said to be highly distinctive. The practical result of this for consumers must be, it is submitted, that they are enabled to more accurately select the products or services

¹⁶⁰ The reason may be that although TOYOTA’s logo is famous throughout the world; unlike ‘COCA-COLA’, a car is a high-end product: we do not buy a car on daily basis, therefore in theory the Toyota logo itself is unlikely to be seen at the shop on daily basis. Therefore, the scope of a relevant sector of consumers seems to be narrower than that of daily products, such as ‘COCA-COLA’.

¹⁶¹ *Supra* note 131.

¹⁶² *Ibid.*

¹⁶³ *Ibid.*

¹⁶⁴ It refers to services for providing food and drink; temporary accommodation.

¹⁶⁵ It refers to medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

¹⁶⁶ It refers to legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

¹⁶⁷ See Diagram 2: The Full Definition Model.

that these marks are attached to. In other words, the more distinctive (the greater the *concept* of) a mark, the more consumers are capable of distinguishing, for instance, ‘COCA-COLA’ from other cola drinks¹⁶⁸. In addition, it might also be said that causal factors of the highly distinctive nature of ‘COCA-COLA’ include the attractive presentation of the words¹⁶⁹, extensive use of this mark in the market¹⁷⁰ and extensive advertising¹⁷¹. Thus, it is submitted, what has made ‘COCA-COLA’ highly distinctive (and, thus, a well-known trade mark) is acquired, not just innate, distinctiveness¹⁷².

The Definition Model has been developed as a simple tool to allow this author to discern and compare, *via* indirect (selected primary resources relating to the definition of ‘trade mark’) and direct (the primary resources as to the definition of ‘well-known trade mark’) critical analysis, what the definitions of ‘well known trade mark’ are in the international, EU and Japanese trade mark regimes.

Applying this Model to two real-life marks (Sections 2.2.1-2.2.2 above) illustrates how the Definition Model can be used to conceptualise marks at the individual level. In the rest of this Chapter, as well as in Chapters 3-6, the Definition Model will be employed (within the jurisdictional scope of this thesis) in the critical analysis of what constitutes a trade mark at the systemic (rather than individual mark) level, and the critical analysis (and comparison) of what constitutes a well-known trade mark in law.

2.3 What Constitutes ‘Trade Mark’ in Law?

This author has looked at the utility of the Definition Model by applying it to the two real-life well-known trade marks as exemplars. To recap some of the features of this Model - in practice, *form* and *concept* interconnect and certain *preconditions* to registration also have to be present. This author considers that the scope of (well-known) trade mark *form* can and should be flexible, whereas (well-known) trade mark

¹⁶⁸ See Tritton, *supra* note 37 at 225.

¹⁶⁹ *Supra* note 151.

¹⁷⁰ *Supra* note 152.

¹⁷¹ *Supra* note 153.

¹⁷² Here, see Chapter 3, Section 3.3.3, *and infra* note 469.

concept has a more fixed and certain scope ('distinctiveness' for trade marks, 'a high level of distinctiveness' for well-known trade marks).

Now, the author will critically consider the definitions of 'trade mark' at the international, a regional (the CTM), and a national (Japan) levels, with reference to the Definition Model.

2.3.1 The International Level

Trade mark law has been subject to international harmonisation over a considerable period of time¹⁷³. International agreements relevant to trade mark law include the Paris Convention¹⁷⁴, GATT TRIPS¹⁷⁵, the TLT¹⁷⁶, the Singapore Treaty¹⁷⁷, the Nice

¹⁷³ See Mostert, F, W, *supra* note 49, and *supra* note 62; Tatham, D, H, *supra* note 13; Grabrucker, M, 'Marks For Retail Services – An Example for Harmonising Trade Mark Law' (2003) 34 *IIC* 503-520.

¹⁷⁴ The Paris Convention (the Paris Convention for the Protection of Industrial Property) was signed in Paris on 20 March 1883. It was one of the first intellectual property treaties. The provisions related to trade mark subject matter are Articles 6bis, 6ter, 7bis, 8, and 9 of the Paris Convention. The Paris Convention came into force in 1884 signified by 14 States and amended several times (the last amendment was in 1979). Currently it has been ratified by 151 Member States. The Paris Convention is an international convention for promoting trade among the member countries, devised to facilitate protection of industrial property simultaneously in member countries without any loss in the priority date. See *supra* note 13 for the full text of the Paris Convention.

¹⁷⁵ GATT TRIPS (the General Agreement on Tariffs and Trade, Agreement on Trade-Related Aspects of Intellectual Property Rights) was negotiated in the 1986-94 Uruguay Round and had the effect of incorporating intellectual property directly into the legal regulation of the multilateral trading system for the first time. The Agreement on Trade Related Aspects of Intellectual Property Rights (GATT TRIPS) which came into force from 1 January 1995 in Marrakesh, Morocco on 15 April 1994. It lays down minimum standards for protection and enforcement of intellectual property rights in member countries which are required to promote effective and adequate protection of intellectual property rights with a view to reducing distortions and impediments to international trade. The obligations under GATT TRIPS relate to provision of a minimum standard of protection within the member countries, legal systems and practices. Article 2(1) of GATT TRIPS requires Member States to comply with the substantive provisions of the Paris Convention. See for example, Smith, G, W, 'Intellectual Property Rights, Developing Countries and TRIPS' (1999) 6 *JWIP* 969-975 at 967. Also, see Gervais, D, *The TRIPS Agreement: Drafting History and Analysis* (London, Sweet and Maxwell, 2008). Provisions in GATT TRIPS relating to trade mark subject matter can be found in Article 15(1). The full text of GATT TRIPS is to be found at http://www.wto.org/english/tratop_e/trips_e/t_agm2_e.htm. (Last accessed on 12 January 2010).

¹⁷⁶ The TLT (the Trademark Law Treaty) was adopted in Geneva on 27 October 1994. It was the first unified international trade mark law by the members of WIPO. The aim of the TLT is to harmonise trade mark law and simplify registration procedures. See *WIPO Handbook on Intellectual Property* at 297. This handbook is to be found at <http://www.wipo.int/about-ip/en/iprm/pdf/ch5.pdf#lt>. (Last accessed on 12 January 2010).

¹⁷⁷ The Singapore Treaty (the Singapore Treaty on the Law of Trademarks) is a new international treaty on trademarks adopted on 28 March 2006. The Singapore Treaty deals mainly with procedural aspects of trademark registration and licensing. Furthermore, this treaty was built on TLT to provide wider scope of application and addresses new developments in the field of communication technology. It also creates a dynamic regulatory framework for brand rights to introduce a new approach to securing investment in product differentiation. See for example, WIPO Press Release 439 (Geneva/Singapore,

Agreement¹⁷⁸, and the Madrid Protocol¹⁷⁹. Detailed consideration of the evolution, influence and content of all these international trade mark legal instruments is, however, beyond the scope of this thesis¹⁸⁰. Critical discussion of international trade mark law in this Chapter will, instead, be confined to consideration of the guidance (or lack of guidance) provided in these international trade mark treaties as to the definition of ‘trade mark’.

This author will start by considering the Paris Convention¹⁸¹, as this is the earliest multi-lateral international intellectual property instrument¹⁸² which, as part of this, also addresses trade mark law¹⁸³. Further, as the aim of the Paris Convention was to

14 March 2006), ‘Dr. Idris Opens Diplomatic Conference to Revise Key Trademark Treaty’. The Full text of this press release is to be found at http://www.wipo.int/edocs/prdocs/en/2006/wipo_pr_2006_439.html. (Last accessed on 12 January 2010). The full text of the Singapore Treaty is to be found at http://www.wipo.int/treaties/en/ip/singapore/singapore_treaty.html. (Last accessed on 12 January 2010). Articles, which are relevant to trade mark subject matter, shall be Articles 2(1) and (2) of the Singapore Treaty. However, the aim of this treaty is with regard to facilitate administrative trade mark registration procedures, therefore, further investigation of the international harmonisation of trade mark law is beyond the scope of this thesis.

¹⁷⁸ The Nice Agreement (the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks) was adopted at Nice in June 1957 as revised and amended. It sets out an international classification of goods and services for the purposes of registering trade marks and service marks. The current edition of the Classification is the ninth, which entered into force on 1 January 2007. The full text of this version of the Nice Agreement is to be found at http://www.wipo.int/treaties/en/classification/nice/trtdocs_wo019.html. (Last accessed on 12 January 2010). As the Nice Agreement does not pertain to the definition of trade mark, it does not merit further discussion in the context of this thesis.

¹⁷⁹ The Madrid Protocol (Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks) was adopted at Madrid on 27 June 1989. It is the primary international system for facilitating the registration of trade marks in multiple jurisdictions around the world. It offers a trade mark owner the possibility to have his trade mark protected in several countries by simply filing one application directly with his own national or regional trade mark office. See Eckhardt, C, ‘Is there still a need for the 1891 Madrid Agreement? (2007) 170 *CW* 22-24; Seville, C, ‘Trade Mark Law: The Community’s Thinking Widens and Deepens’ (2004) 53 *ICLQ* 1013-1023. The Madrid Protocol is aimed at the unification of trade mark applications, therefore, with regard to the trade mark subject matter, it is of little relevance to this thesis.

¹⁸⁰ See the overview of internationalisation of trade mark laws. Cornish, W, and Lleywen D, *supra* note 37; Phillips, J, and Middlemiss, S, ‘The Community Trade Mark’ (1996) 7 *PLC* 39-44; Mostert, F, W, ‘Is Goodwill Territorial Or International? Protection of the Reputation of a Famous Trade Mark Which Has Not Been Used in the Local Jurisdiction’ (1989) 11 *EIPR* 440-448.

¹⁸¹ The Paris Convention contains rules of substantive law, which guarantee a basic right, known as the right to national treatment (Articles 2 and 3); the avowed purpose of national treatment is to ensure that, in any Convention Member State, there is no difference in the treatment of national IP right holders (or applicants) and foreign IP right holders (or applicants). See the overview of detailed information in WIPO, *supra* note at 37 and *supra* note 170.

¹⁸² For example, See Dilbary, S, J, ‘Famous Trademarks and the Rational Basis for Protecting “Irrational Beliefs”’ (2006) John M. Olin Law & Economics Working Paper No. 285. This paper is to be found at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=890632. (Last accessed on 19 January 2010).

¹⁸³ Articles 6 to 9 of the Paris Convention.

approximate the national level of intellectual property law to grant the same protection to signatory nations¹⁸⁴, it is of obvious import to this thesis. An examination of GATT TRIPS¹⁸⁵, the TLT¹⁸⁶ and the Singapore Treaty¹⁸⁷ will then follow.

As is made clear also in Sections 2.3.1-2.3.4, this author is aware of the importance of other legal factors in trade mark registration, such as public policy and administrative factors. As the focus of this thesis, and this chapter is, lies not in trade mark registrability *per se*, but the substantive legal definition of (well-known) trade mark, discussion of the full range of legal requirements for registering a trade mark is beyond the scope of this Chapter and this thesis.

2.3.1.1 The Paris Convention

It is submitted that the Paris Convention does not explicitly provide a definitive and comprehensive definition of ‘trade mark’¹⁸⁸. The author will apply the Definition Model to relevant provisions of the Convention in order to summarise and critique the guidance that is provided (or, that can be inferred) as to defining ‘trade mark’. Having said that the Paris Convention does not provide an explicit and comprehensive definition of ‘trade mark’, it clearly does speak indirectly to selected aspects of *form* and *concept* of ‘trade mark’¹⁸⁹. However, it is interesting to note at this stage that no *preconditions*, namely *graphic representation* or *commercial use*, are explicitly set out herein.

The Definition Model introduced in Section 2.2 is employed to analyse the Paris Convention definition, as follows. The first point to be made about the Paris

¹⁸⁴ WIPO, ‘Summary of the Paris Convention for the Protection of industrial Property (1883)’. This summary is to be found at http://www.wipo.int/treaties/en/ip/paris/summary_paris.html. (Last accessed on 12 January 2010). See *supra* note 149.

¹⁸⁵ See Section 2.3.1.4.

¹⁸⁶ See Section 2.3.1.2.

¹⁸⁷ See Section 2.3.1.3.

¹⁸⁸ Relevant Articles relating to protection of ‘trade mark’ and thus ‘well-known trade mark’ are 6bis, 6ter, 6quinquies, 6sexies, 7, 7bis and 8 of the Paris Convention.

¹⁸⁹ See for example, the protection afforded to service marks in Article 6sexies, collective marks in Article 7bis, and trade names in Article 8 of the Paris Convention.

Convention is that it is made clear¹⁹⁰ that the nexus of trade mark registrability is national (in this, it is therefore possible to conclude that, the Convention can be seen as encouraging a certain flexibility, and certainly allows for an expansionist approach to registrability at the local level). More specifically, *context in form* of ‘trade mark’ can thus be said to specifically include: indications of source or appellations of origin¹⁹¹; well-known trade marks¹⁹²; service marks¹⁹³; collective marks¹⁹⁴, and trade names¹⁹⁵ (consideration of marks registered in a bad faith¹⁹⁶ and marks which are against morality or public order and may deceive the public¹⁹⁷ is beyond the scope of this thesis, as per Section 2.3.1 above). It is also submitted that the specific examples of *context in form* that are listed¹⁹⁸ – state emblems¹⁹⁹, official hallmarks²⁰⁰ and emblems of intergovernmental organisations²⁰¹ – are similarly beyond the scope of this thesis). It is submitted that, aside from the mention of ‘signs and indications’²⁰² the real guidance provided as to trade mark *types of form* is Article 6(1): ‘The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation’, i.e. the Convention is silent on *type*, and this is left for national law.

Concept of ‘trade mark’ is both indirectly stated and is implicit within the Paris Convention²⁰³ as follows: marks, which are “...devoid of any distinctive character”²⁰⁴; and marks which “...consist exclusively of signs or indications which may serve, *in trade*, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in

¹⁹⁰ *Ibid*, Article 6(1).

¹⁹¹ *Ibid*, Article 1(2).

¹⁹² *Ibid*, Article 6bis.

¹⁹³ *Ibid*, Article 6sexies. Service marks are recognised, but there is no obligation to protect them.

¹⁹⁴ *Ibid*, Article 7bis.

¹⁹⁵ *Ibid*, Article 8.

¹⁹⁶ *Ibid*, Article 6septies.

¹⁹⁷ The author of this thesis argues that morality and public order issues are not primarily *concepts* of trade marks, therefore the detailed analysis of morality and public order is beyond the scope of this thesis.

¹⁹⁸ It is assumed by this author that these cannot be granted as registered trade marks on the ground of public policy.

¹⁹⁹ Article 6ter(1)(a) of the Paris Convention.

²⁰⁰ *Ibid*.

²⁰¹ *Ibid*, Article 6ter(1)(b).

²⁰² *Ibid*, Article 6quinquies B(ii).

²⁰³ See Appendix 1: Defining ‘Trade Mark’ for an overview of the Paris Convention.

²⁰⁴ Article 6quinquies B(ii) of the Paris Convention.

the current language...²⁰⁵. Thus it can be concluded that ‘distinctiveness’ is the *concept* of ‘trade mark’ within the Paris Convention. It is submitted, however, that the Paris Convention does not provide the sort of clear and explicit definition of the *concept* of ‘trade mark’ that this author would like to see, although the list of non-registered categories of trade marks²⁰⁶ (which themselves have an implicit connection with ‘distinctiveness’) is instructive.

To summarise, the Paris Convention addresses criteria that fall into both the *context* in *form* and *concept* elements of the Definition Model of ‘trade mark’. Whereas *type of form* can be seen as largely being left for national law, the same might be said for the *preconditions, graphic representation* and *commercial use*, which are not explicitly present in the Paris Convention²⁰⁷.

2.3.1.2 The Trademark Law Treaty

There is a slightly different emphasis in the TLT²⁰⁸, wherein the following guidance of ‘trade mark’ is provided:

“Article 2(1) [Nature of Marks]

- (a) This Treaty shall apply to marks consisting of *visible signs*, provided that *only those Contracting Parties which accept for registration three-dimensional marks shall be obliged to apply this Treaty to such marks*.
- (b) This Treaty shall *not apply to hologram marks and to marks not consisting of visible signs, in particular, sound marks and olfactory marks*.

(2) [Kinds of Marks]

- (a) This Treaty *shall apply to marks relating to goods (trademarks) or services (service marks) or both goods and services*.
- (b) This Treaty *shall not apply to collective marks, certification marks and guarantee marks.*” [Emphasis added].

²⁰⁵ *Ibid.*

²⁰⁶ *Ibid.*

²⁰⁷ *Ibid.*, Article 6(1).

²⁰⁸ It should be reiterated here that the main aim of the TLT is to approximate and streamline national and regional trade mark registration procedures. See for example, WIPO, *supra* note 37 at 423.

Again, this treaty cannot be said, it is submitted, to provide a comprehensive definition of what a trade mark is, but, with reference to the Definition Model, it can be seen to provide further guidance as to *form* of ‘trade mark’, and interestingly one of the *preconditions* can be found in this instrument also. There is no real guidance as to *concept*, it is submitted. It is possible to say that, according to the TLT, *context* of *form* of trade mark consists of marks relating to goods²⁰⁹, service marks²¹⁰, but not collective marks²¹¹, certification marks²¹² and guarantee marks²¹³. *Type* of trade mark *form* requires *visible* marks, also includes three-dimensional marks²¹⁴ and excludes hologram marks, non-visible signs, sound marks, and olfactory marks²¹⁵. It should be also be highlighted that the TLT explicitly includes one of the *preconditions* of trade mark registration: that is visual representation within Article 2²¹⁶. It is submitted that this term is synonymous with the term preferred within the Definition Model, *graphic representation*.

Therefore, this author submits that under the TLT the actual scope of trade mark registrability (in particular, registrable *type* in *form*) is likely to be reduced *via* the criterion of *graphic* (visual) *representation*.

However, there is no explicit reference to what could be categorised as *concept* of ‘trade mark’. So it can be said that the TLT speaks mainly to *form* of ‘trade mark’ (although, as implied in the paragraph above, *graphic representation* may constitute a barrier to a generous and expansive approach to *type* in *form* to encompass so-called non-traditional marks) rather than detailed treatment of *concept*.

2.3.1.3 The Singapore Treaty

²⁰⁹ Article 2(2)(a) of the TLT.

²¹⁰ *Ibid.*

²¹¹ *Ibid.*

²¹² *Ibid.*

²¹³ *Ibid.*

²¹⁴ *Ibid.*

²¹⁵ *Ibid.*

²¹⁶ See the wording of Article 2(1) of the TLT.

The Singapore Treaty takes rather a similar approach to the TLT, and sets out the following:

“Article 2 Marks to Which the Treaty Applies

- (1) [Nature of Marks] Any contracting party shall apply this Treaty to marks consisting of *signs* that can be registered as marks under its law.
- (2) [Kinds of Marks]
 - (a) This Treaty *shall apply to* marks relating to *goods (trademarks) or services (service marks)* or both goods and services.
 - (b) This Treaty *shall not apply to collective marks, certification marks and guarantee marks.*” [Emphasis added].

It is submitted that the guidance on what constitutes a trade mark provided in the Singapore Treaty primarily focuses on *context of form* of ‘trade mark’ (e.g. service marks are protected,²¹⁷ but collective marks, certification marks, and guarantee marks are excluded from the ambit of the Treaty)²¹⁸. As opposed to the TLT²¹⁹, the Singapore Treaty applies generally to marks that can be registered under the law of a contracting party²²⁰. Further, it is in the Singapore Treaty that non-traditional marks²²¹ have first been explicitly recognised at the international level²²² as a

²¹⁷ Article 16 of the Singapore Treaty.

²¹⁸ The similarity between the TLT and the Singapore Treaty is pointed out within the WIPO’s Standing Committee’s document, ‘Representation and Description of Non-Traditional Marks: Possible Areas of Convergence’ (document SCT/19/2). The full text of this document is to be found at http://www.wipo.int/edocs/mdocs/sct/en/sct_19/sct_19_2.pdf. (Last accessed on 12 January 2010).

²¹⁹ Article 2(1) of the TLT.

²²⁰ This is of significance in relation to the international trade mark regime; the same principle is applied by the Paris Convention. The Singapore Treaty incorporates a more flexible concept of trade mark subject matter, largely because there is no requirement of *graphic representation* in the Singapore Treaty (Article 2(1) of the Singapore Treaty). Neither the Singapore Treaty nor the Paris Convention requires *graphic representations*; however this is for different reasons. The aim of the Singapore Treaty to provide the broader scope of trade mark subject matter, the Paris Convention does not attempt to provide the definition of trade mark. Also, collective marks, certification marks, and guarantee marks are specifically excluded from the Singapore Treaty, whilst collective marks are specifically protected in Article 7bis of the Paris Convention. The Paris Convention contains rules of substantive law which guarantee a basic right to national treatment in each of the Member States, which sets up the minimum standard of harmonisation and gives the capacity to each nation to adapt; the Singapore Treaty, on the other hand, provides the maximum standard of trade mark protection followed by its own purpose.

²²¹ Non-traditional trade marks are defined as a mark which cannot be graphically represented. Sandri, S, and Rizzo, S, ‘Non-Conventional Trade Marks?’ (2004) 138 *MIP* 8-10.

²²² As is noted in Section 2.3.1.2, the TLT is the first international instrument to note, albeit to exclude, sound and olfactory marks. See Article 2(1)(b) of the TLT.

protectable *type* (part of *form*) of ‘trade mark’ in an international trade mark law instrument. This author would like to note that she believes that an expansionist (or at least, flexible) approach of trade mark *form type* is appropriate. There is no reference to any of the *preconditions*.

Interestingly, the Singapore Treaty refers to marks as consisting of signs that can be registered as marks under national trade mark law²²³. In other words, if a nation’s trade mark law allows non-traditional marks (particularly a wider than usual range of *form type*) to be registered as trade marks, this is allowed for in the Singapore Treaty. Thus, it might well be said that potential at the international level for expansion of protectable trade mark *form* is inherent²²⁴ in the Singapore Treaty, *via* the legal flexibility to be found in Article 2(1).

Given this, it is perhaps unsurprising that ‘trade mark’ under the Singapore Treaty is explicitly stated to include a wide variety of *forms* of ‘trade mark’ such as holograms, three-dimensional marks, colour, position and movement marks, sound, olfactory, gustatory and tactile marks²²⁵. The Singapore Treaty might thus be expected to have an impact on *form* of ‘trade mark’ at the national level²²⁶. However, the number of signatory nations is just under 60²²⁷. In particular, this author would like to note that Japan is not yet a signatory nation of the Singapore Treaty. The Singapore Treaty is

²²³ Article 2(1) of the Singapore Treaty.

²²⁴ *Ibid.* See also, WIPO ‘Summary of the Singapore Treaty on the Law of Trademarks (2006)’. This document is to be found at http://www.wipo.int/treaties/en/ip/singapore/summary_singapore.html. (Last accessed on 12 January 2010).

²²⁵ Article 2(1) of the Singapore Treaty. See Barracough, E, ‘Introducing the Singapore Treaty’ (2006) 159 *MIP* 16-18.

²²⁶ In the 18th meeting held in 2008, the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) endorsed an agreement on areas of convergence on ‘non-traditional marks’, namely holograms and audio marks. Although the most recent meeting was held in June 2009, no major development with relation to non-traditional trade mark was made. See WIPO ‘Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 21st Session Geneva June 22 to 26, 2009’ (Document SCT/21/2). A full text of this report is to be found at http://www.wipo.int/edocs/mdocs/sct/en/sct_21/sct_21_2.pdf. (Last accessed on 12 January 2010). See also the historical development of this endorsement in a report entitled ‘Report on the 18th Session of WIPO’S Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications’ and SCT/18/2. The report in full to be found at http://www.wipo.int/edocs/sct_18_2.doc. (Last accessed on 12 January 2010).

See ‘WIPO activities: Singapore to host diplomatic conference on revised TLT’ (2006) 20 *WIPR* 17.

²²⁷ The contracting parties of June 18th 2009 include Australia, Spain, and the United States. A list of the contracting parties are to be found at Signatory nations of the Singapore Treaty include the United Kingdom, Italy, France, Spain, and most recently, the United States ratified in 2008. The full list of current signatory nations is to be found at http://www.wipo.int/treaties/en>ShowResults.jsp?lang=en&treaty_id=30. (Last accessed on 12 January 2010).

relatively new, so (this author speculates) its impact in providing an atmosphere for national re-consideration of expansion of *form* of ‘trade mark’ may be felt in the medium and long-term.

To summarise, in the Singapore treaty, similar to the TLT, the *form* of ‘trade mark’ seems to be the main concern, with no clear guidance of *concept* of ‘trade mark’ being explicitly present. However, this author submits that the main aim of the Singapore Treaty cannot be said to be the provision of a conceptual definition of ‘trade mark’ (or, indeed, ‘well-known trade mark’), so although deficient in terms of the Definition Model, the scope of the Singapore Treaty cannot be criticised in general terms. This author submits that, nevertheless, that (along with the TLT), the Singapore Treaty has a role to play in establishing at the international level an expansionist approach to *form* of ‘trade mark’.

2.3.1.4 GATT TRIPS

It is submitted by this author that GATT TRIPS appears to provide more detailed and instructive definition of ‘trade mark’, as compared to the international legal instruments considered thus far. The relevant Article in full is:

“Article 15(1) any *signs*, or any combination of signs capable of *distinguishing* the goods or services of one undertaking from those of other undertaking, shall be capable of constituting a trade mark, such signs, in particular, including *personal names, letters, numerals, figurative, elements and combinations of colours as well as any combinations of such signs* shall be eligible for registration as trade marks. Where *signs are not inherently capable of distinguishing* the relevant goods or service, members may make registrability *depend on distinctiveness acquired through use*. Member may require, as a condition of registration, that *signs be visually perceptible*.” [Emphasis added].

GATT TRIPS appears to provide the most comprehensive definition of ‘trade mark’²²⁸ at the international level, and, as can be seen in the extract above, attention is given to both *form* and *concept* (albeit in a slightly different manner from that used by the other international instruments²²⁹). Thus GATT TRIPS can be seen as somewhat standing out on its own in defining most fully the scope of registered trade marks²³⁰.

At this stage, the author would also like to highlight that GATT TRIPS provide a treatment to the *preconditions* of the Definition Model (see the explicit reference to visual perception (*graphic representation*))²³¹.

Returning to other aspects of the Definition Model, the following can be noted: within trade mark *form*, trade mark *context* can be seen to include trade marks²³², service marks,²³³ geographical indication might also be included herein²³⁴. Also within trade mark *form*, trade mark *type* is said to include: signs, words, personal names, letters, numbers and figurative marks, combination of colours, and combination of signs²³⁵. The scope of *form type* thus appears to be sufficiently flexible to include non-traditional trade marks such as scents, as well as the more traditional trade marks examples explicitly listed.

Concept of ‘trade mark’ within the Definition Model is noted in the phrase ‘signs, which are capable of *distinguishing*’. It is to be noted that Article 15(1) distinguishes between what might be conceptualised as inherent distinctiveness (‘capable of distinguishing’) and acquired distinctiveness (‘where signs are not inherently capable

²²⁸ See for example, Gervais, D, *supra* note 171, and Gervais, D, J, ‘The TRIPS Agreement: Interpretation and Implementation’ (1999) 21 *EIPR* 156-162 at 158.

²²⁹ Articles 6^{ter}, 6^{sexies}, 7^{bis} and 8 of the Paris Convention; Article 2 of the TLT; and Article 2 (1) of the Singapore Treaty.

²³⁰ Cornish, W, *supra* note 37 at 613. Rogers, D, ‘The TRIPS Regime of Trademarks and Designs’ (2007) 29 *EIPR* 76-78. Rangel-Ortiz, H, ‘Well-known Trademarks Under International Treaties: Part 1: Paris Convention and TRIPS’ (1997) 94 *TW* 14-16. McGrady, B, ‘TRIPS and Trademarks: The Case of Tobacco’ (2004) 3 *World T.R.* 53-82.

²³¹ Article 15(1) of GATT TRIPS. As noted earlier, this term is regarded as being synonymous with *graphic representation*. It should also be noted that this is set out as an optional criterion for registration in GATT TRIPS. It might well be possible to infer that implicitly *commercial use* may well be implicit in Articles 15(2) and 15(3) of GATT TRIPS. Albeit it is conceded that: (i) reference is made to mere ‘use’ and; (ii) Article 15(3) makes it clear that members may make registrability contingent on use.

²³² *Ibid*, Article 15(1).

²³³ The Paris Convention does not include service marks as a protectable trade mark *form*.

²³⁴ Article 22 of GATT TRIPS.

²³⁵ *Ibid*, Article 15(1).

of distinguishing the relevant goods or service, members may make registrability depend on distinctiveness acquired through use'). It is clear that GATT TRIPS requires inherent distinctiveness, but gives the option for signatory states to also recognise acquired distinctiveness. The implications here for the Definition Model are not clear to this author – does the mode of distinctiveness (inherent or acquired) matter for the Definition Model? Should this be a distinction recognised in the Definition Model? This author does speculate (but cannot comprehensively prove) that acquired distinctiveness, where substantial, could be what distinguishes a well-known trade mark from a trade mark. Thus this author concludes that although there may be little practical import for use of the Model in this thesis, she would like to introduce this distinction to the Definition Model (see Chapter 7, Section 7.2).

To briefly conclude, this author submits that in GATT TRIPS, reference is made to trade mark *form* and *concept*. Furthermore, it is submitted by this author that GATT TRIPS appears to offer the most detailed guidance to both *form* and *concept* of 'trade mark'. Moreover, GATT TRIPS does address the *preconditions* (albeit that *graphic representation* is presented as an optional criterion for signatory states). GATT TRIPS must, it is submitted, be seen in an historical context, with both *form* and *concept* of 'trade mark' evolving from the position as set out in the Paris Convention²³⁶. Whilst GATT TRIPS clearly provides more explicit guidance on both *form* and *concept* of 'trade mark', perhaps there is a little more guidance as distinctiveness (trade mark *concept*) in the Paris Convention²³⁷, where exemplars are provided. In terms of the *preconditions*, GATT TRIPS is clearly superior to the Paris Convention. Therefore, on balance, with reference to the Definition Model, GATT TRIPS seems to provide the clearest overall guidance as to the definition of 'trade mark'.

2.3.1.5 Comparison

Above, some comparative comments have been made in the description and critical analysis of the individual international legal instruments. Here, the author would like

²³⁶ See Section 2.3.1.1.

²³⁷ Article 6*quinquies* B(ii) of the Paris Convention.

to summarise the application of the Definition Model to the relevant international IP law instruments:

- *The Paris Convention.* Both an aspect of *form*, and, *concept* of ‘trade mark’ can be found, but the Convention would appear to be silent as to the *preconditions*. A trade mark is said to constitute a sign, which should not be devoid of distinctiveness (a negative definition, but one that is deemed by this author to be synonymous with the Definition Model definition of *concept*: ‘distinctiveness’). Exemplars of marks which are said not to be distinctive are helpfully provided, including: description of mere information of the goods/services, or mark which is customarily used. Furthermore, there is implicit confirmation of *concept* in the statement that distinctiveness may be lost by a trade mark becoming customary to consumers. Within trade mark *form*, elements of *context* that are registrable include service marks, collective marks and trade names. In terms of trade mark *form*, guidance as to *type* is limited to ‘signs and indications’, national law is presumably expected to regulate this area further. Exclusions from registration are noted, including marks which are contrary to morality or public order or are registered with bad faith: these, it is submitted, fall outside the Definition Model, being concerned with policy considerations rather than the definition of ‘trade mark’ *per se*. (Policy considerations similarly can explain the exclusion of state emblems, official hallmarks, emblems of intergovernmental organisations and so on, from registrability). Thus, the definition of ‘trade mark’ in the Paris Convention contains both *form* (with more detail on *context* than *type*) and *concept* elements from the Definition Model of ‘trade mark’, but not the *preconditions*.
- *The TLT.* Within the Definition Model, *form* of ‘trade mark’ is explicitly provided, and given reasonably detailed treatment, within the TLT, which states that a trade mark should be a visible²³⁸ sign and sound marks, olfactory marks, and marks not consisting of visible signs, hologram marks, collective marks, certification marks, and guarantee marks are excluded. However, trade

²³⁸ This explicitly reflects on of the *preconditions* of the Definition Model.

mark *concept* is absent – only *form* and one of the *preconditions – graphic representation* – are present in the definition of ‘trade mark’ offered in the TLT.

- *The Singapore Treaty*. Similar to the TLT, there is no explicit guidance on *concept* – here trade marks are said to be marks recognised under national law (it might be argued that there is, therefore, an implicit recognition of *concept*, but that presupposes that all current and intended future Singapore Treaty signatory countries’ national trade mark laws contain explicit mention of *concept*: a rather difficult argument to prove, so this author elects to conclude that there is no implicit recognition of *concept* in the Singapore Treaty). The *form* of ‘trade mark’ can be inferred in the Treaty, which explicitly excludes collective marks, certification marks, and guarantee marks. Like the TLT, not all elements of the Definition Model are present, with *concept* and *preconditions* here being absent, but there being some mention of *form*²³⁹.
- *GATT TRIPS*. Both *form* and *concept* of ‘trade mark’ are explicitly present, as is one of the *preconditions (graphic representation)*. GATT TRIPS, therefore, addresses all elements identified in the Full Definition Model (see Diagram 2, above), and in this, it exceeds the Paris Convention (see above). These elements can be found as follows: the first to note is *form*. Trade mark *type* is explicitly present, a trade mark being said to contain a sign including personal names, letters, numerals, figurative elements and combination of colour. Trade mark *context* as well as *type* is also explicit – registrable trade marks being said to include service marks and geographical indications. Second – *concept*: this is also explicitly addressed herein. A trade mark is a distinctive (*concept*) sign, which is capable of being distinguished from the other competitors in the same sector. It is additionally noted that distinctiveness can obtain through use of the mark. *Graphic representation*, as noted above, is also present (a *precondition*).

²³⁹ Thus, here, application of the Definition Model has made it very clear that not only that there are gaps in the definitions of ‘trade mark’ provided in the TLT and the Singapore Treaty, but it has allowed (what this author hopes) for a relatively clear *conceptualisation of what is missing* from these definitions. For more detailed analysis of the relevant provisions of these treaties, section 2.3.1.2 for the TLT and Section 2.3.1.3 for the Singapore Treaty.

A basic comparison of these international treaties, it can be argued, shows that the Singapore Treaty provides the broadest (and therefore the most generous) interpretation as to *form* of ‘trade mark’, whereas GATT TRIPS provides the narrowest *form* of ‘trade mark’. There are, thus, significant differences in the guidance as to what constitutes a trade mark in these international instruments. However, what is truly remarkable to this author is the very different approaches taken in the treaties to defining trade mark *concept*. Whilst some (for example, the Paris Convention and GATT TRIPS) do address trade mark *concept*²⁴⁰, others (for example, the TLT and the Singapore Treaty) concentrate on trade mark form and barely address trade mark concept²⁴¹. Why this might be the case is difficult to say, but it is interesting that no one international agreement provides a comprehensive definition of ‘trade mark’: each of these international instruments provides a subtly different definition of ‘trade mark’²⁴². It should be made clear that this inconsistency does not appear to be problematic in practice²⁴³.

In summary, this author would argue that, of these international instruments, the definition of trade mark to be found in GATT TRIPS is the most precise and clear; however, it should be noted here that the Paris Convention provides more concise guidance regarding *concept* (distinctiveness) *per se*.

Both the Paris Convention and GATT TRIPS address most of the criteria defined in the Definition Model, albeit, GATT TRIPS provides the fuller treatment. This author

²⁴⁰ I.e. providing conceptual guidance to what constitutes a trade mark – e.g. *sign*, *distinctiveness*, etc.

²⁴¹ I.e. focusing on trade mark subject matter – that service marks, collective marks and trade names are all permissible subject matter.

²⁴² See each purpose of the international treaties in Sections 2.3.1.1- 2.3.1.4.

²⁴³ See WIPO, *supra* note 37 at 423. Bomahrd, V, ‘Dormant Trade Marks in the European Union – Swords of Damocles?’ (2006) 96 *TMR* 1122-1136. Caravalho, N, P, D, *The TRIPS Regime of Trademarks and Designs* (London, Kluwer Law International, 2006). In this book, the author points out that harmonisation of legal norms that is a consequence of GATT TRIPS places limitations on the legislation the members can adopt. This is reviewed by Rogers, D, ‘The TRIPS Regime of Trademarks and Designs’ (2007) 29 *EIPR* 76-78. A Summary of the Paris Convention for the Protection of Industrial Property (1883), ‘Summary of the Trademark Law Treaty (TLT) (1994)’ and ‘Summary of the Singapore Treaty on the Law of Trademarks (2006)’ by the WIPO are to be found in respectively, http://www.wipo.int/treaties/en/ip/paris/summary_paris.html; http://www.wipo.int/treaties/en/ip/tlt/summary_tlt.html; <http://www.wipo.int/treaties/en/ip/singapore/summarysingapore.html>. (Last accessed on 12 January 2010).

thus believes a combination of GATT TRIPS and the Paris Convention trade mark definitions can be regarded as the most robust (although not the broadest) guidance at the international level as to the definition of ‘trade mark’, and this can be expressed in terms of the Definition Model thus:

- Trade mark *type in form*: signs and indications, including letters (including names), numerals, figurative elements and colour combinations, as well as any combinations of such signs;
- Trade mark *context in form*: trade marks, service marks, well-known trade marks, trade names, geographical indications, collective marks and indications of source or appellations of origin;
- Trade mark *concept*: distinctiveness, and;
- The *preconditions*: *graphic representation* (and use, if not full *commercial use*).

In particular, it would appear that in trade mark *context in form*, collective marks, certification marks, and guarantee marks are controversial subject matter, as under both the TLT²⁴⁴ and the Singapore Treaty regime²⁴⁵ they cannot be registered trade marks (albeit in GATT TRIPS they can be²⁴⁶). Interestingly, the Singapore Treaty, the most current international trade mark legal instrument, does not address any visibility or *geographic representation* registration requirements (the *preconditions*), but there is some implication that protectable subject matter might become broader.

Returning to the application of the Definition Model to the international trade mark regime, it can be submitted that according to this Model, the definition of ‘trade mark’ in the international trade mark regime is less cohesive and comprehensive than might have been hoped. Nevertheless, the various differences (and, in some cases, contradictory positions) in the international instruments do not appear to cause any problems in (local) practice. Indeed, some might argue that true substantive harmonisation in the international instruments as to the definition of ‘trade mark’ would be disadvantageous, that inconsistency here is actually an advantage and that

²⁴⁴ Article 2(2)(b) of the TLT.

²⁴⁵ Article 2(2)(b) of the Singapore Treaty.

²⁴⁶ Article 15(1) of GATT TRIPS.

trade mark law is²⁴⁷ and should²⁴⁸ remain, in terms of substantive legal guidance, a largely *national* (or local) system. Alternatively, perhaps the differing definitions of ‘trade mark’ offered can be seen as reflecting an evolving international consensus as to a broadening definition of ‘trade mark’ (and, perhaps, trade mark harmonisation?). It is, however, beyond the scope of this thesis to consider how representative the international trade mark regime is of national trade mark systems, so this author will not address these interesting questions further in this thesis. Nevertheless, it should be noted that identifying what constitutes a well-known trade mark (the focus of this thesis) would be somewhat easier if there were, first, a clear definition of ‘trade mark’ at the international level.

2.3.2 The Regional level – the EU

Having outlined how ‘trade mark’ is defined at the international level, the following two sections now turn to the two jurisdictions that form the focus of this thesis – the EU (considered in this Section) and, in Section 2.3.3 – Japan.

The entry into force of the Community Trade Mark Regulation²⁴⁹ on 14 March 1994 put the final seal on the establishment of a unified European trade mark system²⁵⁰ and the establishment of dual national and EU routes to registering trade marks in the EU²⁵¹. The focus of this thesis lies, however, with the EU (CTM), not the national

²⁴⁷ E.g., see Dinwoodie, G, B, ‘The Architecture of the International Intellectual Property System’ (2002) 77 *Chi.-Kent L. Rev* 993-1014. In the view of the author of this thesis, trade mark law variously exists at the national, regional and international levels, with each of these co-existing ‘levels’ having a distinct role. As trade mark law evolves over time, more substantive law-making appears to be taking place at the regional and international levels but, as noted above, much is still focused at the national level. In the case of well-known trade marks, this author submits that this is problematic; that the concept of the well-known trade mark requires a global approach and therefore should be regulated at the international level. This will be explored further in Chapter 3.

²⁴⁸ This author suggests with reference to the Definition Model, that at the level of the individual trade mark, both trade mark *form* (*type* and *context*) and *concept* have linguistic and cultural aspects that are specific and this specificity does correlate with national boundaries. Perhaps this is the difference with well-known trade marks: through use these have crossed such boundaries. In the view of this author, this cross over can be fully reflected by the following quotation: “people in places as diverse as Paris and Hong Kong, Khartoum and Tokyo, New York and Brasilia wear, drive and drink the same brands”. See McDermott, J, *Corporate Society* (Boulder, Westview Press, 1991) at 41.

²⁴⁹ Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.

²⁵⁰ Gielen, C, and Strowel, B, ‘The Benelux Trademark Act: A Guide to Trademark Law In Europe’ (1996) 86 *TMR* 543-575 at 543.

²⁵¹ The process of harmonisation of national trade mark laws in the EU states began in 1988 with the enactment of the EU Trade Mark Directive (First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to Trade Marks (89/104/EEC))

route to obtaining trade marks in Europe; therefore all comments and analysis on EU trade mark law in this thesis are, hereafter, confined to the CTM system unless specifically indicated otherwise. In relation to national trade mark laws, it should perhaps be noted here that the individual EU member states are signatory nations to the Paris Convention, GATT TRIPS, the TLT and, in some cases, the Singapore Treaty.

A brief summary of the CTM route to trade mark registration would, at this stage, be helpful. Essentially, the outcome of the CTM application is that a single trade mark application can be made which, if successful, enables the trade mark owner to exercise their rights throughout the EU Member States²⁵². The EU Member States²⁵³ whose national trade mark system continue to exist alongside the CTM, have largely ensured that their national trade mark laws are in line with the principle of the First Harmonisation Directive²⁵⁴ (the EU Trade Mark Directive)²⁵⁵. Indeed, the substantive provisions of the EU Trade Mark Directive and the CTMR are very similar (and in respect of key provisions relevant to this thesis – identical)²⁵⁶. Hence preliminary references made by national courts to the EU courts relating to the interpretation of the Directive may, it is submitted, also be useful in determining the approach of OHIM (Office for Harmonisation in the Internal Market (Trade marks and Designs)) the CFI (Court of First Instance) and the ECJ (European Court of Justice) to the CTM system (and *vice versa*)²⁵⁷. In short, although this thesis specifically excludes the national trade mark systems of the EU, reference will be made to the EU courts'

(OJ L 40, 11.2.1989). See Dinwoodie, G. B, 'The Integration of International and Domestic Intellectual Property Lawmaking' (2000) 23 *Colum.-VLA J.L. & Art* 307-315 at 307.

²⁵² See Article 1(2) of the CTMR. See also Cornish, W, and Llewelyn, D, *supra* note 37 at 671.

²⁵³ The current 27 EU Member States are, in alphabetical order, Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, and United Kingdom. Future candidates for the EU membership are announced: Croatia, Former Yugoslav Republic of Macedonia and Turkey. Information concerning EU Member States is available at http://europa.eu/abc/european_countries/candidate_countries/index_en.htm.

²⁵⁴ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (hereafter the EU Trade Mark Directive). The full text of the EU Directives is available at <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=CELEX:31989L0104:EN:HTML>. (Last accessed on 19 January 2010).

²⁵⁵ All EU Member States have ratified the Paris Convention and GATT TRIPS. Those treaties request Member States to provide a similar standard of intellectual property protection.

²⁵⁶ Cornish, W, and Llewelyn, D, *supra* note 37 at 671.

²⁵⁷ It is intended that Chapters 4 and 5 will contain limited reference to relevant national trade mark litigation in the EU in that Chapter's analysis of the CTM. The CTM/national trade mark systems with the limited reference to national law made in Chapter 5.

consideration of the EU Directive where this is felt to enhance understanding of parallel provisions in the CTMR. The author submits that such reference is appropriate.

Now this author turns to the definition of ‘trade mark’ in the CTM focusing solely on Article 4, which concerns signs of which a Community trade mark may consist. The CTMR provides explicit guidance²⁵⁸ here:

“Article 4: Signs of which a Community trade mark may consist
A Community trade mark may consist of *any signs* capable of *being represented graphically*, particularly words, *including personal names, designs, letters, numerals, the shape of goods or of their packaging*, provided that such signs are capable of *distinguishing the goods or services of one undertaking from those of other undertakings*.” [Emphasis added].

Applying the Definition Model, both *form* and *concept* are explicitly represented here. Trade mark *type* in *form* in the CTMR constitutes any signs, including symbols, logos, slogans, get-up, personal names, designs, letters, numerals and the shape of goods or of their packaging²⁵⁹. Elsewhere in the CTMR is clear that trade mark *context* in *form* includes trade marks, service marks, geographic marks²⁶⁰ and certification marks²⁶¹.

²⁵⁸ Some similarities between the CTMR and GATT TRIPS as follows; Article 4 of the CTMR Regulation and Article 15(1) of GATT TRIPS appear to be rather similar; ‘trade mark’ is defined both in the CTMR and GATT TRIPS as a sign which is capable of being distinguished, and being graphically represented including personal names, designs, letters and colours.

²⁵⁹ In this respect, the CTMR can be seen as being more innovative than international standards at the time of adoption. The TLT, which makes the first specific mention of three-dimensional marks was adopted in 1994 (interestingly, there is no explicit mention of such marks in GATT TRIPS – see Section 2.3.1.4), whilst the CTMR was adopted in 1988.

²⁶⁰ Geographical indication can be protected by Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (hereafter the GIs). GIs are names associated with products from a specific place when the geographic origin of the product gives its specific characteristics and quality. See O’Connor, B, ‘The EC Need Not Be Isolated on GIS’ (2007) 8 *EIPR* 303-306 at 303. A general view of GIs is seen in Bainbridge, D, ‘Changes to the Community Trade Mark’ (2004) 9 *I.P & I.T. Law* 18-20. The full text of this Regulation is to be found at http://europa.eu.int/eurlex/en/consleg/pdf/1992/en_1992R2081_do_001.pdf. Implementing regulations for Regulation 2081-92. However, the detailed examination of protection of geographical indication *per se* is beyond the scope of this thesis.

²⁶¹ Phillips, J, *supra* note 37 at 604.

Concept of ‘trade mark’ can be found in the criterion that signs have to be capable of *distinguishing* the goods or services of one undertaking from those of others: i.e. trade mark *concept* is distinctiveness. In contrast to the international regime, GATT TRIPS in particular, the CTMR does not provide further guidance as how to define trade mark *concept*.

In addition, one of the *preconditions* for trade mark registration is explicitly present within the CTMR: *graphic representation*. The other *precondition*, *commercial use*, is not explicitly present as a condition of registrability²⁶². Therefore, it can be said that the CTMR explicitly addresses almost all aspects of the Full Definition Model.

It should be emphasised at this point that, as in Article 15(1) of GATT TRIPS, an expansive approach to trade mark *form* is taken: Article 4 is worded so as to allow expansion of ‘trade mark’ beyond the examples listed²⁶³. Thus there is the potential for the scope of *form* of ‘trade mark’ to broaden over time, at least according to the wording of the CTMR²⁶⁴. Indeed, some commentators have argued that Article 4 should not be seen as limiting the *types* of signs that can be protected as a trade mark in the EU²⁶⁵. This author suggests that the aim of Article 4 is suggestive (to provide examples of both *type* and *context* in trade mark *form*²⁶⁶), not definitive²⁶⁷. This author suggests that taking an incremental expansive approach to trade mark *form* is useful, as this gives the law the capacity to be flexible. This author therefore hopes that other *forms* of trade mark could be protected in the CTM system in the future²⁶⁸.

²⁶² For further comment, and comparison on this point, please see Section 2.3.4.1.

²⁶³ Article 4 of the CTMR.

²⁶⁴ In time, the influence of the Singapore Treaty might be felt here – see Section 2.3.1.3. However, in the view of this author, thus far the ECJ has taken a restrictive, rather than expansive, approach to the scope of trade mark *form* (see for example the decision in *Sieckman* (Case C-273/00 *Sickmann v Dutsches Patent – Und Markenamt*: reported in [2003] RPC 38). In fact, under current ECJ jurisprudence, it is currently not possible to register two of the Article 4 exemplars of trade mark *form*: olfactory and gustatory marks.

²⁶⁵ Principally, Maniatis (Maniatis, S, *supra* note 37 at 61).

²⁶⁶ E.g., see Sandri, S, and Rizzo, S, ‘Non-Conventional Trade Marks?’ (2004) 138 *MIP* 8-10. Maniatis, S, *ibid* at 61.

²⁶⁷ As argued by, for example, Dunstan, S, ‘Smells and Shapes in the United Kingdom: Continuing Pitfalls of Non-Traditional Trademarks’ (2007) 197 *TW* 41-46. Hering, I, ‘Pushing at the Boundaries of Protection’ (2001) 114 *MIP* 23-32. Inglis, A, ‘Registrability and Enforcement of Inherently Non-distinctive Trade Marks in the United Kingdom’ (1997) 19 *EIPR* 138-141.

²⁶⁸ Here, see Phillips, J, ‘A Busy Year In Europe’s Courts’ (2004) 79 *MIP* 79-82 at 82.

This author would now like to consider whether there is, apart from Article 4, further guidance in the Regulation as to the definition of ‘trade mark’. It is submitted that Article 7 can be seen as playing a role in providing further implicit guidance of both *form* and *concept* of ‘trade mark’. Article 7 per se sets out a list of signs and trade marks which cannot be registered under the CTM system.

The relevant parts of Article 7 are as follows:

“Article 7(1) the following shall not be registered:

- (a) signs which do not conform to the requirements of Article 4;
- (b) trade marks which are *devoid of any distinctive character*;
- (c) trade marks which consist exclusively of signs or indications *which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service*;
- (d) trade marks which consist exclusively of signs or indications which have *become customary in the current language* or in the bona fide and established practices of the trade;
- (e) signs which consist exclusively of: (i) the shape which *results from the nature of the goods themselves*; or (ii) the shape of goods *which is necessary to obtain a technical result*; or (iii) the shape *which gives substantial value to the goods*;...

2. Paragraph 1 (b), (c) and (d) shall not apply if the trade mark *has become distinctive in relation to the goods or services* for which registration is requested in consequence of the use which has been made of it...” [Emphasis added]

It is submitted by this author that implicit guidance as to trade mark *concept* is to be found here. As has been seen, in Article 4, *concept* of ‘trade mark’ is explicitly set out as: “... signs, which are capable of *distinguishing the goods or services of one undertaking from those of other undertakings* ...”. Article 7 seems to provide further

guidance to trade mark *concept* by giving these (non-distinctive) exemplars (which are, themselves, similar to that found in the Paris Convention²⁶⁹).

Furthermore, it is submitted that *form (type and context)* of ‘trade mark’ are also implicitly present in Article 7, thus²⁷⁰:

“(h) trade marks which have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention;

(i) trade marks which include *badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention* and which are of *particular public interest*, unless the consent of the appropriate authorities to their registration has been given.

(j) trade marks for wines which contain or consist of a *geographical indication identifying wines or for spirits* which contain or consist of a geographical indication identifying spirits with respect to such wines or spirits not having that origin.

(k) trade marks which contain or *consist of a designation of origin or a geographical indication registered* in accordance with Regulation (EEC) No 2081/92 when they correspond to one of the situations covered by Article 13 of the said Regulation and regarding the same type of product, on condition that the application for registration of the trade mark has been submitted after the date of filing with the Commission of the application for registration of the designation of origin or geographical indication.” [Emphasis added by this author].

Thus, to summarise, applying the Definition Model to Article 7 of the CTMR in more detail, within trade mark *form, context*, which are not registrable signs, include geographical indications for wine and spirits²⁷¹, designations of origin or a geographical indication registered²⁷² in accordance with Regulation (EEC) No

²⁶⁹ Article 6*quinquies* B(ii) of the Paris Convention.

²⁷⁰ Here, items which are related to morality are excluded from the extract quoted. This author considers that marks which fall within Articles 7(1)(f) and (g) of the CTMR are excluded on public policy, rather than true definitional, grounds and thus similar provisions will not be considered in the *context* of the Definition Model.

²⁷¹ *Ibid*, Article 7(1)(j).

²⁷² *Ibid*, Article 7(1)(k).

2081/92²⁷³. Further, trade mark *types* in *form* that are not registrable includes signs or indications which may serve merely as an indication of origins and description of the goods²⁷⁴ the shape which results from the nature of the goods²⁷⁵, which is necessary to gain a technical result²⁷⁶, which gives substantial value²⁷⁷, badges, emblems or escutcheons²⁷⁸.

In short, Article 7 expands on Article 4 by setting out an explicit negative definition of trade mark *form* (please see the paragraph above), as well as implicit guidance as to what is not distinctive (and in this, guidance as to trade mark *concept*), namely: signs which are not distinctive²⁷⁹, are mere descriptions of the nature of the products²⁸⁰, become customary to the current languages²⁸¹. Additionally, the author would like to note that trade mark *concept* explicitly includes distinctiveness acquired through use²⁸². Thus in the CTMR, both implicit and explicit reference is made to both trade mark *form* and *concept*.

At this stage, the author would like to note one striking similarity between the Regulation and the international regime in this area (and utilises the Definition Model in this). This is a similarity in the approach taken by both the Paris Convention and the CTMR. For example, this can be seen within a negative definition of trade mark *form*: in both it is made clear that the following *forms* of ‘trade mark’ are not registrable: state emblems and hallmarks²⁸³ (consideration of registering marks which are against morality or public order and which may deceive the public is beyond the scope of this thesis), and *concept* of ‘trade mark’, such as any signs which are devoid of distinctiveness²⁸⁴.

²⁷³ Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

²⁷⁴ Article 7(1)(c) of the CTMR.

²⁷⁵ *Ibid*, Article 7(1)(e)(i).

²⁷⁶ *Ibid*, Article 7(1)(e)(ii).

²⁷⁷ *Ibid*, Article 7(1)(e)(iii).

²⁷⁸ *Ibid*, Article 7(1)(i).

²⁷⁹ *Ibid*, Article 7(1)(b).

²⁸⁰ *Ibid*, Article 7(1)(c).

²⁸¹ *Ibid*, Article 7(1)(d).

²⁸² *Ibid*, Article 7(3).

²⁸³ See Article 6ter of the Paris Convention. These are also known as the public consideration. It should be noted here that an examination of these criteria which are direct to public concern is beyond the scope of this thesis.

²⁸⁴ Article 7(1)(b) of the CTMR.

To summarise the arguments made thus far in this Chapter, it can be seen that the relevant international instruments, when viewed collectively, do contain reference to trade mark *form* and *concept* and the *preconditions* for trade mark registration. Individually, the international instruments variously refer to different elements of both *form* and *concept* of ‘trade mark’, with some also providing additional instruction, such as the *preconditions* for trade mark registration (*graphic representation*²⁸⁵ and *commercial use*²⁸⁶). In relation to the definition of ‘trade mark’ in the CTMR, it can be seen that trade mark *concept* and *form*, and one of the *preconditions* for trade mark registration, are present. Further, this author submits that the CTMR provides a reasonably full treatment of both *form* and *concept*, with the former (at least at surface reading, if not according to trade mark jurisprudence) allowing for further expansion. Similarities with aspects of the international regime can be seen: aspects of Article 4 of the CTMR can be seen as being rather similar to the approach taken in GATT TRIPS. There also appears to be a similar approach in terms of non-registrable *form* of ‘trade mark’ in the CTMR to that in the Paris Convention.

Now, the author’s attention turns to the Japanese trademark regime. In the Section below, the author will critically consider how ‘*syohyo*’ (trademark) is defined in the Japanese Trademark Act. When this exercise is completed, a critical comparison of these various international, the EU and the Japanese definitions of ‘trade mark’ (see 2.3.3 below) will be undertaken.

2.3.3 The National level – Japan

In this Section, the author will undertake an analysis of the Japanese Trademark Act. Please note that Japan has ratified both the Paris Convention²⁸⁷ and GATT TRIPS²⁸⁸ but not yet the Singapore Treaty. There is no regional trademark system in Japan which is akin to the CTM system.

²⁸⁵ See for example, Article 15(1) of GATT TRIPS.

²⁸⁶ Article 7(3) of the CTMR.

²⁸⁷ Japan has been a signatory of the Paris Convention since 1899. The internationalisation of the Japanese Trademark Act began in 1899. An Official Speech of the JPO; Kondo, T, ‘Roles of the Intellectual Property Rights System in Economic Development in the light of Japanese Economy’ 16 November 1999 in Tokyo. Tamura, Y, *Syohyo ho* (Tokyo, Kobun-do, 2004) at 433.

²⁸⁸ The Japanese Trademark Act was amended in 1994 to sign the GATT TRIPS Agreement. Ozima, ‘A TRIPS Agreement (Nippon Kikai Yushitsu Kiko, 1999) at 16. Kondo, T, ‘The Development of the Internationalisation of the Japanese Trademark Law’ (2000) at the Trademark Conference in Tokyo.

The Cabinet Secretariat English translation²⁸⁹ of the Japanese Trademark Act²⁹⁰ defines *syohyo* as follows:

“Article 2 (Definitions, etc.)

(1) ‘Trademark’ in this Act means *any character(s), figure(s), sign(s) or three-dimensional shape(s), or any combination thereof, or any combination thereof with colours* (hereinafter referred to as ‘mark’) which are:

(1) *used in connection with the goods* of a person who produces, certifies or assigns the goods as *a business*; or

(2) *used in connection with the services* of a person who provides or certifies the services *as a business* (except those provided for in the preceding item).”

[Emphasis added]

As this illustrates, a definition of ‘*syohyo*’ in Japan is explicitly provided in the Act: the extent to which this definition fits within the Definition Model will now be critically considered.

The scope of trade mark *type in form* of ‘*syohyo*’ to be found in the Act can be noted: characters, figures, signs, three-dimensional shapes or any combination thereof. It is

²⁸⁹ This author considers the Cabinet Secretariat English translation of Article 2 as the authorised translation of the Japanese Trademark Act. However, this is not the case for all provisions in the Japanese trademark act and there seems to be a difficulty in giving the most accurate translation. For instance, in the view of this author, an English translation of Article 2 does not use the term ‘sign’ in the same context as the international and the EU law. A ‘sign’ in Article 2 seems to this author, more like symbols, since the scope of signs is broader than that of symbol. However, the sign in the international and EU context is implicit in the Japanese term *syohyo*. Understanding the Japanese etymology is rather important in order to examine the Japanese laws and its lack is highly likely to cause disadvantages for non-Japanese speakers, since they are incapable of reading the Japanese *kanji* scripts and, thus incapable of comprehending all the implications of the Japanese characters. Therefore, it would be of benefit for a more detailed English translation of the law to be reproduced.

²⁹⁰ Act No.127 of 1959 last amended by Act No.16 of 2008. It is important to be clear here: only the original Japanese language version of the Trademark Act is official and considered to be legally binding, therefore it is this text that is analysed in this thesis. In deference to non-Japanese speakers, the author will also refer to the unofficial Cabinet Secretariat translation, but where this appears inaccurate or abbreviated; the author will provide her own translation, in addition. The original Japanese act is as follows: “(定義等) 第2条 この法律で「商標」とは、文字、図形、記号若しくは立体的形状若しくはこれらの結合又はこれらと色彩との結合(以下「標章」といふ。)であつて、次に掲げるものをいう。1. 業として商品を生産し、証明し、又は譲渡する者がその商品について使用をするもの 2. 業として役務を提供し、又は証明する者がその役務について使用をするもの(前号に掲げるものを除く。)”

noteworthy that a ‘sign’ is identified as the only trade mark *type* in trade mark *form* in the international and the EU trade mark regimes, whilst in Japan, it appears not to be the case; it seems as if ‘sign’ is just one among many such narrow *types*, according to the English translation of the Japanese Trademark Act²⁹¹.

Trade mark *context* in *form* of ‘syohyo’ can be summarised as comprising trade marks or goods marks with a trade mark attached to the goods, and service marks. In the view of this author, comparison with the relevant international laws²⁹² and the CTMR²⁹³ shows the Japanese Trademark Act as providing a quite detailed explicit (if narrow) treatment of *form* of ‘syohyo’. However, *concept* of ‘syohyo’ – distinctiveness – is not explicitly set out at all in the Japanese Act. Although the Japanese Trademark Act is not alone in failing to explicitly address *concept* – as has been already seen, the TLT²⁹⁴ and the Singapore Treaty²⁹⁵ also do not explicitly address trade mark *concept* – this is an important point, and one which the author will return later in this Section.

Returning now to the scope of *syohyo form* as outlined in Article 2, it is clear to this author that *form* appears to be significantly narrower than that of equivalent provisions in the CTM system and also narrower than that set out in the (collective) international regime. There are three additional points to be made in relation to *syohyo form*. First, this author would like to alert the reader to the fact that the JPO is currently considering expansion of the scope of *syohyo* subject matter to include movement marks and sound marks²⁹⁶. So, some expansion in *syohyo form* in Japan is likely to take place in the near future.

²⁹¹ In fact, the unofficial English translation of the Japanese Trademark Act is not considered to be entirely accurate by this author. She considers that the inclusion in this translated Act of ‘sign’ as one of the sub-categories of *type* is misleading. Her view is supported when one considers ‘sign’ in a linguistic context, etymological analysis of the Japanese symbol for ‘trademark’ reveals that the notion of ‘sign’ is implicit to *syohyo*. Thus, it appears, that it would be more correct for ‘sign’ not to be regarded as one of the sub-categories of *syohyo* to be found in Article 2(1) of the Japanese Act.

²⁹² See Section 2.3.1.1 for the Paris Convention; Section 2.3.1.4 for GATT TRIPS.

²⁹³ See Article 4 of the CTMR and Section 2.3.2 for the further information regarding the CTMR.

²⁹⁴ See Section 2.3.1.2.

²⁹⁵ See Section 2.3.1.3 for the Singapore Treaty. However, the author does not consider that the aims of both the TLT and the Singapore Treaty would require explicit reference to trade mark *concept*.

²⁹⁶ *Infra* notes 997 and 1221. In June 2009, the JPO officially announced a consideration of broadening the trademark subject matter to non-traditional trademarks; i.e. movement marks and sound marks. See the JPO press release *Sangyo kozo shingikai ni working group wo seccchishi, ugoki oto tou wo riyoushita atarashii type no syohyo nitsuite kennto wo kaishi shimashita*: here, the JPO has announced that it has started consideration of new types of trademarks, including movement marks and sound

Second, a later provision in the Act provides a negative list of *syohyo form* – this is to be found in Article 4 of the Japanese Trademark Act²⁹⁷:

“Article 4 (Unregisterable trademarks)

(1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

- (1) is identical with, or similar to, the national flag, the imperial chrysanthemum crest, a decoration, a medal or a foreign national flag;
- (2) is identical with, or similar to, the coats of arms or any other State emblems (except national flags of any country of the Union to the Paris Convention, member of the World Trade Organization or Contracting Party to the Trademark Law Treaty) of a country of the Union to the Paris Convention (refers to the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at the Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958 and at Stockholm on July 14, 1967; the same shall apply hereinafter), a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty designated by the Minister of Economy, Trade and Industry;
- (3) is identical with, or similar to, a mark indicating the United Nations or any other international organization which has been designated by the Minister of Economy, Trade and Industry;

marks, by setting up a working group under the industrial structure committee’ (no longer available on website). The author of this thesis would like to note here her own speculation that the outcome of this consideration is highly likely to be that non-traditional trademarks will be available for registration as trademarks in Japan. Factors supporting her speculation are the impact of the TLT and the Singapore Treaty on Japan, and, Japanese membership of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (the SCT), a body that has produced ‘The Representation and Description of Non-Traditional Marks: Possible Areas of Convergence’ (made by the Nineteenth Session Geneva, July 21 to 25, 2008). A full text of this SCT document is to be found at http://www.wipo.int/edocs/mdocs/sct/en/sct_19/sct_19_2.pdf. (Last accessed on 12 January 2010).

²⁹⁷ Here, items which are related to morality are not considered in the context of the Definition Model, as this author considers that the basis of the exclusion of marks which are listed in (f)-(k) stems from public policy reasons rather than from the definition of ‘trade mark’ *per se*. Similar exclusions founded on public policy can be found in the CTMR (see *supra* note 267).

- (4) is identical with, or similar to, the emblems or titles in Article 1 of the Act Concerning Restriction on the Use of Emblems and Titles of the Red Cross and Others (Act No.159 of 1947) or the distinctive emblem in Article 158(1) of the Act Concerning Measures to Protect Japanese Citizens During Armed Attacks and Others (Act No.112 of 2004);
- (5) is comprised of a mark identical with, or similar to, an official hallmark or sign indicating control or warranty by the national or a local government of Japan, a country of the Union to the Paris Convention, a member of the World Trade Organization or a Contracting Party to the Trademark Law Treaty which has been designated by the Minister of Economy, Trade and Industry, if such a trademark is used in connection with goods or services identical with, or similar to, the goods or services in connection with which the hallmark or sign is used;
- (6) is identical with, or similar to, a famous mark indicating the State, a local government, an agency thereof, a non-profit organization undertaking a business for public interest, or a non-profit enterprise undertaking a business for public interest;
- (7) is likely to cause damage to public policy;
- (8) contains the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person, or famous abbreviation thereof (except those the registration of which has been approved by the person concerned);”

Thus, we can conclude from Article 4 that the following marks are excluded from registration:

- (a) From trade mark *type in form*: the national flag, the imperial chrysanthemum crest, a decoration, a medal or a foreign national flag²⁹⁸, any state emblems²⁹⁹; marks indicating the United Nations or any other international organization³⁰⁰;

²⁹⁸ Article 4(1) of the Japanese Trademark Act.

²⁹⁹ *Ibid*, Article 4(2).

³⁰⁰ *Ibid*, Article 4(3).

and the emblems or titles³⁰¹; the portrait of another person, or the name, famous pseudonym, professional name or pen name of another person³⁰²;

(b) From trade mark *context* in *form*: official hallmarks³⁰³; any famous the State, a local government mark³⁰⁴; marks which are detrimental to public policy³⁰⁵.

Nevertheless, the subject matter of Article 4 is felt to mainly stem from public policy, rather than true trade mark definitional, considerations, therefore is outside the scope of the Definition Model.

Thirdly, Article 2 of the Japanese Trademark Act is in fact supplemented by Trade Mark Registry Guidance³⁰⁶ which includes further examples of registrable trade marks: this indicates that the scope of *syohyo type* and *context in form* is slightly wider than is indicated by Article 2 alone. For example: *syohyo type* is said to include: character marks³⁰⁷, design marks³⁰⁸, symbol marks³⁰⁹, colour marks, three-dimensional marks³¹⁰, combined marks with colours. *Syohyo context in form* of ‘trade mark’ is similarly broader, including: merchandising marks³¹¹, service marks³¹²,

³⁰¹ *Ibid*, Article 4(4).

³⁰² *Ibid*, Article 4(8).

³⁰³ *Ibid*, Article 4(6).

³⁰⁴ *Ibid*, Article 4(9).

³⁰⁵ *Ibid*, Article 4(7).

³⁰⁶ Ono, S, Overview of Japanese Trademark Law (Tokyo, Seirin-syoin, 2005) at 25-30.

³⁰⁷ 文字商標 (*Moji-syohyo*); the author translates this as characters marks such as SONY.

³⁰⁸ That is 図形商標 (*Zukei-syohyo*); the author translates this as referring to design marks, an example of such being the MITSUBISHI Logo .

³⁰⁹ That is 記号商標 (*Kigo-syohyo*); the author translates this as referring to symbol marks, an example of such being the ‘LOUIS VUITTON’ symbol ‘LV’ .

³¹⁰ That is 立体商標 (*Rittai-syohyo*); the author translates this as referring to three-dimensional marks. Three-dimensional marks have been recognised as trademarks rather recently; although proving the distinctiveness in three dimensional marks has become an obstacle for trademark registration in practice. Intellectual Property High Court, Heisei 17nen, (Gyo Ke) 10673. A three-dimensional shape of a chic was disputed. In the case, the Intellectual Property High Court concluded that the three-dimensional shape of a chic lacks the distinctiveness required to be a registered trademark. The official English translation of this case is not available; therefore, a brief summary of this case in English done by the author is introduced. From this decision, it might be considered that distinctiveness, which is required in the Japanese Trademark Act, appears significantly high. IP News, ‘Registrability of a Three Dimensional Chic Shape in JPO’ (11 August 2005). http://news.braina.com/2005/0811/judge_20050811_001.html. An English translation is not available.

³¹¹ That is 商品商標 (*Syohin-syohyo*); the author translates this as referring to goods marks, an example of such being the ‘SHISEIDO’ mark.

³¹² That is 役務商標 (*Yakumu-syohyo*); the author translates this as referring to service marks, examples of such being ‘JAL’ or ‘ANA’.

business marks³¹³, collective marks³¹⁴, grade marks³¹⁵, manufacturer marks³¹⁶, retailer marks³¹⁷, house marks³¹⁸, certification marks³¹⁹, family marks³²⁰, coined marks³²¹, stock marks³²², promotional marks³²³.

However, although the scope of *syohyo form* in the Japanese law is somewhat broader than would first appear, it is submitted that it is still quite narrow in scope and that there are three substantial differences between the Japanese law and that of the EU and (collectively) the international regime in relation to the Definition Model here. First, with respect to *syohyo form*, there is no explicit reference to ‘sign’ in a broad context: instead, reference is made to ‘sign’ in a narrower context, alongside concepts such as characters and figures. In contrast, in the EU CTM and GATT TRIPS³²⁴, the TLT³²⁵ and the Singapore Treaty³²⁶, the broader *concept* of ‘sign’ appears to be explicit and the sole element of *syohyo form* within the Definition Model. Although this might be seen as a significant difference, this author has already noted (and does explain in the etymological analysis of *syohyo* to be found below) that ‘sign’ is in fact implicit in the Japanese symbols for ‘trademark’. The author submits that poor translation of Japanese to English is the reason for the explicit and misleading use of

³¹³ That is 営業商標 (*Eigyo-syohyo*); house mark is a part of business mark; the author translates this as referring to business marks, examples of such being ‘TOSHIBA’, ‘SEIKO’, and ‘SONY’.

³¹⁴ That is 団体商標 (*Dandai-syohyo*); collective marks, grade marks, certification marks and guarantee marks are protectable trademark subject matter whereas those are not in the TLT or the Singapore Treaty.

³¹⁵ That is 等級商標 (*Tokyu-syohyo*); the author translates this as referring to grade marks, examples of such being ‘NISSAN GLORIA’, ‘NISSAN TURISMO’, ‘NISSAN CUSTOM’, and ‘NISSAN CLASSIC’.

³¹⁶ That is 製造標 (*Seizo-syohyo*); the author translates this as referring to manufacturer marks, an example of such being a ‘MUJI’ logo.

³¹⁷ That is 販売標 (*Hanbai-hyo*); the author translates this as referring to retailer marks, examples of such being ‘UNIQLO’ or ‘MUJI’.

³¹⁸ That is 社標 (*Sya-hyo*); the author translates this as referring to house marks or company marks, examples of such being ‘MITSUBUSHI’, ‘HONDA’.

³¹⁹ That is 証明標 (*Syomei-hyo*) the author translates this as referring to certification marks, an example of such being ‘JAS’ mark.

³²⁰ That is ファミリーマーク; 派生商標 (family mark: *hasei-syohyo*) the author translates this as referring to family marks, ‘NINTENDO WII’ or ‘SONY VAIO’.

³²¹ That is 造語商標 (*Zougo-syohyo*) the author translates this as referring to coined marks, examples of such being ‘HELLO KITTY’ and ‘SANRIO’.

³²² That is 貯蔵商標 (*Vorratszeichen: Chozou-syohyo*); the author translates this as referring to marks not in current use.

³²³ That is 広告商標 (*Koukoku-syohyo*); the author translates this as referring to advertising marks, an example of such being ‘TOUCH GENERATIONS!’ by ‘NINTENDO DS’.

³²⁴ Article 15(1) of GATT TRIPS.

³²⁵ Article 1 of the TLT.

³²⁶ Article 2(1) of the Singapore Treaty.

the word ‘sign’ in Article 2(1)³²⁷, and that to the Japanese reader it is linguistically implicit that the concept of ‘sign’ is broader than is indicated in the English language translation of Article 2(1). She submits, therefore, that the differences between the Japanese and the CTM (and international) approaches to trade mark *form* are not as marked as would first appear (although, as concluded below, the scope of *syohyo form* is clearly narrower than that of the CTM trade mark *form*).

Before turning to a more detailed consideration of *syohyo concept*, the author would like to address one of the other elements of the Definition Model explicitly present in the Japanese Act. Indeed, this is a rather interesting aspect of the Japanese Trademark Act: the treatment of one of the *preconditions* for trade mark registration, that of *commercial use*³²⁸. The *commercial use* point will be further considered in the paragraph below.

In the view of this author, the Japanese trademark regime seems to have a singularly strong emphasis on *commercial use*³²⁹, an emphasis that is not reflected in either the EU³³⁰ or international regimes³³¹ where (in contrast) there is reference to use, but this is either not *required* to be a *precondition* of registration (the international regime) or is more a matter for revocation (the EU regime³³²).

³²⁷ See *supra* note 286.

³²⁸ Article 2 of the Japanese Trademark Act.

³²⁹ The requirement of the *commercial use* is clearly present within Article 2(3) of the Japanese Trademark Act. Article 2(3) provides that: “(3) “Use” with respect to a mark as used in this Act means any of the following acts: (1) to affix a mark to goods or packages of goods; (2) to assign, deliver, display for the purpose of assignment or delivery, export, import or provide through an electric telecommunication line, goods or packages of goods to which a mark is affixed; (3) in the course of the provision of services, to affix a mark to articles to be used by a person who receives the said services (including articles to be assigned or loaned; the same shall apply hereinafter); (4) in the course of the provision of services, to provide the said services by using articles to which a mark is affixed and which are to be used by a person who receives the said services; (5) for the purpose of providing services, to display articles to be used for the provision of the services (including articles to be used by a person who receives the services in the course of the provision of services; the same shall apply hereinafter) to which a mark is affixed; (6) in the course of the provision of services, to affix a mark to articles pertaining to the provision of the said services belonging to a person who receives the services; (7) in the course of the provision of services through an image viewer, by using an electromagnetic device (an electromagnetic device shall refer to any electronic, magnetic or other method that is not recognizable by human perception; the same shall apply in the following item), to provide the said services by displaying a mark on the image viewer; or (8) to display or distribute advertisement materials, price lists or transaction documents relating to goods or services to which a mark is affixed, or to provide information on such content, to which a mark is affixed by an electromagnetic device.”

³³⁰ See Article 15 of the CTMR. See also Section 2.3.2 above.

³³¹ See for example Article 15(3) of GATT TRIPS. See also See Section 2.3.1.4. above.

³³² See Article 50 of the CTMR.

A rather different position is to be found in relation to the other *precondition*, *graphic representation*. Article 2 does not explicitly require *graphic representation*³³³ or visual perception³³⁴ as a *precondition* for trade mark registration (here there is a direct contrast with Article 4 of the CTMR³³⁵ and Article 15(1) of GATT TRIPS³³⁶).

However, this author submits that it is generally understood that a mark must be displayed visually in a plane or three-dimensional form with respect to goods or services in Japan³³⁷: i.e. graphic representation is an *implicit* requirement, so in practice the Japanese law here is similar to both the EU requirements³³⁸ and the requirements to be found at the international level³³⁹. This implicit legal requirement is bolstered by administrative requirements in the Japanese system (Article 5(2) requires submission of an application form, upon which the *syohyo* for which registration is sought is to be shown³⁴⁰). As a consequence of the implicit criterion of *graphic representation* in Japan, sound, light, taste or smell marks cannot be registered as *syohyo*³⁴¹. In summary, this author submits that the *graphic representation* requirement is both legally and administratively implicit³⁴² in the Japanese regime.

Now, the author would like to turn to *concept* of ‘*syohyo*’ in the Japanese law. As has been noted above, there is no explicit reference to a criterion of distinctiveness within the English translation of Article 1 of the Japanese Trademark Act, (which is itself the equivalent to Article 4 of the CTMR³⁴³ and Article 15(1) of GATT TRIPS³⁴⁴). In relation to *concept* of ‘trade mark’ within the Definition Model, this author has

³³³ *Ibid*, Article 4.

³³⁴ Article 15(1) of GATT TRIPS and Article 2(1) of the TLT.

³³⁵ See Section 2.3.2.

³³⁶ See Section 2.3.1.4.

³³⁷ Article 5(2) of the Japanese Trademark Act.

³³⁸ Article 4 of the CTMR.

³³⁹ Article 15(1) of GATT TRIPS and Article 2(1) of the TLT.

³⁴⁰ “Article 5: (Application for trademark registration): (1) Any person who desires to register a trademark shall *submit an application* to the Commissioner of the Patent Office accompanied by the required documents. The application shall state the following matters: (1) the name and the domicile or residence of the applicant for trademark registration; (2) *the trademark for which registration is sought*; and (3) the designated goods or designated services and the class of goods or services provided by Cabinet Order as provided for in Article 6(2)”. [Emphasis added].

³⁴¹ Sound trademarks are recognised under the Unfair Competition Prevention Act in Japan though not approved as registered trademarks in the Japanese Trademark Act. Remarkably, the sound of ‘HARLEY DAVIDSON’ (motor bikes) was regarded as a distinctive mark in the Unfair Competition Prevention Act (Tokyo District Court, Syowa 55nen 1gatsu 28 nichi, Mutaishi-shu 5562go at 42).

³⁴² Article 5 of the Japanese Trademark Act.

³⁴³ See Section 2.3.2.

³⁴⁴ See Section 2.3.1.4.

previously submitted that distinctiveness is at the heart of the definition of ‘trade mark’³⁴⁵. As there is no explicit *concept* of ‘syohyo’, the Japanese Act would appear to both contradict the Definition Model and contrast sharply with the international³⁴⁶ and EU³⁴⁷ trade mark regimes on this point, however, utilising the methodology of etymology, it is submitted, the author is able to provide further insight into the approach to *syohyo concept* in the Japanese Law. This is provided in the next paragraph.

By way of introduction, it should be noted that it is not only *syohyo concept* that benefits from a consideration of linguistic context here. The arguments of linguistically implicit criteria in the Japanese Trademark Act that are made in this thesis are, to the knowledge of this author, novel and, in the view of this author, one of the contributions that this thesis makes to the literature. Returning to *syohyo concept*, at issue is the fact that the Cabinet Secretariat’s English translation of Article 2 of the Japanese Trademark Act contains no explicit reference to distinctiveness or an analogous concept. However, this author submits that distinctiveness is clearly *linguistically implicit* in the Japanese Trademark Act.

This is clear to the fluent Japanese reader of the official version of the Law, as distinctiveness is conceptually implicit³⁴⁸ in the written Japanese symbol for ‘trademark’. The etymology of the *Kanji* symbols for ‘trademark’ implies not only ‘distinctiveness’, but also implies other concepts too. Thus: ‘商標’ (trademark, or *syohyo*) consists of two *Kanji* symbols, (1) 商 (*Syo*) and (2) 標 (*Hyo*). *Syo* implies *business*, trade and commerce³⁴⁹ and *Hyo* represents signs, symbols, marks, or indications³⁵⁰, and, also implies distinctiveness³⁵¹. Japanese speakers, thus, automatically read ‘syohyo’ not only as ‘trademark’ but also referring to distinctive signs used in a business (and/or commercial) context³⁵².

³⁴⁵ See Chapter 1, Section 1.7, and Section 2.2.2.

³⁴⁶ See Section 2.3.1.

³⁴⁷ See Section 2.3.2.

³⁴⁸ See Chapter 1, Section 1.5 for a brief explanation of written Japanese.

³⁴⁹ Shinnmura, I, *Koji-en* (Tokyo, Iwanami-syoten, 1998) at 1298. *Koji-en* is regarded as the most authoritative dictionary amongst Japanese citizens.

³⁵⁰ *Ibid* at 2274. See also page 69, above.

³⁵¹ *Ibid* at 1298.

³⁵² Thus: (i) not only is ‘sign’. Further, (ii) not only is *commercial use* explicitly present in the Japanese regime, it is linguistically implicit also (see page 51, above).

So, not only does use of etymological methodology clarify that there is an implicit distinctiveness criterion in the Japanese trademark regime, it is revealed that: (i) the concept of ‘sign’ is implicitly used in a broad sense in the Japanese system (as well as the explicit, confusing and (it is submitted by this author) incorrect reference to ‘sign’ in a narrow context in Article 2(1), and; (ii) there is implicit (as well as explicit) reference to commercial use. This author submits that considering the linguistic context of ‘trademark’ does enrich one’s understanding of how this term is defined

Alert to potential criticism that etymological methodology might not be regarded as a traditional means of legal analysis, the author has also looked elsewhere in the Japanese Act for support for her submission that *syohyo concept* (distinctiveness) is implicitly present in the Act.

It is submitted that consideration of Article 3 of the Japanese Trademark Act may also be used to provide support for the argument that there is an implicit notion of distinctiveness in the Japanese regime. Article 3 itself contains a list of items that cannot be granted as registered trademarks³⁵³. The unofficial translation of the relevant part of this Article provides that:

“Article 3 (Requirements for trademark registration)

(1) Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark:

(1) consists solely of a mark *indicating, in a common manner, the common name of the goods or services*;

(2) is *customarily used* in connection with the goods or services;

(3) consists solely of a mark *indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape (including shape of packages), price, the method or time of production or use, or, in the case of services, the location of*

³⁵³ The function of Article 3 of the Japanese Trademark Act is equivalent; it is submitted, to that of Article 7 of the CTMR (which concerns the absolute grounds for refusal).

provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision;

(4) consists solely of a mark *indicating, in a common manner, a common surname or name of a juridical person;*

(5) consists solely of a *very simple and common mark*; or

(6) is in addition to those listed in each of the preceding items, a trademark by *which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person.*” [Emphasis added]

Thus it can be seen that within the Japanese Trademark Act, the following can be excluded from qualifying a registered *syohyo*: a mark which is used in a common manner³⁵⁴; one used ordinarily to present the goods/services³⁵⁵; a mark that is merely a description of the product information including the place of origin, price, quality, quantity, material, and intended purpose³⁵⁶; a mark which consists of common surname or common name³⁵⁷, and, very simple and common marks³⁵⁸. It is submitted by this author that the common theme running through Article 3(1)(i)-(vi) is that these are all examples of marks that lack distinctiveness. Thus, it is also submitted that (in addition to the earlier arguments as to linguistic implicitness) Article 3(1)(i)-(vi) itself alludes to an implicit criterion of distinctiveness.

At this point, the author would like to summarise her findings as to her analysis of *syohyo* in relation to the Definition Model. Both *form* and *concept* of ‘*syohyo*’ can be found in the Japanese Trademark Act, but the latter is implicitly, rather than explicitly, present. The Japanese approach to the definition of *syohyo* can, therefore, be summarised as follows. Although *concept* of ‘*syohyo*’ is not explicitly stated in the law *per se* it is implicitly present within the Japanese *Kanji* symbols (商標) for

³⁵⁴ Article 3(1) of the Japanese Trademark Act.

³⁵⁵ *Ibid*, Article 3(2).

³⁵⁶ *Ibid*, Article 3(1)(3).

³⁵⁷ *Ibid*, Article 3(1)(4).

³⁵⁸ *Ibid*, Article 3(1)(6). Linguistic context is also important here. The Japanese symbols used in the official version of the Law here are ‘*ありふれた*’ [which transliterates as *arifureta* and translates as ‘simple/commonly used’] and/or ‘*普通*’ [the transliteration of which is *futsu* and the translation is ‘common’]. These terms, which are employed in this context to represent one of the situations in which a mark will not be registrable, are also used as synonym of not being distinctive in Japan (please note that authority for this point can be found in most Japanese-English Dictionaries, e.g. Shinnmura, I, *supra* note 345 at 1947 and 74 in respectively). Thus there is also a linguistic basis within Article 3(1)(4) for concluding that there is an implicit criterion of distinctiveness in the Japanese Act.

syohyo: distinctiveness. There is further implicit guidance as to *concept* in Article 3, where exemplars of non-distinctive marks are set out. *Syohyo type in form* is very developed in the Act, if not being particularly broad in scope. It is explicitly set out in Article 2 (which at Article 2(1) specifies character(s), figure(s), sign(s) or three-dimensional shape(s), or any combination thereof, or any combination thereof with colours), and this is further supplemented by Trade Mark Registry guidance, which includes examples of registrable trade marks (here, in addition to the subject-matter found in Article 2: design marks, symbol marks and colour marks). *Syohyo context in form* is to be found in explicit form in Article 2 (here, trade marks or goods marks with a trade mark attached to the goods, and service marks) and this is further supplemented by Trade Mark Registry guidance, which includes additional examples of registrable trade marks (here, in addition to the subject-matter of Article 2: merchandising marks, business marks, collective marks, grade marks, manufacturer marks, retailer marks, house marks, certification marks, family marks, coined marks, stock marks, promotional marks). Although there is some confusion, in the English translation of the Act, as to the scope of ‘sign’, this can be resolved, as has been submitted, with reference to Japanese etymology.

Of the Definition Model *preconditions*, *commercial use* is not only explicitly present in the Act, but is heavily emphasised. In contrast, *graphic representation* is not explicitly present, but is legally and administratively implicit.

Thus all elements of the Definition Model are present in the Japanese system. Further, the merits of preferring transliterations rather than translations of key Japanese terms (and, of understanding of Japanese etymology)³⁵⁹ have, it is submitted, been illustrated in this Section of the thesis: placing the Act in the correct *linguistic* context is, it is submitted, essential.

It is also helpful to note the *legislative* context of *syohyo* protection: the reader should be aware that, in practice, the Japanese Trademark Act very much operates with the Japanese Unfair Competition Prevention Act³⁶⁰. In fact, it would be fair to observe

³⁵⁹ See Chapter 1, Section 1.5.

³⁶⁰ Unfair Competition Prevention Act (Law No. 14 of 1934 last amended by Law No. 30 of 2009).

that the Unfair Competition Prevention Act both complements and supplements Japanese Trademark Act, and that the scope of the former is substantively broad³⁶¹. As discussion of the Unfair Competition Prevention Acts is beyond the scope of this thesis, only the *trade mark* implications of this relationship will be noted here for the sake of completeness. In brief, according to the Definition Model, *syohyo form* seems to be broader than that of the Trademark Act, for instance, an extra level of protection is provided for three-dimensional marks³⁶². The same can be said of *syohyo context* in trade mark *form*: the Unfair Competition Prevention Act appears to provide some protection for trade dress³⁶³, and specifically protects domain names³⁶⁴ and business reputation³⁶⁵. Thus although there is a restricted notion of 'form' in Article 2 of the Japanese Trademark Act, the regulation of *marks* (i.e. the combined regulation of the Japanese Trademark Act and the Unfair Competition Prevention Act) is broader. It should be noted here that the scope of this thesis is confined to (well-known) trade marks: the *form* of which are relatively narrowly drawn in Japanese law, but it cannot be ignored that some less traditional *forms* of mark are afforded protection in Japan in practice *via* a different route: the Unfair Competition Prevention Act.

Thus placing the Trademark Act in its *legislative* context leads us to the conclusion that a wider range of *syohyo form* can be protected in general Japanese law (using both the Trademark Act and the Unfair Competition Prevention Act) than is immediately apparent, but it must be conceded that this is still narrower than in the CTM system.

[http://www.japaneselawtranslation.go.jp/law/detail/?ft=2&re=01&dn=1&yo=&kn\[\]=%E3%81%B5&x=12&y=21&ky=&page=2](http://www.japaneselawtranslation.go.jp/law/detail/?ft=2&re=01&dn=1&yo=&kn[]=%E3%81%B5&x=12&y=21&ky=&page=2). (Last accessed on 12 January 2010). An unofficial translation of the law made by the Japanese Cabinet Secretariat is to be found at [http://www.japaneselawtranslation.go.jp/law/detail/?ft=2&re=01&dn=1&yo=&kn\[\]=%E3%81%B5&x=12&y=21&ky=&page=2](http://www.japaneselawtranslation.go.jp/law/detail/?ft=2&re=01&dn=1&yo=&kn[]=%E3%81%B5&x=12&y=21&ky=&page=2).

³⁶¹ Tamura, Y, *Fusei kyoso boshi ho* (Tokyo, Iwanami-syoten, 2003) at 56. See one example of the protectable subject matter in the Unfair Competition Act, Tessensohn, J, A, and Yamamoto, S, 'Japan: Unfair Competition – Pharmaceuticals – Trade Dress' (2007) 29 *EIPR* N43-44.

³⁶² Articles 2(1), (2), (3), and (13) of the Japanese Unfair Competition Prevention Act.

³⁶³ *Ibid*, Articles 2(1),(2),(3) and (13) and 2(3).

³⁶⁴ *Ibid*, Article 2(12).

³⁶⁵ *Ibid*, Article 2(14).

2.3.4 A Comparison

Because the EU Member States and Japan are, in most cases, signatories to the main international instruments, one might expect each to comply with those treaties³⁶⁶ and as a result for little difference to be found in the respective trade mark laws of the EU and Japan. However, in respect of one small aspect of trade mark regulation – the statutory definition of ‘trade mark’, it has already been shown that there are a number of points of contrast (as well as some commonality).

Using the Definition Model, in the Section below the author will now undertake a more formal comparison of the various definitions of ‘trade mark’ to be found within international, EU and Japanese laws.

2.3.4.1 ‘Trade Mark’: A Comparison – Definition Model

As stated in Section 2.3.1, the definitions of ‘trade mark’ found within each of these international instruments are different³⁶⁷; therefore, analysis and comparison of these varying definitions of ‘trade mark’³⁶⁸ at the international level was necessary. Also, a comparison of the definitions of ‘trade mark’ at the regional (EU) and the national (Japan) levels was carried out in Sections 2.3.2-2.3.3. A more general comparison of all these definitions will now be undertaken.

To provide an overview of both *form* and *concept* of ‘trade mark’, as variously defined, a basic comparison of the international treaties seems to show that the Singapore Treaty provides the broadest (and therefore the most generous) definition regarding *form* of ‘trade mark’, whereas it is GATT TRIPS that has what this author regards as being the neatest representation of *form* of ‘trade mark’. There are significant differences in the international guidance as to *concept* of ‘trade mark’

³⁶⁶ Davis, J, ‘Locating The Average Consumer: His Judicial Origins, Intellectual Influences and Current Role in European Trade Mark Law’ (2005) 2 *IPQ* 183-203. Dunlop, T, ‘The Average Consumer’s Opinion’ (2000) 22 *EIPR* 177-181; Phillips, J, ‘Europe’s March Towards Harmonisation’ (2000) 98 *MIP* 36-38.

³⁶⁷ See each purpose of the international treaties in Section 2.3.1.

³⁶⁸ Nonetheless, this inconsistency does not appear to be problematic in practice. See WIPO, *supra* note 37 at 423.

Some (for example, GATT TRIPS and the Paris Convention) focus on both *form* and *concept* guidance³⁶⁹, whereas others (for example, the TLT and the Singapore Treaty) take a more *form*-oriented approach³⁷⁰ i.e. there is a lack of consistency in both the detail and mention of *concept* of ‘trade mark’ in these international treaties. As should be clear to the reader, although the definitions of ‘trade mark’ found within each of these international instruments are different, this inconsistency does not appear to be problematic in practice³⁷¹.

Nevertheless, this author would argue that, of these international instruments the most precise and clear overall treatment of *form* and *concept* and the *preconditions* is to be found in GATT TRIPS. If there was to be just one international definition to be preferred, thus author would choose this one, because GATT TRIPS manages to provide relatively equal weight to both *form* and *concept* of ‘trade mark’. In addition to that, GATT TRIPS also mentions the *preconditions*. Although GATT TRIPS nearly fully addresses the Definition Model (as illustrated in Diagram 2), there are still deficiencies in the scope of the definition offered, it is submitted. Although combining the GATT TRIPS and Paris Convention definitions, as undertaken above, results in a slightly broader definition, other international instruments go still further. Noticeably, the Singapore Treaty, the most recent international trade mark legal instrument, takes an open and incremental approach to *form* of ‘trade mark’. Although there no guidance as to *concept* of ‘trade mark’, nor is there any mention of *graphic representation*, and *commercial use* criteria³⁷², this does appear to represent a high water mark as to *form* of ‘trade mark’.

If one mosaics or combines all the material on *form* and *concept* of ‘trade mark’ from the international instruments, ‘trade mark’, at the international level, can be summarised as constituting: certain *signs* including service marks, trade names, and three dimensional marks which are capable of being *graphically represented*, and

³⁶⁹ I.e., providing conceptual guidance to what constitutes a trade mark – e.g. *sign*, *distinctiveness*, etc.

³⁷⁰ I.e., focusing on trade mark subject matter – that service marks, collective marks and trade names are all permissible subject matter.

³⁷¹ Perhaps due to the differing purpose of the international treaties, see Section 2.3.1.

³⁷² If the provisions of the Singapore Treaty were replicated at the national level, the lack of a *concept* of ‘trade mark’ (in particular the absence of a visibility criterion) would have the effect of increasing the scope of marks that could be registered. Thus: reducing concept of ‘trade mark’ *increases* the scope of trade mark protection, whereas reducing form (type and context) of ‘trade mark’ *decreases* the scope of trade mark protection.

used (if not *commercially used*), and of *distinguishing* the goods of one undertaking from those of other undertakings³⁷³. This proposed definition of ‘trade mark’ contains both *form* and *concept* of ‘trade mark’ and at least one of the *preconditions*.

There *has* been a degree of innovation *vis-à-vis* the scope of both *type* and *context* of *form* of ‘trade mark’ in recent times – particularly at the national level³⁷⁴. At the international level, although the Singapore Treaty and the TLT do not fall into the Definition Model in a full sense, the Singapore Treaty, in particular, gives a generous impression regarding *types* in *form* of ‘trade mark’. This is because this Treaty affords protection for non-traditional marks such as sound marks, colour, position and movement marks, olfactory, gustatory and tactile (known as feel) marks³⁷⁵. It is presumed that this expansion might be caused by the increase in the sophistication of both consumers and trade mark proprietors. At the international level, the scope of *context* of *form* of ‘trade mark’ is variable; for example, collective marks, certification marks, and guarantee marks appear to be controversial in the *context* of *form* of ‘trade mark’ as under both the TLT³⁷⁶ and the Singapore Treaty regime³⁷⁷ they cannot be registered trade marks, whilst in GATT TRIPS they can be³⁷⁸.

In contrast a more equal balance between the *form* and *concept* of ‘trade mark’ seems to be found at the regional level, ECJ has now dealt with the issue of what constitutes *a sign*.

Here a very brief discussion of two cases – *Dyson (Dyson Ltd v Registrar of Trade Marks)*³⁷⁹ and *Phillips (Koninklijke Philips Electronics NV v Remington Consumer Products Ltd)*³⁸⁰ – will be helpful so as to examine how the ECJ jurisprudence has

³⁷³ Section 1(1)(a) of the WIPO Model Law for Developing Countries on Marks, Trade Names and Acts of Unfair Competition of 1967. WIPO Publication No 805 (E) (1967).

³⁷⁴ Ono, S, *Syohyo ho* (Tokyo, Seirin-syoin, 2005).

³⁷⁵ Article 2(1) of the Singapore Treaty.

³⁷⁶ Article 2(2)(b) of the TLT.

³⁷⁷ Article 2(2)(b) of the Singapore Treaty.

³⁷⁸ Article 15(1) of GATT TRIPS.

³⁷⁹ *Dyson Ltd v Registrar of Trade Marks* (Case C-321/03) [2007] RPC 27. This case was about Dyson’s application to register the transparent bin of its vacuum cleaner for vacuum cleaners. See also case note in Smith, E, ‘Dyson and the Public Interest: An Analysis of the Dyson Trade Mark Case’ (2007) 29 *EIPR* 469-473.

³⁸⁰ *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* (Case C-299/99) [2002] ETMR 81.

approached what constitutes ‘sign’ in the EU trade mark regime. Therefore an examination of such provides greater guidance on developing the Definition Model.

The former will be discussed first. The reasoning of the court in *Dyson* is of such interest to examine how the EU jurisprudence defines ‘sign’³⁸¹. Thus reasoning will be introduced in full; the court stated that:

“Article 2 of the Directive provides that a trade mark may consist of any sign, provided that it is, first, capable of being represented graphically and, secondly, capable of distinguishing the goods or services of one undertaking from those of other undertakings... It follows that, to be capable of constituting a trade mark for the purposes of Art.2 of the Directive, *the subject matter of any application must satisfy three conditions*. First, *it must be a sign*. Secondly, that sign must be *capable of being represented graphically*. Thirdly, the sign *must be capable of distinguishing the goods or services of one undertaking from those of other undertakings ...*³⁸²

“...the *application lodged by Dyson* does not fulfil the first of those conditions because *it relates to a concept*, in this case, the concept of a transparent collecting bin for a vacuum cleaner, irrespective of shape. Since *a concept is not capable of being perceived by one of the five senses and appeals only to the imagination, it is not a “sign” within the meaning of Art.2 of the Directive*. *If a concept were able to constitute a trade mark, the logic behind Art.3(1)(e) of the Directive, namely to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product, would be frustrated*. Accordingly, it should not be possible to achieve that advantage by registering all the shapes which a particular functional feature might have, which would be the result of allowing the registration of a concept which can cover many physical manifestations.”³⁸³

³⁸¹ Trimmer, B, ‘An Increasingly Uneasy Relationship - the English Courts and the European Court of Justice in Trade Mark Disputes’ (2008) 30 *EIPR* 87-92 at 87-88.

³⁸² *Dyson*, *supra* note 375 at 27-28.

³⁸³ *Ibid* at 29.

“...that a concept is not a sign capable of being registered as a trade mark, its application does relate to a “sign” within the meaning of Art.2 of the Directive.

The concept of a “sign”, which is defined broadly by the case law, in fact covers any message which may be perceived by one of the five senses.”³⁸⁴

Here, use of term ‘concept’ used in this case indicates an abstract idea, which is not a registrable subject matter. It can be summarised that *types* in trade mark *form* do *not* include *concept* (as being abstract idea); and a strong emphasis on *graphic representation* is one of the *preconditions*. Trade mark *precondition* was explained more clearly that that in law that: *being perceived by one of the five senses and appeals only to the imagination.*

Now, from this sentence, it might well be possible to say that the ECJ implicitly mentioned a possibility of non-traditional signs being able to be registered trade marks. It is also interesting to note that this author identifies two elements of trade mark *preconditions*, and these two are treated in different ways in the EU and Japan, for instance, the EU has put a great importance in *graphic representation*, whereas in Japan, *commercial use* has been the main focus.

According to the latter, The UK High Court left two remaining questions for the ECJ to answer, such as:

“1. In a situation where an applicant has used a sign (which is not a shape) which consists of a feature which has a function and which forms part of the appearance of a new kind of article, and the applicant has, until the date of application, had a de facto monopoly in such articles, is it sufficient, in order for the sign to have acquired a distinctive character within the meaning of Article 3(3) of [the Directive], that a significant proportion of the relevant public has by the date of application for registration come to associate the relevant goods bearing the sign with the applicant and no other manufacturer?

³⁸⁴ *Ibid* at 30.

2. If that is not sufficient, *what else is needed in order for the sign to have acquired a distinctive character* and, in particular, is it necessary for the person who has used the sign to have promoted it as a trade mark?”³⁸⁵

It was of great disappointment that the ECJ did not provide any answers to the above. However, it can be acknowledged that *Dyson* spoke of what constitutes ‘signs’ and a great implication of this in the future might well be anticipated. All the three elements are addressed in *Dyson* within the Definition Model.

The next discussion will begin by the reference to *Philips*³⁸⁶. The trade mark *concept* being capable of distinguishing the goods from among the others, was noted to be first considered in *Philips*³⁸⁷. It is also said that the ECJ had an opportunity to deal with distinctiveness ‘more comprehensively’³⁸⁸. Note that “the essential function of a trade mark is to guarantee the identity of the origin of the marked product to consumer or end-user by enabling him, without any possibility of confusion to distinguish the product or service from others which have another origin...”³⁸⁹ was reiterated.

Regarding an issue of distinctiveness in the *Philips*, it was commented that:

“it is clear from the wording of Article 3(1)(a) and the structure of the Directive that that provision is intended essentially to exclude from registration signs which are not generally capable of being a trade mark and thus cannot be represented graphically and/or are not capable of distinguishing the goods or services of one undertaking from those of other undertakings.”³⁹⁰

Accordingly, the court said:

“It follows that there is no class of marks having a distinctive character by their nature or by the use made of them which is not capable of distinguishing goods or services within the meaning of Article 2 of the Directive.”³⁹¹

³⁸⁵ *Ibid* at 13.

³⁸⁶ *Philips* *supra* note 402.

³⁸⁷ See Maniatis, S, *supra* note 37 at 99.

³⁸⁸ See Maniatis, S, ‘Arsenal & Davidoff: the Creative Disorder Stage’ (2003) 7 *Mar.Intell.Prop.L. Rev* 99-148 at 108.

³⁸⁹ *Philips* *supra* note 402 at 30.

³⁹⁰ *Philips* *supra* note 402 at 37.

³⁹¹ *Philips* *supra* note 402 at 39.

Therefore, it can be inferred that any marks must distinguish, according to their origin, the relevant goods and/or services; the EU Trade Mark Directive does not make a distinction between marks according to the types³⁹². It is also submitted by this author that ‘distinctness’ had been examined on the ground that ‘trade mark’ being an indication of origins.

An examination of registrability of non-traditional marks (colour, smell and olfactory marks) seems to come up with an issue of distinctiveness and functionality. Japan classifies and recognises *syohyo* in relation to the functional perspective. A brief summary of how the EU jurisprudence takes view on the functional perspective, therefore, might be noteworthy here. So, for instance in *Libertel Groep BV v Benelux-Merkenbureau* (hereafter the *Libertel*):

“In the case of a colour *per se*, *distinctiveness without any prior use is inconceivable* save in exceptional circumstances, and particularly where the number of goods or services for which the mark is claimed is very restricted and the relevant market very specific.”³⁹³

“...a colour *per se*, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of Art.3(1)(b) and Art.3 of the Directive, provided that, *inter alia*, it may be represented graphically in a way that is *clear, precise, self-contained, easily accessible, intelligible, durable and objective.*”³⁹⁴

This case, therefore, the colour marks have hardships which, are not faced by the more ordinary visual and verbal marks, and the ECJ confirmed that a colour will be hardly ever inherently be distinctive of the goods and/or services for which registration is sought. It may be also said that there is an EU consensus that consumers do not see colours and shapes as trade marks, and therefore shapes and

³⁹² *Philips* *supra* note 402 and 48.

³⁹³ *Libertel Groep BV v Benelux-Merkenbureau* (Case C-104/01) [2003] ETMR 63 at 66.

³⁹⁴ *Ibid* at 68.

colours and scents will always need evidence of distinctiveness, being said these signs can never be inherently distinctive. Only way to obtain distinctiveness is through use.

According to the CTMR, with reference to the Definition Model, ‘trade mark’ is: *a sign which is capable of distinguishing the goods of one undertaking from those of other undertaking and being represented graphically.*

Concept of ‘trade mark’ to this definition is somewhat explicit; that is distinctiveness. In addition to that, it is helpful that *graphic representation*, one of the *preconditions*, is, explicit within the CTMR. Under the EU regime (see Section 2.3.2), certain signs are said to constitute *type in form* of ‘trade mark’ with examples of signs given including symbols, logos, slogans, get-ups, personal names, designs, letters, numerals and the shape of goods or of their packaging and *context* of ‘trade mark’ may include service marks, collective marks and so on³⁹⁵. However, this author would argue that these forms of ‘trade mark’ in the CTMR seem to be a simplified version of Article 15(1) of the GATT TRIPS³⁹⁶. Therefore, the CTM system can similarly be seen to address nearly all aspects of the Definition Model. Although many so-called non-traditional trade marks³⁹⁷ are explicitly included in the examples of *form* of ‘trade mark’ in the CTMR³⁹⁸, in practice it remains difficult to register some non-traditional trade marks; this appears to be an issue of particular concern amongst legal academics³⁹⁹ and, in the view of this author, the difficulties experienced here are invariably due to the strict interpretation of the *precondition* of *graphic*

³⁹⁵ Article 4 of the CTMR.

³⁹⁶ Article 15(1) of GATT TRIPS.

³⁹⁷ Conventional trade marks are known as letters, words and pictures or drawings, and the range of non-conventional trade marks are; (i) slogans; (ii) three-dimensional signs (shapes); (iii) colours; (iv) sound signs, taste signs and scent signs; (v) action signs, and; holograms. The criteria for registering non-conventional trade marks are known to be established by a case called SIECKMANN. *Ralf Sieckmann v Deutsches Patent- und Markenamt* (Case C-273/00). The outcome of this case seems to have some import to the EU regime. See for example, Brown, A, ‘Illuminating European Trade Marks’ (2004) 1 *Script-ed* 1. This article is to be found at http://www.law.ed.ac.uk/ahrc/script-ed/docs/trade_marks.doc. (Last accessed on 12 January 2010).

³⁹⁸ Article 4 of the CTMR.

³⁹⁹ See for example, Maniatis, S, M, and Sander, A, K, ‘A Consumer Trade Mark: Protection Based on Origin and Quality’ (1993) 15 *EIPR* 406-451. It may be that future technological developments make it easier to register non-traditional trade marks – for example see Wilson, C, ‘Trade Mark Law in an Online Future – Coming to its senses?’ (Conference paper, GikII 2, London, 19 September 2007).

*representation*⁴⁰⁰. ‘Distinctiveness’ as *concept* of ‘trade mark’ seems to have great importance within the treatment of ‘trade mark’ within the CTMR.

In contrast, *concept* of ‘*syuchi-syohyo*’ in Japan is implicit, not explicit (distinctiveness being implicit in the Japanese *kanji* symbols 商標: *syohyo* or trademark). Even if this implication was missed by the non-Japanese speakers, the Japanese law includes another independent article⁴⁰¹, which also implies ‘distinctiveness’ (although this term is not used in this article). Therefore, the Japanese law falls into the Definition Model, and moreover, this author submits that concept of ‘trade mark’ is reasonably comprehensively, if implicitly, addressed. Also, there is explicit inclusion of one *precondition* for trade mark registration, but here it is business use (equivalent to *commercial use*). The crucial difference to the CTM system lies, in the view of this author in *form* of ‘trade mark’: this is rather narrowly interpreted by the law⁴⁰² (although the JPO Guidelines⁴⁰³ provides slightly more generous guidance as to the scope of *form* of ‘*syuchi-syohyo*’.

Here, the author would like to make an additional point relating to ‘distinctiveness’ in the CTM and Japanese regimes: acquired distinctiveness through use is explicitly allowed in both the Japanese⁴⁰⁴ and CTM⁴⁰⁵ systems. This, in this respect, trade mark *concept* has a similar scope in both jurisdictions.

Although both the CTM system and the Japanese trademark system do provide definitions of ‘trade mark’ and ‘*syuchi-syohyo*’, these definitions are not complete (in terms of the Definition Model), and there could be – in the view of this author – better guidance provided as to how the existing definitions are to be interpreted. In this regard, perhaps the Japanese system is slightly better, firstly as the JPO Guidelines to the Japanese Trademark Act⁴⁰⁶ indicate a still wider scope of *type* in *form* of ‘trade

⁴⁰⁰ Article 15(1) of GATT TRIPS: Article 4(1) of the CTMR. See also, SIECKMANN *supra* note 393.

⁴⁰¹ Article 3 of the Japanese Trademark Act.

⁴⁰² Article 2 of the Japanese Trademark Act.

⁴⁰³ Item 4 of Part 2: Principal Paragraph of Article 3(1) of the CTM Guidelines.

⁴⁰⁴ Article 3(2) of the Japanese Trademark Act.

⁴⁰⁵ Article 7(3) of the CTMR.

⁴⁰⁶ See for example, Chapter I: Article 3(1) Part 2: Principal Paragraph of Article 3(1) of the JPO Guidelines and the functional definitions of trademarks in Japan is generally accepted by the legal academics. See also Amino, M, *Syohyo-ho* (Tokyo, Yuhi-kaku, 2004) at 23, and Ono, S, *supra* note 370.

mark' (stating that it includes any characters, figures, signs (symbols) or three-dimensional shapes, or any combination thereof, or any combination thereof with colours). Secondly, Japanese legal scholars categorise trade marks from a functional perspective⁴⁰⁷, and this gives a good 'flavour' of the actual scope of *context of form* of 'trade mark' in Japan. Japanese academics would thus categorise *types in form* of 'trade mark' as including character marks, design marks, symbol marks, colour marks, three-dimensional marks, combined marks; and *context of form* of 'trade mark' as including merchandising marks, service marks, business marks, collective marks, geographical indications, grade marks, manufacturer marks, retailer marks, certification marks, family marks, coined marks, stock marks, and promotional marks⁴⁰⁸. Nevertheless, the actual scope of *form* of 'trade mark' is narrower in the Japanese Trademark Act than it is in the CTM regime, with the Japanese Trademark Act appearing to be both more proscriptive and narrower than the CTM *vis-à-vis* the scope of *form* i.e. *type* of 'trade mark'.

2.4 Conclusion

The main purpose of Chapter 2 was to critically compare the definitions of 'trade mark' in the international, the EU and the Japanese trade mark regimes with reference to the Definition Model. As the author of the thesis assumes that a 'well-known trade mark' (the focus of this thesis) can be regarded as being the purest and strongest category of a trade mark, thus, this exploration of 'trade mark' can be seen as a helpful first step in defining what constitutes a 'well-known trade mark'.

As conceded earlier, the author would also have liked to undertake critical consideration of what a trade mark is *for* (that is, an exploration of trade mark

⁴⁰⁷ See Ono, S, *supra* note 370.

⁴⁰⁸ Trade mark subject matters are narrowly indicated in the Japanese law whilst the future expansion of trade mark subject matter in the EU regime is implicit in Article 4 of the CTMR. The non-traditional trademarks are highly unlikely to be protected. See also Item 4 of Part 2: Principal Paragraph of Article 3(1) of the Guidelines. In Japan, the functional aspects of trade marks can have an impact on the classification of trade marks. The legal aspect of trade marks are seen in the statutory definition of 'trade mark' such as signs, symbols, characters, etc; see Article 2 of the Japanese Trademark Act. The functional aspect can be classified as character marks, design marks, symbol marks, colour marks, three-dimensional marks, combined marks with related to merchandising marks, service marks, business marks, collective marks, geographical indications, grade marks, manufacturer marks, retailer marks, certification marks, family marks, coined marks, stock marks, promotional marks. In the EU regime, on the other hand, the lesser categorisation of 'trade mark' can be seen.

function). However, it is submitted that a detailed critical examination of trade mark function is not essential to the main focus of this thesis, and it has not been undertaken. For the purpose of completeness, therefore, it will merely be noted that in the primary and secondary literature on trade mark function, commentators variously identify one, two or three essential functions of a trade mark, these can be described as: (i) origin function⁴⁰⁹; (ii) quality or guarantee function⁴¹⁰; and (iii) advertising functions⁴¹¹. Again: please note that it is beyond the scope of this thesis to critically analyse these.

Now, to return to the issue of definitions and the application of the Definition Model. As has been seen, each of the various definitions of ‘trade mark’ in the international agreements differ in both scope and detail, with varying attention being paid to *form* and *concept* of ‘trade mark’⁴¹². In the view of this author, these differences seem to depend on the purpose, and to a certain extent, the age, of the laws in question, and, the fact that there is not a consistent definition of ‘trade mark’ to be found in all these agreements does not appear to be problematic in practice.

⁴⁰⁹ Cornish explains origin function as follows: “...marks deserve protection so that they may operate as indicators of the trade source from which goods or services come, or are in some other way connected.” See Cornish, W, and Llewelyn, D, *supra* note 37 at 620.

⁴¹⁰ See Article 7(1)(j) of the CTMR and Article 4(1)(16) of the Japanese Trademark Act. It is explained by Cornish (see above) that “...marks deserve protection because they symbolise qualities associated by consumers with certain goods or services and guarantee that the goods or services measure up to expectations”. However, Tritton explains that the essential function of a trade mark is merely as a guarantee of unitary control, and not a guarantee of quality. Trade marks do not provide a legal guarantee of quality but consumers rely upon the economic self-interest of trade mark proprietors to maintain the quality of products and services sold under a brand.” (Tritton, G, *supra* note 37 at 257).

⁴¹¹ See Articles 8(5) and 9(1)(c) of the CTMR, and Article 4(1)(19) of the Japanese Trademark Act. Schechter defined that “...the value of the modern trade mark lies in its selling power; (ii) that this selling power depends for its psychological hold upon the public, not merely upon the merit of the goods upon which it is used, but equally upon its own uniqueness and singularity...” See Schechter, *supra* note 84 at 831. Griffiths summarises that “...trade marks can gain a ‘psychological hold’ on the minds of consumers, which give them a selling power above that of the underlying goodwill”. (Griffiths, A, *infra* note 682 at 329). According to Cornish, advertising function is explained “...marks are cyphers around which investment in the promotion of a promotion of a product is built and that investment is a value which deserves protection as such, even when there is no abuse arising from misrepresentations either about origin or quality”. See Cornish, W, and Llewelyn, D, *supra* note 37 at 620.

⁴¹² For example, Article 15(1) of GATT TRIPS, Article 2(1)(a) of the TLT and Article 2(1) of the Singapore Treaty can be seen as relating to a *concept-oriented* definition. Articles 6bis, 6ter, 6sexies of the Paris Convention, Article 15(1) of GATT TRIPS, Articles 2(1)(b), 2(2) of the TLT, Article 2(2) of the Singapore Treaty can be regarded as a *form-oriented* definition.

As can be seen, in the CTMR, both *concept*⁴¹³ and generously-defined *form*⁴¹⁴ elements can be explicitly found in the definition of ‘trade mark’ offered. However, in Japan (at least to a non-native Japanese speaker) there is only explicit reference to very narrowly-defined scope of *form*⁴¹⁵ of ‘trade mark’. As noted above, however, *concept* of ‘trade mark’ is, in fact, *implicit* in the native language of Japanese Act⁴¹⁶. Therefore, it might be fair to say that the EU definition of ‘trade mark’ appeared to have an equal balance between *form* and *concept* of ‘trade mark’ whereas the Japanese version of ‘trade mark’ seems to put more explicit emphasis on *form* of ‘trade mark’ than that of *concept*. Both in the CTMR and the Japanese Trademark Act, *concept* of ‘trade mark’ is present. This author concludes from this that the emphasis on *concept* in the Definition Model is supported by the analysis, in this Chapter, of the definitions of ‘trade mark’.

To conclude: in this Chapter, this author has set out the definitions of ‘trade mark’ in all the main international trade mark instruments and within the CTM system and the Japanese Trademark Act. These definitions have been both compared (see Appendix 1) and a conceptual approach (see earlier in Section 2.2) to ‘trade mark’ suggested and utilised.

The purpose of this Chapter was to critically examine *how* ‘trade mark’ is defined in the international, the EU and the Japanese laws⁴¹⁷, thus providing important background for the forthcoming exploration of the *concept* of ‘well-known trade mark’ in Chapter 3.

⁴¹³ ‘Distinctiveness’ is categorised as a *concept* of ‘trade mark’, and ‘graphically represented’ is categorised as one of *preconditions* of trade mark registration in Article 4 of the CTMR.

⁴¹⁴ Personal names, designs, letters, numerals, the shape of goods or of their packaging are regarded as *types* in trade mark *form* in Article 4 of the CTMR.

⁴¹⁵ Any characters, figures, signs or three-dimensional shapes, or any combination thereof, or any combination thereof with colours are seen as *types* of trade mark *form* in Article 2 of the Japanese Trademark Act.

⁴¹⁶ Japanese *kanji* symbols for trade marks refer to ‘商標’ (syohyo). ‘商標’ (syohyo) implies one of the *concepts* of ‘trade mark’ (distinctiveness) and one of *preconditions* for trade mark registration (*commercial use*).

⁴¹⁷ Nevertheless, the author would like to briefly note that in determining what might constitute an ideal definition of ‘trade mark’, she favours clarity over content; that is, she believes that *form* and *concept* clarity is more important than the actual content of scope of the trade mark *form* and *concept* in a definition of ‘trade mark’.

Chapter 3 ‘Well-Known Trade Mark’ at the International Level

3.1 Introduction

The overriding aim of this thesis is to critically analyse and to explore the most appropriate means of well-known trade mark and *syuchi-syohyo* protection against likelihood of confusion and *kondo* in the CTM Japanese systems respectively.

To recap, the hypothesis made in this thesis is: well-known trade mark protection (with relation to registrability) against likelihood of confusion in EU and Japan is unclear. In order to address this hypothesis⁴¹⁸, some assumptions have been made; such as that ‘well-known trade mark’ is the purest form of ‘trade mark’. Having noted the difficulties in clearly establishing a current legal definition for ‘well-known trade mark’, logically extending this assumption, in Chapter 2, relevant definitions of ‘trade mark’ were critically considered. This analysis was undertaken using the Definition Model developed by this author: this Model being used to analyse and compare *form* and *concept* within definitions of ‘trade mark’ to be found at the international⁴¹⁹, regional⁴²⁰ and national⁴²¹ levels.

The main focus of this chapter, Chapter 3, is the critical consideration of the definition of ‘well-known trade mark’ at the international level. In this Chapter, the relevant international instruments are the Paris Convention⁴²², GATT TRIPS⁴²³, and the WIPO Joint Recommendation (hereafter the WIPO Recommendation)⁴²⁴, with other

⁴¹⁸ See Chapter 1, Section 1.7.

⁴¹⁹ Here the relevant international instruments are: the Paris Convention; GATT TRIPS, the TLT, and the Singapore Treaty. See Chapter 2, Section 2.3.1

⁴²⁰ Here, the relevant statute is the CTMR. See Chapter 2, Section 2.3.2

⁴²¹ Here, the relevant national law is the Japanese Trademark Act. See Chapter 2, Section 2.3.3.

⁴²² *Supra* note 170.

⁴²³ *Supra* note 171.

⁴²⁴ The World Intellectual Property Organization (the WIPO) is an international organization dedicated to promoting the use and protection of works of the human spirit. These works – intellectual property – are expanding the bounds of science and technology and enriching the world of the arts. Through its work, WIPO plays an important role in enhancing the quality and enjoyment of life, as well as creating real wealth for nations. See *supra* note 13 for the full text of the WIPO Recommendation and see the WIPO official website; <http://www.wipo.int/about-wipo/en/>. (Last accessed on 12 January 2010). A ‘Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks’ adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999 World Intellectual Property Organization Geneva 2000’. The WIPO has published “a Joint Recommendation Concerning

international instruments, such as the TLT, the Singapore Treaty, the Nairobi Treaty⁴²⁵, being beyond the scope of Chapter 3.

In particular, the following are to be critically explored in this chapter with reference to the Definition Model⁴²⁶: first, the definition(s) of ‘well-known trade mark’ in the relevant treaties noted above; second, a brief comparison of these definitions. The findings of this chapter will form the foundation of the next three Chapters: the guidance to be found at the international level as to what constitutes a well-known trade mark forming the background of the critical consideration in Chapters 4 and 5 of how such marks are protected against confusion in the EU and Japanese trade mark systems and, in Chapter 6, how the EU and Japanese systems can be critically compared on this issue⁴²⁷.

Before undertaking these tasks, there are some related questions that go to the heart of this thesis briefly considered in Chapter 1 that this author would like to revisit: is it necessary to have a comprehensive definition of well-known trade mark (at the local and/or national level)? And, do inconsistencies and uncertainties as to the definition of ‘well-known trade mark’ at the international level matter?

Does this matter? This author submits, yes in the context of this thesis. It is submitted that if the definition(s) of ‘well-known trade mark’ are unclear, then this will at the very least make it difficult to establish whether such marks are effectively protected (logically, how can one establish whether such marks are effectively protected if one cannot define them?). Beyond the context of this thesis, this question

Provisions on the Protection of Well-Known Marks”, according to which not only the trade mark’s degree of prominence in the relevant consumer circles of the country of protection is to be given consideration, but also other parameters. The WIPO Recommendations, nonetheless, is not binding. Apart from the WIPO Recommendation there is one attempt to create one definition of well-known marks. The AIPPI (international Association for the Protection of Industrial Property at its Executive Committee Meeting in Barcelona in 1990 defined a well-known mark as ‘a mark which is known to a large part of public, being associated with the article or service in the mind of the public as indicating their origin’. See *infra* note 482.

⁴²⁵ This treaty is aimed at protecting the Olympic Symbol. The full text of this Treaty is to be found at http://www.wipo.int/treaties/en/ip/nairobi/trtdocs_wo018.html. (Last accessed on 12 January 2010).

⁴²⁶ See Diagrams 1 and 2 in Chapter 2, Section 2.2 for the application of the Definition Model

⁴²⁷ In these chapters it will be argued that the definitions of concepts analogous to that of ‘well-known trade mark’ to be found under the EU and the Japanese Trademark Act regimes are not comprehensive. In this chapter (Chapter 3), the author will argue that there also seems to be uncertainty and inconsistency as to the definition of ‘well-known trade mark’ at the international level.

is more difficult to answer, and, it must be noted, some commentators take the view⁴²⁸ that identifying what is a ‘well-known trade mark’ is essentially a factual question, and taking on this view the lack of a comprehensive definition of ‘well-known trade mark’ is likely to be less problematic. More fundamentally, *are* international and local laws uncertain here? Not only does this author feel that this is the case but there is also support in the secondary literature:

“The recognition and protection of well-known marks differ from country to country: the definitions and criteria in this area of trade mark law remain elusive.”⁴²⁹

Having noted these views, the structure of Chapter 3 can be very simply set out as follows:

- Critical consideration and comparison of the definitions of ‘well-known trade mark’ in the relevant international treaties and instruments, utilising the Definition Model.

3.2 What Constitutes a ‘Well-Known Trade Mark’?

This section will identify and compare the definitions of ‘well-known trade mark’ in the relevant international treaties and instruments. In the course of the resultant analysis and comparison, black letter treaty interpretation methodology will be employed and the Definition Model applied (the same exercise was undertaken in Chapter 2 to define ‘trade mark’)⁴³⁰.

Before engaging in this analysis and comparison of the individual international treaties and instruments, the author would like to make two observations: (i) there has been no recent major international developments relating to well-known trade mark protection in the legislative context⁴³¹, and; (ii) overall, relatively little academic legal

⁴²⁸ See Mostert, F, W, *supra* note 62.

⁴²⁹ See Mostert, F, W, *supra* note 47.

⁴³⁰ See Chapter 2, Section 2.2.

⁴³¹ There is the WIPO Recommendation, but this instrument does not have binding force and, in the view of this author, it would be helpful to have modern Treaty provisions (or an entire Treaty)

research has been undertaken in relation to well-known trade mark protection at the international level⁴³². Thus, there is relatively little primary and secondary literature here.

3.2.1 The Paris Convention

As noted in Chapter 2, the Paris Convention as being the first international legal instrument has given rise to the importance of well-known trade mark protection⁴³³ and is where the term ‘well-known trade mark’ was first used⁴³⁴. This has, it is submitted, had a great impact on national legislation for protection of well-known trade marks, as this provision was seen as a model to be followed⁴³⁵. In other words, the Paris Convention can be seen as providing a minimum standard of protection⁴³⁶. It must be conceded, however, that the Paris Convention is not self-executing and, for example, Article 6bis does not provide an independent cause of action at the national level. Further, it is a well-understood principle that the protection afforded to trade marks which are well-known, was primarily for jurisdictions which do not otherwise afford protection to unregistered trade marks⁴³⁷. A critical examination of the Paris

concerned with the comprehensive definition of and protection of ‘well-known trade marks’. This author’s view as to the import of *binding* international law here is not supported in the secondary literature, where some commentators are much more enthusiastic as to the role and utility of the Recommendations, for example: “I believe that we now have in our hands, at last and for the first time, an authoritative statement of how to define a well-known mark and the rights which an owner of it can claim. This comes 74 years after the introduction of Article 6bis into the Paris Convention and 41 years since it was last revised, but a mere five years since GATT TRIPS last extended.” Tatham, D, *supra* note 13 at 137. In the course of this chapter, this author will argue that, along with the other relevant international treaties (which, in the main cannot be expected to provide comprehensive and detailed provisions as the purpose of these is to provide a minimum standard of IP protection that signatory states are expected to meet – see, for example, the purpose of the Paris Convention. See Chapter 2, Section 2.3.1.1 here), this ‘authoritative statement’ is not comprehensive.

⁴³² See for example, Kur, A, *supra* note 47, Grinberg, M, *supra* note 47. A Report of joint symposium by WIPO and International Telecommunication Union, December 6 to 7, 2001, on challenges related to use of multi lingual domain names. ‘WIPO, ITU joint seminar addresses problem of multilingual domain names’ (2001) 2 *W.E.C. & I.P.R* 24.

⁴³³ It is generally known that the beginning of the developed system of international intellectual property law can be found in the 1880s, with the conclusion of the Paris Convention and the Bern Convention. These treaties were built around two basic positions. First, signatory states had to provide minimum levels of intellectual property protection, so-called substantive *minima* in their domestic law. Secondly, as a general rule, a signatory state was obliged to offer protection to nationals of other signatory states that matched the protection it afforded its own nationals. This is the principle of national treatment.

⁴³⁴ See WIPO, *supra* note 37. Kur *supra* note 47 at 219. Kur argues that the contribution made by the Paris Convention to protect ‘well-known trade mark’ is rather minor.

⁴³⁵ Tritton, *supra* note 37 at 230.

⁴³⁶ WIPO, *supra* note 37 at 359-384.

⁴³⁷ Tritton, *supra* note 37 at 231.

Convention as a threshold standard of the definition of ‘well-known trade mark’ is vital to this Chapter. The article in full is as follows:

Article 6bis:

“the countries of the Union undertake, *ex officio* if their legislation so permits, or *at the request of an interested party*, to *refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion*, of a mark considered by the competent authority of the country of registration or *use to be well known in that country* as being already the mark of a person entitled to the benefits of this Convention and used *for identical or similar goods*. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an *imitation liable to create confusion therewith*”. [Emphasis added]

Now, this author will explore the definition of ‘well-known trade mark’ in the Paris Convention with reference to the Definition Model. It should be noted, that there is no explicit definition of ‘well-known trade mark’ or any clear indication as to when a trade mark becomes well-known to be found in the Paris Convention⁴³⁸. Nevertheless, some guidance may be found.

First, attention will turn to ‘well-known trade mark’ *form* (both *type* and *context*) within the Paris Convention. No explicit reference is made to ‘well-known trade mark’ *form*, although Article 6bis(1) does provide that:

“...[countries of the Union are to undertake] to refuse or to cancel the registration and to prohibit the use, of a trademark...[which is a confusing reproduction, imitation or translation of an identical or similar mark] considered by the competent authority of the country of registration or use to be *well-known* in that country. These provisions shall also apply when the

⁴³⁸ *Ibid* at 230.

essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith. [Emphasis added]”

As one of the assumptions of this thesis is that ‘well-known trade marks’ are (Chapter 1, Section 1.7) a *type* of ‘trade mark’. And utilising this assumption it is submitted that guidance in the Paris Convention as to the *form* of ‘trade mark’,⁴³⁹ can be used to infer the *form* of ‘well-known trade mark’. Therefore, (well-known) trade mark *context* in *form* can be held to include service marks⁴⁴⁰, collective marks⁴⁴¹ and trade names⁴⁴², but excluding hallmarks⁴⁴³ and marks contrary to morality, public order⁴⁴⁴ and bad faith⁴⁴⁵. ‘Well-known trade mark’ *type* in *form* can be held to specifically exclude state emblems, armorial bearings, marks of intergovernmental organisations etc, without their authorisation⁴⁴⁶. Thus in terms of *form*, the Paris Convention can be seen as providing some guidance as to *context*, but only providing examples of what are *not* to be regarded as acceptable *form*.

Second, the *concept* of ‘well-known trade mark’ is to be examined. It has already been noted⁴⁴⁷ that the *concept* of ‘trade mark’ is considered in the Paris Convention, however, there are no such provisions on *concept* that are particular to ‘well-known trade marks’. Again, exercising the assumption that it is possible to infer the latter through the former, it can be submitted that (well-known) trade mark *concept* is a distinctive character⁴⁴⁸, and that such distinctive character needs (at least) to be national in nature⁴⁴⁹. No comprehensive definition of a distinctive character in

⁴³⁹ Here, see Chapter 2 Sections 2.3.1.5, and 2.3.4 for an overview of comparison of ‘trade mark’ at the international level. See also Appendix 1.

⁴⁴⁰ Article 6^{sexies} of the Paris Convention: however, the Union countries are not required to provide for the registration of such marks.

⁴⁴¹ *Ibid*, Article 7^{bis}.

⁴⁴² *Ibid*, Article 8.

⁴⁴³ *Ibid*, Article 6^{ter}.

⁴⁴⁴ *Ibid*, Article 6^{ter} (3)(7).

⁴⁴⁵ *Ibid*, Article 6^{quinquies} B(iii).

⁴⁴⁶ *Ibid*, Article 6^{ter}.

⁴⁴⁷ See Chapter 2, Section 2.3.1.

⁴⁴⁸ Article 6^{quinquies} B(ii) of the Paris Convention. Again, to clarify: this provision relates to the definition of ‘trade mark’, it can be expected that the *concept* of a ‘well-known trade mark’ to be more developed than that of ‘trade mark’ (here, distinctive character): so it is tentatively suggested that – at least – *concept* of ‘well-known trade mark’ in the Paris Convention might be inferred and assumed to be a ‘highly distinctive character’. It should also be noted that this author submits that there is not a substantive difference between the (Paris Convention) term ‘distinctive character’ and the terminology used in the Definition Model (‘distinctiveness’).

⁴⁴⁹ *Ibid*, Article 6^{bis}(1).

relation to ‘trade mark’ is provided, but certain things are listed as *not* possessing such character – for example, signs or indications that are customary. This list gives us examples of signs or indications that do not have distinctive character (in the context of ‘trade mark’), but does not tell us what it is (either in relation to trade marks or well-known trade marks). One factor that might be used in determining a distinctive character in trade marks is noted – the length of time of use of the mark is to be one of the considerations of its registrability⁴⁵⁰.

Thus, it can be seen that the Paris Convention can be seen to provide implicit guidance (on the basis of the assumption made in this thesis that one can infer what constitutes a ‘well-known trade mark’ *via* what constitutes a ‘trade mark’) on *form*. There is also no explicit guidance as to *concept*, although some guidance can be (tentatively) inferred, largely from that relevant to ‘trade mark’.

The Paris Convention does not explicitly provide guidance to the *preconditions*. The Convention states that, “...the conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation”⁴⁵¹: therefore, although the Paris Convention does not specify any of the *preconditions*, it can be said to leave scope for their introduction at the local level.

By now, it becomes noticeable that although the Paris Convention requires Member States to provide protection for well-known trade marks⁴⁵², it is – in effect – silent as to the definition of such marks, and the only real guidance as to the definition of ‘well-known trade mark’ is that that can be inferred through the definition of ‘trade mark’: Article 6bis, therefore, seems to encourage individual interpretation of what constitutes a ‘well-known trade mark’ by each of the Union countries⁴⁵³.

⁴⁵⁰ *Ibid*, Article 6*quinquies* C(1).

⁴⁵¹ *Ibid*, Article 6.

⁴⁵² *Ibid*, Article 6*bis*. Here is stated that protection must be provided (re. registered marks or well-known marks) against reproduction, imitation or translations liable to create confusion where used for identical or similar goods. It is also specifically stated that Article 6*bis* also applies where a well-known mark is reproduced in its essential parts, or is imitated, or is liable to create confusion.

⁴⁵³ *Ibid*, Article 2. It is stated that “(1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with. (2) However, no requirement as to domicile

Thus, as a result, there would appear to be scope for different definitions of ‘well-known trade mark’ at the local level, and – indeed – such national variations have been observed and commented upon in the literature⁴⁵⁴. However, this author is rather less sanguine about these national variations than are these commentators: she submits that the Paris Convention should have gone beyond merely requiring that signatory states protect well-known trade marks against certain actions. The Paris Convention should have also, in the view of this author, provided a *definition* of ‘well-known trade marks’ and an indication of *how* such trade marks are to be protected in national law.

An alternative mechanism for well-known trade mark protection in the Paris Convention – can be found in the unfair competition clause⁴⁵⁵. Although unfair competition law⁴⁵⁶ is beyond the scope of this thesis, a short comment on this Paris Convention provision would be helpful. Clearly Article 10bis protects more than trade marks (and well-known trade marks) as it applies to any act of unfair competition. But, Article 10bis⁴⁵⁷ would apply to *particular manners of use* of trade marks, including (i) allegations and indications used in the course of trade; (ii) those that might cause confusion, and; (iii) those that might mislead the public. Thus the scope of protection provided by Article 10bis can be seen as being at once more general (in that it extends beyond trade marks) than Article 6bis and having some

or establishment in the country where protection is claimed may be imposed upon nationals of countries of the Union for the enjoyment of any industrial property rights. (3) The provisions of the laws of each of the countries of the Union relating to judicial and administrative procedure and to jurisdiction, and to the designation of an address for service or the appointment of an agent, which may be required by the laws on industrial property are expressly reserved”. See Dinwoodie, G, B, ‘Trademarks and Territory: Detaching Trademark Law from the Nation-State’ (2004-2005) 41 *Hous.L.Rev.*885-974.

⁴⁵⁴ This trend can be seen by thoughts of legal schools. Various definitions of ‘well-known trade mark’ are introduced in Tatham, D, H, *supra* note 13 at 128 and also see generally, Mostert, F, W, *supra* note 49.

⁴⁵⁵ Article 10bis (1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition; (2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition; (3) The following in particular shall be prohibited: (i) all acts of such a nature *as to create confusion* by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor; (ii) *false allegations in the course of trade* of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor; (iii) *indications or allegations* the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

⁴⁵⁶ The Unfair Competition Prevention Act will be again introduced in Chapter 5 (Japan).

⁴⁵⁷ *Supra* note 511.

similarities (inasmuch as both Articles 6bis and 10bis refer to protection against confusion).

With relation to unfair competition issues, signposts given by Article 10bis: ‘well-known trade mark’ may well include allegations and indications used in the course of trade, which might cause confusion, and be misled by the public. Both trade mark *form* and *concept* of ‘well-known trade mark’ might be seen. The former includes allegations and indications used in the course of trade; the latter includes those which might cause confusion, and be misled by the public. However, it is submitted that this definition by Article 10bis seems to be that of ‘trade mark’ rather than that of ‘well-known trade mark’.

3.2.2 GATT TRIPS

Next, the author intends to examine GATT TRIPS⁴⁵⁸ and the definition, if provides for ‘well-known trade mark’, and apply the Definition Model to this. It is submitted that there is more guidance provided here as to the definition of ‘well-known trade mark’, and this provides an interesting contrast to the Paris Convention⁴⁵⁹.

The relevant article of GATT TRIPS⁴⁶⁰ is:

“Article 16 *Rights Conferred*

2. Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. *In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.*

⁴⁵⁸ See *supra* note 150. The more information regarding GATT TRIPS and other international instruments are to be found in Chapter 2, Sections 2.3.1.1-2.3.1.4.

⁴⁵⁹ The author of this thesis submits that the definition of ‘well-known trade mark’ in the Paris Convention implies a mark that is well-known in that country, including unregistered trade marks. See Chapter 2, Section 2.3.1.1.

⁴⁶⁰ *Supra* note 150. GATT TRIPS is the Marrakesh Agreement Establishing the World Trade Organization signed in Marrakesh, Morocco on 15 April 1994.

3. Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services *which are not similar to those in respect of which a trademark is registered*, provided that use of that trademark in relation to those goods or services would *indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use*". [Emphasis added].

In some ways, GATT TRIPS is rather similar to the Paris Convention⁴⁶¹ in this context. Neither, it is submitted, can be said to provide a comprehensive definition of 'well-known trade mark'. This author is fully aware that it was not the purpose of GATT TRIPS to provide a definition of 'well-known trade mark'⁴⁶², but still hopes that GATT TRIPS can provide further guidance as to the definition of 'well-known trade mark'.

Indeed, initial indications here are encouraging: it is widely accepted that GATT TRIPS provides stronger and wider scope of protection, and more effective protection⁴⁶³, to well-known trade marks than the Paris Convention⁴⁶⁴. First, to consider the definition of 'well-known trade mark': some guidance is provided here – service marks explicitly may be 'well-known trade marks'⁴⁶⁵. Further, it is stated that a court must consider knowledge (this author has pondered whether one could substitute the term 'reputation' here) in the relevant sector of the public when evaluating whether a mark is well-known⁴⁶⁶. (In other words, it is sufficient for knowledge of a trade mark to be established among a *substantial segment* of the public, rather than the general public⁴⁶⁷.) Moving beyond the definition of 'well-

⁴⁶¹ See Section 3.2.1.

⁴⁶² See Gervais, D, *supra* note 171 at 170. See, the aims of GATT TRIPS in Chapter 2, Section 2.3.1.4.

⁴⁶³ Other notable features of GATT TRIPS can be described as follows: GATT TRIPS emphasises enforcement both internally and at national borders, taking into account the widespread nature of infringement of intellectual property rights (Article 51). GATT TRIPS further provides that enforcement procedures should be meaningful (Article 41). The enforcement procedures must be fair and equitable, and not unnecessarily complicated or costly. They should not entail unreasonable time limits or unwarranted delays. In so doing, the enforcement mechanisms in GATT TRIPS may be more effective than those found in the Paris Convention.

⁴⁶⁴ See, for example, Malkawi, B, H, 'Well-Known Marks in Jordan: Protection and Enforcement' (2007) 12 *Comms. L.* 119-124.

⁴⁶⁵ Article 16(2) of GATT TRIPS.

⁴⁶⁶ *Ibid*, Article 16.

⁴⁶⁷ *Ibid*.

known marks', it is made clear that the protection of such marks is to be extended to dissimilar goods under certain circumstances⁴⁶⁸.

Returning to the Definition Model, we shall examine this definition of 'well-known trade mark' (that in Article 16 of GATT TRIPS), before critiquing the same. First, it is clear that Article 16 of GATT TRIPS includes and builds upon the well-known trade mark protection provided in the Paris Convention⁴⁶⁹. In Article 16 of GATT TRIPS both the *form (context)* and the *concept* of 'well-known trade mark' can be recognised. Firstly, the *form* of 'well-known trade mark' recognised is limited to *context* (there is no explicit reference to *type*): i.e. the reference to service marks in Article 16(2)⁴⁷⁰.

Secondly, at first reading, the *concept* of 'well-known trade mark' in the Definition Model does not appear to be found in GATT TRIPS, as the term 'distinctiveness' is not used. However, unlike in the Paris Convention⁴⁷¹, some explicit guidance as to when a mark is well-known is provided:

"...In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark." [Emphasis added].

Here, clearly, *knowledge* of trade marks in the relevant sector of the public is an essential part in assessing if a trade mark is well-known, and knowledge of the mark can be established by means of promoting the trade mark⁴⁷². It is submitted by this

⁴⁶⁸ The Paris Convention is only applicable to the identical or similar goods.

⁴⁶⁹ See the wording of Articles 16(2) and (3) of GATT TRIPS, it is state that "...Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis...*".

⁴⁷⁰ Although there is some recognition of service marks in the Paris Convention, it is only here in GATT TRIPS that we see the full recognition of service marks specifically as a *form* of 'well-known trade mark'.

⁴⁷¹ This lack has been criticised, e.g. see Tritton, G, *supra* note 37 at 230.

⁴⁷² Article 16(2) of GATT TRIPS. It also submitted that the term 'knowledge of the trade mark' can be seen from the two different aspects; the extent to which the mark is known to consumers, and the geographical extent of the mark (for example, how many Member States recognise the trade mark in question) – see Rahanasto, L, *Intellectual Property Right, External Effect, and Anti-Trust Law: Leveraging IPRs in the Communications Industry* (Oxford, Oxford University Press, 2003) at 35.

author that the term ‘knowledge’ in this context has some correlation to distinctiveness.

Therefore, the *concept* of ‘well-known trade mark’ is explicitly present in GATT TRIPS, and it is also stated that this knowledge can be acquired⁴⁷³. It is still unclear as to *how* distinctive (or how *well-known*) a trade mark has to be considered to be well-known.

Thus, in relation to the definition of ‘well-known trade mark’, GATT TRIPS does not provide as much guidance as this author had hoped for: returning to the Definition Model, in terms of *context* within *form* it is clear that in addition to that provided by the Paris Convention, service marks are specifically included in relation to ‘well-known trade marks’. In relation to *concept*, we are told how knowledge (or distinctiveness) should be measured, but not how much is required. Where GATT TRIPS does seem to improve⁴⁷⁴ on the Paris Convention is in the area of scope of protection afforded to well-known trade marks: as noted above, protection is extended to dissimilar goods under certain circumstances.

It should not be forgotten that the Definition Model also has *preconditions*. One of these does appear to be present in GATT TRIPS⁴⁷⁵, although the term used is ‘visual perception’ rather than *graphic representation*. It should be noted that *commercial use* (the other *precondition*) is not present.

⁴⁷³ It is submitted by this author that this might be one of the conceptual differences between ‘trade mark’ and ‘well-known trade mark’: as alluded to at Chapter 2, Section 2.2.3, where it was noted that the *concept* of the well-known trade mark ‘COCA-COLA’ relied on acquired distinctiveness. In this line of reasoning, ‘trade mark’ *concept* could be innate and/or acquired, but to achieve the level of distinctiveness (or knowledge) required of a well-known trade mark, a very significant amount of distinctiveness must be acquired (whether the mark was originally innately distinctive or not). This line of reasoning does not, it is submitted, substantively affect the Definition Model, but it is a refinement worth noting. See *supra* note 137.

⁴⁷⁴ Another way in which the two instruments are similar (although further discussion of this is precluded by the scope of this thesis) lies in unfair competition. Similarly to Article 10bis of the Paris Convention, an alternative route to well-known trade mark protection could be provided by the unfair competition proviso under Article 39 of GATT TRIPS. Article 39 is clearly based on the equivalent Paris Convention provision (it is stated in Article 39 that the purpose here is to ensure effective protection against unfair competition as provided in Article 10bis of the Paris Convention).

⁴⁷⁵ Article 15(1) of GATT TRIPS.

Before moving on to the next relevant international instrument, the WIPO Recommendation, it is felt to be helpful to undertake a very brief comparative analysis of the Paris Convention and GATT TRIPS as to the definitions provided of ‘trade mark’.

3.2.4 A Comparison: The Paris Convention and GATT TRIPS

It is submitted that no comprehensive definition of ‘well-known trade mark’ is to be found in either of the relevant treaties i.e. the Paris Convention and GATT TRIPS. Although it is possible to imply (from provisions that relate to the definitions provided of ‘trade mark’) some further guidance as to what constitutes a ‘well-known trade mark’, it is thought by this author to be helpful at this point to compare the provisions, using the Definition Model, in these two Treaties that *explicitly* relate to ‘well-known trade marks’:

- *The Paris Convention.* It can be submitted that a ‘well-known trade mark’ is a trade mark that is well-known in the country of registration or use. Thus, there is no explicit guidance as to *form* or *concept*;
- *GATT TRIPS.* It can be submitted that a ‘well-known trade mark’ is a trade mark (including a service mark (*context of form*)) for which there is sufficient knowledge in the relevant sector of the public (including knowledge obtained as a result of promotion of the trade mark); and the *concept* lies here in knowledge (*knowness*).

Placing these two definitions together, does not provide much more in the way of guidance: collectively from these two treaties it can be said that a well-known trade mark is a trade mark or service mark that is well-known (in the sense of there being sufficient knowledge in the relevant sector of the public in the country of registration or use).

It is submitted that GATT TRIPS has the broader definition⁴⁷⁶ of well-known trade mark *context*, as in terms of *form* it is clear that service marks are included⁴⁷⁷: neither, however, explicitly provide for ‘well-known trade mark’ *type*. The other difference between the Paris Convention and GATT TRIPS is that the latter does give some guidance as to *concept*⁴⁷⁸, explicitly providing that there has to be sufficient knowledge and awareness of the trade mark in the relevant part of the public, including knowledge obtained as a result of a trade mark being promoted⁴⁷⁹.

Overall, ‘well-known trade mark’ *context* in *form* is addressed to some degree in these two Treaties, but what level of knowledge is required for a trade mark to be ‘well-known’⁴⁸⁰ is not explicitly set out, so well-known trade mark *concept* is not set out fully. There are also deficiencies relating to form, as *context* is only lightly dealt with and there is no explicit guidance as to *types* of well-known trade mark.

3.2.4 The WIPO Recommendation

Thus far, the author believes that she has demonstrated that there is not a comprehensive definition of ‘well-known trade mark’ within the Paris Convention or GATT TRIPS⁴⁸¹, with reference to the Definition Model.

Any consideration of ‘well-known trade mark’ at the international level must, of course, also consider the WIPO Recommendation⁴⁸². Please note that it is not the

⁴⁷⁶ It can be said that it also has the broader scope of well-known trade mark protection since protection is extended to dissimilar goods (see Article 16(2) of GATT TRIPS).

⁴⁷⁷ Article 16(2) of GATT TRIPS.

⁴⁷⁸ A fact recognised, albeit not using the terminology of the Definition Model, in Wurtenberger, G, ‘Risk of Confusion and Criteria to Determine the Same in European Community Trade Mark Law’ (2002) 24 *EIPR* 20-29 at 27.

⁴⁷⁹ See Article 16(2) of GATT TRIPS.

⁴⁸⁰ *Supra* note 150. GATT TRIPS is aimed at providing the additional legal standards for the recognition and protection of well-known marks, although the aim of both the Paris Convention and GATT TRIPS is to provide the minimum standard of IP protection. See Chapter 2, Section 2.3. Handler, M, ‘Trade Marks Dilution in Australia?’ (2007) 29 *EIPR* 307-318 at 308.

⁴⁸¹ See Article 6bis of the Paris Convention and Articles 16(2) and (3) of GATT TRIPS.

⁴⁸² See the Preamble of the WIPO Recommendation and a document A/32/2-WO/BC/18/2 at 86 and “Main Program 09 WIPO Program and Budget for the biennium 1998-99, which comes under Main Program 09” document A/32/2-WO/BC/18/2 at 86. It is sought to provide more flexibility into the legal context as follows “Given the practical imperative for accelerated development and implementation of certain international harmonised common principles and rules in industrial property law, the future strategy for this main program includes consideration of ways to complement the treaty-

purpose of this section to explore the historical development⁴⁸³ or consideration of the administrative aspects⁴⁸⁴ of WIPO (the World Intellectual Property Organisation)⁴⁸⁵; instead the focus is the definition of ‘well-known trade mark’⁴⁸⁶.

The purpose of the WIPO Recommendation is said to be the establishment of a certain international harmonised approach to common principles and rules to assess the extent to which marks are well-known⁴⁸⁷. It is, of course, a mere guideline, not a binding legal instrument⁴⁸⁸, but it is submitted that it is important for both pragmatic and legal reasons. First, pragmatism: the WIPO Recommendation, by virtue of being one of the few international guides in this area, seems to be the main model for the

based approach [...]. If Member States judge it to be in their interests so to proceed, a more flexible approach may be taken towards the harmonisation of industrial property principles and rules...”

⁴⁸³ The predecessor to the WIPO was the BIRPI (*Bureaux Internationaux Réunis pour la Protection de la Propriété Intellectuelle*: French acronym for United International Bureau for the Protection of Intellectual Property), which was set up in 1893 to administer the Bern Convention (Berne Convention for the Protection of Literary and Artistic Works) and the Paris Convention for the Protection of Industrial Property in 1883. It should be note here that the Paris Convention is administered by the WIPO. See WIPO web site, WIPO-Administered Treaties. It was consulted on August 10, 2007. Also, a full text of the Berne Conventions is to be found at

http://www.wipo.int/treaties/en/ip/berne/trtdocs_wo001.html. (Last accessed on 12 January 2010).

⁴⁸⁴ The role of WIPO in relation to trade marks and trade mark law can be set out as follows: (i) *normative activities*, involving the setting of norms and standards for the protection and enforcement of trade marks (and other intellectual property rights) through the conclusion of international treaties and instruments (the WIPO Recommendation can be categorised under (i)); (ii) *program activities*, involving legal technical assistance to States in the field of intellectual property; (iii) *international classification* and standardization activities, involving cooperation among industrial property offices concerning patents, trade marks and industrial design documentation (the Nice Classification of trade marks can be categorised as (iii)); and (iv) registration activities, involving services related to international applications for patents for inventions and for the *registration of international marks* and industrial designs (the TLT and the Singapore Treaty can be categorised as (iv)).

⁴⁸⁵ For further information, please see Kunze, G, F, WIPO Standing Committee on the Law of Trade Marks, Industrial Designs and Geographical Indications’ (2000) 2 *WLLR* 3-4.

⁴⁸⁶ Apart from the WIPO Recommendation, this author has noted that Tatham has proposed a definition of both famous and well-known trade marks (see Chapter 1, Section 1.2). This author is also aware of one other such attempt to create a definition of ‘well-known mark’ at the international level: the AIPPI (International Association for the Protection of Industrial Property at its Executive Committee Meeting in Barcelona in September 30 – October 5, 1990) defined a well-known mark as “a mark which is known to a large part of public, being associated with the article or service in the mind of the public as indicating their origin”. See AIPPI Yearbook 1991/I ‘Question 100 Protection of unregistered but well-known trademarks (Art. 6bis Paris Convention and protection of highly renowned trademarks’ at 295-297. A full report is to be found at

<https://www.aippi.org/download/comitees/100/RS100English.pdf>. (Last accessed on 12 January 2010).

This author submits that this constitutes a very general description rather than a definition of ‘well-known marks’ and, as such, has elected not to critically analyse this further.

⁴⁸⁷ See the third paragraph of the Preamble of the WIPO Recommendation.

⁴⁸⁸ The non-binding nature of the WIPO Recommendation can be read from the third paragraph of the Preamble of the WIPO Recommendation. It is clearly stated that “...recommend that each Member State may consider the use of any of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT)...”

regulation of well-known trade marks at the national level⁴⁸⁹. Secondly, law: in the Preamble to the Recommendation⁴⁹⁰, there is a specific recommendation that member states of WIPO and Paris Union countries bring the Recommendation to the attention of regional trade mark organisations. If or where such regional organisations have noted the Recommendation, this could influence the development of regional (and national) trade mark law. Thus, by an unofficial route, the Recommendation could attain a *quasi-official* character at the local level.

Although the WIPO Recommendation has already been exposed to some criticisms by commentators⁴⁹¹, this author believes that it is important to critically explore the WIPO Recommendation directly in this thesis, rather than just relying on such secondary sources. It should be noted that the Recommendation essentially constitutes the first (non-binding) international guideline providing tests or guidance establishing whether a mark is well-known⁴⁹². However, there seems no comprehensive definition of ‘well-known trade mark’ set out herein. It should be stressed here that the Recommendation speaks to the *determination* of well-known marks, not the definition of such marks⁴⁹³, so much of this author’s critical analysis of this Recommendation lies in considering what implicit guidance the Recommendation provides for the definition of ‘well-known trade mark’.

By way of introduction it should be appreciated that what is provided in the WIPO Recommendation are mere factors or thresholds which *may* be considered in determining whether a trade mark⁴⁹⁴ is well-known. Therefore, in applying the Definition Model here, we might expect that the main focus of the WIPO Recommendation would relate to guidance as to establishing *concept*, and less to *form*

⁴⁸⁹ Indeed, it is said that the WIPO Recommendation has influenced the contents of the JPO Guidelines). See Chapter 5, Section 5.3.2.

⁴⁹⁰ See the third paragraph of the Preamble of the WIPO Recommendation.

⁴⁹¹ There was uncertainty concerning the criteria to be used in preparing such a list and how account should be taken of the fact that the status of a mark being well-known can be subject to continuous change. Kur, A, *supra* note 47 at 826.

⁴⁹² See Article 2(2)(a)(iii) of the WIPO Recommendation.

⁴⁹³ In a linguistic context, ‘definition’ can be said to be “statement of the meaning of a word or the nature of the thing”; whilst the term ‘determination’, can be said to relate to “the process of deciding; or to find out or establish precisely”. All definitions from the Concise Oxford English Dictionary (Allen, R, E, *The Concise Oxford Dictionary of Current English* (Clarendon Press, Oxford, 1990) at 308 and 318. Thus, this author would expect a definition to be precise (and, hopefully, comprehensive), whereas an indication can be expected to be indicative.

⁴⁹⁴ See Article 2 of the WIPO Recommendation.

(*type and context*) of ‘well-known trade mark’. This author submits, however, that *concept and form* should both be represented in a comprehensive definition of ‘well-known trade mark’ and, indeed (as will be seen below), there is some guidance as to both of these in the WIPO Recommendation. However, this author strongly believes that the use of indicative factual-based criteria, factors or thresholds in the Recommendation causes problems in attempting to elucidate a definition of what constitutes a ‘well-known trade mark’: in short, the Recommendation provides *some* factors to determine whether a mark is ‘well-known trade mark’, but not an explicit definition: it is not easy to fit such factors into the Definition Model.

Nevertheless, the Definition Model will be applied to the WIPO Recommendation, below.

Firstly, *form* (*type and context*) of ‘well-known trade mark’. Well-known trade mark’ *context* in *form* is addressed in the Recommendation, and is said to include business identifiers⁴⁹⁵, and domain names⁴⁹⁶. The former are further explained in the Recommendation as being:

“... signs which *identify* businesses as such, and not the products or services offered by the business, the latter feature constituting a pure trademark function. Signs that may constitute business identifiers are, for example, *trade names, business symbols, emblems or logos*. Some confusion as regards the functions of marks and business identifiers stems from the fact that, sometimes, the name of a company, i.e., its business identifier, is identical with one of the company’s trademarks”⁴⁹⁷. [Emphasis added].

⁴⁹⁵ The definition of ‘business identifier’ is to be found at Article 1(iv) of the WIPO Recommendation as follows: “business identifier” means any sign used to identify a business of a natural person, a legal person, an organisation or an association.

⁴⁹⁶ The definition of domain name is to be found at Article 1(v) of the WIPO Recommendation as follows: “domain name” means an alphanumeric string that corresponds to a numerical address on the Internet.

⁴⁹⁷ Item (iv) of the Explanatory Notes. See further information regarding Explanatory Note. It is stated that :“This notes were prepared by the International Bureau of the WIPO for explanatory note only, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) agreed that the notes would not be submitted for adoption by the Assembly of the Paris Union and the WIPO General Assembly, but would rather constitute an explanatory document prepared by the International Bureau so that, *in cases of conflicts between the provisions and the notes, the provisions would prevail* (see paragraph 17 of document SCT/2/5).” [Emphasis added].

With relation to ‘domain name’, the following definition is provided:

“...can be described as user-friendly substitutes for numerical Internet addresses. A numerical Internet address (also referred to as “Internet Protocol address” or “IP address”) is *a numeric code which enables identification of a given computer connected to the Internet*. The domain name is a mnemonic substitute for such an address which, if typed into the computer, is automatically converted into the numeric address⁴⁹⁸”. [Emphasis added].

This is our third application of the Definition Model in this Chapter: in the interests of avoiding repetition, it should be noted the WIPO Recommendation specifically includes that subject matter set out in the Paris Convention⁴⁹⁹, thus, all the implicit guidance as to what constitutes a ‘well-known trade mark’ that was set out in Section 3.2.1, should equally apply to the Recommendation.

Nevertheless, the Recommendation clearly goes further than the Paris Convention. Furthermore, *type* and *context* of well-known trade mark *form* are explicitly present: *forms* provided include logos (*type*), trade names and other business identifiers and internet domain names (*context*). The fact that domain names are explicitly noted here in what is one of the more recent instruments pertaining to (well-known) trade marks does provide some support for the author’s view that the extent of (well-known) trade mark *context* can expand over time, and, indeed, that this should be expected. This is significant, whilst the aims of this thesis mean that this author is looking in the relevant jurisdictions for *comprehensive* definitions of ‘well-known trade marks’, it must be accepted that any definition of *context* must, as a result, be indicative (albeit, it is submitted, detailed), rather than definitive. This author also believes that similar flexibility should also apply to well-known trade mark *type*: as, again, the scope of trade mark *type* can, it is submitted, be expected to expand over

⁴⁹⁸ Item (v) of the Explanatory Notes.

⁴⁹⁹ See the WIPO Recommendation at 4. It is stated that “...taking *into account* the provisions of the Paris Convention for the Protection of Industrial Property relative to the protection of well-known marks...”.

time⁵⁰⁰. To summarise: in this thesis, any definitions offered of *form* of ‘well-known trade mark’ should reflect the need for such flexibility.

Now ‘well-known trade mark’ *concept* is to be examined. In the application of the Definition Model, in Chapter 2, this author has submitted that distinctiveness lies at the heart of ‘trade mark’ *concept*⁵⁰¹. However, the term ‘distinctiveness’ is not to be found in the WIPO Recommendation, instead we find in Article 2(1)(a) the statement that ‘the competent authority shall take into account any circumstances from which it may be inferred that the mark is well-known’ and in Article 2(1)(b), a list of factors – all, some, or none⁵⁰² of which can be used in inferring that the mark is well-known. Hereafter, these factors will be referred to as the non-exhaustive factors.

Knownness or knowledge does, it is submitted have some correlation with distinctiveness (and, thus, *concept*). Nevertheless, a more detailed consideration of *concept* of ‘well-known trade mark’ requires that these non-exhaustive factors should be taken into consideration⁵⁰³:

“Article 2 (1)

(b) In particular, the competent authority *shall consider information* submitted to it with respect to *factors* from which it may be inferred that the mark is, or is not, well known, *including, but not limited to, information* concerning the following:

1. the *degree of knowledge or recognition of the mark in the relevant sector of the public*;
2. the *duration, extent and geographical area* of any *use of the mark*;
3. the duration, extent and geographical area of *any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies*;

⁵⁰⁰ See the demand for registrability of non-traditional trade marks in the TLT (Chapter 2, Section 2.3.1.2. and the Singapore Treaty (Chapter 2, Section 2.3.1.3.).

⁵⁰¹ See Chapter 2, Section 2.2.2.

⁵⁰² See Article 2(1)(c) of the WIPO Recommendation. As made very clear, again, in item 2.10 of the Explanatory Notes, these factors are *not* exhaustive.

⁵⁰³ *Ibid*, Article 2(1)(a). There is a great emphasis on the particular circumstance being considered by each case. See for example, *Ibid*, Articles 2(1)(b) and (c).

4. the duration and geographical area of *any registrations, and/or any applications for registration, of the mark*, to the extent that they reflect use or recognition of the mark;
5. the *record of successful enforcement of rights in the mark*, in particular, the extent to which the mark was recognized as well known by competent authorities;
6. the *value associated with the mark.*" [Emphasis added].

It is submitted by this author that, as well as being factors that can infer whether a particular trade mark is well-known (i.e. being a test of 'well-known trade mark' status), that these six non-exhaustive factors can be used to infer an implicit notion of the WIPO Recommendation *concept* of a 'well-known trade mark' (i.e. one can infer part of how the notion of 'well-known trade mark' should be defined). Nevertheless, it is submitted by this author that *if concept* were represented in the Recommendation as part of an explicit definition of 'well-known trade mark' (rather than just having indicative factors that may be used in a case-by-case factual enquiry), this would lead to greater understanding, and certainty, as to what a 'well-known trade mark' is.

It is submitted that the following might be inferred as to trade mark *concept* from the six non-exhaustive factors:

1. The first factor relates to *knowledge or recognition of the mark in the relevant sector of the public*⁵⁰⁴. It has already been submitted⁵⁰⁵, that in this context, knowledge can be regarded as being synonymous with distinctiveness. It is also submitted that 'recognition' of the mark is similarly synonymous with distinctiveness;
2. the *duration, extent and geographical area of any use of the mark*⁵⁰⁶. It is submitted that temporal and geographic considerations (and extent of use) are proxies for distinctiveness⁵⁰⁷;

⁵⁰⁴ See the Explanatory Note: 2.3 No. 1. "The degree of knowledge or recognition of a mark can be determined through consumer surveys and opinion polls. The point under consideration recognizes such methods, without setting any standards for methods to be used or quantitative results to be obtained".

⁵⁰⁵ This argument has already been made in Section 3.2.2 pages 93-94.

⁵⁰⁶ See the Explanatory Note: 2.4 No. 2. "The duration, extent and geographical area of any use of the mark are highly relevant indicators as to the determination whether or not a mark is well known by the

3. the duration, extent and geographical area of *any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions*, of the goods and/or services to which the mark applies⁵⁰⁸. Again, it is submitted that these are proxies for distinctiveness⁵⁰⁹.

4. the duration and geographical area of *any registrations, and/or any applications for registration, of the mark*, to the extent that they reflect use or recognition of the mark⁵¹⁰. Following the reasoning set out above, it is again submitted that these are proxies for distinctiveness;

5. the *record of successful enforcement of rights in the mark*, in particular, the extent to which the mark was recognized as well known by competent authorities⁵¹¹. This, it is suggested, is a form of informal mutual recognition – i.e. if one state has recognised a mark as being well-known, then others might

relevant sector of the public. Attention is drawn to Article 2(3)(a)(i), providing that actual use of a mark in the State in which it is to be protected as a well-known mark cannot be required. However, use of the mark in neighbouring territories, in territories in which the same language or languages are spoken, in territories which are covered by the same media (television or printed press) or in territories which have close trade relations may be relevant for establishing the knowledge of that mark in a given State”.

⁵⁰⁷ In the context of the Paris Convention, it has already been seen that *duration* of use may be a factor in relation to protection being afforded to trade marks (see Article 6*quinquies*C(1) of the Paris Convention).

⁵⁰⁸ See the Explanatory Note: 2.6 No. 3. “Although “promotion of a mark” may well be considered to constitute use, it is included as a separate criterion for determining whether a mark is well known. This is mainly done in order to avoid any argument as to whether or not promotion of a mark can be considered to be use of the mark. Where an ever increasing number of competing goods and/or services are on the market, knowledge among the public of a given mark, especially as regards new goods and/or services, could be primarily due to the promotion of that mark. Advertising, for example, in print or electronic media (including the Internet), is one form of promotion. Another example of promotion would be the exhibiting of goods and/or services at fairs or exhibitions. Because the visitors at an exhibition may come from different countries (even if the access as exhibitors is limited to nationals from one country, for example, in the case of a national fair or exhibition), “promotion” in the sense of No. 3 is not limited to international fairs or exhibitions”.

⁵⁰⁹ In the context of GATT TRIPS, we have already seen that trade mark promotion has been linked to *concept* (in the context of knowledge/distinctiveness) – please see Article 16(2) of GATT TRIPS.

⁵¹⁰ See the Explanatory Note: 2.7 No. 4. “The number of registrations of a mark obtained worldwide and the duration of those registrations may be an indicator as to whether such a mark can be considered to be well known. Where the number of registrations obtained worldwide is held relevant, it should not be required that those registrations are in the name of the same person, since in many cases a mark is owned in different countries by different companies belonging to the same group. Registrations are relevant only to the extent that they reflect use or recognition of the mark, for example, if the mark is actually used in the country for which it was registered, or was registered with a *bona fide* intention of using it”.

⁵¹¹ See the Explanatory Note: 2.8 No. 5. “Due to the principle of territoriality, well-known marks are enforced on a national basis. Evidence of successful enforcement of the right to a well-known mark or of the recognition of a given mark as being well known, for example, in neighbouring countries, may serve as an indicator as to whether a mark is well known in a particular State. Enforcement is intended to be construed broadly, also covering opposition procedures in which the owner of a well-known mark has prevented the registration of a conflicting mark”.

consider doing so. Combined with other factors, this factor might usefully contribute some indication of whether a mark is well-known;

6. the *value associated with the mark*.⁵¹² [Emphasis added]. This, it seems to this author, points to a valuable mark, rather than a well-known mark.

Because of the possible confusion between valuable and well-known marks⁵¹³, this author submits that value is not a good indicator of well-known status, although this factor might serve some (limited) role in indicating well-known status in combination with other factors.

Returning to the Definition Model, as has been seen, both *form* and *concept* of ‘well-known trade mark’ can be found herein⁵¹⁴. As noted above by this author: the WIPO Recommendation does not conceptually define ‘well-known trade mark’, but instead provides some criteria to be used in assessing *concept* – this is submitted to be distinctiveness. Of these criteria, it is submitted that the first and third factors seem to be directly derived from GATT TRIPS⁵¹⁵, with consolidation and confirmation that the relevant sectors includes actual and potential consumers⁵¹⁶, including the particular business traders⁵¹⁷ in particular business circles⁵¹⁸. In addition to this, it is provided that a mark needs to be well-known in at least one relevant sector of the public⁵¹⁹, but that it is not necessary for it to be well-known by the public at large⁵²⁰, in one or more jurisdictions other than that of the member states⁵²¹.

Moreover, it is stressed that global recognition of the mark plays a role in this list⁵²² regarding geographic extent. It is made clear that a mark needs to be well-known by the public at large if use of the mark by third parties is to be capable of impairing or diluting it in an unfair manner⁵²³, and taking an unfair advantage of⁵²⁴ the distinctive

⁵¹² See the Explanatory Note: 2.9 No. 6. “There exists a considerable variety of methods for trademark evaluation. This criterion does not suggest the use of any particular method. It merely recognizes that the value associated with a mark may be an indicator as to whether or not that mark is well known”.

⁵¹³ Please see page 106.

⁵¹⁴ Articles 2(3)(i) and (ii) of the WIPO Recommendation.

⁵¹⁵ See Article 16(1) of GATT TRIPS. See Kur, A, *supra* note 47 at 828.

⁵¹⁶ Article 2(2)(a)(i) of the WIPO Recommendation.

⁵¹⁷ *Ibid*, Article 2(2)(a)(ii).

⁵¹⁸ *Ibid*, Article 2(2)(a)(iii).

⁵¹⁹ *Ibid*, Article 2(2)(b).

⁵²⁰ *Ibid*, Article 2(3)(iii).

⁵²¹ *Ibid*, Article 2(3)(b).

⁵²² See Kur, A, *supra* note 47 at 828.

⁵²³ Article 4(1)(b)(ii) of the WIPO Recommendation.

character of the well-known trade mark⁵²⁵. The Recommendation can be seen to introduce less novelty here, and, overall – in determining if a mark is well-known or not, great weight seems to be on factual evidence, and thus (potentially) a wide scope of discretion can be expected.

To summarise, with reference to the Definition Model, ‘well-known trade mark’ in the WIPO Recommendation can be presented as follows:

More guidance with relation to ‘well-known trade mark’ *form (context)* can be seen: domain names and business identifiers are included. However, there is no clear explicit elucidation of ‘well-known trade mark’ *concept*. Implicitly, it is argued by this author, the approach to *concept* appears to relate to distinctiveness (knowledge/reputation), but as a range of factors can be used jointly or individually (or not at all) to infer well-known status, the Recommendation notion of *concept* is clearly broader than that of distinctiveness (whether a high level of this or otherwise), as it encompasses mutual recognition and value. Although this author has argued, above, that a number of the non-exhaustive factors are proxies for distinctiveness, she must concede that there is also an alternate argument here. Namely, this: if knowledge and reputation are synonymous with distinctiveness, and use, promotion and registration are proxies of distinctiveness, why does Article 2(1)(b) of the WIPO Recommendation not just refer to distinctiveness?

Concluding this application of the Definition Model, it should be noted that none of the *preconditions* appear to be present in the Recommendation.

This author submits that this framework provided by the WIPO for determining whether a mark is well-known can be criticised in more detail in a number of ways. First, if one assumes (contrary to the assumptions that underpin this thesis) that the *concept* of ‘well-known trade mark’ cannot be comprehensively defined, but that it is best to determine whether marks are well-known on a case-by-case basis, then having factual questions or thresholds for determining whether a mark is well-known is logical. However, is it impossible to conceptually define well-known trade mark

⁵²⁴ *Ibid*, Article 4(1)(b)(iii).

⁵²⁵ *Ibid*, Article 4(1)(b).

concept? Is this purely a factual question? This author *suggests* that the answers here are ‘no’ and ‘no’, but the author’s view is derived from the logical extension of one of the assumptions made in this thesis⁵²⁶: this author cannot *prove* that it is possible to conceptually define what constitutes ‘well-known trade mark’ *concept*, or that such a definition would be more efficacious⁵²⁷ than reliance on case-by-case application of fact-based questions.

Returning to the more detailed critique of the WIPO Recommendation, firstly this author has submitted that there is no explicit elucidation of ‘well-known trade mark’ *concept* contained therein. Further, now she would like to place further arguments that the implicit guidance as to *concept* that can be derived from the Recommendation is both too broad and too uncertain.

Secondly, this author submits that there are some curious provisions that pertain to (implicit) ‘well-known trade mark’ *concept*. For example, Article 1(b)(4)⁵²⁸ requires consideration of the duration and geographical extent of the trade mark being registered or used. As to duration of use, particularly where trade marks are used in a Web context⁵²⁹, it is conceivable that a trade mark could now become ‘well-known’ in a very short time period. Admittedly, duration is just one of the factors that can be used in determining to what extent a mark is well-known (well-knownness), but there is at least an argument that in some contexts (e.g. domain name use) the duration guidance provided should indicate that very short periods of use can be sufficient. As to geographic extent of use there is also, it is submitted, rather old-fashioned guidance: it is stated that a mark shall be assumed to be well-known *within the country of protection* if it satisfies the relevant criteria. However, as noted by a number of legal scholars⁵³⁰, trade marks are no longer merely national assets and trade marks now exist in a very international, and in some respects, borderless world⁵³¹.

⁵²⁶ That well-known trade marks are the purest or strongest category of ‘trade mark’, thus analysis and consideration of the latter can be used to infer the nature of the former: as illustrated in Chapter 2, ‘trade mark’ is conceptually defined in law, so it must be possible to do the same for a ‘well-known trade mark’ as a *form* of trade mark.

⁵²⁷ One question to be considered in Chapter 7 is how *form* and *concept* of ‘well-known trade mark’ do and should differ from those of ‘trade mark’ under the Definition Model.

⁵²⁸ Article 1(b)(4) of the WIPO Recommendation.

⁵²⁹ *Supra* note 68.

⁵³⁰ See Mostert, F, W, *supra* note 62.

⁵³¹ See Mc Dermott, *supra* note 223 at 41.

That a more modern approach to geographic extent of use of well-known trade marks is necessary has already been conceded by WIPO⁵³², but this view is not reflected in the Recommendation itself.

Thirdly, this author strongly criticises the WIPO Recommendation for failing to make a distinction between so-called ‘valuable marks’⁵³³ and ‘well-known trade marks’⁵³⁴. The introduction of the under-explained term, “the value associated with the mark”⁵³⁵ is, in the view of this author, extremely unhelpful. An example might illustrate this point more fully: the trade mark ‘GE’ was ranked as one of the top 10 most *valuable marks* in 2008⁵³⁶, and the market value of the ‘GE’ mark has been estimated at \$ 53.086 million⁵³⁷. However, is this trade mark more well-known than, for instance, ‘GOOGLE’ which has been estimated as being worth \$17.387 million in 2007⁵³⁸ and, in 2008, \$25.259 million⁵³⁹? Economic value determines whether a mark is valuable, but it is consumer recognition (at the heart of which must be distinctiveness) that determines whether a mark is well-known. It is submitted that although the more well-known a mark becomes, the greater commercial and economic value the mark may become, it is arguable that valuable marks are not the same as well-known marks and *vice versa*. Therefore, this author submits that the Recommendation is extremely unhelpful in this regard, and tentatively submits that if the Recommendation did include an explicit definition of ‘well-known trade mark’ that fully addressed both concept and form, that the mention of famous marks here would be less problematic.

⁵³² It has been argued that that the WIPO Recommendation should be amended to protect well-known trade marks in territories of their goodwill, and not within Members State’s national boundaries. See Compare Protection of Well-Known Marks, World Intellectual Property Organisation (WIPO) at 8-9, Document SCT/1/3/ (May 14, 1998).

⁵³³ See Article 2(1)(b)(6) of the WIPO Recommendation. Regrettably, no further explanation is given with relation to ‘valuable mark’ in the Explanatory Notes.

⁵³⁴ See the legal recognition of valuable trade marks; Blakeney, M ‘Trade Marks and the Promotion of Trade’ (1999) 5 *Int. T.L.R* 140-146 at 140. See Mostert, F, W, and Aplozon, L, E, *From Edison to Ipod: Protect Your Ideas and Make Money* (New York, DK Publishing, 2007) at 88-89.

⁵³⁵ See Article 2(1)(b)(6) of the WIPO Recommendation.

⁵³⁶ *Supra* note 26. Interbrand reported that the top 10 of the most valuable international brands from between 2007 to 2008 were as follows: Coca-Cola (US); IBM (US); Microsoft (US);GE (US); Nokia (FI); Toyota (JP); Intel (US); McDonald’s (US); Disney (US); and Google (US). An interesting change can be observed: the word mark ‘GOOGLE’ was ranked to the 20th in 2007, whilst in 2008 again it became 10th. An estimation of the legitimacy of the Interbrand survey is rather beyond the scope of this thesis. The Interbrand survey is used *as one of the exemplars* to see how a trade mark can be commercially valuable in practice. The full text of the Interbrand survey is to be found at http://www.interbrand.com/best_global_brands.aspx. (Last accessed on 12 January 2010). The methodology employed by the Interbrand Survey is based on a financial analysis.

⁵³⁷ *Ibid*

⁵³⁸ *Ibid*.

⁵³⁹ *Ibid*.

3.3 Conclusion

So far, this author has sought a definition of ‘well-known trade mark’ within the relevant international framework (the Paris Convention⁵⁴⁰, GATT TRIPS⁵⁴¹ and the WIPO Recommendation⁵⁴²) and has critiqued the same, utilising the Definition Model⁵⁴³ in this process.

Here it is felt that it would be helpful to set out a dual composite definition of ‘well-known trade mark’, by combining the guidance on this to be found in the Paris Convention⁵⁴⁴ and GATT TRIPS⁵⁴⁵, and framing this within the basic binary definition within the Definition Model (*form* and *concept*), as follows:

- ‘Well-known trade mark’ *form*: a mark includes ones which can be inferred from ‘trade mark’ under the Paris Convention and includes, as *per* GATT TRIPS, service marks;
- ‘Well-known trade mark’ *concept*: mark being well known in a member of states and being held in the knowledge of the relevant public, in which the promotion of trade marks needs to be taken into consideration in assessing if a mark is well-known or not.

The additional elements brought by the WIPO Recommendation are as follows:

With reference to the Definition Model, both *form* (*type* and *context*) and *concept* of ‘well-known trade mark’ is explicitly expanded upon: the former contains business identifiers, and the latter comprises the detailed guidelines or tests of determining whether a mark is a ‘well-known trade mark’. Business identifiers and domain names are recognised as falling within the *form* of ‘well-known trade mark’. As to the *concept* of ‘trade mark’, the WIPO Recommendation does not really add, it is

⁵⁴⁰ See Article 6bis of the Paris Convention.

⁵⁴¹ See Articles 15 and 16 of GATT TRIPS.

⁵⁴² See mainly Article 2 of the WIPO Recommendation.

⁵⁴³ See Chapter 2 Section 2.2 for the application of the Definition Model.

⁵⁴⁴ See Section 3.2.1 above.

⁵⁴⁵ See Section 3.2.2 above.

submitted, to the jurisprudence in this area, although the means of determining whether marks are well-known are set out. The followings means or factors are to be considered, in determining whether a mark is well-known: the degree of knowledge or recognition of the mark in the relevant sector of the public⁵⁴⁶; the duration, extent and geographical area of any use of the mark⁵⁴⁷, any promotion of the mark (advertising or publicity and the presentation)⁵⁴⁸, any registration or trade mark applications⁵⁴⁹, and the record of successful enforcement of rights in the mark⁵⁵⁰, and finally value of the mark⁵⁵¹.

So, considering all three instruments within the Definition Model, this author submits that one can produce a composite international definition of ‘well-known trade mark’ as follows:

‘Well-known trade mark’ *form* explicitly includes registrable trade marks, service marks, business identifiers and domain names. ‘Well-known trade mark’ *concept* lies in the consideration of to what extent a mark is well-known (well-knownness) which is submitted to relate to distinctiveness. Factors that may be used in assessing whether a mark is well-known or not include: the degree of knowledge or recognition of the mark in the relevant sector of the public; the duration, extent and geographical area of any use of the mark, promotion of the mark, trade mark registration or applications, a record of successful enforcement of rights in the mark, and the value of the mark.’

This author has argued in Chapter 2, in relation to the Definition Model, that *concept* of ‘trade mark’, i.e. distinctiveness, lies at the heart of what constitutes both ‘trade mark’ and ‘well-known trade mark’. Returning to this view at this point also allows some brief consideration of the merits of one of the assumptions made in this thesis – that a ‘well-known trade mark’ is the strongest or purest form of ‘trade mark’. If the reader reconsiders both the arguments presented in the real-life well-known trade mark examples analysed earlier in Chapter 2, Section 2.2.1 and the arguments made

⁵⁴⁶ Article 2(1)(b)(1) of the WIPO Recommendation.

⁵⁴⁷ *Ibid*, Article 2(1)(b)(3).

⁵⁴⁸ *Ibid*, Article 2(1)(b)(2).

⁵⁴⁹ *Ibid*, Article 2(1)(b)(3).

⁵⁵⁰ *Ibid*, Article 2(1)(b)(4).

⁵⁵¹ *Ibid*, Article 2(1)(b)(6).

above in Chapter 3 relating to the critical consideration and comparison of the definitions of ‘well-known trade mark’ at the international level, this assumption does appear to be realistic.

In relation to the consideration of the word mark ‘COCA-COLA’ and the figurative mark ‘TOYOTA’ logo in Section 2.2.1⁵⁵², the *highly distinctive nature* of the signs (which might be obtained through use) was highlighted in the (successful) process of mapping characteristics of these individual marks to the Definition Model. Returning to the tripartite composite definition of ‘well-known trade mark’ at the international level, above: this ‘definition’ cannot, it is submitted, be said to be clear or comprehensive: producing this tripartite composite definition cannot, therefore, be said to have been conventionally successful (beyond pointing out what is missing). What is the key difference between mapping the Definition Model on those two individual well-known marks and mapping on the relevant definitions in the international regime?

If, as is suggested, the former mapping process was indeed successful and the latter unsuccessful, then this provides some evidence of the centrality of trade mark *concept*. Returning now to that assumption made in this thesis – that a ‘well-known trade mark’ is the strongest or purest form of ‘trade mark’ – it is suggested by this author that the Definition Model offers a way of differentiating between the definitions of ‘trade mark’ and ‘well-known trade mark’: that just as ‘distinctiveness’ is the *concept* of ‘trade mark’, ‘highly distinctive’ is the *concept* of ‘well-known trade mark’. Distinctiveness, in this view, forms a continuum between trade marks (which are merely distinctive) and ‘well-known trade marks’ (which are highly distinctive).

Having concluded that the definition(s) of ‘well-known trade mark’ provided at the international level are not particularly clear or comprehensive, and speculated on the centrality of concept in a successful definition of ‘well-known trade mark’, it is time to turn to the main part of this thesis: the consideration of the definitions of the concepts analogous to ‘well-known trade mark’ in the EU and Japanese trade mark

⁵⁵² See also, Appendix 2: Illustrations of the Definition Model.

systems, and the consideration of the extent of protection afforded to such trade marks against confusion and '*kondo*'.

In the next two Chapters, (Chapters 4 and 5), well-known trade mark protection in the EU regime and that in the Japanese system will be critically examined, with the next chapter (Chapter 4) comprising a critical consideration of the definition of 'trade mark of repute' in the CTM system and a critical examination of the extent to which such marks are protected against confusion. Comparison with the Japanese regime and overall conclusions will then be the main concern of Chapters 6 and 7.

Chapter 4 ‘Trade Mark of Repute’ and ‘Confusion’ in EU

4.1 Introduction

The earlier chapters in this thesis have concerned the direct and indirect exploration of the definition of ‘well-known trade mark’. In this chapter, attention turns to exploring the definition of the equivalent concept, ‘trade mark of repute’, and the protection of such marks against likelihood of confusion in the CTM system. Before beginning this consideration of the effectiveness of protection of well-known trade marks against confusion in the CTM system, the author would first like to briefly re-visit the findings of Chapter 3.

In Chapter 3, the guidance as to the definition of ‘well-known trade mark’ provided by relevant international instruments such as the Paris Convention⁵⁵³, GATT TRIPS⁵⁵⁴ and the WIPO Recommendation⁵⁵⁵ was critically considered with reference to the Definition Model⁵⁵⁶ set out in Chapter 2⁵⁵⁷. Then, an attempt was made to draw this varied guidance together in one composite definition of ‘well-known trade mark’ at the international level, again employing the Definition Model, the result of this being the following definition of ‘well-known trade mark’ offered by this author:

- *Form (type and context)* of ‘well-known trade mark’: no explicit reference to *type* is made, but *context* is defined in the relevant conventions and guidelines⁵⁵⁸ as including trade marks⁵⁵⁹, service marks, business identifiers and domain names, and;

⁵⁵³ See Chapter 3, Section 3.2.1.

⁵⁵⁴ See Chapter 3, Section 3.2.2.

⁵⁵⁵ See Chapter 3, Section 3.2.4.

⁵⁵⁶ The Definition Model consists of two elements: *form (type and context)* and *concept*. Examples of trade mark *context* are service marks and collective marks; and those of trade mark *type* are signs and three-dimensional marks. Trade mark *concept* here is distinctiveness, see also Diagram 2: The Full Definition Model

⁵⁵⁷ See Chapter 2, Section 2.2.

⁵⁵⁸ Article 6bis of the Paris Convention, Articles 16(2) and (3) of GATT TRIPS, and Article 2 of the WIPO Recommendation.

⁵⁵⁹ The relevant articles related to ‘trade mark’ are Articles 6ter, 6sexies, 6species, 7bis and 8 of the Paris Convention, Article 15 of GATT TRIPS, Article 1 of the TLT, and Article 1 of the Singapore Treaty. See Appendix 1: Defining ‘Trade Mark’.

- *Concept* of ‘well-known trade mark’: such marks have to be well-known in the country in question, although the nature of the ‘well-knownness’, and how it is to be determined, is less clear than that of *form*. Well-known trade mark *concept*, it has been inferred, lies in identification/distinctiveness, with this being determined with reference to the following factors set out in the international regime: the degree of knowledge or recognition of the mark in the relevant sector of the public⁵⁶⁰; the duration, extent and geographical area of any use of the mark⁵⁶¹, any promotion of the mark (advertising or publicity and presentation)⁵⁶², any registration or trade mark applications⁵⁶³, and the record of successful enforcement of rights in the mark⁵⁶⁴, and finally value of the mark⁵⁶⁵.

This analysis of the international perspective as to the definition of ‘well-known trade mark’ will be referred to in this Chapter. However, the primary aim of this Chapter is to critically assess the effectiveness of the protection of ‘trade mark of repute’ (a concept analogous to ‘well-known trade mark’) against confusion within the CTM system.

In this Chapter, therefore, arguments will be developed in relation to:

- Critical consideration of the definition of ‘trade mark of repute’, this term being treated as being analogous with that of ‘well-known trade mark’, in the CTM regime (in Section 4.3, below), and;
- Critical consideration as to the protection of trade mark of repute against likelihood of confusion in the CTM system, with particular reference as to whether the scope of such protection is uncertain (in Section 4.4, below).

⁵⁶⁰ See Article 6bis of the Paris Convention, Article 15 (2) of GATT TRIPS and Article 2(1)(b)(1) of the WIPO Recommendation.

⁵⁶¹ Article 2(1)(b)(3) of the WIPO Recommendation.

⁵⁶² *Ibid*, Article 2(1)(b)(2).

⁵⁶³ *Ibid*, Article 2(1)(b)(3).

⁵⁶⁴ *Ibid*, Article 2(1)(b)(4).

⁵⁶⁵ *Ibid*, Article 2(1)(b)(6). This author condemned some inapplicability in the wording of the WIPO Recommendation; that is, it appears that a definition of well-known trade marks and valuable trade marks failed to be identified properly, which causes further confusion to the international level of well-known trade mark protection.

Before addressing the issues outlined above, the author first wishes to set out the basic legal and historical background of the CTM system (see Section 4.2, below).

4.2 Background

4.2.1 European Harmonisation of National Trade Mark Law

Generally speaking, the history of trade mark law harmonisation in Europe is said to have its origins in the 1960's⁵⁶⁶. However, the first substantive step towards such harmonisation, the First Council Trade Mark Directive to Approximate the Laws of the Member States Relating to Trade Marks (hereafter the EU Trade Mark Directive)⁵⁶⁷ was adopted only in 1988. Alongside this Directive, the Community Trade Mark Regulation (the CTMR)⁵⁶⁸ was introduced in 1993. To understand why trade mark harmonisation was seen as being desirable in the EU, it is necessary to state the obvious: trade mark rights are exclusive⁵⁶⁹ and territorial⁵⁷⁰: this means that national trade mark registrations can be used as obstacles to cross-border trade between national markets within the EU⁵⁷¹.

The EU Trade Mark Directive is understood by this author to have introduced significant changes to the substantive national trade mark laws of each EU Member State in the following areas⁵⁷²: (i) types of trade marks that can be registered⁵⁷³; (ii)

⁵⁶⁶ See, for example, Tritton, G, *supra* note 37; Jaeschke, L, 'The Quest For a Superior Registration System for Registered Trade Marks in the United Kingdom and the European Union: An Analysis of the Current Registration System in the United Kingdom, the Community Trade Mark (CTM) Registration System and Coming Changes' (2008) 30 *EIPR* 25-33; Tatham, D, and Gervers, F, 'The Continuing Story of the Examination of Seniority Claims by the OHIM in Alicante' (1999) 21 *EIPR* 228-235; Ghidini, G, 'European Trends in Trade Mark Law' (1991) 12 *ECLR* 122-125; Horton, A, 'The Community Trade Mark Regulation' (1994) 16 *EIPR* 1.

⁵⁶⁷ First Directive 89/104/EEC of the Council, of 21 December 1988, to Approximate the Laws of the Member States Relating to Trade Marks. Council Directive 89/104/EEC, 1988 O.J. (L40)1, available at http://europa.eu.int/eur-lex/en/search/search_lif.html. (Last accessed on 12 January 2010).

⁵⁶⁸ Council Regulation 40/94/EEC, 1994 O.J. (L11) 1, available at http://europa.eu.int/eur-lex/en/search/search_inf.html. (Last accessed on 12 January 2010).

⁵⁶⁹ See for example, Article 9 of the CTMR.

⁵⁷⁰ See for example, Article 2 of the Paris Convention.

⁵⁷¹ See Muhlendahl, A, 'Community Trade Mark Riddles: Territoriality and Unitary Character' (2008) 30 *EIPR* 66-70.

⁵⁷² A well-defined summary of the EU Trade Mark Directive can be seen; Roche, C, C, and Rosini, J, E, 'Trade Marks in Europe 1992 and Beyond' (1991) 13 *EIPR* 404-412 at 407.

⁵⁷³ Article 2 of the EU Trade Mark Directive. It is stated that "A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters,

grounds for opposition⁵⁷⁴; (iii) rights granted⁵⁷⁵; and (iv) sanctions for non-use and acquiescence⁵⁷⁶. The EU Trade Mark Directive, and its implementation at the national level, is just one part of the EU trade mark regime: the CTM system, as governed by the Regulation, was introduced in order to further reduce territorial trade barriers between EU member states⁵⁷⁷.

The EU Trade Mark Directive itself, sets out detailed provisions on registrability and scope of protection, which must be adopted into national trade mark laws⁵⁷⁸. It is also stated in the Recitals that member states are not deprived “of the right to continue to protect trade marks acquired through use; however, they are taken into account ... in regard to the relationship between them and registered trade marks⁵⁷⁹”. It is stressed in the Recitals that it “does not exclude the application (of other national laws) to trade marks ... such as ... provisions relating to unfair competition, civil liability, or consumer protection.”⁵⁸⁰ After all, somewhere in the middle lie provisions that are optional for Member States to adopt. The next section will consider the main focus of this Chapter – the CTM system.

4.2.2 The Community Trade Mark System

The CTM system⁵⁸¹ created a unified regional trade mark registration system in Europe⁵⁸², whereby one registration provides protection in all member states of the

numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings”.

⁵⁷⁴ *Ibid*, Articles 3 and 4.

⁵⁷⁵ *Ibid*, Article 5.

⁵⁷⁶ *Ibid*, Article 1.

⁵⁷⁷ Roche, C, C, and Rosini, J, E, *supra* note 532 at 404.

⁵⁷⁸ Articles 3-16 of the EU Trade Mark Directive.

⁵⁷⁹ *Ibid*, Recitals.

⁵⁸⁰ *Ibid*.

⁵⁸¹ The motive of establishing the community trade mark system (CTM) and concepts are known to stem from the single market theory, since it was clear that the common single market required a single industrial property right. Although the CTM was set out by a Commission proposal in the 1970s, it still took another 13 years to acquire approval of the Member States. However, the CTM became a reality as from 20 December, 1993, when the Commission regulation was adopted which entered into force on 15 March, 1994, and following, the OHIM (The Office of Harmonisation for the Internal Market), begun to operate in Alicante, Spain). In fact, the OHIM started to receive applications for CTM in January 1996, and its success was expected to be remarkable.

⁵⁸² A great amount of articles with relation to the CTM system and CTMR has been written. See for example; Pretnar, B, ‘Is the Future Enlargement of the European Union an Immediate Issue for the Community Trade Mark System’ (1997) 14 *EIPR* 185-187; Gielen, C, ‘Harmonisation of Trade Mark

EU⁵⁸³. The most symbolic character of the CTM system, in the view of this author, is that a CTM is said to be *unitary* in character⁵⁸⁴. Although an objection against a CTM application in any member state can defeat the entire application, a CTM registration is enforceable in all member states⁵⁸⁵. The CTM system operates alongside Member States' national trade mark registration systems (which are, themselves, largely the product of the Directive, see Section 4.2.1, above). In general, however, these developments, and the popularity⁵⁸⁶ of the CTM, suggest that a *supra-national* EU, which attracts wide rights, resonant of EU nations may well play an important role in the future of Europe⁵⁸⁷ including further enlargement of EU nations⁵⁸⁸. Aside from this, it should be noted that both the advantage, but also the potential disadvantage, to a CTM applicant is that a CTM will stand or fall as a single unit⁵⁸⁹.

In general, most legal scholars are in favour of the principle of the CTM system⁵⁹⁰, with the main advantage that the CTM system is considered to be that of seniority⁵⁹¹,

Law in Europe: The First Trade Mark Harmonisation Directive of the European Council' (1992) 14 *EIPR* 262-269.

⁵⁸³ See for example, Phillips, J, *supra* note 37.

⁵⁸⁴ See Paragraph 2 of Article 1 of the CTMR; "2. A Community trade mark shall have a unitary character. It shall have equal effect throughout the Community: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community. This principle shall apply unless otherwise provided in this Regulation.". See an example of critics: Muhedahl, A, V, 'Community Trade Mark Riddles: Territoriality and Unitary Character' (2008) 30 *EIPR* 66-70.

⁵⁸⁵ See Mallinson, R, 'Trade Marks in the EU: One Right, One Law, One Decision – or Not?' (2007) 29 *EIPR* 432-437 at 432.

⁵⁸⁶ An increase in a number of the CTM trade mark applications has occurred over a decade. For example, in 2001, the number of the CTM trade mark application was reported 48,856, whilst by 2008 (the most current statistic reported by the OHIM) the number of the application was almost doubled, 73,028. A full text of the Report 'Statistic on national, international and community trade mark application' is to be found at http://oami.europa.eu/ows/rw/resource/documents/OHIM/statistics/ctm_stats2008.pdf. (Last accessed on 12 January 2010).

⁵⁸⁷ Brown, A, E, E, L, 'Post Harmonisation Europe – United, Divided or Unimportant?' (2001) 3 *IPQ* 275-286.

⁵⁸⁸ For users of the CTM system, enlargement of the Union by 10 new Member States can be seen as a positive opportunity, and means that as of 1 May 2004 the effects of registration of a community trade mark extends to a market of 450 million people. A number of advantages of the CTM system can be pointed out: one application at one location in one language, examined under single standards with a single fee and with a single representative leading to unitary protection in all Member States under a unitary scope of protection. This combination of unique features cannot be obtained from the Madrid Agreement or Protocol. Here, see Folliard-Monguinal A, and Rogers, D, 'The Community Trade Mark and Designs System and the Enlargement of the European Union' (2004) 26 *EIPR* 48-58 at 58. Ranitz, R, and Muhlendahl, A, 'Alexander Von Muhlendahl in Conversation with Remco De Ranitz' (2000) 22 *EIPR* 528-533 at 528.

⁵⁸⁹ *Ibid.*

⁵⁹⁰ Ranitz, R, and Muhlendahl, A, *supra* note 584 at 528.

(as provided in Articles 34 and 35 of the CTMR⁵⁹² and Rules 9 and 28⁵⁹³). The potential for conflict between *national* trade mark rights and the establishment of a common market without national frontiers has already been noted in this thesis, and the CTM system goes some way to addressing this.⁵⁹⁴.

4.2.3 The Community Trade Mark Regulation

Armed with this brief background knowledge of the EU Trade Mark Directive and the advantages of the CTM system, now the historical development of the CTMR will briefly be set out.

In 1980, an EU Commission Proposal for a CTM system⁵⁹⁵ was approved in a first reading by the European Parliament, subject to several recommendations for amendment⁵⁹⁶. In 1984 the Commission promulgated an amended proposal, incorporating the Parliament's recommendations⁵⁹⁷. As of July 1991 that amended proposal was before the European Council of Ministers for debate, and once a common position on the issues was formed, the proposal was sent to the European Parliament for a second reading⁵⁹⁸. As a consequence, the CTMR came into force in

⁵⁹¹ See Tatham, D, and Gervers, F, 'The Continuing Story of the Examination of Seniority Claims by the OHIM in Alicante' (1999) 21 *EIPR* 228-235; Ghidini, G, 'European Trends in Trade Mark Law' (1991) 12 *ECLR* 122-125.

⁵⁹² See Council Regulation (EC) No 40/94 on Community trade mark. A full text of this CTM Regulation is to be found at <http://oami.europa.eu/en/mark/aspects/pdf/4094enCV.pdf>.

⁵⁹³ See Commission Regulation (EC) No. 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on Community trade mark. A full text of this Regulation (hereafter the Rule) is to be found at <http://oami.europa.eu/en/mark/aspects/pdf/2868-95.pdf>.

⁵⁹⁴ Maniatis, S, *supra* note 384 at 99.

⁵⁹⁵ The effort to establish a CTM system has a long legislative history. In 1976 the EC Commission proposed a Draft Regulation to establish a CTM system. See *Memorandum on the Creation of an EEC Trade Mark*, Bull. Eur. Communities (Supp. August 1976). A Draft Council Regulation on the Community Trademark, Doc. COM(78) 753, was circulated in July 1978. In 1980 the Commission promulgated another proposal for a Regulation on the Community Trade Mark. Doc. COM(80) 635 final; 23 OJ [1980] C351, 31 December 1980 (known as the 1980 CTM Proposal). The Commission amended this proposal in 1984. See, Amended Proposal for a Council Regulation on the Community Trade Mark, Doc. COM(84) 470 final; 27 OJ [1984] C230, 31 August 1984 (known as the 1984 CTM Proposal). The proposal continues to be amended, and the most recent, publicly available proposal was published in May 1988. See, Amended Proposal for a Regulation on the Community Trade Mark, Doc. COM(88) 5865 draft (IP/36), 11 May 1988 (known as the 1988 CTM Proposal). Although additional amendments continue to be debated, this article comments on the proposed CTMR as embodied in the 1988 CTM Proposal. See Roche, C, C, and Rosini, J, E, *supra* note 568.

⁵⁹⁶ See the 1980 CTM Proposal, *supra* note 591.

⁵⁹⁷ See EU Commission memorandum, *supra* note 591.

⁵⁹⁸ See the 1988 CTM Proposal, *supra* note 591 for the most recent proposal for a CTM system is the consolidated text.

1994 with several amendments being made⁵⁹⁹ under the administration of the OHIM (the Office for Harmonization in the Internal Market (Trade Marks and Designs))⁶⁰⁰. The CTMR offers the extra layers of protection to ‘trade marks of repute’⁶⁰¹.

Many of the substantive provisions of the Regulation mirror those in the EU Trade Mark Directive⁶⁰² and indeed, one of the reasons for the Directive was to pave the way for the CTMR, by ensuring that Member States’ national trade mark laws accord in key respects with the CTM regime (so that neither system should be markedly inferior to the other)⁶⁰³.

So far, brief information regarding the CTM system and CTMR has been provided as background for both the remainder of this Chapter and for the comparative analysis that will be undertaken in a later Chapter (see Chapter 6)⁶⁰⁴.

4.3 ‘Well-Known Trade Marks’? – the Regional Level

4.3.1 Community Trade Mark Regulation (the CTMR)

⁵⁹⁹ A few amendments are as follows: firstly, Council Regulation (EC) No 422/2004 of 19 February 2004 amending Regulation (EC) No 40/94 on the Community trade mark; secondly, Council Regulation (EC) No 1992/2003 of 27 October 2003 amending Regulation (EC) No 40/94 on the Community trade mark to give effect to the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989; thirdly, Council Regulation (EC) No 1653/2003 of 18 June 2003 amending Regulation (EC) No 40/94 on the Community trade mark (Article 118a) (Article 136), in force since 1 October 2003; fourthly Incorporation of Article 142a to Regulation (EC) No 40/94 on the Community trade mark according to Annex II (4. Company law – C. Industrial property rights) of the Act of Accession, in force since 1 May 2004; fifthly, Council Regulation (EC) No 807/2003 of 14 April 2003 adapting to Decision 1999/468/EC the provisions relating to committees which assist the Commission in the exercise of implementing powers laid down in Council instruments adopted in accordance with the consultation procedure (unanimity) – amendment of Article 141 of Council Regulation (EC) No 49/94 on the Community trade mark, in force since 5 June 2003; and most currently, Council Regulation (EC) No 3288/94 of 22 December 1994 amending Regulation (EC) No 40/94 on the Community trade mark for the implementation of the agreements concluded in the framework of the Uruguay Round, came in force since 1 January 1995.

⁶⁰⁰ *Supra* note 1.

⁶⁰¹ See Articles 8(5) and 9(1)(c) of the CTMR.

⁶⁰² See for example, Article 2 of the EU Trade Mark Directive and Article 4 of the CTMR are identically termed; Article 3 of the EU Trade Mark Directive and Article 7 of the CTMR are also rather similarly termed.

⁶⁰³ Although it can be questionable that if each EU Member States speaks a same language as a result of the EU Trade Mark Directive, particularly given the difference between common and civil law approaches.

⁶⁰⁴ See Chapter 5 for well-known trademark protection in Japan; see Chapter 6 for a comparative analysis of the Japanese system and the CTM system.

The most striking fact in a thesis concerned with well-known trade marks to note is that the term ‘well-known trade mark’ is not used in a substantive sense within the CTMR⁶⁰⁵. Strictly speaking, the CTMR does not refer to well-known trade marks. However, there is a concept that, this author submits, can be regarded as being equivalent to that of ‘well-known trade mark’, indeed it is widely accepted by legal scholars⁶⁰⁶ that the requirements of well-known trade mark protection within the Paris Convention⁶⁰⁷ and GATT TRIPS⁶⁰⁸ are reflected in this equivalent concept: trade marks of repute. For the purpose of this thesis, the key provisions on trade marks of repute are to be found in both Articles 8(5) and 9(1)(c) of the CTMR (and Article 5(2) of the EU Trade Mark Directive⁶⁰⁹). As noted previously, the CTMR is approximated by⁶¹⁰ and corresponds to the EU Trade Mark Directive⁶¹¹: hereafter, this author will confine her consideration of EU law to the CTMR (although, as noted below,

⁶⁰⁵ It should be noted here though, that Article 8(2)(c) imported ‘well-known trade mark’ cited in the Paris Convention. According to this article, therefore, it is speculating that that the CTMR provides protection to ‘well-known trade mark’ within the meaning of the Paris Convention. However, as was argued in Chapter 2, Section 2.3.1.1, and Chapter 3, Section 3.2.1, the utility of it seems doubtful, as the Paris Convention provides no comprehensive definition of ‘well-known trade mark’.

⁶⁰⁶ See for example, Phillips, J, *supra* note 37 at 364.

⁶⁰⁷ Article 6bis of the Paris Convention.

⁶⁰⁸ Article 16(3) of GATT TRIPS.

⁶⁰⁹ An examination of the EU Trade Mark Directive (Directive 89/104), and thus all the national decisions in the EU member states, is beyond the scope of this thesis.

⁶¹⁰ See First Directive 89/104/EEC of the Council, of 21 December 1988, to Approximate the Laws of the Member States Relating to Trade Marks (OJ EC No L 40 of 11.2.1989, p. 1). The full text of the EU Trade Mark Directive is to be found at <http://oami.europa.eu/en/mark/aspects/direc/direc.htm>. The full text of Article 4(3) and (4) is cited here in full: “A trade mark shall furthermore not be registered or, if registered, shall be liable to be declared invalid if it is identical with, or similar to, an earlier Community trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier Community trade mark is registered, where the earlier Community trade mark has a reputation in the Community and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trade mark. (4). Any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that: (a) the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark; (b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.” See Phillips, J, *supra* note 37 at 402-403.

⁶¹¹ Article 5(2) of the EU Trade Mark Directive. Article 5(2) sets out that: “Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State 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.”

occasional reference will be made to ECJ decisions and preliminary rulings under the Directive where this is deemed to be instructive of the equivalent position under the Regulation).

At this point, this author raises what she feels to be an important question: *how* do legal scholars know that the protection afforded to trade marks of repute accords with the ‘well-known trade mark’ protection defined both in the Paris Convention⁶¹² and GATT TRIPS⁶¹³? As has been demonstrated in Chapters 2 and 3, it cannot be said that there is a single precise and comprehensive definition of ‘well-known trade mark’ at the international level. How, therefore, can one equate this (unclear) international concept of ‘well-known trade mark’ with the EU concept of ‘trade mark of repute’? Although this author maintains that this is a pertinent question, it must be conceded that: (i) Articles 8(5) and 9(1)(c) of the CTMR appear to be equated with well-known trade mark protection in the literature⁶¹⁴, and (ii) that ‘repute’ and ‘well-known’ clearly can be *equated*, even if they are not exact equivalents.

The provisions on marks of repute are as follows:

“Article 8(5):

Furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where in the case of an earlier Community trade mark the *trade mark has a reputation in the Community* and, in the case of an earlier national trade mark, *the trade mark has a reputation in the Member State* concerned and where the use without due cause of the trade mark applied for would *take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark*.[emphasis added]”

⁶¹² Article 6bis of the Paris Convention.

⁶¹³ Article 16(3) of GATT TRIPS.

⁶¹⁴ See Phillips, J, *supra* note 37 at 122.

As has already been repeatedly emphasised, the familiar term ‘well-known trade mark’ is not present in the CTM system, the terminology used is that of ‘trade mark of repute’ (the term ‘trade mark with a reputation’ is also occasionally used⁶¹⁵).

A parallel provision concerning infringement of such marks is as follows:

“Article 9

1. A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(c) any sign which is identical with or similar to the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the *latter has a reputation in the Community* 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 Community trade mark.*” [Emphasis added].

The first point to note here is that in one sense, Articles 8(5) and 9(1)(c) of the CTMR are only indirectly relevant to this thesis, as they do not relate to protection against confusion (which is the subject of Articles 8(1)(c) and 9(1)(b)). However, although Articles 8(5) and 9(1)(c) of the CTMR provide for protection of ‘trade marks of repute’ against dilution-type infringements, they are relevant to this thesis as it is here that the term ‘trade marks of repute’ is introduced, but it is important to note that neither in Articles 8(5) or 9(1)(c) is the term ‘trade mark of repute’ explicitly defined. Clearly Articles 8(5) and 9(1)(c) provide for a wide degree of protection for such marks, both in terms of third party trade mark registrations and use is, but this protection against marks for dissimilar goods and services is beyond the scope of this thesis (which focuses on confusion⁶¹⁶, not unfair advantage or detriment), hence Articles 8(5) and 9(1)(c) are only considered in this thesis in relation to the critical consideration of the definition of ‘trade mark of repute’.

⁶¹⁵ For example, Section 4.3.3.

⁶¹⁶ A critical examination of the definition of ‘confusion’ will be separately discussed later in Section 4.4. It is necessary to note here that Articles 8(5) and 9(1)(c) do not address confusion .

4.3.1.1 The *Form* of ‘Trade Mark of Repute’

Applying the Definition Model to the relevant provisions, it is submitted that:

- (i) Trade mark *type* in *form* in the CTMR constitutes any signs, including symbols, logos, slogans, get-up, personal names, designs, letters, numerals and the shape of goods or of their packaging⁶¹⁷, and;
- (ii) *Context* in *form* includes trade marks, service marks, geographic marks⁶¹⁸ and certification marks⁶¹⁹.

It can therefore be seen that ‘trade mark of repute’ *type* and *form* are the same as those for ordinary CTM trade marks (see Chapter 2, Section 2.3.2) and more detailed than that detailed for well-known trade marks at the international level (see Chapter 3).

4.3.1.2 The *Concept* of ‘Trade Mark of Repute’

Applying the Definition Model⁶²⁰ to the relevant provisions, it is submitted that:

Concept of ‘trade mark of repute’ seems, to this author, to be represented in a more interesting fashion than in relation to well-known trade marks at the international and national levels⁶²¹. There is clearly also some mark of repute/well-known trade mark equivalence⁶²². So, what is the *concept* of this equivalent to the ‘well-known trade mark’, the trade mark of repute? Implicitly it must be reputation and distinctive character (as noted above, such trade marks have to have *a reputation* in the

⁶¹⁷ In this respect, the CTMR can be seen as being more innovative than international standards at the time of adoption. The TLT, which makes the first specific mention of three-dimensional marks was adopted in 1994 (interestingly, there is no explicit mention of such marks in GATT TRIPS – see Section 2.3.1.4), whilst the CTMR was adopted in 1988.

⁶¹⁸ *Supra* note 256. Geographical indication can be protected by Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs. The detailed examination of protection of geographical indication *per se* is beyond the scope of this thesis.

⁶¹⁹ Phillips, J, *supra* note 37 at 604.

⁶²⁰ See Chapter 2, Section 2.2.

⁶²¹ Here, C.F. Article 6bis of the Paris Convention, Article 16(3) of GATT TRIPS, Article 2 of the WIPO Recommendation, and Articles 4(1)(10) and (19) of the Japanese Trademark Act (see Chapter 5).

⁶²² Article 8(2)(c) of the CTMR provides that: ‘...in the sense in which the words ‘well-known’ are used in the Article 6bis of the Paris Convention’ as one part of the relative grounds for refusal.

Community or Member States, and the *distinctive character* or *the repute* of such marks is protected).

In other words, it could be argued that at a basic level the definition of a ‘trade mark of repute’ is indeed close to what is understood to be that of a ‘well-known trade mark’ according to international norms. How close is more difficult to indicate, simply because there is not, as argued throughout this thesis, a clear definition of what constitutes a well-known trade mark. It should also be noted that the similarities to be found within the definitions of ‘trade mark’ and ‘trade mark of repute’ in the CTM support another assumption made in this thesis, which is that well-known trade mark’ is the purest form of ‘trade mark’⁶²³.

Returning to the definition of ‘trade mark of repute’, one suggestion offered by this author is that this term should not be regarded as being a terminological equivalent of that of ‘well-known trade mark’ trans-planted to an EU context. Rather, it could be regarded as an original interpretation of this concept, with the replacement term ‘trade mark of repute’ serving to more accurately describe the distinction between mere trade marks and well-known trade marks: i.e. is the term ‘trade mark of repute’ a more accurate term than ‘well-known trade mark’? Does the term ‘trade mark of repute’ more accurately describe the nature of a well-known trade mark (that such marks are not only more distinctive than mere trade marks, but that said, distinctiveness has to be sufficient to amount to a reputation? These suggestions are entirely speculative as to what the purpose of employing the term ‘trade mark with repute’ rather than ‘well-known trade mark’ is, and the author may return to these speculations in future research, but further consideration of this issue is, it is submitted, beyond the scope of this thesis.

In this thesis, as the preferred methodologies for critical consideration at this stage are the Definition Model and black letter legal interpretation, the author will now briefly summarise the findings thus far under these methodologies before undertaking a critical consideration of the relevant parts of the CTM Guidelines.

⁶²³ See Chapter 1, Section 1.7 for the assumption made by this author; ‘well-known trade mark’ is the purest form of ‘trade mark’.

Under the Definition Model, as noted above, *concept* of ‘trade mark of repute’ can be said to constitute reputation and distinctiveness. *Form* appears to be the same as that for ‘trade mark’ in the CTM. Having inferred both the *form* and *concept* of ‘well-known trade mark’ in the CTM trade mark regime from analysis of the CTMR, further clarification as to what constitutes a trade mark of repute is now sought by critical consideration of the CTM Guidelines (Section 4.3.2) and jurisprudence (Section 4.3.3), respectively.

It should be noted that one of the Definition Model *preconditions* are also present (in part). It is clear from Article 8(5) that *graphic representation* is required for trade mark registration. It is submitted that it is possible to infer that the same is the case for the registration of a well-known trade mark⁶²⁴. Although Article 9(1)(c) does speak to ‘use in the course of trade’: this is not a term used in the Definition Model, and in any case Article 9(1)(c) relates to the scope of protection of trade marks, not the definition of (well-known) trade marks, so it is submitted that there is no explicit requirement of *commercial use* in the Regulation.

4.3.2 The CTM Guidelines

The Community Trade mark Opposition Examination Guidelines (the CTM Guidelines)⁶²⁵ provide a significant amount of information as to ‘trade mark of repute’ (here the actual term employed is ‘trade mark with reputation’)⁶²⁶. However, these

⁶²⁴ Whether this is also required, *de jure*, of well-known trade marks that are not registered is not possible to say.

⁶²⁵ The Japanese Trademark Examination Guidelines will be also examined in Chapter 5 respectively. The aim of the JPO Guidelines is to standardise the examination process of trademark application at the JPO.

⁶²⁶ In addition to these Guidelines, there is a Trade Mark Manual called, ‘The Manual concerning proceedings before the Office for Harmonization in the Internal Market (Trade Marks and Designs)’, an examination of the CTM Manual, however, is irrelevant to this thesis. The wording of the CTM Manual is almost identical to that of the CTM Guidelines in order to combine the parts of the existing CTM Guidelines which remain unchanged since the last revision with amendments reflecting current trade mark practice. See the editorial notes of the Manual. The full text of this is to be found at <http://oami.europa.eu/EN/mark/marque/manual.htm>. It is said that “From a practical point of view, the Manual should be the first point of reference for users of the Community trade mark system and professional advisors who wish to make sure they are using the latest information.”

Guidelines function solely as a supplement to⁶²⁷ the CTMR in the practical contexts⁶²⁸, in other words, they work closely with the Regulation⁶²⁹.

Returning to the Definition Model, an attempt to find the conceptual definition of ‘trade mark of repute’ in the CTMR will now be made.

Firstly ‘trade mark of repute’ *form*. No further assistance is found, although *form* can be inferred from the *form* of ‘trade mark’ in the CTMR. It is also explicit that the influence of the WIPO Recommendation is not significant, since it is not binding for the interpretation of the CTMR⁶³⁰. Therefore, it is possibly arguable that *form* and *concept* of ‘well-known trade mark’ composed in the WIPO Recommendation⁶³¹ may well not be applicable here to the CTMR.

In this sense, the EU law shows the *narrowest* but the most precise, concise *form* of ‘well-known trade mark’ at all levels considered⁶³².

The *concept* of ‘well-known trade mark’, on the other hand, seems to be lacking further explanation herein. It is explicitly stated that even though the term ‘well-known trade mark’ (traditionally used in Article 6bis of the Paris Convention) and reputation denote distinct legal principle concept, there is a substantial overlap between them as shown by a comparison of the way well-known marks are determined⁶³³ in the WIPO Recommendation and the way reputation has been described by the Court in the *General Motors* case⁶³⁴:

⁶²⁷ The CTM Guidelines provide a significant amount of explanatory comments regarding ‘trade mark of repute’ in a different structure of reference to the JPO Guidelines (a comparative analysis will be further explored in Chapter 6). Nonetheless, they seem not to be as helpful as hoped.

⁶²⁸ It is clearly stated that these CTM Guidelines are not legislative texts. See the second paragraph of General Introduction. The JPO Guidelines and the Japanese Trademark Act are conceptually similar. See Chapter 5, Section 5.3.2.

⁶²⁹ The purpose of the CTM Guidelines is explained as: to outline the practice of the OHIM relating the CTMR for its practical use. See the general introduction of the CTM Guidelines. The full text of this introduction is to be found at <http://oami.europa.eu/en/mark/marque/directives/intro.htm>.

⁶³⁰ See the CTM Guidelines, Part 5, Article 8(5) CTMR at 6. See *General Motors Corporation v Yplon SA* (Case -375/97) [1998] ETMR 950.

⁶³¹ See the composit definition of ‘well-known trade mark’ at the international level in Chapter 3.

⁶³² As Chapter 5 will introduce the Japanese Trademark Act, unregistered marks are included as the protectable well-known trademark subject matter in Japan. A critical comparison of the EU and Japan is to be found in Chapter 6.

⁶³³ It is rather important to note there that the Guidelines employed the word ‘defined’ instead of ‘determined’. This author stressed in Chapter 3 that the WIPO Recommendation provides the way of

It is said that:

“... thus, it will not be unusual for a mark which has acquired well-known character, to have also reached the threshold laid down by the Court in *General Motors* as regards marks with reputation, given that in both cases the assessment is principally based on quantitative consideration as regarding the degree of knowledge of the mark among the public, and the thresholds required for each case are expressed in quite similar terms (“known or well-known in the relevant sector of the public” for well-known marks as against “known by a significant part of the relevant public” as regards marks with reputation) ...”⁶³⁵

As the *General Motors* case is cited as a significant exemplar, other relevant cases are also to be examined in the next chapter. As for *concept* of ‘well-known trade mark’, there might be differences in the interpretation of ‘well-known trade mark’ by the Paris Convention⁶³⁶ and that of the equivalent CTMR position. However, there is not enough by way of explicit definitions and guidance as to ‘well-known trade mark’ and ‘trade mark of repute’ for this author to say that they are used in a similar or dissimilar way.

Finally it should be noted that the Guidelines do not seem to contain any specific reference to the *preconditions* found in the Definition Model.

Although the Guidelines themselves do make some reference to the case law in this area, a fuller treatment of the relevant jurisprudence is – it is submitted – necessary, and this is undertaken in outline in Section 4.3.3, below.

determining ‘well-known trade mark’; *not* defining that. See the CTM Guidelines, Part 5, Article 8(5) CTMR at 6.

⁶³⁴ See the CTM Guidelines, Part 5, Article 8(5) CTMR at 6.

⁶³⁵ *Ibid.*

⁶³⁶ *Ibid.*

4.3.3 The Cases

Before beginning a review of relevant jurisprudence, it is felt necessary at this stage to remind the reader again of the main focus of this thesis, which is the protection of well-known trade marks (in this Chapter, marks of repute) against confusion in the CTM and Japan. In this respect, the author has both placed a limitation and is faced with an inherent limitation in the primary and secondary literature to be considered:

- (i) In the context of this section, the author believes that it is justifiable to limit her consideration of CTM jurisprudence to relevant decisions of the ECJ, the CFI, and the BoA⁶³⁷, and;
- (ii) As has already been discussed, the nature of ‘reputation’ is not explicitly defined by either the CTMR⁶³⁸ the EU Trade Mark Directive⁶³⁹ or the CTM Guidelines, so guidance from relevant jurisprudence is crucial to clearly establishing what ‘reputation’ means. Unfortunately, it is submitted that there is relatively little jurisprudence relating to the definition of ‘trade mark of repute’.

Although there are relatively few cases relevant to the question of defining trade marks of repute, there does seem to be a reasonable body of secondary literature on such trade marks⁶⁴⁰. However, both the primary and secondary literature on ‘trade mark of repute’ tend to focus on Articles 8(5) and 9(1)(c) of the CTMR – the protection of ‘trade marks of repute’ against *detriment and unfair advantage*, whereas the thrust of this thesis is the consideration of the protection of well-known trade marks against *confusion* (Articles 8(1)(b) and 9(1)(b) of the CTMR). This has particular implications for Section 4.4 below, but also has some import for this section, and the question of how ‘trade mark of repute’ is defined.

⁶³⁷ It can be noted that the decisions of the BoA are still limited in number, and of these, relatively few have dealt with the interpretation of Article 8(5) of the CTMR thoroughly (see the CTM Guidelines, Part 5, Article 8(5) CTMR at 4).

⁶³⁸ See Articles 8(5) and 9(1)(c) of the CTMR.

⁶³⁹ So far, ‘trade mark has a reputation’ in the CTMR, has been summarised: trade marks, which include ‘well-known trade mark’ in the Paris Convention and ‘trade mark has a reputation’ within the community or the member states concerned.

⁶⁴⁰ For example, see *supra* note 11, and Bernnet, S, and Marshall, J, ‘How Far Does Reputation Alone Get You?’ (2009) 214 *TW* 17-19; Middlemiss, S, and Warner, S, ‘The Protection of Marks with a Reputation: Intel v CPM’ (2009) 31 *EIPR* 195-20; Smith, J, and Meale, D, ‘EU: Trade Marks – Revocation – Similar Mark for Dissimilar Goods’ (2009) 31 *EIPR* N23-34.

So, how relevant is the primary and secondary literature on Articles 8(5) and 9(1)(c) of the CTMR to the protection of well-known trade marks against confusion⁶⁴¹? How relevant is the primary and secondary literature on Articles 8(1)(b) and 9(1)(b) of the CTMR to trade marks of repute?⁶⁴² And, is there any primary and secondary literature that is helpful in defining what a ‘trade mark of repute’ is and how it might differ from a well-known trade mark? These are difficult questions to answer with certainty, but it is these first and third issues that have relevance for establishing the definition and conceptualisation of ‘trade mark of repute’.

To specifically respond to that third issue, it might be helpful to recap that, so far, the following have been critically argued: (i) there is no agreed comprehensive definition of ‘well-known trade mark’ at the international level, thus we cannot say with certainty how ‘well-known trade mark’ is defined; (ii) the Paris Convention⁶⁴³ requires signatory nations to provide legal protection to (this ill-defined) concept, and; (iii) the term ‘well-known trade mark’ is not used in both the CTMR and the EU Trade Mark Directive⁶⁴⁴. Therefore, by inference it is possible to say that even if it is possible to define ‘trade mark of repute’, it would be difficult (if not impossible) to fully compare this concept with that of ‘well-known trade mark’, as the latter concept is not comprehensively defined. Some further thoughts and analysis on what constitutes a trade mark of repute, drawing on relevant jurisprudence, now follows.

The issue of dis-harmony of terminology (trade mark of repute/well-known trade mark) was mentioned in the *General Motors* case⁶⁴⁵, here it was noted that there is a further complication: the terms used in the different language versions of the CTMR are not fully equivalent to each other⁶⁴⁶, which has led to considerable confusion as to the true meaning of the term ‘reputation’⁶⁴⁷.

⁶⁴¹ For some further discussion, please see Section 4.4.

⁶⁴² For some further discussion, please see Section 4.3.

⁶⁴³ See for example, national court cases *Oasis Stores Ltd’s Trade Mark Application* [1999] ETMR 531.

⁶⁴⁴ Hildebrandt, U, *Harmonised Trade Mark Law in Europe: Case-Law of the European Court of Justice* (Cologne, Carl Heymanns Verlag, 2005) at 70-72.

⁶⁴⁵ *General Motors Corporation v Yplon SA* (Case C-375/97) [1999] ETMR 950; [1999] ETMR 122 (The Opinion of Advocate General Francis Jacobs).

⁶⁴⁶ See Chapter 1, Section 1.2 and see Section 4.3.3 and *infra* note 726. For example, the variety of the English term ‘a mark with reputation’: the words “*er renommeret*” in the Danish version of that provision; “*bekannt ist*” in the German version; “*Εχει φημην*” in the Greek version; “*goce de renombre*”

It is understood that⁶⁴⁸, in the EU trade mark context⁶⁴⁹, the ECJ has dealt, so far, with the protection of ‘trade mark of repute’ in the EU trade mark in the following two primary rulings including the *General Motors v Yplon S.A.*, (hereafter the *General Motors case*)⁶⁵⁰, then, *Davidoff & Cie SA, Zino Davidoff SA v Gofkid Ltd.* (hereafter the *Davidoff case*)⁶⁵¹.

Furthermore, opinions of Advocate General Jacobs in the *General Motors case*⁶⁵² seem to be relevant here as to ‘trade mark of repute’ (the analysis of Article 5(2) of the EU Trade Mark Directive⁶⁵³). Although those opinions are not legally binding, these might be useful to the extent that they provide a source of arguments and suggestions for the definition of ‘a trade mark of repute’⁶⁵⁴.

More recent developments also have some import here: *Intel Corporation Inc. v CPM United Kingdom Limited* (hereafter the *Intel case*)⁶⁵⁵ and *L'Oréal v Bellure*⁶⁵⁶

in the Spanish version; “*jouit d'une renommée*” in the French version; “*godo di notorietà*” in the Italian version; “*bekend is*” in the Dutch version; “*goze de prestigio*” in the Portuguese version; “*laajalti tunnettu*” in the Finnish version; “*är känd*” in the Swedish version.

⁶⁴⁷ In the paragraphs 34-36 of the Opinion of Advocate General Jacobs in *General Motors*.

⁶⁴⁸ See Maniatis, S, *supra* note 37 at 370. Also, see Turner-Kerr, P, ‘EU Intellectual Property Law: Recent Cases Development (2004) 4 *IPQ* 448-519 at 448.

⁶⁴⁹ The CTM Guidelines, Part 5, Article 8(5) CTMR at 4.

⁶⁵⁰ *General Motors Corporation v Yplon SA* (Case C-375/97) [1999] ETMR 950.

⁶⁵¹ *Davidoff & Cie SA, Zino Davidoff SA v Gofkid Ltd* (Case C-292/00) [2003] ETMR 42.

⁶⁵² *General Motors Corporation v Yplon SA* (Case C-375/97) [1999] ETMR 122 (The Opinion of Advocate General Francis Jacobs).

⁶⁵³ The CTM Guidelines, Part 5, Article 8(5) CTMR at 4.

⁶⁵⁴ See ‘Advocate General Defines Scope to Protection Under Trade Mark Directive’ (1998) 24 *EU Focus* 12-13 at 12-13.

⁶⁵⁵ *Intel Corporation Inc. v CPM United Kingdom Limited* (Case C-252/07) [2009] ETMR 13.

Examples of secondary literature re *Intel* case: Davis, J, ‘The European Court of Justice Considers Trade Mark Dilution’ (2009) 68 *CLJ* 290-292 (she said the *Intel* has been a disappointing decision and this cautious approach might well be abandoned if there were likelihood of future damage); Slopek, D, E, F, ‘European Union: Council Directive (EEC) 89/104 of 21 December 1988 to approximate the laws of the Member States relating to trade marks, art.4(4)(a) – “Intel/Intelmark”’ (2009) 40 *ICC* 348-353 (he commented that an economic approach as suggested by the ECJ certainly has its charm, but a closer look reveals that it does not really fit in the assessment of Arts. 4(4)(a) or 5(2) of the Directive and its national counterparts); Breitschafft, A, ‘Intel, Adidas & Co - Is the Jurisprudence of the European Court of Justice on Dilution Law in Compliance With The Underlying Rationales And Fit For The Future?’ (2009) 31 *EIPR* 497-504 (he said that this case is more specific and concise than the decision of the Court of Appeal).

⁶⁵⁶ *L'Oréal SA v Bellure NV* (Case C-487/07) [2009] ETMR 55. Also see examples of secondary literature re the *Bellure* case: Morcom, C, ‘*L'Oréal v Bellure - Who Has Won?*’ (2009) 31 *EIPR* 627-635 (he commented that all the functions of trade marks, not just the essential function as an indication of origin are now of consideration for the court); Gielen, C, and Dutilh, N, ‘*L'Oréal v Bellure* (C-487/07) and *Dior v Copad* (C-59/08): EU - Trade Marks - Protection of Well-Known Brands’ (2009) 31 *EIPR* N70-71 (it was commented that mis-use of

(hereafter the *Bellure* case). These two cases have great import for EU trade mark law generally, but in the context of this thesis, it must be conceded that these two cases primarily speak to issues of dilution⁶⁵⁷: however, these, and earlier cases, remain indirectly (it is submitted) relevant to the definition of ‘trade mark of repute’.

The jurisprudence will be considered in approximate chronological order. First we have the *General Motors* case⁶⁵⁸. *General Motors* is cited in the CTM Guidelines, and its importance is described⁶⁵⁹ as “...reputation has been described by the Court in *General Motors*...”.

Given the absence of an explicit statutory definition of ‘reputation’, it appears to be understood that the *General Motors* case⁶⁶⁰ was the first case that tested the requirements for obtaining the well-known trade mark protection⁶⁶¹ as follows:

“...the mark shall be known by a significant part of the public concerned by the products or services covered by that trade mark”⁶⁶². [Emphasis added by this author].

Then, the ECJ added:

“...The first condition implies a certain degree of knowledge of the earlier trade mark among the public. It is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks, even

allure and prestigious image, which can be attached to luxury and prestigious goods, can constitute trade mark infringement).

⁶⁵⁷ *Supra* notes 11 and 652.

⁶⁵⁸ See the case comment Brevetti, S, I ‘European Community: Trade Marks – Just How Well Known Must a Well-Known Trade Mark Be? – the “Chevy” Case Question Answered’ (2000) 22 *EIPR* N46-47. The fact of this case can be summarised as follows: General Motors holds the trade mark ‘Chevy’ for motor vehicles and asked for an injunction against the Yplon’s use of the same mark for dissimilar goods that is, cleaning product. The main focus of this was whether reputation within one of the Benelux countries of part thereof would be sufficient. The CTM Guidelines, Part 5, Article 8(5) CTMR at 4.

⁶⁵⁹ The CTM Guidelines, Part 5, Article 8(5) CTMR at 6.

⁶⁶⁰ Article 6bis of the Paris Convention.

⁶⁶¹ Manistis, S, *supra* note 37 at 370.

⁶⁶² See the *General Motors* case, *supra* note 646 at 26.

when used for non-similar products or services and that the earlier trade mark may consequently be damaged....”⁶⁶³.

The court, subsequently, went on to note:

“all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of investment made by the undertaking in promoting it”⁶⁶⁴.

And finally, it was said:

“...the stronger the earlier mark’s distinctive character and reputation the easier it will be accept that detriment has been caused to it”⁶⁶⁵.

By reference to the Definition Model, it can be inferred that:

- No guidance as to *form* of ‘trade mark of repute’ in the CTMR is to be found in *General Motors*⁶⁶⁶;
- Instead, there is some guidance as to what constitutes *concept* of ‘trade mark of repute’, in the sense that factors indicative of repute are noted. It is said that such marks have to be known by a significant part of the relevant sectors of the public and that ‘reputation’ is tested explicitly: in determining if the mark has a reputation or not, various criteria are to be applied such as: the *degree of knowledge or recognition of the mark* in the relevant sectors of the public, duration, extent and geographical area of use of the mark; the scale and scope of investment in promoting the mark. It is submitted that the correlation between distinctiveness of marks and reputation of a mark is clearly stated above, thus it can be argued that ‘trade mark of repute’ *concept* is distinctiveness. Furthermore, it may well be inferred from those criteria above that ‘trade mark of repute’ *concept* (distinctiveness) is rather closely related to knowledge and or recognition of a mark.

⁶⁶³ *Ibid* at 23.

⁶⁶⁴ *Ibid* at 27.

⁶⁶⁵ *Ibid* at 30.

⁶⁶⁶ *Ibid*.

To summarise, the following factors are said to be amongst those that might be taken into account of assessing if a mark is ‘trade mark of repute’ or not:

- (i) The *degree of knowledge* required must reach a certain sector of the relevant public, that is to say addressed by the product or service and its trade mark;
- (ii) The degree of knowledge must be determined by taking into account all the relevant facts of the case, in particular the *market share* held by the trade mark;
- (iii) The *intensity* of use;
- (iv) The *geographical extent* of use;
- (v) The *duration* of use, and;
- (vi) The *size of the investment* made by the undertaking *in promoting it*⁶⁶⁷.

[Emphasis added].

It should be noted that the wording of these CTM factors or criteria are quite noticeably similar to those of the WIPO Recommendation⁶⁶⁸. For example, it can be observed that the first criterion is rather similar to Article 2(1)(b)(1), the third is similar to Articles 2(1)(b)(2) and (3), the fourth and fifth are similar to Article 2(1)(b)(2), and sixth is similar to Article 2(1)(b)(3).

In addition to that, there is some similarity with GATT TRIPS⁶⁶⁹. As there, the *General Motors* guidance does seem to present a criterion indicative of value (which may be appropriate for defining or identifying a ‘valuable trade mark’, but, it is submitted, is not a useful indicator of distinctiveness) as being indicative of the status of ‘trade mark of repute’ (in GATT TRIPS – the status of ‘well-known trade mark’).

⁶⁶⁷ The *General Motors* case, *supra* note 646 at 25 and 27. Wurtenberger, G, *supra* note 474 at 28.

⁶⁶⁸ See Chapter 3, Section 3.2.4.

⁶⁶⁹ See Chapter 3, Section 3.2.2. This author has argued that there is a similarity in wordings between GATT TRIPS and the WIPO Recommendation (see Chapter 3, Section 3.3).

It is submitted that, Advocate General Francis Jacobs's opinion (hereafter Advocate General Jacobs) in the *General Motors* case is particularly germane to this thesis⁶⁷⁰. Interestingly, he spoke of the difference of 'well-known trade mark' in the relevant international treaties (the Paris Convention⁶⁷¹) and that of the national laws as follows:

"…Whether a mark with a reputation is a quantitative or qualitative concept, or both, it is possible to conclude in my view that, although the concept of a well-known mark is itself not clearly defined, a mark with a "reputation" need not be as well known as a well-known mark."⁶⁷²

So, contrary to the views thus far promulgated in this thesis, Advocate General Jacobs seems to be indicating that 'well-known trade mark' and 'trade mark of repute' are in some ways different (Advocate General Jacobs also considers the concept of 'well-known trade mark' to be clearly defined: something that, it is submitted, is refuted in this thesis). He also recognised the linguistic differences in relation to the terms 'known' and 'reputation'. He observed that⁶⁷³ the German, Dutch, and Swedish version of the Regulation used words closer to first term without indicating the extent of knowledge required, whereas the other versions used expressions close to "reputation" implying, "at a quantitative level a certain degree of knowledge amongst the public"⁶⁷⁴.

This author continues to ponder whether it is even appropriate to speak of 'trade mark with a reputation' in a CTM context when there is some linguistic variation amongst EU member states, with some using terms closer to 'well-known trade mark'. This author strongly submits that clarity as to terminology ('trade mark of repute' or 'well-known trade mark?') and definition of 'trade mark of repute' are needed. Further to linguistic niceties, this author would like to emphasise that Advocate General Jacobs must be correct in pointing out these differences. She would, however, submit that Advocate General Jacobs is incorrect in indicating that 'well-known trade mark' is a

⁶⁷⁰ See Griffiths, A 'The Impact of the Global Appreciation Approach on the Boundaries of Trade Mark Protection' (2001) 4 *IPQ* 326-360 at 345-346.

⁶⁷¹ Article 6bis of the Paris Convention.

⁶⁷² The *General Motors* case, Opinion of the General Jacobs *supra* note 648 at 37.

⁶⁷³ *Ibid.*

⁶⁷⁴ *Ibid* at 36-37.

clearly-understood concept. However, whether ‘trade mark of repute’ is actually different to ‘well-known trade mark’, as suggested by Advocate General Jacobs, is a more difficult question. As noted above, this author has suggested that ‘trade mark of repute’ can be equated to ‘well-known trade mark’: in this view, the author respectfully differs from Advocate General Jacobs, whilst conceding that she cannot provide definitive evidence that her view is correct.

The third quotation noted above is of some help here. It is thus acknowledged that the stronger the mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it⁶⁷⁵. It is thus possible to show an interconnection between distinctiveness and ‘trade mark of repute’ (in this thesis, distinctiveness has already been shown to be important to the *concept* of ‘well-known trade mark’). However, there is also the statement that well-known trade mark’ under the Paris Convention and that ‘trade mark of repute’ under the CTMR differ in terms of the level of what is here called ‘well-knownness’ (to what extent a mark is well-known) – perhaps, it is submitted by this author, a reflection of the use of the term ‘repute’ rather than ‘well-known’.

In summary, it is argued that the term ‘reputation’ implies a higher level of *distinctiveness* than that for ‘well-known trade mark’: a knowledge threshold which is reached when a trade mark is known by a significant part of public concerned by the products or services covered by the mark, in a substantial part of the member states concerned⁶⁷⁶.

At this stage, another question might arise: what constitutes ‘significant part of public’? It was clearly commented by the Advocate General Jacobs that:

“...it is difficult to give a general definition and it is essential that national courts should proceed on a case-by-case basis without using fixed criteria which may prove arbitrary in their application to specific cases. For example,

⁶⁷⁵ The *General Motors* case, *supra* note 648 at 30.

⁶⁷⁶ The *Intel* case, *supra* note 651 at 23; Advocate General Sharpston summarised the *General Motors* case in his opinion.

the practice of using fixed percentages of the relevant public is now widely criticised, and may be inadequate if taken alone.”⁶⁷⁷.

Therefore it can be summed up that the requirement could not be specified more precisely, for example in terms of a given percentage of the relevant public.

Accordingly, the BoA cited in *Hollywood S.A.S. v Souza Cruz S.A* case follows that⁶⁷⁸:

“The Board of Appeal considers that the fact that a trade mark has a reputation simply means that it is known by a significant part of the relevant public. On the other hand, a trade mark’s reputation in the sense of recognition of the sign does not decide in advance the particular significance this reputation may have, in the sense of “repute”, or “image”, to which registration of the contested trade mark would be detrimental.”

Above all, it appears that ‘trade mark of repute’ does seem to differ from a ‘well-known trade mark’. Returning to the Definition Model, *form (type and context)* of ‘trade mark of repute’ appears to be the same as that for ‘trade mark’ defined under Article 3 of the CTMR⁶⁷⁹. *Concept* of ‘trade mark of repute’, it can now be said, appears to imply a very high level of distinctiveness. The test for marks obtaining a reputation is when the mark is known by at least a significant part of the relevant public throughout at least a substantial part of the relevant Member States depending on the product marketed and the relevant public⁶⁸⁰. This is known as a knowledge threshold requirement⁶⁸¹ implying that it must be principally assessed on the basis of fact-based quantitative criteria⁶⁸² such as the geographical extent of a mark being well-known and the degree of a mark being known to a significant part of the relevant sectors of the public⁶⁸³, but not to set out the fixed criteria⁶⁸⁴.

⁶⁷⁷ The *General Motors* case, *supra* note 648 at 40.

⁶⁷⁸ *Hollywood S.A.S. v Souza Cruz S.A.* (Case R-283/1999-3) [2002] ETMR 64 at 61.

⁶⁷⁹ See Chapter 2, Section 2.3.2.

⁶⁸⁰ The *General Motors* case, *supra* note 646 at 35-36.

⁶⁸¹ *Ibid* at 22.

⁶⁸² The *General Motors* case, *supra* note 648 at 41.

⁶⁸³ *Ibid* at 39.

⁶⁸⁴ *Ibid* at 40. See Maniatis, S, *supra* note 37 at 370-371. Maniatis argues that fixed criteria were potentially arbitrary; instead courts should apply a variety of criteria including the degree of knowledge

This does provide more information as to what constitutes a ‘trade mark of repute’ at the EU level. However, at a fundamental level, this adds very little to an understanding as to what, at the conceptual level, are ‘trade marks with reputation’. It appears that the courts have not yet approached this question from a conceptual perspective.

An observation to be made here is as follows: it seems to this author that rather than defining what a ‘trade mark of repute’ is and asking what is the appropriate scope of protection is for the same, protection afforded to ‘trade mark of repute’ is approached primarily by assessing the situations where use of the sign applied for is capable of taking an unfair advantage of, or being detrimental to the distinctiveness or the repute of the earlier mark (such use must be without due course)⁶⁸⁵. This author submits that a comprehensive definition of ‘trade mark of repute’ might provide more help to delineate the scope of ‘trade mark of repute’ protection.

Thus, as implied above, the process of determining how ‘trade mark of repute’ is defined requires a reliance on implicit, rather than overt, guidance as to what constitutes a ‘trade mark of repute’. It has already been examined that in relation to the available explicit guidance as to what constitutes a ‘trade mark of repute’, that the noted criteria (please see above) relate to the economic value of the mark⁶⁸⁶. If there was an overriding factor in the list, it might be of help to conceptually define ‘trade mark of repute’.

Consequently, in one case⁶⁸⁷ reputation was proved by submitting survey evidence, revenue statistics advertising and promotional expenditures in well-known fashion magazines, statements in well-known Spanish financial newspapers and other magazines that attested to the revenues achieved in previous years. Additionally, the mark in question was considered to have an extensive and important physical

or recognition of the mark in the relevant sectors of the public; the duration, extent and geographical are of use of the mark; and the scale and scope of investment in promoting the trade mark.

⁶⁸⁵ See Article 8(5) of the CTMR.

⁶⁸⁶ Griffiths, A, *supra* note 154 at 346; Simon, I, *supra* note 85.

⁶⁸⁷ *Mango Sport System S.R.L. Socio Unico Mangone Antonio Vincenzo v Diknah S.L.* (Case R 308/2003-1) [2005] ETMR 5.

presence throughout Spain due to the existence of numerous outlets under the mark in every major Spanish town and city⁶⁸⁸.

Further, according to the CTM Guidelines⁶⁸⁹, the Court has simplified the test of reputation, as compared with what was often needed in the past for accepting that marks enjoyed reputation⁶⁹⁰.

One factor relating to reputation appears to be field of endeavour. The fact that the famous pop artist Andy Warhol saw some artistic value in the packaging of Campbell's soup is not sufficient in itself for establishing that the mark enjoys reputation within the meaning of Article 8(5), and this is irrespective of the success and renown of the painting as a work of art⁶⁹¹.

Another appears to be geographical extent⁶⁹². It is held that “an earlier mark is known by a *significant part of the public concerned by the products or services* covered by the trade mark”⁶⁹³, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector⁶⁹⁴: this might be seen as beneficial, and does provide considerable flexibility for consideration of the scope of Article 9(1)(c) of the CTMR. It is clear that ‘significant’ does not mean that the earlier mark has to be known in one or more countries: in the *General Motors* decision itself, part of one of the Benelux countries was recognised as “a significant part of the public concerned”⁶⁹⁵. In another case involving the Benelux countries, it was decided that relevant public was considered to be the part of Benelux where only Dutch is spoken⁶⁹⁶. In another current case⁶⁹⁷, being well-known in one part of Spain, which had 10% of the Spanish population,

⁶⁸⁸ *Ibid* at 13; “The applicant was wrong to argue that only a luxury mark can attract customers and be the subject of infringement under Art.8(5). An earlier mark can be attractive to the consumer and yet enjoy a reputation for everyday goods (such as the fashion goods in this case) that are not luxury goods”. (see at 15.).

⁶⁸⁹ See the CTM Guidelines, Part 5, Article 8(5) CTMR.

⁶⁹⁰ 2333-2000 Telefonica on line/t-online (EN).

⁶⁹¹ 1243/2000 CAMPBELL'S et al./CAMPBELL CATERING (EN).

⁶⁹² *Nieto Nuno v Monlleo Franquet* (Case C-328/06) [2008] ETMR 12.

⁶⁹³ The *General Motors* case, *supra* note 646 at 26.

⁶⁹⁴ *Ibid* at 24.

⁶⁹⁵ *Ibid* at 31.

⁶⁹⁶ *Bovemij Verzekeringen NV v Benelux-Merkenbureau* (Case C-108/05) [2007] ETMR 29.

⁶⁹⁷ *Nieto Nuno v Monlleo Franquet*, *supra* note 688.

was not considered to be well-known in the Spanish territory⁶⁹⁸. Clearly the geographic extent of ‘knownness’, whilst it has to be significant, does not have to follow territorial boundaries: ‘knownness’ in smaller geographically-defined populations may suffice, as may groups defined by language or profession within or across EU member states.

Turning now to issues of repute, in one case it was argued that that: “(1) the reputation was to be determined in relation to the perception of a specialised public, which was especially well informed and highly attentive, and the term “nasdaq” identified, in the eyes of the European public, a pre-eminent provider of recognised financial market indices...”⁶⁹⁹.

Also, the author of this thesis argues that the generous decision was given to the word mark ‘SPA-FINDERS’,⁷⁰⁰. It was of surprise that the ‘reputation’ of the word mark ‘SPA’ is not approved⁷⁰¹ and ‘reputation’ in Benelux nations is not enough to be considered as well-known in this case⁷⁰². It was established that only the Benelux SPA mark had a reputation, and detriment to the distinctive character of this mark could not be inferred from the link that the public would make between SPA and the applied for mark ‘SPA-FINDERS’. The existence of such a link was insufficient to demonstrate the risk of detriment to distinctive character, which was limited in any event owing to the fact that Spa was the name of a Belgian town⁷⁰³.

⁶⁹⁸ *Nieto Nuno v Monlevo Franquet*, *supra* note 688 at 18. “However, the customary meaning of the words used in the expression ‘in a Member State’ preclude the application of that expression to a situation where the fact of being well known is limited to a city and to its surrounding area which, together, do not constitute a substantial part of the Member State.”

⁶⁹⁹ *Antaritica Srl v Offince for Harmonisation in the Internal Market (Trade Marks and Designs)* (Case T-47/06) [2007] ETMR 77.

⁷⁰⁰ The other examples are: *SIGLA SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-215/03) [2007] ETMR 79.

⁷⁰¹ *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonisation in the Internal Market, Spa-Finders Travel Arrangements Ltd Intervening* (Case T-67/04) [2005] ETMR 109.

⁷⁰² The author of this thesis points out that this case can be of reference as it was clearly stated that “the purpose of Art.8(5) is *not* to prevent the registration of every mark that is identical or similar to a mark with a reputation. Instead, it is limited to preventing the registration of marks which are likely to be detrimental to the repute or distinctive character of the earlier mark or which are likely to take unfair advantage of them”. *Ibid* at 4. This case confirmed three points as follows: firstly that the marks at issue are identical or similar; secondly, that the earlier mark cited in opposition has a reputation and, thirdly, that there is a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. Those conditions are cumulative and failure to satisfy one of them is sufficient to render that provision inapplicable.

⁷⁰³ The *Spa Monopole* case, *supra* note 697.

These are all factors introduced on a case-by-case basis: nothing is conceptually defined⁷⁰⁴.

In summary, the test for a registered ‘trade mark of repute’ is that it shall be known by a significant part of public. Significance may be defined geographically, i.e. concerning a substantial part of territory, but it could also be defined by linguistic considerations or by profession. All the relevant factors need to be considered such as the market share of the trade mark, the intensity, geographical extent and length of its use, and the size of investment for the promotion of the trade mark. It should be emphasised that under this (so-called) definition, a number of the factors mentioned can be regarded as being proxies for the economic value of mark, and as such could be seen as being part of *form* within the Definition Model. It can thus be argued that the language of assessment of detriment or unfair advantage⁷⁰⁵ makes this interpretation arguable.

Now, a second tranche of cases will be considered, starting with, *Davidoff & Cie SA, Zino Davidoff SA v Gofkid Ltd*⁷⁰⁶, known as the *Davidoff* case⁷⁰⁷. This case delivered a significant ruling for ‘trade mark of repute’ at the regional level and considered whether Article 5(2) and Article 4(4) of the EU Trade Mark Directive (corresponded to the Article 8(5) and Article 9(1)(c) of the CTMR) covered also identical or similar goods or services. It should be noted here that this case did not explicitly speak of the

⁷⁰⁴ See the judgments of *El Corte Ingles SA v Office for Harmonisation in the Internal Market* (Case T-443/05) [2007] ETMR 81.

⁷⁰⁵ The CTM Guidelines, Part 5, Article 8(5) CTMR at 4.

⁷⁰⁶ The *Davidoff* case, *supra* note 647 at 42.

⁷⁰⁷ The summary of the case is demonstrated in Maniatis, S, *supra* note 37 at 372 as follows: The case was referred to the Court of Justice by the German Federal Court of Justice. Davidoff was the owner of the homonymous trade mark for *inter alia*, good in Classes 14 (precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments) and 34 (tobacco; smoker’s articles; matches). It is evidenced that the ‘DAVIDOFF’ trade mark registered internationally by Davidoff for a number of goods noted above. Gofkid later registered the mark ‘DURFFEE’ in Germany. Davidoff brought a claim against Gofkid in Germany for trade mark infringement. It was argued that there was a likelihood of confusion between the two marks in question. Gofkid used the same scripts and the letters ‘D’ and ‘FF’ in the same distinctive manner as the earlier mark. It was alleged to be deliberately designed to take advantage of the high prestige value of the Davidoff mark and to use its advertising appeal for the goods it marketed and to be detrimental to the good reputation of the Davidoff mark. See also, Turner-Kerr, P, *supra* note 644 at 483-489.

conceptual definition of ‘trade marks with reputation’; however, a brief illustration is of help before a fuller analysis in the following section.

The ECJ observed that Article 5(2) of the EU Trade Mark Directive allowed stronger protection to be given marks with reputation than that conferred under Article 5(1) of the EU Trade Mark Directive. Article 5(2) allowed the proprietor to prevent the use of a sign which was identical with or similar to his mark for goods and services which were not similar to those in respect of which the mark was registered, that is, in situations where there was no protection under Article 5(1) of the EU Trade Mark Directive. This stronger protection was given when the use of the sign without due cause took unfair advantages of, or was detrimental to, the distinctive character or the repute of the mark⁷⁰⁸.

So it was concluded that Article 5(2) could not be interpreted in such way that lead to marks with reputation having less protection where a sign was used for dissimilar goods and or services. Therefore, Article 5(2) (correspondence to Article 4(4)(a)) entitles member states to provide specific protection for registered trade marks with reputation in cases where the later mark, which was identical with or similar to the earlier mark, was intended to be used or was used for goods or services identical or similar to those covered by the registered mark⁷⁰⁹.

The Advocate General Jacobs delivered his opinion that:

“It must, moreover, be remembered that even under Articles 4(1) and 5(1) marks having a particularly distinctive character – whether *per se* or because of the reputation they enjoy with the public – benefit from broader protection than other marks...”

And also, he raised a concern that:

“I find very persuasive the argument of Gofkid and the United Kingdom that *the proposed broader interpretation of Articles 4(4)(a) and 5(2) would blur*

⁷⁰⁸ The *Davidoff* case, *supra* note 647 at 48.

⁷⁰⁹ *Ibid.*

the clear outlines of the protection afforded by the Directive, which is based essentially on the existence of a likelihood of confusion, by allowing in certain circumstances a concurrent or alternative protection based on other criteria and thus *entailing legal uncertainty*.⁷¹⁰ [Emphasis added]

Although the *Davidoff* cases appears not directly to provide any guidance to the conceptual definition of well-known trade mark' at the regional level, it was considered to be important here to show the stepping stones to the confusion theory.

In addition to that, although the *Adidas-Salom AG and Adidas Benelux BV v Fitnessworld Trading Ltd* case does not underpin the main focus of this thesis, a brief sketch of the main points of the case⁷¹¹ will be of help in observing an approach to the correlation between the similarity and distinctiveness of the marks.

It was found that similarity was required between the earlier and later marks such that the relevant section of the public makes a connection between two marks, that is to say, "establishes a link between them even thought it does not confuse them".

Finally, attention will be turned to the more recent case-law, that of *Intel*⁷¹² and *Bellure*⁷¹³. Although these decisions do not directly relate to this thesis, some aspects of the reasoning employed in each may have some import to the definition of 'trade mark of repute'.

In *Intel*, at issue was the scope of protection available to a 'trade mark of repute'⁷¹⁴ against infringement under Article 9(1)(c): specifically the definition of 'detiment'

⁷¹⁰ *Ibid* at 55.

⁷¹¹ The Advocate General took the opportunity to provide the first comprehensive ECJ-level analysis of the types of injuries enjoined by Article 5(2) of the EU Trade Mark Directive. Detiment to distinctive character can be equated with the US concept of blurring while detriment to repute is akin to tarnishment. For the defendant's sign to be detrimental to or take advantage of the plaintiff's mark, it must in some way bring the plaintiff's mark to the mind of the relevant public. In order to determine whether this is the case, national courts should, according to the Advocate General, determine the degree of sensory (visual, aural or olfactory) and conceptual similarity between the two marks as they would under Article 5(1)(b) of the EU Trade Mark Directive. However, unlike under Article 5(1)(b) of the EU Trade Mark Directive, it is not necessary to show that this similarity gives rise to a likelihood of confusion. Beyond that, it is for national courts to determine whether the degree of similarity is sufficient to cause the type of harm specified in Article 5(2) of the EU Trade Mark Directive.

⁷¹² The *Intel* case, *supra* note 651.

⁷¹³ The *Bellure* case, *supra* note 652.

⁷¹⁴ See *supra* notes 11 and 652.

and whether it was sufficient to establish a link between the earlier mark of repute and the allegedly infringing mark or whether actual harm or damage must be caused to the earlier mark of repute. Although a very interesting dilution decision⁷¹⁵ for many reasons, it is submitted that it does not contain any explicit guidance to the definition of ‘trade mark of repute’.

A summary of findings of this case⁷¹⁶ with accordance to the assessment of ‘trade mark of repute’ can be outlined as follows:

- Article 4(4)(a) of the EU Trade Mark Directive, (thus Article 8(c) of the CTMR) was to be interpreted as meaning that whether there was a link, within the meaning of *Adidas-Salomon and Adidas Benelux*⁷¹⁷, between the earlier mark with a reputation and the later mark was to be assessed globally, taking into account all the relevant factors⁷¹⁸;
- The relevant factors are as follows⁷¹⁹:
 - (i) the fact that, for the average consumer, who was reasonably well informed, observant and circumspect, the later mark called the earlier mark with a reputation to mind, was tantamount to the existence of such a link between the conflicting marks, and;
 - (ii) the fact that: (a) the earlier mark had a huge reputation for certain specific types of goods or services; (b) those goods or services and the goods or services for which the later mark was registered were dissimilar or

⁷¹⁵ See Opinion of A.G. Sharpston in the *Intel* case *supra* note 651 at 239.

⁷¹⁶ The fact of this case can be summarised as follows: the registered trade mark holder of the INTEL mark, which had a high reputation in the UK for microprocessor products and software, applied for a declaration of invalidity of the defendant’s INTELMARK trade mark, which was registered under the classification for marketing and telemarketing services. The claimant contended that use of INTELMARK would take unfair advantage of, or be detrimental to, the distinctive character or the repute of its earlier mark. On appeal, (the High Court Dismissed the claim) the claimants argued that Article 4(4)(a) of the EU Trade Mark Directive provided protection to the proprietor of a trade mark with a reputation against the risk of dilution. The Court of Appeal sought a preliminary ruling from the Court of Justice to clarify the nature of the *link* required by the case-law, and the concepts of (i) unfair advantage and (ii) detriment to the distinctive character or repute of the earlier mark.

⁷¹⁷ *Adidas-Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01) [2004] ETMR 10.

⁷¹⁸ The *Intel* case, *supra* note 651 at 9.

⁷¹⁹ *Ibid.*

dissimilar to a substantial degree, and; (c) the earlier mark was unique in respect of any goods or services, did not necessarily imply that there was a link between the conflicting marks;

- Furthermore, Article 4(4)(a) of the EU Trade Mark Directive (thus Article 8(c) of the CTMR) was to be interpreted as meaning that: (i) the use of the later mark could be detrimental to the distinctive character of the earlier mark with a reputation even if that mark was not unique; (ii) a first use of the later mark could suffice to be detrimental to the distinctive character of the earlier mark, and; (iii) proof that the use of the later mark was or would be detrimental to the distinctive character of the earlier mark required evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change would occur in the future.

It is also concluded that:

“... the existence of such a link is not sufficient, in itself, to establish that there is one of the types of injury referred to in Article 4(4)(a) of the Directive, which constitute...the specific condition of the protection of trade marks with a reputation laid down by that provision”⁷²⁰.

It is submitted that from this decision it can be inferred that in defining ‘trade mark of repute’ that economic factors are likely to be emphasised. The fact that empirical evidence of damage or harm to the mark of repute is to be required before infringement is made out, might be seen as an indication of a restrictive ECJ approach to the protection of trade marks of repute: this author has pondered the possibility that this might be reflected in a more restricted definition of ‘mark of repute’, but has no evidence of this.

⁷²⁰ *Ibid.*

Although some commentators have praised the reasoning in *Intel*⁷²¹ for its flexibility, this author is less sure of the impact of this decision for the definition of ‘well-known trade mark’ and submits that this decision does little to clarify an already unclear concept.

To muddy the waters further, the more recent *Bellure* decision⁷²² raises further questions and issues. As this decision does consider the relationship between confusion and unfair advantage (although it also deals with issues, such as comparative advertising, that are beyond the scope of this thesis), we will return to these issues at Section 4.4 below. Nevertheless, in this context it should be noted that although *Bellure* does not explicitly speak to the definition of ‘trade mark of repute’, a much more generous scope of protection was afforded to such marks here than in *Intel*. In *Bellure* the Court stated that unfair advantage was taken (in relation to Article 5(1)(a) of the Directive⁷²³):

“...where that party sought by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark’s image.”⁷²⁴

It was also stated that protection afforded under Article 5(1)(a) *does* require damage (*Intel*-type reasoning, it is submitted), but this does not require damage to the essential function of a trade mark (that of guaranteeing the origin of goods/services), provided that one of the other specified functions of the mark⁷²⁵ was affected. Not only is *Bellure* interesting in the sense that it is indicative of a much wider scope of protection for marks of repute than before (perhaps running contrary to *Intel* here), but it does appear to confirm the *Intel* view that that in defining ‘mark of repute’ that

⁷²¹ Middlemiss, S, and Warner, S, ‘The Protection of Marks with a Reputation: Intel v CPM’ (2009) 31 *EIPR* 195-201 at 326.

⁷²² The *Bellure* case, *supra* note 652.

⁷²³ The equivalent of Article 9(1)(a) of the CTMR.

⁷²⁴ The *Bellure* case, *supra* note 652 at 46.

⁷²⁵ *Ibid* at 51. These other functions are stated to include, “....in particular that of guaranteeing the quality of the goods or services in question and those of communication, investment or advertising.”

economic factors are likely to be emphasised. Again, *Bellure* provides more questions than answers for this thesis: an accurate definition of ‘trade mark of repute’ still remains out of reach.

Finally it should be noted that these cases do not seem to contain any specific reference to the *preconditions* (*graphic representation* and *commercial use*) found in the Definition Model.

4.3.4 Summary

Above all, it can be concluded that no accurate definition of ‘trade marks of repute’ is provided by the primary materials. Even applying the Definition Model, it can be seen that there is no explicit conceptual definition of ‘trade mark of repute’ either in the Regulation or the cases.

Although there is some, implicit, guidance as to *form* (*type* and *context*) of ‘trade mark of repute’ in the Regulation, no further guidance is provided by the cases. Where the cases do contribute to the jurisprudence is in developing fact-based criteria to assess ‘trade mark of repute’ status: thus in this sense, the cases do provide some indication (if not an explicit definition of) *concept*. In order to assess if a trade mark is a mark of repute, a certain degree of knowledge on behalf of the relevant public must be achieved, with the factual criteria⁷²⁶ outlined in the *General Motors* case⁷²⁷ being indicative (but not conclusive) of this. This author has already noted the similarities between these criteria and those of the WIPO Recommendation (thus, many of the same criticisms can apply to the CTM approach, (see Chapter 3, Section 3.2.4)). From this, it can be inferred that *concept* of ‘trade mark of repute’ includes notions of distinctiveness, although value also appears to be relevant (incorrectly, in the view of this author).

Not only can the CTM regime be criticised for failing to provide a full definition of ‘trade mark of repute’ according to the Definition Model, there are – as noted earlier – issues as to the clarity of the guidance provided for determining well-known trade

⁷²⁶ See page 131-132.

⁷²⁷ The *General Motors* case, *supra* note 646.

mark status. This author submits that these requirements should be specified more precisely, that is to say, why should there not be a fixed percentage of the public which must recognise the mark and why should the national court be directed to take into consideration all the relevant factors of the case (in addition to the *General Motors* criteria)? The result of this lack of clarity is that ‘trade mark of repute’ is bound to be variously interpreted due to the unspecified parameters of the fact-based assessments. It is submitted by this author that it is this uncertainty that also accounts for the various approaches employed in the cases at the ECJ, the CFI, and the BoA⁷²⁸: i.e. not only is there scope for variation in defining and recognising ‘trade mark of repute’ at the national level, but that there is also some such scope within the CTM system itself. Discretion and flexibility at both the national and CTM levels on this issue hinders, in the view of this author, the development of a consistent and certain approach to both defining and identifying ‘trade marks of repute’. This view is based on the author’s belief that law should be always consistent, concise and certain, and she has seen no reason why the definition and identification of ‘trade marks of repute’ should not be so.

An additional layer of uncertainty is provided by language, it is submitted: the terms employed to describe ‘trade mark of repute’ in the different EU languages⁷²⁹ are not fully equivalent to each other, which must contribute to uncertainty as to the true meaning of the term ‘trade mark of repute’⁷³⁰. Also, more fundamentally, there is some indication (refuted by this author) that there is a difference between ‘well-known trade mark’ in Article 6bis of the Paris Convention and ‘trade mark of repute’ in the CTMR and the EU Trade Mark Directive⁷³¹. The nature of any such difference is not clear and no attempt has been made to provide any conceptual definition of ‘reputation’⁷³².

⁷²⁸ See the recent examples of cases in terms of Article 5(2) of the EU Trade Mark Directive. The *Nieto Nuno* case, *supra* note 688. This is for the geographical context, *Crunch Fitness International Inc v Societe des Produits Nestle SA*, (Case R-52/2005-4) [2008] ETMR 18, the *Bellure* case, *supra* note 652. Walmsley, M, ‘Trade Mark Dilution – Court of Appeal Waters Down Trade Mark Owners’ Rights’ (2008)30 *EIPR* 109-111. The *Intel* case, *supra* note 651. *Riemann & Co v Linco Care Ltd* [2007] ECC 23; *Antartica Srl v Office for Harmonisation in the Internal Market* (Case T-47/06/2007) [2007] ETMR 77.

⁷²⁹ *Supra* note 642, and see the *General Motors* case, *supra* note 646 at 20.

⁷³⁰ The *General Motors* case (opinion of General Jacobs), *supra* note 642 at 34-36.

⁷³¹ The *General Motors* case, *supra* note 646 at 19.

⁷³² For example, it has been clearly stated that “the Directive itself makes no attempt at a definition”. See the *General Motors* case (opinion of General Jacobs), *supra* note 648 at 2.

It has already been argued that the loosely defined concept of ‘well-known trade mark’ at the international level⁷³³, could pose advantages and disadvantages for the EU and Japanese trade mark laws. An advantage might be the scope for flexibility in the regional and national regulation of well-known trade marks, whilst a disadvantage might well be confusion, inconsistency and uncertainty in the protection afforded to well-known trade marks. Indeed, a consequence of the international approach to well-known trade mark protection, it is submitted by this author, is that the EU has (to some extent) taken its own route here, for example, introducing the term ‘trade mark of repute’ rather than using ‘well-known trade mark’. However, there also does appear to be implicit recognition of the benefits of a harmonised approach to this issue, inasmuch as the fact-based criteria to test if a mark is a ‘trade mark of repute’ draw heavily on international norms here⁷³⁴. It is, therefore, not clear to this author how at the international level an appropriate balance between flexibility, and consistency and certainty, can be struck. However, this author does submit that there she has evidenced a lack of clarity as to both the definition of, and means of determining, ‘trade mark of repute’ in the CTM system. Whether there is a causal connection between the lack of clarity on this issue earlier identified at the international level and that at the CTM level as to the definition of ‘well-known trade mark’/‘trade mark of repute’ is not something that this author is in a position to evidence in this thesis – although she would like to suggest such a causal link.

Having concluded that there is a lack of clarity as to the definition of ‘trade mark of repute’ in the CTM system (to some extent mirroring that at the international level, although not necessarily caused by this), it is now time to consider the extent to which trade marks of repute are also protected against confusion.

4.4 What Constitutes ‘Confusion’? – the Regional Level

Having considered the definition and conceptualisation of ‘trade mark of repute’, it is time to move on to the next sphere of enquiry – the critical analysis of the protection of trade marks of repute against confusion. As noted in Chapter 1, the scope of this

⁷³³ See Chapter 3, Section 3.2.1 for the Paris Convention.

⁷³⁴ See Section 4.3.3.

thesis means that the level of critical attention as to the definition of ‘well-known trade mark’ (or, in the CTM context, ‘trade marks of repute’) is not replicated in the context of confusion: the concept of confusion is not itself conceptualised or critically analysed in detail in this thesis. In this thesis (although this author may engage in a more detailed treatment of confusion in future research), the concept of confusion is accepted as being the main focus of trade mark infringement and trade mark protection⁷³⁵, and the focus of analysis here lies in critical examination of the evidence of how confusion applies to well-known trade marks (in this Chapter – marks of repute).

This author has already critically considered the difficulties in clearly defining what constitutes a trade mark of repute. However, (as the reader will already be aware), there are no CTM provisions specific to the protection of trade marks of repute against confusion, thus it was in Section 4.3.3 above that the following questions were posed:

- (i) How relevant is the primary and secondary literature on Article 8(5) and 9(1)(c) of the CTMR to the protection of well-known trade marks against confusion?, and;
- (ii) How relevant is the primary and secondary literature on Article 8(1)(b) and 9(1)(b) of the CTMR to trade marks of repute?

These questions are difficult to give simple answers to, but if pressed, this author’s answer to both questions would be – ‘quite relevant’. Clearly Articles 8(5) and 9(1)(c) of the CTMR pertain to the protection of trade marks of repute against *detriment and unfair advantage*, whereas the thrust of this thesis is the consideration of the protection of well-known trade marks (‘trade mark of repute’) against *confusion* (the latter being regulated by Articles 8(1)(b) and 9(1)(b) of the CTMR). This author argues that material relating to Articles 8(5) and 9(1)(c) of the CTMR may be informative as to the *nature* of a mark of repute, whereas Articles 8(1)(b) and 9(1)(b)

⁷³⁵ See Articles 8(1) and 9(1) of the CTMR respectively. Article 8 states that “upon opposition by the proprietor of an earlier marks...” and Article 9(1) states that “A Community trade marks shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using the course of trade...”

of the CTMR must, by a simple process of statutory definition, apply to trade marks of repute as well as ‘mere’ trade marks.

Now, this section will undertake a critical analysis of ‘confusion’ in the CTM regime. A similar structure to that employed in Section 4.3 will be followed: firstly, the statutory definition of ‘confusion’ in the CTMR (and the EU Trade Mark Directive), will be explored⁷³⁶, before moving on to the CTM Guidelines and relevant jurisprudence.

Just before starting this critical consideration, it should be noted here that in this thesis, the terms ‘confusion’ and ‘likelihood of confusion’ are regarded as being interchangeable.

4.4.1 Community Trade Mark Regulation (the CTMR)

The relevant articles, which directly pertain to ‘likelihood of confusion’ and ‘confusion’, are Articles 8(1)(b) and 9(1)(b) of the CTMR⁷³⁷. There seems no explicit definition of what constitutes ‘confusion’ in the CTMR⁷³⁸. Nonetheless, the fundamental *legal* conditions for determining whether ‘likelihood of confusion’ is subject to occur provided within the law (and Rules⁷³⁹) as follows:

“Article 8 Relative grounds for refusal

1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

⁷³⁶ Although the relevant Articles in the EU Trade Mark Directive have been examined, it needs to be noted here that the CTMR is the primary focus of this Chapter.

⁷³⁷ Any trade marks, which cause ‘likelihood of confusion’ shall not be registered under Article 8(1)(b), and the trade mark holders are entitled to have right to prevent third party for their registration of such marks (Article 9(1)(b)).

⁷³⁸ The relevant Articles in the CTMR are Articles 8(1)(b) and 9(1)(b) of the CTMR. Furthermore, it is understood that the interpretation of Article 8(1)(b) is employed to that of Article 9(1)(b) of the CTMR. Wagner, A, ‘Infringing Trade Marks: Function, Association and Confusion of Signs According to the E.C. Trade Marks Directive’ (1999) 21 *EIPR* 127-132 at 128 and Gert-Jan Van De Kamp, ‘Protection of Trade Marks: The New Regime-Beyond Origin?’ (1998) 20 *EIPR* 364-370 at 365.

⁷³⁹ See Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark.

(b) if *because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks* there exists a *likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.*” [Emphasis added by this author].

Correspondingly,

“Article 9 Rights conferred by a Community trade mark

1. A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(b) any sign where, *because of its identity with or similarity to the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark*”. [Emphasis added]

The Articles noted above provide that confusion occurs where *because of its identity with or similarity to the earlier mark and the identity or similarity of the goods or services covered by the earlier mark, and confusion includes the likelihood of confusion, including association, with the earlier trade mark*⁷⁴⁰.

Further, it is argued that the CTMR does not, in fact, attempt to provide any conceptual explanation or definition of confusion. Nevertheless, from the text of the Regulation therein, it is clearly demonstrated that the number of factors shall be considered regarding the appreciation of ‘likelihood of confusion’ including (i)

⁷⁴⁰ It is accepted law that likelihood of confusion is narrower than that of likelihood of association, and that likelihood of association serves to define the scope of confusion. See Articles 8(1) and 9(1)(b) of the CTMR and see *Sabel BV v Puma AG, Rudolf Dassler Sport* (Case C-251/95) [1998] ETMR 1 at 18.

identity or similarity; (ii) the association of the trade mark, and; (iii) the degree of similarity between the trade marks.

It should be correctly noted that the EU Trade Mark Regulation *per se* does not clearly assert that the primary function of a trade mark is an indication of origins. Therefore, it might be helpful to seek further guidance in the EU jurisprudence, as ECJ has referred to rights of trade mark proprietors, which link with functions.

Before the EU Trade Mark Directive had become effectively implemented, the EU jurisprudence had considered an essential function of trade marks as being an indication of trade origins⁷⁴¹. For instance, in *Van Zuylen v Hag* case (known as *Hag I*)⁷⁴², it was commented that “the indication of origin of a trade-marked product is useful, informing consumers”⁷⁴³.

Further to this, in *S.A Cnl-Sucal NV SA v Hag GF AG* (known as *Hag II*)⁷⁴⁴, an essential function of a trade mark was explicitly stated that:

“...It is true that the essential function of a trade mark is ‘to guarantee to consumers that the product has the same origin’. But the word ‘origin’ in this context does not refer to the historical origin of the trade mark; it refers to the commercial origin of the goods... The function of a trade mark is to signify to the consumer that all goods sold under that mark have been produced by, or under the control of, the same person and will, in all probability, be of uniform quality.”⁷⁴⁵

And, this essential function was again mentioned in later cases, for example, in *Canon*:

“...according to the settled case-law of the Court, *the essential function of the trade mark is to guarantee the identity of the origin of the marked product to*

⁷⁴¹ An essential function of trade marks being indications of origins is also mentioned in the *Philips* (see *supra* note 402).

⁷⁴² *Van Zuylen v Hag AG* (Case 192/73) [1974] 2 CMLR 127.

⁷⁴³ *Ibid* at 14.

⁷⁴⁴ *Ibid* at 14.

⁷⁴⁵ *S.A. Cnl-Sucal NV v Hag GF AG* (Case C-10/89) [1990] 3 CMLR 571 at 24.

the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality...”⁷⁴⁶ [emphasis added].

Above all, it may well also be submitted that confusion is related to the confusion as to an indication of trade origin⁷⁴⁷.

4.4.2 The CTM Guidelines

This author has, so far, considered the CTMR in considering the test for, and scope of, confusion. Thus far, three factors have been identified relating to the test of confusion, but it cannot be said that these comprise a full test. Similarly, although guidance as to the scope of the protection against confusion is provided, there has not yet been the opportunity to consider whether said scope is appropriate. Lastly, no distinction has yet been drawn as to how ordinary trade marks and marks of repute benefit from the protection against confusion. Therefore, the author will now further examine the CTM Guidelines to obtain further guidance as how to delineate ‘likelihood of confusion’.

Rather similar to the CTMR, no explicit definition of ‘likelihood of confusion’ is provided within the CTM Guidelines. It is clearly stated “....the basic *requirement of determining* of likelihood of confusion...”⁷⁴⁸; thus inexistence of the conceptual definition can be predicted. Accordingly, the CTM Guidelines refer to Recital 7 of the Preamble of the CTMR⁷⁴⁹, in order to emphasise that the assessment of confusion

⁷⁴⁶ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* (Case C-39/97) [1999] ETMR 1 at 28.

⁷⁴⁷ See Recital 7 of the Preamble of the CTMR.

⁷⁴⁸ See the CTM Guidelines Part 2 Chapter 2 at 2. The emphasis added by this author.

⁷⁴⁹ Recital 7 of the Preamble of the CTMR. It is stated that “Whereas the protection afforded by a Community trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, is absolute in the case of identity between the mark and the sign and the goods or services; whereas the protection applies also in cases of similarity between the mark and the sign and the goods or services; whereas an interpretation should be given of the concept of similarity in relation to the likelihood of confusion; whereas the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the

is based on *special conditions*⁷⁵⁰. Again, assessments of confusion are not considered within the law; there may well be a legitimate reason for not having a legal definition of confusion. Moreover, the CTM Guidelines refer to some established cases as to assess ‘likelihood of confusion’⁷⁵¹. The cases cited therein are in a chronological order: *Sabel BV v Puma AG Rudoff Deassler Sport* (hereafter *Sabel v Puma* in 1998)⁷⁵²; *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* [1999] (hereafter *Canon v Metro*)⁷⁵³; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijzen Handel BV* [2000] (hereafter *Lloyd v Klijzen* in 2000)⁷⁵⁴; and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] (hereafter *Marca Mode v Adidas*)⁷⁵⁵, and *Intel Corporation Inc. v CPM United Kingdom Limited Intel* [2009]⁷⁵⁶ and *L'Oréal v Bellure* [2009]⁷⁵⁷. Given the importance of these cases in the Guidelines, the next section will turn to this jurisprudence directly.

4.4.3 The Cases

Since establishing a definitive definition of ‘likelihood of confusion’ does not appear to be the intention of the Regulation⁷⁵⁸ or the CTM Guidelines⁷⁵⁹, it is necessary to examine the relevant jurisprudence⁷⁶⁰ for further guidance as to the scope of confusion, to then allow the author to argue what is the extent of protection provided for marks of repute against confusion. Further examination of cases quoted within the CTM Guidelines (see Section 4.3.2 above), does, it is submitted, provide some clarity⁷⁶¹.

association which can be made with the used or registered sign, the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for such protection;...”.

⁷⁵⁰ See the CTM Guideline Part 2 Chapter 2 at 2.

⁷⁵¹ *Ibid* at 3-6.

⁷⁵² The *Sabel v Puma*, *supra* note 736.

⁷⁵³ *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* (Case C-39/97) [1999] ETMR 1.

⁷⁵⁴ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijzen Handel BV* (Case C-342/97) [2000] FSR 77.

⁷⁵⁵ *Marca Mode CV v Adidas AG and Adidas Benelux BV* (Case C-425/98) [2000] ETMR 723.

⁷⁵⁶ The *Intel* case, *supra* note 651.

⁷⁵⁷ The *Bellure* case, *supra* note 652.

⁷⁵⁸ See the CTM Guideline Part 2 Chapter 2 at 3.

⁷⁵⁹ *Ibid* at 3-6.

⁷⁶⁰ See for example, Prentoulis, N, G, ‘The Omega Ruling: Trade Mark Co-Existence Agreements in the Tension Between “Public” and “Private” Trade Mark Law’ (2008) 30 *EIPR* 202-205.

⁷⁶¹ It is reported that the ECJ has interpreted the concept of likelihood of confusion on a number of occasions in the context of the identical provision of Article 4(1)(b) of the EU Trade Mark Directive.

In the CTM Guidelines⁷⁶², it is noted that the principles of ‘likelihood of confusion’ are set out in four related decisions⁷⁶³, and it is known that these principles must be employed when determining likelihood of confusion⁷⁶⁴. Furthermore, it is understood as *the interpretation of the statutory framework* by the court of justice⁷⁶⁵.

Although it is understood and acknowledged that there is a vast amount of literature written in this area⁷⁶⁶, this author prefers to directly engage with the primary material. This exercise seems appropriate as the foundations of ‘likelihood of confusion’ discourse in the secondary literature are very much found on these decisions⁷⁶⁷.

First, attention will turn to the decision in *Sabel v Puma*⁷⁶⁸, where it was stated that:

(i) “*the likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case*”⁷⁶⁹;

⁷⁶² See the CTM Guideline Part 2 Chapter 2 at 3.

⁷⁶³ Namely, *Sabel v Puma*; *Canon v Metro*; *Lloyd v Kijesen*; and *Marca Mode v Adidas*.

⁷⁶⁴ It is stated that “where appropriate, the Opposition Division and the BoA should expressly refer to those principles that are pertinent in the specific case”. See the second paragraph of the CTM Guideline Part 2 Chapter 2 at 3. Also, see Griffiths, A, *supra* note 154.

⁷⁶⁵ See the CTM Guideline Part 2 Chapter 2 at 3.

⁷⁶⁶ The relevant literature in term of this case are selectively chosen as follows: Carboni, A, ‘Confusion Clarified: *Sabel BV v Puma AG*’ (1998) 20 *EIPR* 107-109 (she commented that this case appears to leave the door open for a well-known trade mark and owners of that to rely on “resemblance” or “recognition” alone in asserting a likelihood of confusion which in fact goes little further than mere association); Hedvig, S, ‘Likelihood of Confusion in European Trade Marks – Where Are We Now?’ (2002) 24 *EIPR* 463-46 at 465 (she pointed out that ECJ had taken a broader approach than the approach taken by, for instance UK court. She agreed on the latter view); Wagner, A, ‘Infringing Trade Marks: Function, Association and Confusion of Signs According to the E.C. Trade Marks Directive’ (1999) 21 *EIPR* 127-132 (she agreed on the ECJ’s decision and stronger protection is required; and she alleged that a determination of trade mark function is the key to determine the scope of protection. She also criticised that limiting the function of a trade mark to an indication of the origin of a product is not appropriate for a highly competitive modern market and pointed an importance in communicative aspect of it).

⁷⁶⁷ Elsmore, M and Wing, M, “‘*Sabel v. Puma*– Confusion is King’ (1998) Sep *JBL* 485-494 (*Sabel v. Puma* was commented to be the case, which is in favour of the public interest, rather than the commercial interest); Norman, H, ‘Perfume, Whisky and Leaping Cats of Prey: a U.K. Perspective on Three Recent Trade Mark Cases Before the European Court of Justice’ (1998) 20 *EIPR* 306-312 (she criticised that the Court’s reticence reveals a weakness, perhaps not previously identified, in the Community’s plans for harmonisation of national trade mark rights, a weakness which stems from the Court’s own constitutional position); Phillips, J, ‘Analysis: Pariah, Piranha or Partner? The New View of Intellectual Property in Europe’ (1998) 1 *IPQ* 107-112 (he made a comment on *Sabel* being a case with very much less direct reference to the balancing act between competition policy and the protection of investment through intellectual property).

⁷⁶⁸ *Sabel v Puma AG*, *supra* note 736 at 22.

⁷⁶⁹ *Sabel v Puma AG*, *supra* note 736 at 22.

(ii) “the *appreciation of the likelihood of confusion depends on numerous elements* and, in particular, on the recognition of the trade mark on the market, on the association that the public might make between the two marks and the degree of similarity between the signs and the goods”⁷⁷⁰;

(iii) “the global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind their distinctive and dominant components”⁷⁷¹;

(iv) “the average consumers normally perceive a mark as a whole and do not proceed to analyse its various details”⁷⁷²;

(v) “the more distinctive the earlier mark, the greater will be the likelihood of confusion”⁷⁷³;

(vi) “it is not possible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a distinctive character, either *per se* or because of the reputation it enjoys with the public”⁷⁷⁴;

(vii) “however where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion”⁷⁷⁵;

(viii) “the concept of likelihood of association is not an alternative to likelihood of confusion, but serves to define its scope”⁷⁷⁶”, and;

⁷⁷⁰ *Ibid.* The wordings of this paragraph seem almost identical to Recital 7 of the Preamble of the CTMR.

⁷⁷¹ *Ibid* at 23.

⁷⁷² *Ibid.*

⁷⁷³ *Ibid* at 24.

⁷⁷⁴ *Ibid.*

⁷⁷⁵ *Ibid* at 25.

⁷⁷⁶ *Ibid* at 18.

(x) “mere association that the public might make between the two marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion”⁷⁷⁷.

The approach to confusion provided by *Sabel v Puma*⁷⁷⁸ can be conceptualised as follows: (i) where the public confuses the two marks (so-called direct confusion); (ii) the public makes a connection between the marks and confuses them (so-called indirect confusion or association), and; (iii) the public merely associates the two marks but is not confused (association in the narrower sense)⁷⁷⁹.

It is also stated that likelihood of association only shall not satisfy the requirement of the likelihood of confusion; thus it can be said that likelihood of confusion requires the higher level of confusion than that of likelihood of association.

This author submits that the scope of confusion seems still rather unclear; although it was stated in this case that “the more distinctive the earlier mark, the greater will be the likelihood of confusion”⁷⁸⁰. Furthermore, a relationship between distinctiveness (previously identified as being the *concept* of a well-known trade mark, and, by inference, also a trade mark of repute) and confusion can be observed, as evidenced by the statement that “the more distinctive the earlier mark, the greater will be the likelihood of confusion”⁷⁸¹. I.e. there does appear to be a clear recognition in the CTM that part of the definition of a trade mark of repute (*concept*) has import for the scope of protection of trade marks (including marks of repute) against confusion. Thus, this author submits, uncertainty as to trade mark of repute *concept* must, logically, have some import for clarity and certainty as to the scope of confusion *vis-à-vis* marks of repute.

In order further explore the debate as to the distinctiveness/confusion interrelationship; it may be helpful to note the comments in *Sabel* more fully:

⁷⁷⁷ *Ibid* at 26.

⁷⁷⁸ *Ibid*.

⁷⁷⁹ *Ibid* at 16.

⁷⁸⁰ *Ibid* at 24.

⁷⁸¹ *Ibid*.

“...the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly *distinctive character*, either *per se* or because of *the reputation it enjoys with the public*”⁷⁸². [Emphasis added by this author].

From the above, some correlation of ‘distinctiveness’, ‘reputation’ and ‘likelihood of confusion’ seems to be judicially recognised, but this author is not aware of clear and explicit definitions of ‘distinctiveness’, ‘reputation’ and ‘likelihood of confusion’ in the CTM jurisprudence, so this apparent correlation, although noteworthy, does not necessarily provide much assistance in establishing the scope of likelihood of confusion in general, or in relation to trade marks of repute in particular.

What does appear to be clear is that well-known trade mark *concept* (distinctiveness) does determine the scope of protection of such marks – in the CTM, trade marks of repute – against confusion. It has also been demonstrated that stronger marks, which have a high level of familiarity and thus distinctiveness in the minds of the average consumers, ought to enjoy a wider scope of protection as compared to ordinary trade marks. Thus, it can be inferred, that a trade mark of repute will enjoy a wider scope of protection against confusion than an ordinary trade mark, but it is not possible – in the view of this author – to state how much broader this scope of protection is. It seems to this author that any general conclusions or suggested ‘rules of thumb’ here are difficult to elucidate: a trade mark of repute, it would appear, enjoys protection against confusion that relates (in some way) to the extent of its distinctiveness/reputation. It has been already seen in this Chapter that it is difficult both to clearly set out a definition of ‘trade mark of repute’ and to identify when a trade mark has attained ‘trade mark of repute’ status, so, it seems that the scope of the protection of trade marks of repute is determined by an uncertain concept – that of the ‘reputation’ or distinctiveness of a mark of repute. The ECJ refers to its distinctive

⁷⁸² *Ibid* at 24.

character and reputation⁷⁸³ in this context without constructing any conceptual definitions of these two terms⁷⁸⁴.

Instead, as was noted in section 4.4.3, the ECJ has listed non-exclusive factors for assessing the distinctive character of the first mark⁷⁸⁵ including: the market share held by the mark; the amount invested by its owner in promoting the mark; and the proportion of the relevant section of the public, which, because of the mark, identifies the products bearing the mark as ‘originating’ from a particular undertaking. However, it should be remembered that this assessment remains in essence a case-by-case exercise and relies on the individual circumstances of each case: thus this would also appear to be the case for the scope of confusion in relation to trade marks of repute.

On this basis, one might argue that there may be a likelihood of confusion even though the respective products are not very similar if the two marks are very similar and the first mark is a trade mark of repute⁷⁸⁶. Indeed, this author submits that such an imitation of a mark of repute could confuse consumers in markets that have no connection with the ones in which the first mark has been used (thus calling into question the need for requiring the products to be similar at all). However, the ECJ – albeit in the context of ordinary trade marks - has rejected that approach, holding in the *Canon* case that “even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered”⁷⁸⁷. This finding must also hold true for marks of repute, otherwise why would it be necessary to have Articles 8(5) and 9(1)(c)?

Having established in the paragraph above that it is not possible for the distinctiveness of a mark of repute to extend the protection afforded by confusion to dissimilar goods and services (that is the role of Articles 8(5) and 9(1)(c), where rather than confusion,

⁷⁸³ Griffiths, A, *supra* note 154 at 336.

⁷⁸⁴ However, here again, there is no intention to set out the statutory definitions of terms at the CTMR level. See Recitals 10 of the Preamble of the CTMR.

⁷⁸⁵ *Lloyd v Klijzen*, *supra* note 750 at 698-699. *Betty’s Kitchen Coronation Street TM* [2000] RPC 825.

⁷⁸⁶ Following the reasoning in *Canon v Metro*, *supra* note 742 in relation to first marks that have a high level of distinctive character. See the commentary on the *Canon* case by Briggs. See Biggs, N, ‘Infringement under Section 10(2) and 10(3) of the 1994 Trade Marks Act in Perspective’ (2009) 9 *EIPR* 429-434 at 433.

⁷⁸⁷ *Canon v Metro*, *supra* note 742 at 22.

criteria of unfair advantage or detriment are required), it must also be accepted that even within the confines of Articles 8(1)(b) and 9(1)(b) there are limits to the distinctiveness/confusion relationship. It has been stressed that the distinctive character of an earlier mark is not part of analysing whether the goods are similar⁷⁸⁸. Instead, the reputation of the earlier mark is to be taken into account at a later stage of the examination, in order to assess whether there is a likelihood of confusion. It is submitted by this author that there is no reason why a trade mark of repute would not be subject to the same approach here.

The decision in *Canon v Metro* should now be considered more fully. This case is mainly known for the establishment of the so-called the *Canon* factors for the assessment of the similarity of marks: these factors are said to include the nature of the goods; the intended purpose; and method of use and competitive relationship⁷⁸⁹. These factors have been considered and applied in a great number of cases⁷⁹⁰. The *Canon* factors set out in full are as follows:

- (i) The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion⁷⁹¹;
- (ii) By contrast, there can be no such likelihood where the public does not think that the goods come from the same undertaking (or from economically linked undertakings)⁷⁹²;
- (iii) In assessing the similarity of the goods and services, all relevant factors relating to those goods or services themselves should be taken into account⁷⁹³;

⁷⁸⁸ *Assembled Investments (Proprietary) Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (T105/05) (Unreported, June 12, 2007) (CFI) cited in Palm, J, ‘Canon, Waterford...How the Issue of Similarity of Goods Should Be Determined in the Field of Trade Mark Law’ (2007) 29 *EIPR* 475-479 at 475.

⁷⁸⁹ Palm, J, *ibid* at 475.

⁷⁹⁰ See for example, *Citigroup Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-181/05) [2008] ETMR 47; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04) [2006] ETMR 13.

⁷⁹¹ *Canon v Metro*, *supra* note 742 at 29.

⁷⁹² *Canon v Metro*, *supra* note 742 at 29-30.

⁷⁹³ *Ibid* at 23.

(iv) Those factors include, *inter alia*, their nature, the purpose for which they are used (the translation “end users” in the official English language version is not correct) and their method of use, and whether they are in competition with each other or are complementary⁷⁹⁴;

(v) A global assessment of the likelihood of confusion implies some interdependence between the relevant factors and in particular a similarity between the marks and between these goods or services. A lesser degree of similarity between the goods may be offset by a greater degree of similarities between the marks and *vice versa*⁷⁹⁵;

(vi) *Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character*⁷⁹⁶;

(vii) Registration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive⁷⁹⁷;

(viii) The distinctive character of the earlier mark and in particular its reputation must be taken into account when determining whether the similarity between the goods and services is enough to give rise to the likelihood of confusion⁷⁹⁸, and;

(x) There may be such likelihood, even if the public thinks that these goods have different places of production⁷⁹⁹.

As with the *Sabel* decision, there is a significant body of secondary literature relevant to *Canon*⁸⁰⁰. As with *Sabel*, the focus of the secondary literature relates to the

⁷⁹⁴ *Ibid.*

⁷⁹⁵ *Ibid* at 17.

⁷⁹⁶ *Ibid* at 18.

⁷⁹⁷ *Ibid* at 19.

⁷⁹⁸ *Ibid* at 24.

⁷⁹⁹ *Ibid* at 30.

⁸⁰⁰ See for example, Palm, J, *supra* note 784 (it was commented that *Canon* remains uncertain how the assessment must be made if there is at least some kind of remote degree of similarity of goods); Wagner, A, *supra* note 699 (she identified the problem of both *Sabel* and *Canon* being not provided a comprehensive interpretation of the rule) at 130; Montagnon, R, ““Strong” Marks Make More Goods

protection of ordinary marks against confusion, rather than specific direction to marks of repute. However, this author does find it interesting that, as far as she can tell, there has been no substantive attempt to conceptualise the principle of ‘likelihood of confusion’. As noted above, detailed critical consideration and conceptualisation of confusion is beyond the scope of this thesis, so speculation as to why confusion has not yet received such attention from commentators is also beyond the scope of this thesis.

Returning to the guidance on confusion provided in *Canon*, it might well be said that ‘likelihood of confusion’ refers to the risk that the public might believe that the goods or services in question come from the same undertaking (implying business relations between the proprietors of the marks in question)⁸⁰¹. More specifically in relation to trade marks of repute, the fifth point above (*marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character*⁸⁰²) can be seen as strong implicit recognition that marks of repute enjoy more protection against confusion than ‘ordinary’ trade marks. More protection – yes, but how much more protection is appropriate? It has already been seen that the normal scope of confusion is to afford protection against confusion as to trade origin: whether this is also the case for trade marks of repute, or whether such marks enjoy a broader scope of protection is a key question, and a question to which this author does not have an answer.

Further, the *Canon* factor with relation to the global assessment of ‘likelihood of confusion’ seems to be clearer than that of *Sabel v Puma*⁸⁰³. It is also said that a global assessment of the likelihood of confusion implies some interdependence between:

“similar” (1998) 20 *EIPR* 401-404 (a concern mentioned by her being as to the ability of the courts and trade mark registries of Member States to apply this interpretation of distinctiveness led similarity uniformly without further guidance).

⁸⁰¹ *Canon v Metro*, *supra* note 742 at 22-23 and 29-30.

⁸⁰² *Ibid* at 18.

⁸⁰³ See Section 4.4.3, and *Sabel BV v Puma*, *supra* note 736 at 22. It has been set out as follows: “the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, on the association that the public might make between the two marks and the degree of similarity between the signs and the goods” and “the global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind their distinctive and dominant components”.

- (i) the relevant factors including their nature, the purpose for which end-users are used, and their method of use and whether they are in competition, and;
- (ii) a similarity between the marks, and, similarity between the goods or services.

In addition to this, it is clearly stated that the distinctive character of the earlier mark, namely its reputation, must be taken into account of determining the similarity of two marks⁸⁰⁴. Nevertheless, if one asks what is ‘likelihood of confusion’, it seems still rather unclear, and *Canon v Metro-Goldwyn Mayer* does not, it is submitted, provide definitive guidance for ordinary trade marks, and certainly not for marks of repute.

Returning to the cases, the *Canon* case was the second such decision to be considered here. Both cases do not directly address the issue of the protection of marks of repute against confusion, but it is clear that, in accordance with *Canon v Metro-Goldwyn Mayer*, “mark[s] with a highly distinctive character in particular because of their reputation, enjoy broader protection than marks with a less distinctive character... nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense”⁸⁰⁵.

The EU jurisprudence seems to take a stricter approach with relation to the proof of acquired distinctiveness and reputation, in other words, strong proof is required by the court. For instance, it is held that in *Flexi Air (L'Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs))*⁸⁰⁶ that “...the result would be that where the earlier mark has only a weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for...”⁸⁰⁷ In *Sergio Rossi (Sergio Rossi v Office for Harmonisation in the Internal Market (Trade Marks and Designs))*⁸⁰⁸, the earlier marks were, in fact not

⁸⁰⁴ *Canon v Metro*, *supra* note 742 at 24.

⁸⁰⁵ See Opinion of Advocate General Francis Jacobs; *Canon Kabushiki Kaisha v Pathé Communications Corporation* (Case C-39/97) [1998] ETMR 366 at 28. He referred to *Sabel BV v Puma AG, Rudolf Dassler Sport* Case C-251/95 [1998] ETMR 1 at 16.

⁸⁰⁶ *L'Oréal SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (C-235/05 P) [2005] ECR II-949.

⁸⁰⁷ *Flexi Air* *supra* note 802 at 61.

⁸⁰⁸ *Sergio Rossi v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (T-169/03) [2005] ECR II-68.

highly distinctive⁸⁰⁹. “Therefore, it need only be examined whether the similarities between the marks are sufficient to outweigh the differences between the goods in question and to give rise to a likelihood of confusion on the part of target public”⁸¹⁰. Finally, in *Picasso*⁸¹¹, it can be concluded that where a name such as Picasso is used in a completely different to its original context, it will not automatically carry with it its distinctiveness; without use it is doubtful whether the name conveys information regarding the source of products⁸¹².

It can thus be summarised that there seems to be a difference in approach between current and acquired distinctiveness; more reputation is needed for a less inherently distinctive trade mark than that for a trade mark that is more inherently distinctive.

So, it is submitted that there is no conceptual or comprehensive definition of reputation or likelihood of confusion: something that finds some support in the literature⁸¹³.

We will now refer to the third decision – *Lloyd Schuhfabrik Meyer v Klijzen Handel BV*⁸¹⁴, (hereafter termed the *Lloyd* decision), for our further exploration of the definition of ‘likelihood of confusion’, and for consideration as to how this applies to marks of repute. One notable feature of *Lloyd* is that further guidance as to the nature of ‘average consumers’⁸¹⁵ is provided. Again, there is a significant body of secondary

⁸⁰⁹ See Maniatis, S, *supra* note 37 at 99.

⁸¹⁰ *Sergio Rossi* *supra* note 804 at 352.

⁸¹¹ *Claude Ruiz-Picasso v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (Case C-361/04 P) [2006] ETMR 29.

⁸¹² See Maniatis, S, *supra* note 37 at 350.

⁸¹³ See for example, Jaffey, P ‘Likelihood of Association’ (2002) 24 *EIPR* 3-8.

⁸¹⁴ *Lloyd v Klijzen*, *supra* note 750.

⁸¹⁵ *Ibid* at 27 as follows: “...the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect....however, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer’s level of attention is likely to vary according to the category of good or services in question.” See, Davis, J, *supra* note 362.

literature in relation to this decision⁸¹⁶, and this decision has also been considered in subsequent cases⁸¹⁷.

A summary of the relevant aspects of the *Lloyd* decision can be set out as follows:

- (i) The level of attention of the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, varies according to the category of the goods and services in question⁸¹⁸;
- (ii) However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind⁸¹⁹;

⁸¹⁶ For example, one scholar commented that the Court took a very practical approach to trade marks and trade mark infringement. See Gielen, C, 'European Community: Trade Marks – Assessing Distinctiveness and Likelihood of Confusion' (1999) 21 *EIPR* N183. Also see, Davis, J, *supra* note 362; Janssens, M, 'The "Toblerone" Chocolate Bar Case in Belgium (Case Comment)' (2004) 29 *EIPR* 554-559; Wurtenberger, G, *supra* note 474.

⁸¹⁷ For example, *supra* note 786, *Lodestar Anstalt v Austin Nichols & Co Inc Irish Patents Office*, [2008] ETMR 54; *O2 Holdings Ltd v Hutchison 3G UK Ltd* (Case C-533/06) [2008] ETMR 55; *Marca Mode v Adidas*, *supra* note 750; *Hoya Kabushiki Kaisha v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-9/05) [2008] ETMR 29; *Castellani SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (T-149/06) [2008] ETMR 22; *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2008] FSR 8; *La Mer Technology Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-418/03) [2008] ETMR 9; *Koipe Corporacion SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (T-363/04) [2008] ETMR 8; *El Corte Ingles* *supra* note 667; *Alcon Inc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-412/05 P) [2007] ETMR 68; *House of Donuts International v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (T-333/04) [2007] ETMR 53; *Il Ponte Finanziaria SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-234/06) [2008] ETMR 13; *SIGLA SA* *supra* note 697; *Uluslararası Saat Ticaret ve dis Ticaret AS v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-171/06); [2007] ETMR 38; *Principe SpA v Principles Retail Ltd Irish Patents Office*, [2007] ETMR 56; *Quelle AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* [2007] ETMR 62; *Market Tools Inc v Optimus Telecommunicacoes SA* (R 253/2006-2) [2007] ETMR 74; *Giersch v Google Inc* (B 795 569) *Office for Harmonization in the Internal Market* (Opposition Division); [2007] ETMR 41; *Sunrider Corp (t/a Sunrider International) v Vitasoy International Holdings Ltd* [2007] EWHC 37 (Ch); *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Kaul GmbH* (Case C-29/05) [2007] ETMR 37; *Mostaza Claro v Centro Movil Milenium SL* (Case C-168/05) [2007] CMLR 22; the *Intel* case *supra* note 651; *Adidas-Salomon AG v Nike Europe Holding BV* *Arrondissementsrechtbank (Den Haag)* [2007] ETMR 12; *Madaus AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-202/04) [2006] ETMR 76; *Muhlens GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-206/04 P) [2006] ETMR 57; *Alecansan SL v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case T-202/03) [2006] ETMR 93; *Ruiz-Picasso v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-361/04 P) [2006] ETMR 29.

⁸¹⁸ *Lloyd v Klijzen*, *supra* note 750 at 26.

⁸¹⁹ *Ibid.*

- (iii) When assessing the degree of visual, phonetic and conceptual similarity it can be appropriate to evaluate the importance attached to each by reference to the category of goods and the way they are marketed⁸²⁰;
- (iv) It is possible that mere aural similarity could lead to likelihood of confusion⁸²¹;
- (v) In determining the distinctive character of a mark and accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods and services for which it has been registered as coming from a particular undertaking⁸²²;
- (vi) In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods and services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations⁸²³, and;
- (vii) It is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has a strong distinctive character⁸²⁴.

⁸²⁰ *Ibid* at 27.

⁸²¹ *Ibid* at 28.

⁸²² *Ibid* at 22.

⁸²³ *Ibid* at 23.

⁸²⁴ See the CTM Guidelines Part 2 Chapter 2A at 4-5.

*Marca Mode CV v Adidas AG and Adidas Benelux BV*⁸²⁵ (hereafter *Marca Mode v Adidas*) is the fourth decision⁸²⁶ to be considered here, with some assistance from the Guidelines⁸²⁷.

A summary of the relevant points in this case is as follows⁸²⁸: ‘likelihood of confusion’ must be positively proved; even where there is identity of goods or services, a high reputation and a possibility of association, confusion cannot be presumed⁸²⁹. It is noted that a likelihood of association in no way implies a presumption of likelihood of confusion⁸³⁰. More relevantly it is noted that: (i) where a trade mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public; (ii) a third party, without the consent of the proprietor of the mark, uses, in the course of trade in goods or services which are identical with, or similar to, those for which the trade mark is registered, a sign which

⁸²⁵ *Marca Mode v Adidas*, *supra* note 751.

⁸²⁶ Similar to the previous three cases, a significant amount of legal literature regarding this case seems to be found. Some of articles are: Maniatis, S, M, and Gredley, E, ‘One Door Closes; Another One Opens? The opinion of the Advocate General in *Marca Mode v Adidas*’ (2000) 11 *Ent. LR.* 127-130 (he agreed on the General advocate’s view and he suggested a clear delineation between domain of trade mark and unfair competition laws); Carboni, A, ‘Two Stripes and You’re Out! Added Protection for Trade Marks with a Reputation’ (2004) 26 *EIPR* 229-233 (she commented that this case took a narrower view emphasising a proof of link between two marks, she speculates that all the evidence being applied to Art 5(1) is also required in applying for protection under Art 5(2)); Norman, H, ‘Davidoff v Gofkid: Dealing with the Logical Lapse or Creating European Disharmony?’ (2003) 3 *IPQ* 342-354 (she criticised a different legal treatment by the different member of states, and urged more harmonised approach to the trade mark protection); Casparie-Kerdel ‘Dilution Disguised: Has the Concept of Trade Mark Dilution Made its Way into the Laws of Europe?’ (2001) 23 *EIPR* 185-195 (she argued that Dilution is not simply a broadening of the protection originally given to trade marks. It is an entirely separate concept, with its own conditions and restrictions), Turner-Kerr, P, ‘Confusion or Association under the European Trade Mark Directive’ (2001) 23 *EIPR* 49-51 (he identified some uncertainty within *Marca* in relation to the exact scope of the protection afforded by Article 5 (2) of the Directive, until such time as the Court is called on specifically to address this point).

⁸²⁷ See the CTM Guidelines Part 2 Chapter 2A at 4-5.

⁸²⁸ *Ibid.* The fact of the cases are presented in overview: Adidas, the registered proprietor of the familiar “three stripes” mark, had, in preliminary proceedings, obtained an injunction against Marca Mode which prevented it from using on its sportswear collection a device of two parallel stripes running across the length of the relevant garments; the two lines were either black on a white background, or white on a black background. Marca Mode was also ordered to stop marketing T-shirts in white or orange with three parallel black stripes. Each stripe had narrow white borders, running across the length of the front of the garment and was broken by a medallion which bore the picture of a cat and the word “TIM”. Marca Mode appealed, without success, to the Court of Appeal and from there to the Supreme Court, alleging that the Court of Appeal had applied the infringement provisions incorrectly, requiring a mere likelihood of association rather than likelihood of confusion. From the facts given in the Opinion it is possible that this was an example of unfair competition masquerading as a trade mark infringement case. See Maniatis, S, M, and Gredley, E, *supra* note 822 at 127.

⁸²⁹ *Marca Mode v Adidas*, *supra* note 751 at 41.

⁸³⁰ *Ibid* at 42.

so closely corresponds to the mark as to give the possibility of its being associated with that mark, and; (iii) the exclusive right enjoyed by the proprietor entitles him to prevent the use of the sign by that third party if the distinctive character of the mark is such that the *possibility of such association giving rise to confusion cannot be ruled out*⁸³¹.

According to this decision, it can be said that an existence of ‘likelihood of confusion’ must be proven and cannot be assumed either from mere association, implicit distinctiveness or repute⁸³². This appears to be a slightly narrower interpretation of ‘likelihood of confusion’ than seen previously⁸³³, which is interesting as some of the wording in the relevant parts of *Marca Mode* (see (i) and (ii) in the paragraph above) seem close to what one would use in a discussion of confusion in the context of a mark of repute. Is it the case that *only* marks of repute must provide evidence of confusion (this would seem rather counter-intuitive)? Or is this the same for ‘ordinary’ trade marks as well? The CTM Guidelines at 5-6 appear to provide the answer here: all trade marks (this must include ‘trade marks of repute’) must provide evidence of confusion.

Thus, at this stage, this author believes that a composite of the various guidelines provided in these cases to establish confusion can be collated and submits that it is the following: ‘likelihood of confusion’ can include likelihood of (business⁸³⁴) association⁸³⁵; likelihood of confusion cannot be presumed, and; confusion has to be positively found⁸³⁶. Likelihood of confusion shall be assessed globally⁸³⁷, taking into all the relevant factors.

Three dominant factors of the global appreciation are⁸³⁸:

⁸³¹ *Ibid* at 42.

⁸³² *supra* note 822.

⁸³³ Indeed, here the Advocate General noted in his Opinion that a broader interpretation of ‘likelihood of confusion’ would be detrimental as it might hinder the internal market, reducing the free movement of goods. It was also noted that this would go against the jurisprudence of national courts and would be contrary to the application of the CTMR (this was a decision based on the Directive).

⁸³⁴ *Canon v Metro*, *supra* note 742 at 29-30.

⁸³⁵ *Sabel v Puma*, *supra* note 736 at 26.

⁸³⁶ *Marca Mode v Adidas*, *supra* note 751 at 41.

⁸³⁷ *Sabel v Puma*, *supra* note 736 at 22.

⁸³⁸ *Ibid*.

- (i) the recognition of the trade mark on the market,
- (ii) the association which can be made with the used or registered sign, and;
- (iii) the degree of visual, phonetic⁸³⁹ (and or aural⁸⁴⁰) and conceptual (which might occur by images with analogous to semantic content if the mark is distinctive⁸⁴¹) similarity between the trade mark and the sign and between the goods or services identified⁸⁴² focusing on distinctive and dominant component⁸⁴³.

Point (iii) the degree of similarity of the marks, needs to be assessed by overall impression of the marks from the average consumers⁸⁴⁴ – reasonably well-informed and reasonably observant (the average consumer perceives a mark as a whole, but does not proceed to analyse its various details⁸⁴⁵) and circumspect⁸⁴⁶ – viewpoint. The following range of non-exclusive factors may be relevant in assessing similarity variously:

- a. The nature of the goods and services;
- b. The intended purpose;
- c. Method of use, and;
- d. Competitive relationship⁸⁴⁷.

Returning to Point (i), the more distinctive the earlier mark, the greater will be the likelihood of confusion⁸⁴⁸, and mark of repute should enjoy broader protection than mark of less repute⁸⁴⁹. Overall assessments of ‘distinctive character’ shall be assessed by the greater or lesser capacity of the mark to identify the goods or services⁸⁵⁰.

⁸³⁹ *Canon v Metro*, *supra* note 742.

⁸⁴⁰ *Sabel v Puma*, *supra* note 736 at 23.

⁸⁴¹ *Ibid.*

⁸⁴² *Ibid* at 22.

⁸⁴³ *Ibid.*

⁸⁴⁴ *Ibid* at 23, and *Lloyd v Klissen*, *supra* note 750 at 26.

⁸⁴⁵ *Sabel v Puma*, *supra* note 736.

⁸⁴⁶ *Lloyd v Klissen*, *supra* note 750 at 26.

⁸⁴⁷ An exemplar of the competitive relationship may well be illustrated: that relationship between ‘COCA-COLA’ and ‘PEPSI-COLA’.

⁸⁴⁸ *Sabel v Puma*, *supra* note 736 at 24.

⁸⁴⁹ *Canon v Metro*, *supra* note 742 at 18.

⁸⁵⁰ *Ibid* at 22.

The following range of non-exclusive factors⁸⁵¹ may be relevant in assessing ‘distinctive character’ variously:

- a. Inherent characteristic of the mark (if the mark contains any descriptive elements);
- b. The market share;
- c. To what extent the mark is known ;
- d. To what geographical extent the mark is known;
- e. To what extent the mark is in use;
- f. The amount invested in promoting the mark, and;
- g. The proportion of the relevant section of the public identifies the goods and services.

Further to this, *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber and Franz Attenberger* (hereafter the *Windsurfing Chiemsee* case) is also relevant here with respect to distinctiveness in the EU jurisdiction. This was the first case, which had brought to the ECJ with discussion of the scope of Article 3(1)(c) – distinctiveness with relation to a geographical name. It is explained⁸⁵² that court stressed the public policy nature of the provisions⁸⁵³; it confines the scope of protection by ensuring descriptive signs might be freely used by all⁸⁵⁴.

The ECJ made it plain that:

“...Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications

⁸⁵¹ *Ibid* at 23.

⁸⁵² See Maniatis, S, *supra* note 834 at 105.

⁸⁵³ *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots- und Segelzubehör Walter Huber and Franz Attenberger* (Joined Cases C-108/97 and C-109/97) [1999] ETMR 585 at 26 and 27.

⁸⁵⁴ *Ibid*.

from being reserved to one undertaking alone because they have been registered as trade marks”⁸⁵⁵.

Therefore, it can be speculated that a sign is not distinctive if a sign is descriptive; so these two can be regarded as antonym.

Also assessment of acquired distinctiveness is importantly mentioned herein:

“...where a geographical name is very well known, it can acquire distinctive character under Article 3(3) of the Directive *only if there has been long-standing and intensive use of the mark* by the undertaking applying for registration...an undertaking applying for registration of the name in respect of goods in that category *must show that the use of the mark—both long-standing and intensive—is particularly well established*”⁸⁵⁶. [Emphasis added].

In addition, there is some guidance regarding criteria in assessing if a sign has an acquired distinctiveness as follows:

“the following may also be taken into account: the *market share* held by the mark; how *intensive, geographically widespread and long-standing use* of the mark has been; the *amount invested* by the undertaking in promoting the mark; the *proportion of the relevant class of persons* who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.”⁸⁵⁷

It should also be noted here that the German approach (a use of percentage to assess whether a mark is well-known) was rejected as an EU approach as a whole in *Lloyds*.

The ECJ held that

⁸⁵⁵ *Ibid* at 25.

⁸⁵⁶ *Windsurfing*, *supra* note 849 at 50 and 54.

⁸⁵⁷ *Ibid.*

“...it is not possible to state in general terms, for example by referring to given percentages relating to the degree of recognition attained by the mark within the relevant section of the public, when a mark has a strong distinctive character.”⁸⁵⁸

Instead,

“...In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.”⁸⁵⁹

Therefore, it can be said that courts must consider the criteria mentioned in *Windsurfing Chiemsee*⁸⁶⁰ and the impression that the mark makes on the average consumer⁸⁶¹. It might be submitted that the *Windsurfing Chiemsee* criteria, in order to assess if there is *acquired distinctiveness* attached to a sign seem to rely heavily on use of the mark, and geographical extent in use of the mark. At this point, this author identifies a similarity between the Japanese and EU trade mark regimes. The former has shown within the Act, a strong emphasis on use of *syohyo* (see Article 2 of the Japanese Trademark Act, and see Chapter 2 Section 2.3.3), and this author submitted that an assessment of whether a mark is well-known in Japan is subject to use in the geographical extent.

⁸⁵⁸ *Lloyd v Klijzen*, *supra* note 750 at 25.

⁸⁵⁹ *Lloyd v Klijzen*, *supra* note 750 at 24.

⁸⁶⁰ *Windsurfing* *supra* note 849 at 49, 50, 51 and 54.

⁸⁶¹ See Maniatis, S, *supra* note 384 at 106.

An approach taken by *Canon* (dismissal of referring to the given percentages as evidence of reputation), was also followed, for instance, *El Corte Ingles SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*⁸⁶²

“...There is, however, no requirement for that mark to be known by a given percentage of the relevant public or for its reputation to cover all the territory concerned, so long as that reputation exists...”⁸⁶³.

Although the no requirement to provide a given percentage as evidence of reputation, ECJ and EU trade mark jurisprudence appear to take a strict view to submit evidences to show whether a mark is trade mark of repute. It seems, in the view of this author, that not relying on a given percentage does provide a great amount of both flexibility and discretion to the court and trade mark examiners. This might well, though, operate less consistently and less clearly. Therefore, it seems correct to say that ‘trade mark of repute’ is not conceptually defined, but assessed on a case-by-case basis.

It is argued by this author that, aside from these (factual and non-exclusive) guidelines, there is no explicit guidance as to the legal principle of ‘confusion’. As set out in the paragraph above, we do have a range of fact-based non-exclusive guidelines for establishing whether confusion is present, but there is not a clear and comprehensive legal definition of confusion, and there is certainly no explicit guidance (or definitions) pertaining to confusion in the context of trade marks of repute.

It has already been made clear, above, that detailed consideration and conceptualisation of confusion is beyond the scope of this thesis. In a future research project, however, this author intends to investigate this lack and intends to consider whether ‘likelihood of confusion’ might be conceptualised as ‘confusion of trade origin’, including ‘likelihood of association’⁸⁶⁴. Further discussion of this is beyond the scope of this thesis.

⁸⁶² *El Corte Ingles* *supra* note 700 at 107.

⁸⁶³ *Ibid.*

⁸⁶⁴ Likelihood of association can arise where: (i) the public confuses the two marks (so-called direct confusion); (ii) the public makes a connection between the marks and confuses them (so-called indirect confusion or association); and (iii) the public merely associates the two marks but is not confused (association in the narrower sense).

What is relevant to this thesis is the point that the ‘average consumer’ appears to be the key perspective via which confusion is to be judged, and there is some guidance as to this hypothetical person: the average consumer is said to be one who is reasonably well-informed and reasonably observant and circumspect⁸⁶⁵. The author submits that this is a reasonable standpoint and has no further critique of this.

The tranche of cases to be considered now are the most recent cases, namely *Intel Corporation Inc. v CPM United Kingdom Limited* (the *Intel* case)⁸⁶⁶ and *L’Oréal v Bellure* (the *Bellure* case⁸⁶⁷). Although both are decisions that relate to dilution provisions in the EU Trade Mark Directive rather than Articles 8(1)(b) and 9(1)(b) of the Regulation, there are still interesting points to be gleaned here relating to the overall role of confusion in relation to trade marks of repute in the CTM. Therefore, although slightly beyond the main scope of this thesis, some mention of *Intel* and *Bellure* should be made.

*Intel*⁸⁶⁸ appears to be generally accepted as authority for the proposition that protection of trade marks of repute against detriment should be drawn narrowly⁸⁶⁹. What is interesting about *Intel*-type reasoning is the insistence that proprietors of marks of repute must provide evidence of damage in the context of dilution: this, it is submitted, has some parallel with the narrower interpretation of likelihood of confusion in the context of Articles 8(1)(b) and 9(1)(b) (see above). Thus, it may be inferred that *Intel* provides additional support for the proposition that – in relation to Articles 8(1)(b) and 9(1)(b) - proprietors of marks of repute (as well as proprietors of ordinary trade marks) must provide evidence of confusion (as this is consistent with the *Intel* approach to dilution of marks of repute, where evidence of damage is

⁸⁶⁵ Davis, J, *supra* note 362, and Dunlop, T, *supra* note 362.

⁸⁶⁶ The *Intel* case, *supra* note 651 and for the relevant literatures.

⁸⁶⁷ The *Bellure* case, *supra* note 652.

⁸⁶⁸ Primarily concerning Article 4(4)(a) of the Directive, a brief summary of the fact of the case is as follows: Intel had a large number of trade marks including the word mark ‘Intel’. Its ‘Intel Inside’ advertising campaign had made it a household name. The respondent was CPM United Kingdom Ltd (hereafter CPM), a specialist in field marketing and telemarketing. It had a registered trade mark consisting of the word ‘Intelmark’ short for Integrated Telephone Marketing. The decision turned on whether the appellant’s earlier mark (Intel) had a large reputation, whether the earlier mark was unique, and whether the earlier mark would be brought to the mind of the average consumer when he or she encountered the later mark (Intelmark).

⁸⁶⁹ E.g. see *supra* note 651.

required). Further, it is submitted that *Intel* could be seen as an indication that the ECJ may be moving to a stricter position on protection of marks of repute *per se*.

However, *Bellure*⁸⁷⁰ can be seen as putting forward an alternative scenario. Here, not only can a slightly more generous general position on protection of marks of repute be inferred⁸⁷¹, but this decision specifically addresses the role of confusion in protecting marks of repute in the context of Article 5(2) of the Directive. It was specifically asked whether there could be unfair advantage under Article 5(2) without (i) confusion and (ii) detriment to the earlier mark. The answer was that unfair advantage does not require a likelihood of confusion or likelihood of detriment to the earlier mark. In particular, there will be unfair advantage where, “...by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation”⁸⁷². The significance of *Bellure* in the context of this thesis is, it is submitted, three-fold:

- Firstly, and specifically, it appears to clarify that confusion only has a role in the protection of marks of repute in relation to Articles 8(1)(b) and 9(1)(b) of the Regulation (and the equivalent Directive provisions). Confusion is not a factor in relation to dilution-type protection of trade marks of repute. It is submitted by the author that this is a correct interpretation of Article 5(2) of the Directive. Further, this finding does appear to validate the focus on Articles 8(1)(b) and 9(1)(b) of the Regulation in this Chapter – in a thesis relating to marks of repute and confusion in the CTM, it appears that the author was right to assume that detailed discussion of dilution-type protection was not relevant;

⁸⁷⁰ Primarily concerning Article 5(2) of the Directive, a brief summary of the fact of the case is as follows: L’Oréal SA, Lancoême parfums et beauté and Laboratoire Garnier are members of the L’Oréal group, which produces and markets luxury fragrances. They are proprietors of the well-known trade marks “Trésor”, “Miracle”, “Anaïs-Anaïs” and “Noa”. In the United Kingdom, Malaika and Starion market imitations of those fragrances, which are produced by Bellure. The bottles and packaging used to market those imitations are generally similar in appearance to those used by L’Oréal, which are protected by word and figurative trade marks. Malaika and Starion also use comparison lists, which are provided to retailers and which indicate the word mark of the luxury fragrance of which the perfume being marketed is an imitation. L’Oréal brought an action against Bellure, Malaika and Starion, alleging infringement of their trade mark rights.

⁸⁷¹ See pages 179-180.

⁸⁷² The *Bellure*, *supra* note 652 at 50.

- Secondly, and more generally, although *Bellure* concerned different provisions to *Intel* (and could be distinguished on this basis) it does seem to be based on a more generous position on protection of marks of repute *per se*, and it is submitted that if this is representative of a new position on marks of repute, that this may affect future legal developments in this area (see Chapter 7), and;
- Thirdly (included for reference as it is not as germane to this thesis) *Bellure* makes it clear that, in the context of dilution, unfair advantage does not require a likelihood of detriment to the earlier mark (i.e. that unfair advantage and detriment are alternatives): this, again, has some significance for this thesis as this is a more generous (and in the view of this author, more accurate) interpretation of Article 5(2) of the Directive and, again, is indicative of the more generous position on marks of repute postulated in the bullet point above.

The author is left in a difficult position and can only conclude that ‘confusion’ in the context of trade marks of repute is rather muddled. Nevertheless, it is clear from the discussion above that there is some agreement as to how to utilise non-exclusive (factual) criteria in determining whether an ordinary trade mark has been subject to confusing identity or similarity under Articles 8(1)(b) and 9(1)(b) of the Regulation. The position for trade marks of repute here is slightly less certain: the same criteria as for ordinary trade marks would appear to be applicable, but on the facts of any such dispute one would expect that confusion as to trade mark would be rather easier to evidence (due to the repute of the earlier mark). It does not appear that trade marks of repute enjoy any advantage as to establishing confusing similarity or identity as to goods and services. Further, there is no clear and comprehensive definition as to ‘confusion’. Lastly, the role of confusion in protecting marks of repute does not extend to the dilution-type provisions (critical analysis of these provisions being, of course, beyond the scope of this thesis).

In addition to the uncertainty as to the lack of a definition of confusion and the extent to which this notion applies to marks of repute, the *Intel* and *Bellure* decisions present conflicting policy positions on the protection of marks of repute in general. What some commentators have argued is that the protection accorded to trade marks (of repute) is based on reputation, but that this depends on the *existence* of reputation but

not of its magnitude of scale⁸⁷³. However, it is tentatively submitted that we have seen in this Chapter that the protection of trade marks of repute against confusion only has a weak relationship with reputation.

4.4.4 Summary

In this Chapter, reference to the CTM Guidelines⁸⁷⁴, the CTMR and relevant jurisprudence have been made in an attempt both to define ‘trade mark of repute’ (Section 4.3) and ‘likelihood of confusion’ (Sections 4.4.1-4.4.3 above). It has been found that there is no clear and comprehensive definition of either of these terms. In particular, applying the Definition Model to ‘trade mark of repute’ (Section 4.3 above) it has been concluded that there is limited, implicit guidance as to *form (type and context)* of ‘trade mark of repute’ in the Regulation, but that no further guidance is provided by the cases. The cases do contribute a range of fact-based criteria to assess ‘trade mark of repute’ status, and from this, it has been inferred that *concept* of ‘trade mark of repute’ includes notions of distinctiveness, and (unhelpfully) value.

The author has criticised the lack of clarity that results from the absence of clear and comprehensive definitions of these terms. The result of this lack of clarity is that not only is ‘trade mark of repute’ bound to be subject to various interpretations due to the unspecified parameters of the fact-based assessments, but ‘likelihood of confusion’ has the same fate (albeit the perspective from which confusion is to be judged – the ‘average consumer’ – is, it is submitted, a reasonable one). Combined with the fact that there is no specific legal treatment of the protection of marks of repute against confusion, this must mean that the scope of protection of marks of repute against confusion in the CTM system is inherently unclear.

When considering the international context of well-known trade marks, in Chapter 3, it was noted that a loose definition of ‘well-known trade mark’ could pose advantages, with the advantage of flexibility compensating for uncertainty. On the basis of evidence considered, the author cannot come to a definitive, evidenced statement that the lack of clarity on what constitutes a mark of repute (and, also, the lack of clarity

⁸⁷³ Phillips, J, *supra* note 37 at 395.

⁸⁷⁴ The CTM Guidelines Part 2 Chapter 2A at 4-5.

on confusion) in the CTM system is disadvantageous. However, this author's own view is that some more clarity here would be helpful to proprietors of trade marks of repute in cases where the mark of repute faces an identical or similar mark for identical or similar goods and services, and, if on this basis only, would argue for the introduction of greater clarity.

4.5 Conclusion

The main purpose of this chapter has been to explore the EU framework of protecting trade marks of repute against confusion and to assess the certainty of the same.

The lack of clarity found, both in this Chapter and in Chapter 3, on the definition and identification of trade marks of repute/well-known trade marks, justifies (in the view of this author) the time taken in earlier Chapters to address the foundation questions of 'what constitutes a well-known trade mark?' by reference to the definition of 'trade mark' in Chapter 2. The assumption in Chapter 1⁸⁷⁵ that 'well-known trade mark' is the purest form of 'trade mark' has, it is submitted, been helpful in exploring both international and regional definitions of well-known trade mark/trade mark of repute.

In this chapter, the interpretation of 'well-known trade mark' in the EU and, thus, the protection afforded to marks of repute against confusion was the focus. It has been highlighted that the term 'well-known' is not employed in the EU trade mark regime, with the term 'trade mark of repute' being preferred instead. Whether there is a real difference between these two terms and the significance of any such difference has not been fully considered: this is an issue that the author highlights for future research. Nevertheless, the author is (reasonably) comfortable that her assumption of equation between 'well-known trade mark' and 'trade mark of repute' is a fair one in the context of this thesis.

The exploration of the EU framework of protecting trade marks of repute against confusion and the assessment of the certainty of the same in this Chapter leads to the conclusion that the protection of marks of repute in the CTM system against

⁸⁷⁵ See Chapter 1, Section 1.4.

confusion is not certain. Thus, in relation to Chapter 4 at least, the hypothesis of this thesis is not made out. Not having clear and comprehensive definitions of repute and confusion in the CTM system may be causal factors of uncertainty (see Section 4.3.4), but, the key reasons for this uncertainty, it is submitted, are:

- (i) The absence of any specific legal treatment of the protection of marks of repute against confusion (see Sections 4.3 and 4.4);
- (ii) The emphasis on non-exclusive factors to determine when a mark is a mark of repute (see Section 4.3.3);
- (iii) The emphasis on non-exclusive factors to determine when (any) trade mark is subject to confusing identity or similarity (see Section 4.4.3), and;
- (iv) The context of a changing policy position on the protection of marks of repute (see Section 4.4.3).

As to whether this lack of certainty (however caused) is problematic – this is also not clear on the evidence presented (see Sections 4.3.4 and 4.4.4).

In the next Chapter, this author will undertake an examination of the well-known trade mark protection at the national level, considering the definition of ‘*syuchi-syohyo*’ (well-known trademarks) in Japanese law and the protection of the same against *kondo* (confusion). The author hopes that the reader will be interested to see how the concept of ‘well-known trade mark’ within the meaning of the Paris Convention⁸⁷⁶ has been imported to this non-English speaking national trade mark regime.

⁸⁷⁶ Article 6bis of the Paris Convention.

Chapter 5 ‘*Syuchi-Syohyo*’ and ‘*Kondo*’ in Japan

5.1 Introduction

In the previous chapter, Chapter 4, the definition of ‘trade mark of repute’, a concept analogous to ‘well-known trade mark’ in the CTMR⁸⁷⁷, was critically considered, and the efficacy of the protection of such marks against confusion⁸⁷⁸ was considered.

Fundamental developments and arguments raised in the chapters so far include: the presentation and use of the Definition Model, the lack of certainty and clarity as to what constitutes a well-known trade mark (and a trade mark of repute) and the suggestion that the central element of the definitions of both ‘trade mark’ and thus ‘well-known trade mark’ is that of distinctiveness (or *concept* in the Definition Model)⁸⁷⁹. Again, the main purpose of this thesis is to critically explore the most appropriate and effective means of protecting well-known trade marks in the EU and Japanese trade mark laws against confusion/*kondo*, and to critically compare the differences therein.

In Chapter 4, the following points were critically examined: (i) the absence of a clear and comprehensive definition of ‘trade mark of repute’ within the CTMR⁸⁸⁰, and; (ii) the lack of clarity as to the protection of such marks against confusion. Accordingly, the following may be submitted: that point (i) may be a potential result of the lack of clarity in the definition in the international regime of ‘well-known trade mark’.

Furthermore, this author has already referred to the fact that one could hold divergent views as to whether ‘well-known trade mark’ and ‘trade mark of repute’ are different concepts. Although, in the view of the author, this debate is not itself hugely significant, it must be conceded that the use of different terminology cannot be said to enhance the clarity of the extent or scope of well-known trade mark protection in the CTM. The consequence of all these points is, this author believes, that there *must* be

⁸⁷⁷ The relevant Articles here are: Articles 8(5) and 9(1)(c) of the CTMR.

⁸⁷⁸ The relevant Articles here are: Articles 8(1)(b) and 9(1)(b) of the CTMR.

⁸⁷⁹ See Chapter 3, Section 3.2.5

⁸⁸⁰ Articles 8(5) and 9(1)(c) of the CTMR.

a strong likelihood that the scope of well-known trade mark protection in the CTM is insufficient, as well as (as has been submitted) being uncertain.

Although an EU-Japanese comparison will not take place until the next chapter, it is useful to bear in mind relevant EU law when turning to analyse to the relevant Japanese law. Said analysis of Japanese law in this Chapter will involve:

- Critical consideration of the definition of ‘*syuchi-syohyo*’⁸⁸¹ in the Japanese Trademark Act (Articles 4(1)(10) and (19)), and;
- Consideration as to the efficacy of the protection of ‘*syuchi-syohyo*’ against *kondo*, (Article 4(1)(15)) in the Japanese Trademark Act.

There are two additional points to be made at this stage, relating to Japanese materials and terminology, respectively. Firstly: there is clearly a dearth of both Japanese secondary trademark material in English translation *and* also of Japanese trademark jurisprudence *per se*⁸⁸². Although the paucity of Japanese trademark jurisprudence⁸⁸³ must be acknowledged⁸⁸⁴, as Japan is a Civil Law jurisdiction just using (trademark) statutory analysis (and analysis of other relevant laws) and employing the Definition Model is, in the view of this author, not only sufficient but apt for critical analysis of the Japanese system.

The second point is to remind the reader of the terminology employed in this thesis – a point previously noted in Chapter 1⁸⁸⁵. Here, the terminology employed is represented again, this time in tabular form, in Table 1 below, which shows a list of the transliterated Japanese trademark terms⁸⁸⁶ employed in this thesis and their English translation:

⁸⁸¹ *Supra* note 2.

⁸⁸² However, for the purpose of this thesis, access to Japanese secondary materials may not be as problematic as might be thought.

⁸⁸³ Here ‘trademark jurisprudence’ is used to refer to case law (which naturally does not have the significance in Japan that it would in a common law jurisdiction) and academic commentaries and other such secondary resources. Two of which are: the Japanese legal journal called *Jurist* and the journal called *Comparative legal study* (Doshisha University Press). This author, as a native Japanese speaker, has outlined and critiqued the (few) key Japanese language secondary legal resources in this Chapter.

⁸⁸⁴ See for example, Doi, K, *Chiteki Zaisan Ho Nyumon* (Tokyo, Tyuokeizai-sha, 2005).

⁸⁸⁵ See Chapter 1, Section 1.4 and see List of Japanese Terms at x.

⁸⁸⁶ *Ibid.*

Table 1: Use of Japanese Trade Mark Terms

Japanese Transliteration	Translation of Japanese Term
<i>Syohyo</i>	Trademark ⁸⁸⁷
<i>Syuchi-syohyo</i>	Well-known trademark
<i>Kondo</i>	Confusion
<i>Kondo no orore</i>	Likelihood of confusion

Before moving on to the definition of ‘*syuchi-syohyo*’ and the protection of such marks against *kondo* in Japan, it is necessary to first place this debate into context. Although this Chapter cannot purport to offer an in-depth analysis of the historical development of Japanese Trademark Act and the current registration system, the brief overview provided in Section 5.2 below does provide necessary background.

5.2 Background

As was briefly described in Chapter 2⁸⁸⁸, under the current legal system in Japan, *syohyo* and *syuschi-syohyo* can be protected both in the Trademark Act⁸⁸⁹ and the Unfair Competition Prevention Act [不正競争防止法: *Fusei Kyoso Boshi Ho*]⁸⁹⁰.

Protectable subject matters under these Acts are different⁸⁹¹, although these laws share the same policy and principle that they ‘establish economic order through the maintenance, etc, of the business reputation of persons using trademarks and

⁸⁸⁷ Please remember that when discussing marks in a non-Japanese context that the term ‘trade mark’ (two words) is preferred in this thesis.

⁸⁸⁸ See Chapter 2, Section 2.3.3.

⁸⁸⁹ Act No.127 of 1959 amended by Act No.16 of 2008.

⁸⁹⁰ Act No.14 of 1934 amended by Act No.30 of 2009. *Fusei Kyoso Boshi Ho* is officially translated as the Unfair Competition Prevention Act, and thus this official term will be employed throughout this thesis. However, as the inadequacy of the English translation of these laws undertaken by the Cabinet has been criticised in *supra* note 286, this author submits that the correct English translation should be “the Unfair Competition Law” and thus trademark law. Apart from this matter, it should also be noted that this Act was firstly introduced in 1943; however, in 1993, the fullest amendment was undertaken. This is the reason why the Unfair Competition Prevention Act is sometimes referred as Law No. 47 of 1993. In this thesis, however, the original version of the serial number, Law No.14 of 1934 is used so as to maintain the historical importance of the law itself.

⁸⁹¹ See the protectable subject matters in Article 2 of the Japanese Trademark Act, and Article 2 of the Unfair Competition Prevention Act.

contribute to the interests of consumers,⁸⁹² Why, in a thesis limited to the protection that *trade mark law* afforded to well-known trade marks against confusion, should a national unfair competition regime be mentioned at all? The answer lies in the *sui generis* nature of the Japanese Trademark Act (see Section 5.2.3 below) and, in particular, the acceptance in Japan that a *syuchi-syohyo* is protected by a combination of the Trademark Act *and* the Unfair Competition Prevention Act⁸⁹³. In short, it would be, therefore, highly misleading to critically analyse the Japanese Trademark Act without making some reference to the associated unfair competition regime: as a consequence, the author makes limited reference to this national unfair competition regime⁸⁹⁴ for the purpose of completeness, but, it should be emphasised, that a detailed examination of cases is beyond the scope of this thesis, the main focus remains the interpretation of the Trademark Act.

5.2.1 Historical Developments

The Japanese Trademark Act and registration systems have a long-established history in comparison with the relatively new CTM system⁸⁹⁵. The first Japanese Trademark Act, which consisted of twenty four main Articles and additional Rules (known as 商標条例 – the *Syohyo jyorei*, or the Trademark Regulation), was established in 1884⁸⁹⁶.

⁸⁹² Article 1 of the Japanese Trademark Act, and Article 1 of the Japanese Unfair Competition Prevention Act.

⁸⁹³ Ono, S, *supra* note 370.

⁸⁹⁴ In Chapter 6 the relative merits and imbalance of comparing the CTMR (with no reference to unfair competition) with Japanese Trademark Act (plus some reference to Unfair Competition Prevention Act) will briefly be addressed.

⁸⁹⁵ See Chapter 4, Section 4.4.2. This author submits that an examination of the Japanese trademark system containing the long established history and the newly established CTM system makes an interesting comparative study.

⁸⁹⁶ The Trademark Act of 1884 is often described as being simplistic (e.g. – Doi, K, *supra* note 880 at 45-46.), however it is accepted (e.g. – see Ono, S, *supra* note 370 at 28-29) that the 1884 Law is known that it contained all the fundamental elements that had helped shaping the modern Japanese Trademark Act including: the first-to-file system, first use, one trademark – one application and publication, an effective period (15 years) of registration, an application for the renewal of registered trademarks, and the classification of goods by type. The Trademark Act of 1884 required the applicant to submit an application to the Ministry for Agriculture and Commerce through a local agency; however, after an 1888 Amendment, the applicant was allowed to send the application directly to the Minister of Agriculture and Commerce.

The first trademark registration system and further Trademark Act were set out in the *Meiji* era (1868-1912)⁸⁹⁷. Since then, the Japanese Trademark Act has been revised and amended on a near-annual basis so as to reflect social and economic changes⁸⁹⁸. However, it has been noted⁸⁹⁹ that the major revisions have tended to occur when Japan has ratified various international treaties⁹⁰⁰ such as the Paris Convention⁹⁰¹, GATT TRIPS, the Nice Agreement⁹⁰², the TLT⁹⁰³, and the Madrid Protocol⁹⁰⁴, and also upon accession to GATT TRIPS⁹⁰⁵.

Although the fundamentals of a modern trademark system were established in the 1889⁹⁰⁶, the most significant period of evolution in the Act probably was the period following accession to the Paris Convention⁹⁰⁷ in 1889. Aside from this, of the near-annual this English need to be checked revisions to the Trademark Act, it is generally accepted⁹⁰⁸ that the most significant such revisions have been those in 1909⁹⁰⁹, 1921⁹¹⁰, 1959⁹¹¹, 1975⁹¹², 1991⁹¹³, 1994⁹¹⁴, 1996⁹¹⁵, 1998⁹¹⁶, 1999⁹¹⁷, 2002⁹¹⁸, 2005⁹¹⁹, and most recently in 2008⁹²⁰.

⁸⁹⁷ The Trademark Ordinance was first enacted in 7 June 1884 and implemented in 1 October 1884. This is one year earlier than the establishment of the Japanese Patent Law. See, Ono, S, *supra* note 370 at 29-30, and JPO ‘History of Industrial Property Rights’. The full text of this note is to be found at http://www.jpo.go.jp/seido_e/index.htm. (Last accessed on 12 January 2010). During the *Edo* era (1603-1868), it is accepted that the *Edo bakudu* (the *Edo* Government) announced a Law called ‘新規法度 (*Shinki hatto*: a new Law for any new inventions’ (unofficial translation). Therefore, it might be suspected that Trademark Act was established before the patent law. See Toyokaki, M, ‘Takahashi korekiyo to syohyo jyorei’ (1973) 8 *Gakisyuin University Law Journal* 187-239 at 190.

⁸⁹⁸ The latest amendment occurred in April 2008, and came into force in June 2008.

⁸⁹⁹ See Inoue, Y, ‘Syohyo ho saisei to kongo nokadai’ 23 *IPR Forum* 20; Terushima, M, ‘Syohyo to brand – konogoro no jyokyo’ (2004) 57 *Patent* 72-75.

⁹⁰⁰ Japan has not ratified the Singapore Treaty.

⁹⁰¹ Japan has been a signatory nation of the Paris Convention since 15 July 1899.

⁹⁰² Japan ratified the Nice Agreement in 1990, and it came into force 1 April 1992.

⁹⁰³ Japan submitted a ratification instrument to the office in 1 January 1996, and it came into force in 1 April 1997.

⁹⁰⁴ Japan signified the Madrid Protocol in 14 April 1891.

⁹⁰⁵ Japan became a signatory member of GATT TRIPS in 15 April 1994 in Marrakesh, Morocco.

⁹⁰⁶ The protection for *syuchi-syohyo*, which allowed providing a sufficient protection to *syuchi-syohyo* and a system for cancellation of trademarks in non-use were introduced in this amendment.

⁹⁰⁷ See Chapter 2, Section 2.3.1.1 for the Paris Convention. Articles, which are related to trade marks and well-known trade marks respectively, are Articles 6bis, 6ter, 6quineuies, 6sexies, 7bis, 8 and Article 6bis of the Paris Convention.

⁹⁰⁸ Ono, S, *supra* note 370 at 52.

⁹⁰⁹ Key elements of this amendment can be summarised: (i) introduced associated trademark system; (ii) allowed divisional transfer of a Trademark Act; (iii) added a provision calling for a trademark to be “distinctive” to be registered.

⁹¹⁰ Today, the Trademark Act of 1921 is still well-known as ‘the former law’ and compared with the present law. See Ono, S, *supra* note 370 at 6-7. The followings were introduced: (i) ‘application Publication System’; (ii) collective mark system; (iii) incorporation of a trial for the cancellation of a trademark application, and; (iv) a change in the definition of an infringement from an offence prosecutable on complaint to an offence prosecutable without complaint.

5.2.2 The Modern Japanese Trademark Act and Policy

It is submitted that it is important to be aware of the policy context of the modern trademark law regime in Japan, and there have been significant relevant policy initiatives in recent times. This author submits that the Japanese trademark regime has become highly policy-based, thus, analysis of the various amendments of the Acts may give some insight into past, present and future trademark policy. Certainly trademarks feature in the national IP policy (*chitekizaisan suishin keikaku*)⁹²¹, a policy

⁹¹¹ The following were introduced: (i) a term for protection a trademark right set at 10 years from the date of registration in Trademark Register; (ii) all forms of transfer being allowed except only for similar trademarks owner; (iii) abolition of a collective mark system; (iv) allowed a right for licensing to use a registered trademark, and; (v) an introduction of the defensive mark system.

⁹¹² The following were introduced: (i) a requirement of indicating “Business of Applicant” in an trademark application; (ii) adding a provision concerning an examination of the status of use at the time of a renewal of the term of a registered trademark, and; (iii) a placement of burden of proof in case of a trial for the cancellation of a registered trademark on its owner.

⁹¹³ The followings were introduced: (i) service marks system; (ii) adopted the International classification under the Nice Agreement.

⁹¹⁴ New provisions added and revisions made to comply with requirements under GATT TRIPS.

⁹¹⁵ The Amendment of 1996 consisted of many substantive changes as follows: (i) a multi-class application system was introduced to bring Japan into compliance with the TLT; (2) the requirement that an applicant enter his type of business in the application was removed; (iii) the ‘associated mark’ system was abolished, in an effort to tackle the problem of unused trademarks; (iv) a system which allowed objections to be raised after a trademark was registered was established. This change was implemented to respond to the demand for the time efficient grant of trademark rights; (v) the implementation of a standard lettering system; (vi) the new amendments forbade the filing of applications with fraudulent intent, in an effort to protect famous trademarks; (vii) the creation of the three-dimensional trademark system in Japan; (viii) a collective trademarks system was adopted; (viii) the system for explaining the designated goods was revised.

⁹¹⁶ The following were introduced: (i) review of the method of calculating the amount of indemnity for damages caused by infringements; and (ii) Issuance of trademark registration certificated and the defensive mark registration certificate.

⁹¹⁷ The following were introduced: (i) new establishment of the pecuniary right of a claim based on a trademark prior to the registration of its establishment; (ii) an implementation of the Madrid Protocol; (iii) new establishment of a prompt publication system for trademark registration applications; (iv) acceptance of the restrictions and corrections related to classification at the time of payment of the registration fees.

⁹¹⁸ In this amendment, the meaning of trademark in use was defined.

⁹¹⁹ Introduction of the protection of collective trademarks was concerned.

⁹²⁰ Act No.127 of 1959 amended by Act No.16 of 2008.

⁹²¹ The fundamental IP policy called ‘the Intellectual Property Strategic Plan (hereafter the Strategic Plan)’ set out annually by Intellectual Property Strategy Headquarters. In *kanji* scripts – 知的財産戦略計画 *chitekizaisan suishin keikaku*. Revising, reforming the relevant IP laws or introducing the new laws is based on this strategic plan; for example, the Strategic Plan 2009 emphasises promotion of the soft power industries. The full text of the ‘Strategic Plan 2009’ is to be found at <http://www.kantei.go.jp/singi/titeki2/090624/2009keikaku.pdf>. (Last accessed on 12 January 2010). The reform of the relevant IP laws including the Trademark Act is based on this strategic plan. For instance, combinations of a geographic indication and a generic name of products have become registered trademarks in Japan by following the Strategic Plan 2006. Furthermore, the continuous developments regarding any IP laws will be implemented in order for Japan to become a strongly pro-IP nation. Although

which was announced by a former Japanese Prime Minister⁹²². This policy and the resultant annual Strategic Plans⁹²³ have led to the establishment of national IP institutions including the Intellectual Property Strategy Headquarters (*chiteki zaisan senryaku honbu*)⁹²⁴ and the Strategic Council on Intellectual Property (hereafter the Council), the aim appearing to be to enhance the international competitiveness of Japanese industries and revitalise the national economy⁹²⁵. Further, an Intellectual Property High Court (*chiteki zaisan koto saiban syo*)⁹²⁶ has recently been established. Although this national IP policy emphasis has led to remarkable developments in other IP rights⁹²⁷, in the view of this author, the body of law relating to *syuchi-syohyo* protection has been relatively unaffected⁹²⁸ by these policy initiatives⁹²⁹.

Nevertheless, at the legislative level, it has been reported that amendment of both the

the JPO addressed the significance of protection of trademarks in the general contexts, the major legislative development in terms of *syuchi-syohyo* protection in Japan has currently remained silent. It can be suggested that attention for well-known trademarks in Japan is needed to be re-drawn as to maintain the sufficient protection to well-known trademarks.

⁹²² The former Japanese Minister, Koizumi, announced that he would set as one of Japan's national goals the strategic protection and usage of the results of research activities and creative endeavours as intellectual property so as to enhance the international competitiveness of Japanese industries, see '2002 Policy Statement by Prime Minister Koizumi'. He also proposed an international treaty related to prevention of counterfeiting products in the G8 summit in 2003.

⁹²³ *Supra* note 864. One of the main focuses of the strategic plan 'Strategic Plan 2009' is to provide and maintain the patent law to provide the appropriate protection to new innovative inventions.

⁹²⁴ In *kanji* script – 知的財産戦略本部: *chiteki zaisan senryaku honbu*. It was set up in March 2003 for the first time. See the overview of the Headquarters is to be found in English at http://www.ipr.go.jp/e_materials.html. (Last accessed on 12 January 2010).

⁹²⁵ The former Prime Minister, Koizumi announced 'Prime Minister Decision's; concerning the Strategic Council on Intellectual Property' in 2005. A full text of this announcement is no longer electronically available.

⁹²⁶ In *kanji* script – 知的財産高等裁判所: *chiteki zaisan koto saiban syo*. An Intellectual Property High Court was introduced in 2005 based on 'Law concerning to Establishment of Intellectual Property High Court (Law No.119 of 2004)'. Intellectual Property High Court (*Chiteki-zaisan-kōtō-saiban-sho*) in Tokyo is a branch of Tokyo High Court specialised in Intellectual Property litigations. Due to an establishment of Intellectual Property High Court, all cases against trial decision and civil appeals to patent, utility model, semiconductor, digital copyrights carry out under this court as the first trial. See more information; <http://www.ip.courts.go.jp/eng/index.html>. (Last accessed on 12 January 2010).

⁹²⁷ *Supra* note 864. For example, the main focus of the Strategic Plan 2007 was on consolidation of the legal protection on digital copyrights.

⁹²⁸ A new introduction of protection of a trademark, which combines geographical indication and generic term, has been granted as a registered trademark. There is a vast amount of literature concerning this improvement. See for example, Tamura, Y, 'chisai rikkokuka niokeru syohyo ho nokaisei to sono ritontekina goi – chiki dantai syohyo to kouri syohyo ho donyu no rinri tekibunseki' (2007) 1326 *Jurist* at 94. A disagreed argument, see Imamura, T, 'chiiki dandai syohyo seido to chiriteki hyoji no hogo – sonoyokisenu hogono kosaku –' (2006) 30 *Annual Industrial Property Law* 274-300 at 274. Kukida, M, 'chiiki brand nituite fusei kyoso boshi ho no syuchi hyoji to shtie hogo ga mitomerareta jisei – MIWA SOMEN jiken' (2005) 7 *Intellectual Property Law and Policy Journal* 201-217. With an introduction of protection of geographical indications, Article 2(1)(13) of the Unfair Competition Prevention Act is added in the last amendment in 2006.

⁹²⁹ *Supra* note 864. The author of this thesis speculates that the Strategic Plan seem highly likely to reflect and identify the most current IP related problems. The same view can be implicitly found in IP Annual Report 2007 at 132-147.

Trademark Act and the Unfair Competition Prevention Act is likely to continue on an almost annual basis so as to reflect changes in the economy and society⁹³⁰. So, it is entirely possible that amendments to the protection of *syuchi-syohyo* will be made in the future.

In terms of *syuchi-syohyo*, amendments strengthening protection for *syuchi-syohyo* occurred in 1996 and 1999. In 1996, Article 4(1)(19) (known as the protection for *syuchi-syohyo*) was introduced so as to reflect the protection provided by Article 4(3) of the EU Trade Mark Directive (and correspondingly, Article 8(5) of the CTMR)⁹³¹. It might be said that Article 4(1)(19) of the Japanese Trademark Act, and Articles 8(5) and 9(1)(c) of the CTMR may, as a consequence offer the same level of protection, and that ‘*syuchi-syohyo*’ can be equated with ‘trade mark of repute’. However, this author does not hold this view and, as seen in the rest of this Chapter, a more complex picture emerges on more detailed analysis of the Japanese regime.

As noted above, in 1999, few but important amendments were made in strengthening protection for *syushi-syohyo*. There were (in the view of this author) two important developments for *syuchi-syohyo* protection: (i) an amendment of the JPO Guidelines regarding Articles 4(1)(10), (11), (15), and (16), and (ii) the introduction of the principle that a *syohyo* application in which the applied-for mark is combined with a *syuchi-syohyo* shall be refused⁹³².

Having set out this basic historical context and introduction to policy, armed with this background knowledge, we can now move on to critically considering the protection afforded to *syuchi-syohyo* against *kondo* in Japan. The author will now set out the legislative context of *syuchi-syohyo* protection, before moving to critically consider the definition of *syuchi-syohyo*.

⁹³⁰ See Doi, K, ‘fuseikyoso boshi ho no kadai’ (2007) 1326 *Jurist* 106; and Gomi, A, ‘Chizaigakusetu no ugoki’ (2008) *IP Annual Report* 132-147.

⁹³¹ See Ono, S, *supra* note 370 at 448.

⁹³² See the JPO, ‘syuchi/chomei syohyo no hogo touni kansuru shinsa kijyun nokaisei nitsuie’ Amendment of the JPO Examination Guidelines of well-known and famous trade mark protection’.

5.2.3 The Japanese Trademark Act: a Different Paradigm?

It is not the purpose of this Chapter to undertake comparative analysis of the relevant provisions of the Trademark Act: this will occur in Chapter 6. Nonetheless, the author would like to note here that, as compared with the CTM system, Japan has a somewhat *sui generis* approach to trademark regulation. In particular, Japanese scholars agree that any *syuchi-syohyo* are best protected by a synthesis of various legal routes⁹³³, and this includes important routes outside of the Trademark Act: i.e., in addition to Articles 4(1)(10), (15), and (19) of the Trademark Act⁹³⁴, *syuchi-syohyo* also benefit from non-trademark mechanisms of protection. In the view of this author, the most important such alternate mechanism of protection is the Unfair Competition Prevention Act (*fusei kyoso boshi ho*)⁹³⁵, but there is also the defensive mark registration system (*bogo hyosyo toroku*)⁹³⁶, and the process of import suspension or border control (*mizugiwa kisei*)⁹³⁷. The scope of protection afforded by the Unfair Competition Prevention Act, *Bogo hyosyo toroku*, and the process of import suspension *vis-à-vis* *syuchi-syohyo* protection are, for completeness, briefly set out below. Although an in-depth analysis of these alternate routes noted above is beyond the scope of this thesis, it is important to have some awareness of the role of, in particular, the Unfair Competition Prevention Act. This is because, in practice, the Unfair Competition and Trademark Acts interplay, and the scope of the protectable subject matters in the former is broader than that of the latter⁹³⁸.

Therefore, the fact that *syuchi-syohyo* protection is more developed under the Unfair Competition Prevention Act is acknowledged by this author⁹³⁹. Interestingly, the

⁹³³ See for example, Miyazaki, M, ‘Cyomei-syohyo no hogo’ (2008) 31 *Japan Industrial Property Right Annual Report* 99-222.

⁹³⁴ Unregistered trademark protection can be applied to Article 4(1)(10), and the general confusion doctrine is dealt with Article 4(1)(15), and the well-known trademarks against unfair advantages are employed in Article 4(1)(19).

⁹³⁵ In Japanese *kanji* script – 不正競争防止法: *Fusei kyoso boshi ho*. This is officially translated as the Unfair Competition Prevention Act.

⁹³⁶ In Japanese script – 防護標章登録: *Bogo hyosyo toroku*. This is officially translated as the defensive mark registration system.

⁹³⁷ In the Japanese script – 水際規制: *mizugiwa kisei*. This is usually translated as ‘border control’.

⁹³⁸ This author would like to note that as the scope of the protectable subject matter in the Trademark Act has expanded; overlap between the Trademark Act and the Unfair Competition Prevention Act has developed.

⁹³⁹ The Japanese government does appear to recognise the importance of providing an appropriate protection for *syuchi-syohyo*. For example, in 1992, the Japanese government commissioned a study of

importance of this supplementary role for unfair competition in Japan can particularly be felt in practice, but is also accepted by most legal schools of thought in Japan⁹⁴⁰.

In support of these arguments, this author would like to point to Article 709 of the Japanese Civil Code (*Min-po*)⁹⁴¹ which essentially states that all unfair competition related infringements function as a safety net⁹⁴². In fact, not only is the scope of the protectable subject matters in the Unfair Competition Prevention Act broader than that of the Trademark Act, but the Unfair Competition Prevention Act appears to provide the more flexible protection too, and this (it is submitted) also holds true for *syuchi-syohyo*⁹⁴³. The Unfair Competition Prevention Act can be seen as providing an effective mechanism for the protection of *syuchi-syohyo*⁹⁴⁴. In the view of this author, the provisions in the Unfair Competition Prevention Act that appear particularly relevant to (registered and unregistered) *syuchi-syohyo* are: indications including personal names, trade names, trademarks (*syohyo*), trade symbols, appellations⁹⁴⁵, well-known unregistered trademarks⁹⁴⁶, and ‘dead-copies’ of get-

the need to have a special protection for well-known marks. It concluded as follows: “In the current information society, product or business appellations are being more broadly used via a variety of different media. These brand images are becoming well known. These independent brand images have specific customer appeal. As such, they have attained an independent value of their own. Through use of these famous appellations, for example even when there is no confusion, such a user can gain the customer appeal of this famous appellation even though he did nothing to achieve it. This is known as ‘free-riding’. As a result, consumers might become confused that this new comer is the same as the company that endeavoured to obtain high trust and repute. In this case, the good image of the first comer would be damaged. This is known as “dilution”. (In such a case in the past,) courts have simply presumed confusion even though the facts of the case made confusion impossibility. Judges have deemed such a conclusion to be appropriate; however, they have come to question the notion of presuming confusion. Therefore, frankly speaking, it is appropriate to create a new cause of action where confusion is not necessary in order to protect famous appellations. Please see JPO, ‘*Sangyo Kozo Shingikai Chiteki Zaisan Seisaku Bukai Hokokusho* (Report of the Intellectual Property Policy Committee of the Industrial Structure Council)’ (1992).

⁹⁴⁰ The academic legal theory of well-known trademark protection is to be explored in Section 5.4.4.

⁹⁴¹ In the Japanese *kanji* script – 民法: *Min-po*. This is officially translated as the Japanese Civil Code. Law No. 89 of 1896 amended by Law No. 78 of 2006. An official English translation of a full text of this is to be found at [http://www.japaneselawtranslation.go.jp/law/detail/?ft=2&re=01&dn=1&yo=&kn\[%\]=%E3%81%BF&x=8&y=24&ky=&page=5](http://www.japaneselawtranslation.go.jp/law/detail/?ft=2&re=01&dn=1&yo=&kn[%]=%E3%81%BF&x=8&y=24&ky=&page=5) (Part I-III) and [http://www.japaneselawtranslation.go.jp/law/detail/?ft=2&re=01&dn=1&yo=&kn\[%\]=%E3%81%BF&x=8&y=24&ky=&page=6](http://www.japaneselawtranslation.go.jp/law/detail/?ft=2&re=01&dn=1&yo=&kn[%]=%E3%81%BF&x=8&y=24&ky=&page=6) (Part IV-V). (Last accessed on 12 January 2010).

⁹⁴² Gomi, A, *supra* note 873 at 132-147.

⁹⁴³ Articles 2(1) and (2) of the Unfair Competition Prevention Act.

⁹⁴⁴ Article 2(1)(1) prohibits the unfair competition acts defined within the Unfair Competition Prevention Act, then the well-known trademark and the famous trademark are protected in accordance with the relevant provisions stipulated in the Unfair Competition Prevention Act. Non exhaustive lists of acts considered as unlawful acts against the fair and just competition are explicitly addressed in the Unfair Competition Prevention Act. Notes that so-called dilution related article can be found herein: in order to establish “dilution” under Article 2(1)(2), the plaintiff must establish the followings: (i) use of the plaintiff’s goods or other appellation by the defendant; (ii) the plaintiff’s appellation is famous, and; (iii) the defendant’s appellation is the same or similar to the plaintiff’s.

⁹⁴⁵ *Ibid*, Article 2(1).

ups⁹⁴⁷. As noted above, the defensive registration trademark system⁹⁴⁸ also provides an alternate mode of protection, but this only provides an extra layer of legal protection to *syuchi-syohyo* that are registered. Although the Trademark Act *per se* might not offer as broad a scope of protection to *syuchi-syohyo* as might be expected⁹⁴⁹, it is submitted that the Trademark Act is ultimately designated to protect the business reputation of *syuchi-syohyo* owners⁹⁵⁰ and the exclusive rights are obtained by the registration of *syuchi-syohyo*⁹⁵¹, and, this role is supplemented by the broader control and more flexible protection provided in the Unfair Competition Prevention Act⁹⁵².

The main points of the Japanese Unfair Competition Prevention Act can be summarised as follows:

⁹⁴⁶ *Ibid*, Article 2(2).

⁹⁴⁷ *Ibid*, Article 2(3).

⁹⁴⁸ See Article 64 of the Japanese Trademark Act, *infra* note 894. Theoretically, it is understood that the defensive mark registration system allows the owner of a registered trademark well recognised among consumers to indicate goods or services connected with the trademark owner's business to register a mark identical with the registered trademark with respect to goods or services not similar to the designated goods or designated services of the registered trademark, with respect to which the use of the trademark by other parties may cause confusion over the source of goods or services.

⁹⁴⁹ Tamura, Y, *supra* note 357 at 65.

⁹⁵⁰ For example, quoting a famous trademark in the comparative advertisement is not regarded as an infringement of the Trademark Act. However, those advertisements are highly unlikely to be seen in Japan due to moral and cultural pressures in the business relationship. This outcome is rather different from the *Bellure* case in the EU. *Supra* note 652.

⁹⁵¹ Article 64 of the Japanese Trademark Act in full are: "Article 64 (Requirements for defensive mark registration) (1) Where a registered trademark pertaining to goods is *well known among consumers* as that indicating the designated goods in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with goods other than the designated goods pertaining to the registered trademark or goods similar thereto or in connection with services other than those similar to the designated goods is likely to cause confusion between the said other person's goods or services and the designated goods pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the goods or services for which the likelihood of confusion exists: (2) Where a registered trademark pertaining to services is *well known among consumers* as that indicating the designated services in connection with the business of a holder of trademark right, the holder of the trademark right may, where the use by another person of the registered trademark in connection with services other than the designated services pertaining to the registered trademark or services similar thereto or in connection with goods other than those similar to the designated services is likely to cause confusion between the said other person's services or goods and the designated services pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the services or goods for which the likelihood of confusion exists." [Emphasis added].

⁹⁵² Although a detailed examination of the Japanese Unfair Competition Prevention Act is beyond the scope of this thesis, a brief overview of how 'syohyo' and 'syuchi-syohyo' are linked with the Unfair Competition Prevention Act and particularly comparative advertising with analogy to *Bellure* case in the EU.

- (i) the Act provides further clarification on terms such as ‘trademark(s)⁹⁵³’, ‘a mark⁹⁵⁴, and ‘configuration of goods⁹⁵⁵;
- (ii) misuse of domain names by unauthorised parties are recognised as a form of unfair competition act⁹⁵⁶;
- (iii) Article 2(1)(ii) is newly introduced in 1993, it is said that this Article protects goodwill attached to the well-known marks against dilution by blurring and tarnishment⁹⁵⁷ and also against free-riding on commercial magnitude and value of marks. Equally importantly, proof of likelihood of confusion is not required.

Now a few cases will be illustrated as exemplars of how *syuchi-syohyo* can afford protection. The Act differentiates well-known marks (*syuchi-syohyo*) and famous marks (*tyomei-syohyo*), and marks need to show higher recognition under Article 2(1)(ii) than that under Article 2(1)(i), however, under the latter, no proof of confusion is required. It can be argued that Article 2(1)(i) is similar to Article 4(1)(10) of the Trademark Act, and Article 2(1)(ii) is similar to Article 4(1)(19) of the Trademark Act.

Some cases are illustrated for further understanding how ‘*syuchi-syohyo*’ is linked with, and accorded protection in the Japanese Unfair Competition Prevention Act. It has been agreed among academics and jurisprudences that marks which are well-known under Article 2(1)(i) need to be well-known in a lesser geographical extent than that of Article 4(1)(10) of the Japanese Trademark Act. Note that it is heavily criticised that although both Articles 2(1)(i) and (ii) are established as to prevent dilution, in practice, Article 2(1)(ii) is highly unlikely to be used⁹⁵⁸.

Accordingly, *Snack CHANEL jiken*⁹⁵⁹ illustrates how Article 2(1)(i) has dealt with dilution issue. A fact of the case is briefly introduced here. A defendant X had used a

⁹⁵³ Article 2(2) of the Japanese Unfair Competition Prevention Act.

⁹⁵⁴ Article 2(3) of the Japanese Unfair Competition Prevention Act.

⁹⁵⁵ Article 2(4) the Japanese Unfair Competition Prevention Act.

⁹⁵⁶ Article 2(1)

⁹⁵⁷ See Tamura, Y, *fusei* at 89.

⁹⁵⁸ See the report.

⁹⁵⁹ *Snack CHANEL jiken*, Supreme Court, Heisei 7nen, (o) 637go.Hanji 1665go 160. A case note is available at Aizawa, H, ‘Kondo (2) – Snack CHANEL jiken’ (2007) 11 *Jurist* 148-149.

sign ‘Snack Chanel’ in relation with service in providing foods. X’s name was alleged to include a famous mark (*tyomei-syohyo*) ‘CHANEL’ in relation to women’s wear, perfumery, cosmetics, and women’s accessories (handbags, shoes, watches). A claimant, which is CHANEL group brought an action against such use alleging that use of such mark seems to have caused likelihood of business association between X and Y, asking for an injunction and damages.

The Supreme Court confirmed that confusion under Article 2(1)(i) does include a broad notion of confusion (*kondo*), that is to say, likelihood of association. It was then held that dilution is included in likelihood of association. This case was dealt under Articles 2(1)(i), not 2(1)(ii). This author argues that a case like this, should have been dealt within the domain of Article 2(1)(i), which does not require proof of confusion (*kondo*). Roles of both Article 2(1)(i) and (ii) has become less clear, therefore, it might cause further confusion in selecting which the Article needs to be applied.

Having said that, Article 2(1)(ii) was applied in the following case, in *Kure Aoyama Gakukin Cyugakko jiken*,⁹⁶⁰ ‘AOYAMA GAKUIN’ is alleged to be famous sign for both the university and the junior high school. It is argued that the use of very similar sign ‘Kure Aoyama Gakuin’ and ‘Kure Aoyama Gakuin Junior High School’ is likely to cause dilution of the name. The Court stated: the defendant ‘Aoyama Gakuin’ has used the name for more than 125 years and have done great amount of advertising and publicity in broadcasting, press (newspapers and magazines), and shown high level of care to develop and maintain their reputation. Therefore, use of a similar mark ‘Kure Aoyama Gakuin’ clearly causes likelihood of confusion *kondo no osore* conceptually, thus this use constitutes infringement under Article 2(1)(ii). It seems interesting to note that although Article 2(1)(ii) does not, by law, require proof of confusion, confusion was discussed therein. Therefore, the relation between famous mark and confusion does not seem unclear.

It is submitted by this author that this case should have been dealt with under Articles 2(1)(i), not (ii). A level of fame in *Chanel*⁹⁶¹ and *Kure Aoyama Gakuin*⁹⁶², shows a

⁹⁶⁰ *Kure Aoyama Gakukin jiken*, Tokyo District Court, Heisei 13nen (wa) 967go, Hanji 1815go, 148.

⁹⁶¹ *Snack CHANEL jiken*, *supra* note 955.

significant level of differences, and in the view of this author, application of either Articles 2(1)(i) or (ii) seems rather confusing, thus needs to be clearly explicit.

This issue was firstly brought in to the court in 1980 (*SWEET LOVER* jiken⁹⁶³) under the Old Unfair Competition Prevention Act. A defendant, a producer of a perfume called Sweet Lover, used a comparative advertising saying that a type of smell of Sweet Lover is rather similar to that of Miss Dior, Chanel No. 5 and Mitsuko. The main issue was case whether this use of famous names as being a part of the comparative advertising is amount to unfair competition act under old Article 1(1)(v), equivalent to the current Article 2(1)(xiii). The perfume ‘Sweet Lover’ in question was sold as if those smell was very similar to one of those (Miss Dior and Chanel No. 5), which was, in fact, not similar at all,

The trial judge dismissed the claim alleging that advertising that type of smell is similar... is not same as saying smell is similar, therefore it does not constitute unfair competition act. The claimant appealed to the High Court and added a claim that the defendant’s act also consist an unfair act under the old Article 1(1)(i), equivalent to the current Article 2(1)(i). The High Court dismissed the claim and held that the defendant had not used the claimant’s marks as if these are theirs, therefore it does not apply to Article 1(1)(i) of the Old Act.

Another recent case, related to use of a domain name, *J-PHONE* jiken⁹⁶⁴ also addresses the same issue under Article 2(1)(ii).

Here the claimant was a telecommunications company called ‘J-PHONE’, providing services in telecommunications, founded in February 1997. The domain name ‘j-phone.co.jp’ had been allocated to the Defendant, who runs a food company, by the Japan Network Information Centre (JPNIC), and the domain name had been in use since August 1997. The defendant had operated a website and used the terms ‘J-PHONE’, ‘ジェイフォン’, ‘J-フォン’, and advertised mobile phones and processing

⁹⁶² *Kure Aoyma Gakukin jiken*, *supra* note 956.

⁹⁶³ *SWEET LOVER* jiken, Tokyo District Court, Syowa 55nen, 1gatsu 28 Mutaisyu 12kan 1go 1.

⁹⁶⁴ *J-PHONE* jiken, Tokyo District Court, Heisei 13nen, 4gatsu, Hanketsu, Heisei 12nen (wa) 3545go, Hanji 1755go 43.

foods for sale. The claimant made a claim against such use under Article 2(1)(i) and (ii) alleging that a use of a famous name ‘J-PHONE’ is an infringement under those. An issue relating to use of a famous mark in comparative advertising seems rather controversial in Japan both under Articles 2(1)(ii) and 2(1)(xiv).

In theory, in order to apply for Article 2(1)(ii), a famous mark of A must be in use as a mark of B. Therefore, a famous mark owned by A is used as an indication of the A’s mark, this act does not constitute an infringement of A’ mark. Therefore, in principle, proprietors of any famous marks are unable to bring a claim when the use of the mark correctly indicates the proprietor of the famous mark. It is rather different from the approach taken by the *Bellure*.

Overall, the Japanese jurisprudence considers that third party’s use of famous marks as being a part of comparative advertising of the third party does not consist of a trademark infringement or; an act of unfair competition.

In this particular point, it may well be said that in practice, a commercial magnitude of the famous mark *per se* seems outside the scope of protection in the Unfair Competition Law. In order to prove this point, one case – *xylitol gum hikaku kokoku jiken*⁹⁶⁵ will now be examined.

The claimant (X) and the defendant Y are both confectionary manufacturers producing chewing gum. In order to sell a ‘Pos-cum – clear dry –chewing gum’, Y made and used an advertisement “a ‘Pos-cum – clear dry –’ is 5 times more effective in remineralisation than general chewing gum, which contains xylitol”. Here, general chewing gums indicate xylitol plus 2. X alleged that this comparative advertising is claimed to be an unfair competition act under Article 2(1)(xiv), and required an injunction. The trial dismissed the claim, thus the claimant appealed.

Above all, it can be concluded (and it is agreed by the Japanese legal academic) that use of a famous mark (*tyomei-syohyo*) (which does not cause any false indication of origin) does not consist of an unfair competition act. It is submitted that prohibiting

⁹⁶⁵ *Xylitol gum hikaku kokoku jiken*, Intellectual Property High Court, Heisei 18nen (ne) 10059go unreported.

their use discourages unfair competition. Under the current regime, it appears that Japan does not seem to change their approach to the comparative advertising under the domain of the Unfair Competition Prevention Act. However, to what extent the decision of the *Bellure* has an effect on the Japanese regime is worth observing.

Next, the defensive trademark system or the *bogo hyosyo toroku* system. Here, Article 64 of the Japanese Trademark Act⁹⁶⁶ provides the exclusive right to ‘a mark, which is well-known among consumers through registration⁹⁶⁷. This is a useful route, particularly for foreign *syuchi-syohyo* owners, to secure some protection in Japan.

Turning to the other routes of protecting *syuchi-syohyo*, import suspension or *mizugiwa kisei* is also significant. In practice, it is accepted in Japan that *syuchi-syohyo* are particularly vulnerable to counterfeiting⁹⁶⁸, with the importation of counterfeit goods itself being a significant problem in Japan⁹⁶⁹, for example, it was estimated that the total economic loss to the relevant Japanese industry caused by the importation of counterfeit products into Japan from China alone were ¥18 billion (equivalent to £11.5 million) in 2008⁹⁷⁰. Japan has attempted to take the initiative to combat this problem⁹⁷¹, and one aspect of this was the pragmatic step of allowing

⁹⁶⁶ *Ibid.*

⁹⁶⁷ Although the abolition of the *bogo hyosyo* registration system has been on agenda, it has not been yet to happen.

⁹⁶⁸ For example, 53.5 % of types of the counterfeit goods or dead copy in Japan were related to trademarks. The estimated economic loss for one company is reported about ¥300 million (=£2million), and the estimated total loss caused by the counterfeiting produces are ¥98.3 billion. (=£628 million at the currency rate of July 09). See JPO, ‘the JPO 2008 Report of Counterfeited goods’. It was published March 2009, and the full text of the report is to be found at http://www.jpo.go.jp/torikumi/mohouhin/mohouhin2/jittai/pdf/2008_houkoku/higai_shousai.pdf. (Last accessed on 12 January 2010). See because well-known trademarks are highly likely to be valuable, therefore, these marks are certain to be a target of counterfeited goods or dead-copy. For instance, ‘SEIKO’ for watches, ‘SONY’ for MP3 players, ‘LOUIS VUITTON’ for bags, and ‘BURBERRY’ check for women’s clothes. These trade marks are not only well-known but also valuable. The information is also available at http://www.meti.go.jp/press/20080630002/03_nenjihoukokusho.pdf. (Last accessed on 12 January 2010).

⁹⁶⁹ For example, 54.92 % of counterfeited goods seized at the EU border in 2008, and 54.57 % of total amount of any counterfeited articles are originated from China. A full text of the EU Report, ‘Report on EU Customs Enforcement of Intellectual Property Rights’ is to be found at http://ec.europa.eu/taxation_customs/resources/documents/customs/customs_controls/counterfeit_piracy/statistics/2009_statistics_for_2008_full_report_en.pdf. (Last accessed on 12 January 2010).

⁹⁷⁰ *Supra* note 897.

⁹⁷¹ This has been on the Strategic Plan since 2002. See for example, http://www.jpo.go.jp/torikumi_e/index.htm. (Last accessed on 12 January 2010). The most recent strategic programme 2009 is also

import suspension for counterfeit goods⁹⁷², and this is a mechanism that *syuchi-syohyo* owners may employ.

So, although we will see that *syuchi-syohyo* are only afforded relatively narrow protection by the Trademark Act (see Sections 5.3 and 5.4 below), when the Trademark Act is combined with these alternate routes, a broader, and perhaps more effective, system for protection for *syuchi-syohyo* in Japan results. It can be concluded that Japan has established its own unique system to protect *syuchi-syohyo* outside (and supplemental to) the Trademark Act regime. In this thesis (and in the next section), attention is focused in the means of how the Trademark Act provide protection for *syuchi-syohyo* alone.

5.3 Well-Known Trade Marks? – the National Level

One of the main themes of this thesis is to explore the efficacy of protection accorded to *syuchi-syohyo* against *kondo* in Japan⁹⁷³ within the Japanese Trademark Act. In order to examine this, firstly, it is necessary to explore the definition of *syuchi-syohyo* in the law. The Definition Model will now be used in critically considering ‘*syuchi-syohyo*’ and then in Section 5.4 attention will turn to a critical consideration of the protection afforded to *syuchi-syohyo* against *kondo*.

Secondly, it should be noted that there has been very little by way of primary and secondary resources concerning *syuchi-syohyo* protection in Japan⁹⁷⁴ since Article 4(1)(19) was added to the Act in 1996⁹⁷⁵. This may be because, as has been suggested,

⁹⁷² *Supra* notes 897 and 898. For example, the Japanese government has primarily contributed to propose the international treaty called ‘Anti-Counterfeiting Trade Agreement (the ACTA)’. The consultation of ratifying the ACTA has started and it is still on progress. The ‘Strategic Plan 2009’ (see Strategic Plan 2009 at 44-45) also mentions the government to make an effort to come to an agreement on the ACTA as early as possible. The expected signatory nations are: Japan, the EU, US, Switzerland, Canada, New Zealand, Mexico, and Korea. In practice, well-known trade marks are highly likely to be victimised by those illegal actions, it can therefore submit that enforcement of regulating those issues implicitly provide legal protection to well-known trade marks. The author of this thesis comments the contribution of the ACTA needs to be observed and the slight reform of the Trademark Act will be expected.

⁹⁷³ Chapter 4, Section 4.3.1.1-4.3.1.2 examines how the CTMR deals with ‘trade mark of repute’ as way of a critical comparative analysis in Chapter 6.

⁹⁷⁴ See Amino, M, *supra* note 402.

⁹⁷⁵ Act No.116 of 1994 to Act No. 68 of 1996.

that introduction of Article 4(1)(19) achieved a high level of an appropriate protection of *syuchi-syohyo* in Japan.⁹⁷⁶

Thirdly, before critically exploring the statutory definition of ‘*syuchi-syohyo*’ in Japan, some etymological analysis of the term ‘*syuchi-syohyo*’ is instructive⁹⁷⁷.

周知商標 is the *Kanji* for *syuchi-syohyo*. Of this, the *kanji* symbols for ‘well-known’ are: ‘周知’, this consists of two *kanji* symbols, (1) 周 (*Syu*) and (2) 知 (*Chi*). The first symbol ‘*Syu*’ has the implicit meaning of ‘around, surrounding, or neighbourhood’,⁹⁷⁸ and the second symbol ‘*Chi*’ implies ‘known or knowledge’⁹⁷⁹. Thus, implicit in the term ‘*syuchi*’ is the notion of ‘knowledge in a geographic area’. It is submitted that two further points flow from an etymological consideration of this term:

- (i) Not only does the explicit meaning, and English translation, of ‘*syuchi*’ approximate notions of ‘knownness’ in the English-language discourse on well-known trade marks, but;
- (ii) The use of the term ‘*syuchi*’ itself tells us something. It is interesting to this author that the term employed is ‘周知’, or ‘*syuchi*,’⁹⁸⁰ rather than ‘著名’ (*tyomei* or famous⁹⁸¹). Thus, in Japanese, the distinction between ‘well-known’ and ‘famous’ is implicit in the relevant *kanji* symbols. In Japanese, therefore, the well-known/famous mark distinction is immediately obvious and implicit⁹⁸² in a way that is not the case in English (for further consideration of the difficulties of and distinction between

⁹⁷⁶ Ono, S, *supra* note 370.

⁹⁷⁷ This author has already indicated the importance of Japanese etymology in Chapter 2, Section 2.3.3.

⁹⁷⁸ Shinnmura, I, *supra* note 345.

⁹⁷⁹ *Ibid.*

⁹⁸⁰ Please note, that the Japanese Trademark Act makes no reference to famous marks: the term *syuchi-syohyo* is used only.

⁹⁸¹ The implicit meanings here are very different. The *kanji* for ‘famous’: ‘著名’ consists of two *kanji* symbols, (1) 著 (*Cho*) and (2) 名 (*Mei*). *Cho* implies ‘remarkable, significant, or enormous’ and *Mei* represents notions of name, repute or fame. Therefore, were *chomei* used in relation to a mark, this would imply that the mark in question was remarkably famous, a narrower concept than *syuchi-syohyo*. This author, being a literate Japanese speaker automatically understands the differences between well-known and famous marks in Japanese. Further information regarding such marks can be found in Shinnmura, I, *supra* note 345.

⁹⁸² It should be noted here that some might argue that the distinction between well-known and famous is not explicitly affirmed in Japanese jurisprudence. This author does not consider this to be important as this distinction is linguistically implicit.

well-known and famous marks outside Japan, see Chapter 1). Further, this author suggests that ‘周知 (*syuchi* or well-known)’ implies that scope of ‘knownness’ relies on geographic factors (please see Section 5.3.1.2 below for further discussion of this) rather than depth of knowledge. It is in 著名 (*tyomei* or famous) that depth of ‘well-knownness’ is implied. Thus, a consideration of Japanese etymology indicates that *syuchi-syohyo* would not have to be known nationwide⁹⁸³, whereas a *tyomei-syohyo*, or famous mark, would require a nationwide degree of ‘fame’ or ‘well-knownness’.

Japanese etymology, although instructive, does not give definitive guidance as to the precise *degree* of well-knownness required for *syuchi-syohyo*, so etymological analysis can not take us any further here. So, now the statutory definition of *syuchi-syohyo* will be critically explored with reference to the Definition Model.

5.3.1 The Japanese Trademark Act

In this section, a critical consideration of the statutory definition of *syuchi-syohyo*, utilising the Definition Model⁹⁸⁴, will be undertaken. To briefly recap, within the Definition Model, two elements of ‘trade mark’ – *form* (*type* and *context*) and *concept* are recognised, together with the two *preconditions*.

The term ‘*syuchi-syohyo*’ appears directly in Articles 4(1)(10) and (19) in the Japanese Trademark Act, although no explicit definition of ‘*syuchi-syohyo*’ provided (please note that there is also reference to ‘商標審査基準: *syohyo shinsa kijyun*’⁹⁸⁵, which acts as a supplement to the Trademark Act, and will be explored in Section 5.3.2 below).

Some further background information is noteworthy here: It is generally accepted in Japan that Article 4(1)(10) was introduced to provide the threshold of unregistered well-known trademark protection⁹⁸⁶ and to implement Article 6bis of the Paris

⁹⁸³ Shinnmura, I, *supra* note 345 at 1050.

⁹⁸⁴ See Chapter 2, Section 2.2 for the further explanation of the Definition Model.

⁹⁸⁵ This is known as the JPO Trademark Examination Guidelines (hereafter the JPO Guidelines).

⁹⁸⁶ Goto, H, *Paris jyoyaku* (Tokyo, Hatsume-kyokai, 2002).

Convention⁹⁸⁷. Article 4(1)(19) was then introduced in 1996 (note that the CTM came into force in 1996), coming into force on 1 April 1997⁹⁸⁸, and this provision is seen as a recognition (and implementation) of stronger *syuchi-syohyo* protection⁹⁸⁹. Article 4(1)(19) is generally understood to be equivalent⁹⁹⁰ to Article 4(3) of the EU Trade Mark Directives⁹⁹¹, and thus (this author submits) to Article 8(5) of the CTMR. Thus, can it be inferred that the scope of protection accorded to ‘trade mark of repute’ and ‘*syuchi-syohyo*’ should be the same, or that these terms should be interpreted as being synonyms? The author submits, as evidenced below, that the guidance provided as to how ‘*syuchi-syohyo*’ is interpreted does, in fact, differ from that of ‘trade mark of repute’.

Further, it should be noted that Articles 4(1)(10)⁹⁹² and 4(1)(19) are considered to provide protection for what in Japan would be known as the private domain (here, please see Articles 15(1)⁹⁹³, 43(2)⁹⁹⁴, 46(1)(1)⁹⁹⁵ – the ground of refusal of

⁹⁸⁷ *Supra* note 149, and see Chapter 2, Section 2.3.1.1.

⁹⁸⁸ See general information: the JPO, *Kogyosyoyu-ken ho chikuzi kaisetsu* (Tokyo Hatsumei-kyokai, 2006), Amino, M, *supra* note 402, and Tamura, Y, *supra* note 283.

⁹⁸⁹ Also, it needs to be noted here that no developments in academic or statutory level relating directly to well-known trademark protection has not been reported since Article 4(1)(19) of the Trademark Act was added in 1996; thus a dearth of legal research will be expected to be seen.

⁹⁹⁰ Ono, S, *supra* note 370 at 448.

⁹⁹¹ Article 4(3) of the EU Trade Mark Directive: A trade mark shall furthermore not be registered or, if registered, shall be liable to be declared invalid if it is identical with, or similar to, an earlier Community trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier Community trade mark is registered, where the earlier Community trade mark has a reputation in the Community and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trade mark.

⁹⁹² Article 4(1)(10) of the Japanese Trademark Act states that a mark can not be registered regardless of Article 3. See Article 3 of the Japanese Trademark Act in full: “Art. 3.(Requirements for trademark registration) (1) Any trademark to be used in connection with goods or services pertaining to the business of an applicant may be registered, unless the trademark: (i) consists solely of a mark indicating, in a common manner, the common name of the goods or services; (ii) is customarily used in connection with the goods or services; (iii) consists solely of a mark indicating, in a common manner, in the case of goods, the place of origin, place of sale, quality, raw materials, efficacy, intended purpose, quantity, shape(including shape of packages), price, the method or time of production or use, or, in the case of services, the location of provision, quality, articles to be used in such provision, efficacy, intended purpose, quantity, modes, price or method or time of provision; (iv) consists solely of a mark indicating, in a common manner, a common surname or name of a juridical person; (v) consists solely of a very simple and common mark; or (vi) in addition to those listed in each of the preceding items, a trademark by which consumers are not able to recognize the goods or services as those pertaining to a business of a particular person. (2) Notwithstanding the preceding paragraph, a trademark that falls under any of items (iii) to (v) of the preceding paragraph may be registered if, as a result of the use of the trademark, consumers are able to recognize the goods or services as those pertaining to a business of a particular person.”

⁹⁹³ Article 15 (Examiner’s decision of refusal) of the Japanese Trademark Act. It states that “Where an application for trademark registration falls under any of the following items, the examiner shall render a decision to the effect that the application is to be refused: (i) the trademark pertaining to an

registration of *syohyo*, opposition of the trademark registration and reasoning for invalidation of trademark registration). Nevertheless, Articles 4(1)(10) and (19) are still parts of absolute grounds (unregistered trade marks) for refusal. Article 43(2) and Article 46(1)(1) function equivalently, it is submitted, to Article 8(5) of the CTMR; and it can be said that Article 25 of the Act has a similar effect to Article 9(1)(c) of the CTMR (comparative analysis of these noted articles will be developed in Chapter 6).

The term ‘*syuchi-syohyo*’ appears explicitly in the following Articles⁹⁹⁶:

“Article 4 (Unregisterable trademarks)

(1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark:

(10) is identical with, or similar to, another person’s *trademark which is well known among consumers as that indicating goods or services in connection with the person's business*, if such a trademark is used in connection with such goods or services or goods or services similar thereto;

(19) is identical with, or similar to, *a trademark which is well known among*

application for trademark registration is not registrable pursuant to the provisions of Articles 3, 4(1), 7-2(1), 8(2), 8(5), 51(2) (including the case of its mutatis mutandis application under Articles 52-2(2)), 53(2) of this Act or Article 25 of the Patent Act as applied mutatis mutandis under 77(3) of this Act.”

⁹⁹⁴ Article 43(2) of the Japanese Trademark Act. This Article is known as Opposition to registration and states that “Any person may file with the Commissioner of the Patent Office an opposition to registration within two months from the date of publication of the bulletin containing the trademark, on the grounds that the trademark registration falls under any of the following items. In this case, an opposition to registration may be filed for each of designated goods or designated services if the relevant trademark has been registered in connection with two or more designated goods or designated services: (i) where the trademark registration has been made in violation of Articles 3, 4 (1), 7-2(1), 8(1), 8(2), 8(5), 51(2) (including its mutatis mutandis application under Articles 52-2(2)), 53(2) of this Act or Article 25 of the Patent Act as applied mutatis mutandis under Articles 77(3) of this Act; and (ii) where the trademark registration has been made in violation of a treaty.”

⁹⁹⁵ Article 46(1)(1) of the Japanese Trademark Act in full: “Art.46(1) Where a trademark registration falls under any of the following items, a request for a trial for invalidation of the trademark registration may be filed. In this case, where the trademark has been registered in connection with two or more designated goods or designated services, a request may be filed for each of the designated goods or designated services: (1) where the trademark registration has been made in violation of Articles 3, 4 (1), 7-2(1), 8(1), 8(2), 8(5), 51(2) (including cases where it is applied mutatis mutandis pursuant to Article 52-2(2)), 53(2) of this Act or Article 25 of the Patent Act as applied mutatis mutandis pursuant to Article 77(3) of this Act.

⁹⁹⁶ See the JPO Report, *supra* note 882.

consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person, if such trademark is used for unfair purposes (referring to the purpose of gaining unfair profits, the purpose of causing damage to the other person, or any other unfair purposes, the same shall apply hereinafter) (except those provided for in each of the preceding items)."

[Emphasis added].

As can be seen from the (translated) phrasing of Articles 4(1)(10) and (19), the Act does not provide any explicit and comprehensive definition of 'syuchi-syohyo'. The next two sections of this Chapter will be concerned with the critical exploration of the definition of 'syuchi-syohyo' in the articles noted above, with reference to the Definition Model.

5.3.1.1 The *Form* of 'Syuchi-Syohyo'

First, we turn to the consideration of *syuchi-syohyo form (type and context)*. No further guidance in terms of *syuchi-syohyo form* is provided above that of *syohyo* within Articles 4(1)(10)⁹⁹⁷ and (19). Whilst acknowledging this, this author would like to briefly note the aim and basic scope of Article 4(1)(19) of the Japanese Trademark Act. The aim of this provision is clearly the provision of protection to *syuchi-syohyo* where a registration is made by a third party in order to take an unfair advantage of a *syuchi-syohyo* for unlawful purposes⁹⁹⁸. In assessing whether this provision is satisfied, additional information pertaining to the assessment of 'taking advantage of a well-known foreign trademark or a trademark' and 'unfair purposes' are provided⁹⁹⁹. This particular provision is generally accepted to be known to be used in preventing *syuchi-syohyo* including foreign trademarks, from dilution and tarnishment¹⁰⁰⁰.

⁹⁹⁷ It should be noted here that Article 4(1)(10) provides a protection to *unregistered 'syuchi-syohyo'*.

⁹⁹⁸ For instance, Article 4(1)(19) of the Japanese Trademark Act.

⁹⁹⁹ See Items 1(a)(b) and 4 of Chapter III: Article 4(1)(3) Part 17: Article 4(1)(19) of the JPO Guidelines. A full text of this is to be found in Appendix 4.

¹⁰⁰⁰ Ono, S, *supra* note 370.

Returning to trade mark *type* in *form* of ‘*syuchi-syohyo*’, it is also as that for *syohyo*, and as such is relatively narrow (see Article 2)¹⁰⁰¹. Further, *syuchi-syohyo context* in *form*, this is essentially (therefore) the same as that to be found in relation to *syohyo* in Article 2(1) of the Japanese Trademark Act.

5.3.1.2 The *Concept* of ‘*Syuchi-Syohyo*’

It is submitted that *concept* of ‘*syuchi-syohyo*’ is not explicit, although some guidance can be inferred from *syohyo concept* set out in Article 2 of the Japanese Trademark Act (i.e. – distinctiveness¹⁰⁰²). Please note that ‘distinctiveness’ is implicit in the *kanji* scripts for *syohyo*, and this term forms part of the phrase ‘*syuchi-syohyo*’.

How *syohyo concept* might be used to infer that of *syuchi-syohyo* is, it is submitted, made clearer by reference to Article 4(1)(10) and Article 4(1)(19). Both of these provisions use similar phrasing in relation to *syuchi-syohyo*. The former states that “...a person’s trademark which is *well known among consumers* as that indicating goods or services in connection with the person’s business...”. The latter also states that “... a trademark which is *well known among consumers in Japan or abroad as that indicating goods or services pertaining to a business of another person*”. Thus it may well be inferred that *syuchi-syohyo concept* might be a high level of distinctiveness amongst consumers, with this distinctiveness being tested in relation to the geographical scope of knowledge, rather than by knowledge *per se*, of the *syuchi-syohyo*. Thus, this author proposes that ‘*syuchi-syohyo*’ *concept* constitutes a high level of geographically-defined distinctiveness amongst consumers.

With reference to one of the parallel systems for *syuchi-syohyo* protection, defensive trademark registration, some support for this particular interpretation can be found:

¹⁰⁰¹ *Supra* note 292, and *infra* note 1221 for Article 4. Having stated that, the expansion of the protectable trademark subject matter such as non-traditional trade marks are very much under discussion. The reader might be interested to know that there is a (limited) Japanese literature relating to the protection the non-traditional trademarks, namely: Kojima, R, *supra* note 117; Kojima, R, ‘Coca-Cola jiken ni mirareru rittai syohyo no hogo – chomei na mojisyohyoga shiyousareta housoyoki jitai no dedokoro shikibetsu nouryoku kakutoku no annketo tyosa’ (2008) 6 *CIPIC Journal* 209; Mityuno, F, ‘Syohyo no rittaiteki keijo nomi karanaru syohyo no torokuyoken handan no kijyun noyukue – mini magligt hanketsukou’ (2008) 58 *Chizai kanri* 191.

¹⁰⁰² See Chapter 2 Section 2.3.3.

here there is also reference to being well-known among consumers *that indicating the designated goods¹⁰⁰³ and/or services¹⁰⁰⁴ in connection with the business of the trademark right holder.*

This author notes that in both GATT TRIPS¹⁰⁰⁵ and the WIPO Recommendation¹⁰⁰⁶, the nexus of (well-known) trade mark *concept* – distinctiveness – seems to relate to knowledge (or recognition) of marks broadly, whilst in Japan, its *concept* seems specifically to relate to the geographical scope of distinctiveness. This author wonders, whether this narrower Japanese approach might lead to a difference in the practice of defining and identifying ‘*syuchi-syohyo*’ in Japan as opposed to the definition and identification of trade marks of repute the CTM. That these two jurisdictions approach the questions differently, is – it is submitted – evident in Chapters 4-6 of this thesis: whether the narrower Japanese approach to *syuchi-syohyo concept* is one of the causal factors (or the sole such factor) for this difference is not something that can be evidenced in this thesis but this does, it is submitted, provide interesting food for thought.

Considering *syuchi-syohyo concept*, it might further be observed that the emphasis in both Articles 4(1)(19) (and 64) on geographical scope of knowledge might be a reflection of a theme of origin-style considerations in the Japanese provisions relating to *syuchi-syohyo*¹⁰⁰⁷. Consequently, in relation to the Definition Model, it could then also be argued that the distinctive nature of *syuchi-syohyo* (which clearly falls within *concept*) might be ‘highly distinctive in the sense that it functions as an indication of origin’. However, this author is not convinced by this and submits that mere indication of origin reasoning must be insufficient here (or otherwise, the *concept* of *syuchi-syohyo* would, in this respect, be no different to that of *syohyo*).

¹⁰⁰³ Article 64(1) of the Japanese Trademark Act.

¹⁰⁰⁴ *Ibid*, Article 64(2).

¹⁰⁰⁵ See Chapter 3, Section 3.2.2.

¹⁰⁰⁶ See Chapter 3, Section 3.2.4.

¹⁰⁰⁷ Such emphasis is, it is submitted, not limited to the definition of *syuchi-syohyo* and/or to the registration of the same (see Article 4(1) of the Japanese Trademark Act, and see Chapter 2, Section 2.2.3.). Indication of origin notions infuse the whole of the Japanese trademark law, it is submitted, with the emphasis on business use made in the Act. In the context of *syuchi-syohyo* in particular, it is provided that where such marks are no longer used in the course of trade, then this has implications for infringement proceedings (see *ibid*, Article 25).

As noted in the paragraph above, the Act explicitly states that *syuchi-syohyo* shall be well-known in Japan *or* abroad. In addition, the scope of distinctiveness can be examined with reference to what might be termed ‘back-up legal requirements’ within the Trademark Acts, i.e. Articles 3(1)(2), (3), (4), (5), 3(2), which all appear, in the view of this author, to be related to ‘distinctiveness’. This author is, therefore, led to the conclusion that *concept* of ‘*syuchi-syohyo*’ can be said to be: ‘*syuchi*, which constitutes a high level of *geographically-defined* distinctiveness amongst consumers of *syohyo* used in relation to goods or services in connection with the business of the trademark right holder in Japan or abroad’.

Thus, although it cannot be said that the explicit wording of *syuchi-syohyo* in the Japanese Trademark Act can be used to provide *syuchi-syohyo concept*, it is possible – combining standard legal interpretation with some knowledge of Japanese – to come to an arguable implicit interpretation of *syuchi-syohyo concept*.

Nevertheless, this author submits that in the absence of a detailed statutory definition of ‘*syuchi-syohyo*’, the legal definition¹⁰⁰⁸, and this author’s conceptualisation of the same using the Definition Model, must be uncertain. Although it has, as noted above, been possible to infer what is meant by ‘*syuchi-syohyo*’, it is also possible to critique the same. In particular, what remains unclear at this stage as to the definition of ‘*syuchi-syohyo*’ is the precise nature of the test used to determine when a *syohyo* is a *syuchi-syohyo*. Clearly, is necessary to be well-known amongst consumers, in other words, it is understood that *syohyo* needs to be well-known to consumers, but *which* consumers and *where*? Is the geographical extent of *syuchi* the main (or only element) that determines whether the distinctiveness of a particular *syohyo* is sufficiently high for it to be considered a *syuchi-syohyo*? There seems not to be enough guidance in the Law for this author to answer these, and other possible, questions.

Finally, in relation to the *preconditions* of the Definition Model, there is no reference to *graphic representation* or *commercial use* in Articles 4(1)(10) or (19). But although not noted in relation to ‘*syuchi-syohyo*’, in relation to a ‘*syohyo*’ it is stated

¹⁰⁰⁸ See Amino, M, *supra* note 402 at 379.

in Article 2 that there must be business use and, it has already been submitted (see Chapter 2 Section 2.3.3), that there is indeed a very strong emphasis on business use in the Act. This author submits that ‘business use’ and *commercial use* can be regarded as being synonymous. Hence, the *precondition commercial use* is, it is submitted, explicitly present in the Japanese Law and is implicitly present for *syuchi-syohyo*. Graphic representation is not a term explicitly seen in the Act, but from an etymological viewpoint, this author considers that this is implicit in the term ‘*syohyo*’, as previously argued in Chapter 2, Section 2.3.3. Hence, both *preconditions* are present.

The JPO Guidelines will now be examined for further guidance to how ‘*syuchi-syohyo*’ can be defined and conceptualised with reference to the Definition Model.

5.3.2 The JPO Guidelines

So far, within the Definition Model, this author has submitted that ‘*syuchi-syohyo*’ has narrow *form* (particularly in comparison with the international and CTM position) and there is a lack of clarity as to explicit *concept*. As was noted in Section 5.3.1, the JPO Guidelines supplement to the Trademark Act (and, indeed they do so in both a legal and practical context¹⁰⁰⁹), thus an exploration of the JPO Guidelines is a reasonable next step in critically considering the definition of ‘*syuchi-syohyo*’.

The JPO Guidelines are intended to ensure a consistent standard of assessments made by the JPO, and are intended to provide a fair and transparent account of the trademark system by revealing the Examination Guidelines to the public¹⁰¹⁰. In the view of this author that (as might be expected in a civil law jurisdiction), both the act and the JPO Guidelines are set out¹⁰¹¹ and maintained quite effectively.

¹⁰⁰⁹ The ‘JPO Examination Guidelines for Trademarks’ are made and published for the sake of standardisation and uniformity in the examination of trademark application at the JPO. The Guidelines was updated in 2007.

¹⁰¹⁰ *Ibid.*

¹⁰¹¹ This author critiques that the numberings of the JPO Guidelines seems rather bewildering; however in order to maintain accuracy, the original format of the numbering is employed in this thesis. To those less familiar with Japanese legal norms, the following explanation (provided by this author) of a sample citation of a provision from said Guidelines might help: ‘Chapter III Part 8: Article 4(1)(3): Article 4(1)(10) of the JPO Guidelines’ – this means that the Guidelines cited here relate to Article

The relevant provisions, in which the term ‘*syuchi-syohyo*’ directly appears, are: Chapter III: Article 4(1)(3) Part 8: Article 4(1)(10)¹⁰¹² and Chapter III: Article 4(1)(3) Part 17: Article 4(1)(19) of the JPO Guidelines. It should be noted here that whilst these two Sections cannot be said to provide a comprehensive definition of ‘*syuchi-syohyo*’, they do provide additional information as to ‘*syuchi-syohyo*’, as compared to the provisions set out in the Act.

Considering the relevant items in the Guidelines, *syuchi-syohyo type in form* is said to be that as defined in Article 2 of the Act, so the Guidelines do not add anything the Act in this respect. However, *context in form* of ‘*syuchi-syohyo*’ is said to include foreign marks, so here the Guidelines explicitly increase the scope of ‘*syuchi-syohyo*’. *Concept of ‘syuchi-syohyo’* receives, it is submitted, more detailed (if implicit) treatment in the Guidelines. The relevant items state the following:

- (i) a mark which is widely known amongst Japanese end-consumers or relevant traders¹⁰¹³;
- (ii) a mark which is known throughout Japan or in a particular area¹⁰¹⁴;
- (iii) a mark which is well-known in several foreign countries (a full consideration shall be taken into account in assessing foreign ‘*syuchi-syohyo*’)¹⁰¹⁵.

It is submitted that this provision of the Guidelines clarifies, to some degree, *concept* of ‘*syuchi-syohyo*’ – the geographical extent of distinctiveness¹⁰¹⁶, and the emphasis on marks needing to be *geographically* well-known. In addition to this, the guidance to consumers seems to be more helpful than that in the Act; it specifically includes end consumers and relevant traders. According to Items 2 and 3 of Chapter III:

4(1)(10) of the Japanese Trademark Act, and the relevant part of the Guidelines here is Part 8 of Chapter 3 of the JPO Guidelines.

¹⁰¹² See Appendix 3.

¹⁰¹³ Items 1 and 2 of Chapter 3 Part 8: Article 4(1)(10) of the JPO Guidelines. See Appendix 3.

¹⁰¹⁴ *Ibid*, Item 2.

¹⁰¹⁵ *Ibid*, Items 5 and 6.

¹⁰¹⁶ The final version of *concept* of ‘*syuchi-syohyo*’ can thus be stated as follows: ‘*Syuchi-syohyo*’ comprises *syuchi*, which constitutes a high level of geographically-defined distinctiveness. National ‘*syuchi-syohyo*’ must be found amongst consumers of *syohyo* throughout or in a particular part of Japan (and traders in Japanese industry), being used and known in relation to goods or services in connection with the business of the trademark right holder in Japan.

Article 4(1)(3) Part 17: Article 4(1)(19) of the JPO Guidelines, it can be summarised as follows:

Though not many additional points to define what constitutes ‘*syuchi-syohyo*’ are provided in the latter¹⁰¹⁷, it can be briefly summed up: (i) a ‘*syuchi-syohyo*’ contains a mark which is not well-known in Japan, but in a few foreign countries¹⁰¹⁸; and (ii) a ‘*syuchi-syohyo*’ includes a mark which is widely recognised by relevant traders¹⁰¹⁹.

Nonetheless, no further guidance concerning *concept* of ‘*syuchi-syohyo*’ are given: here *syuchi-syohyo concept* (distinctiveness) again appears being related to geographical extent. Therefore, this author is able to confirm her earlier conclusion that ‘*syuchi-syohyo*’ *concept* seems to be geographically defined. Although *concept* in the Guidelines is clarified to some degree and provides insight into the Trademark Act¹⁰²⁰, this author submits that there is still not a single, clear and comprehensive definition of ‘*syuchi-syohyo*’.

This geographically-oriented *concept* of ‘*syuchi-syohyo*’ can be seen also from Japanese cases. It can also be submitted that a lack of a conceptual definition of ‘*syuchi-syohyo*’. It should be noted here that appropriate methodology in a Civil Law jurisdiction such as Japan would not usually include analysis of cases. This is recognised in this thesis, where the main methodology employed lies in statutory interpretation. Nevertheless, the author believes that note of some of the cases in this area would serve to exemplify some of the points made thus far, and would be of interest to the non-Japanese reader (to whom, reports of Japanese cases are hardly ever available in English translation). Thus, a few such cases are noted below.

The High Court has commented that a *syuchi-syohyo* is *not* required to be known to Japanese citizens throughout Japan. One should take into consideration the nature of

¹⁰¹⁷ It should be remembered here that Article 4(1)(19) functions as a relative ground for refusal for third parties to the registration of a mark which is taking an unfair advantage of or detrimental to with unfair purposes. See Article 4(1)(19) of the Japanese Trademark Act and the supplemental items of the JPO Guidelines.

¹⁰¹⁸ Item 2 of Chapter III: Article 4(1)(3) Part 17: Article 4(1)(19) of the JPO Guidelines. See Appendix 4.

¹⁰¹⁹ *Ibid*, Item 3.

¹⁰²⁰ See Section 5.3.1.

goods and services to which the mark is attached and *syuchi-syohyo* status should be judged by reference to relevant traders or consumers. The aim of *syuchi-syohyo* protection was said to be the prevention of confusion of origin to relevant parties¹⁰²¹.

Some leading cases considering *syuchi-syohyo* status do seem to reflect the uncertainty as to the definition of *syuchi-syohyo* that this author has submitted is present. For example, a commodity (in this case coffee) available and used throughout Japan, if the associated *syohyo* was recognised by *almost 50% of the relevant traders* and if the *syohyo* was well-known to at least *a few prefectures* in which that business exists (in this particular case, it was known in three prefectures)¹⁰²², it is a *syuchi-syohyo*. So this case, ‘*syuchi-syohyo*’ is defined to be a *syohyo* which is well-known by nearly 50% of the relevant parties in the three different prefectures (please note that ‘prefecture’ is approximately equivalent to the English term ‘county’).

However, in another case, ‘*syuchi-syohyo*’ status turned on whether the *syohyo* was

“...known to a majority of the relevant parties (traders and consumers) in a *substantial number* of prefectures” [emphasis added by the author]¹⁰²³.

It was also noted here that a *syuchi-syohyo* had to be well-known throughout Japan by the majority of the relevant parties. In another case, a *syohyo* was held not to be a *syuchi-syohyo*, as the length of use was less than five years¹⁰²⁴. Elsewhere, we find that an incomplete document can not be treated as legitimate evidence (which is addressed within the Guidelines)¹⁰²⁵. A *syohyo*, which is well-known in one part of a city (here Nagoya city), can not be granted as a *syuchi-syohyo*¹⁰²⁶. A service mark (in this case a service mark for providing food and drinks) was not granted *syuchi-syohyo* status¹⁰²⁷, as the mark was only known in the small area of one prefecture, thus it might be inferred that when a mark is only known in the small area of one prefecture,

¹⁰²¹ Tokyo High Court, Heisei 3nen, (Gyo Ke) 29go, Chizai-syu 24 kan 1go at 182.

¹⁰²² Tokyo High Court, Shyowa 58nen, 6gatsu 16nichi, Mitaisyu 15kan 2go at 501 (DCCII case).

¹⁰²³ Tokyo High Court, Heisei 13nen, (Gyo Ke) 430go, Chizai sokuso 307-10825.

¹⁰²⁴ Tokyo High Court, Showa 49nen, (Gyo Ke) dai 32go, Shinketsu torikeshi syu 529.

¹⁰²⁵ Showa 56nen shinpan, dai 8843go (3203 go).

¹⁰²⁶ Tokyo High Court, Heisei 10nen, (Gyo Ke) dai 7go, sokuhyo 285-8465.

¹⁰²⁷ Tokyo High Court, Heisei 13nen, (Gyo Ke) 253go, Chizai sokuso 326-10796.

the mark shall not be granted as ‘*syuchi-syohyo*’¹⁰²⁸. However, contrary to the Nagoya decision above¹⁰²⁹, in this service mark decision it was said that a different view might be taken depending in the nature of the goods and/or services to which the mark is attached¹⁰³⁰.

In short, looking at these examples, the author submits that practice as to determining, *syuchi-syohyo* status (and thus, by implication, the definition of *syuchi-syohyo* itself) cannot be said to be clear. It appears that *syuchi-syohyo* issues are decided on a case-by-case basis, and there is little certainty or consistency in said approach.

5.3.3 A Test of ‘*Syuchi-Syohyo*’ – the JPO Guidelines

So far, it has been submitted that no clear conceptual definition of ‘*syuchi-syohyo*’ in either the Japanese Trademark Act or the JPO Guidelines. However, the JPO Guidelines, in fact, provide criteria to assess whether a mark is well-known or not. As was briefly noted before, there are two Items, which talks about ‘*syuchi-syohyo*’ within the Guidelines, such as Chapter III: Article 4(1)(3) Part 8: Article 4(1)(10) and Chapter III: Article 4(1)(3) and Part 17: Article 4(1)(19) of the Guidelines, whilst the assessment if a mark is well-known or not, the following are more relevant, that is Chapter II: Article 3(2).

In fact, Item 3 of Part 8: Section 4(1)(10) of the Guidelines sets out:

“...to provide a trademark’s being well-known under the provision of this paragraph, the provisions of Items 2(1) and (2) of Chapter II (Section 3(2)) of the guidelines apply mutatis mutandis...”.

Chapter II: Article 3(2) provides as follows:

“3. (1) Judgment as to whether a trademark has come to gain its *distinctiveness* through use will be made, taking the following points into consideration. The

¹⁰²⁸ *Ibid.*

¹⁰²⁹ (Gyo Ke) dai 7go, *supra* note 955.

¹⁰³⁰ Tokyo High Court, Heisei 15nen, (Gyo Ke) 32go, Chizai sokuho 342-11811.

specifically, level of consumers' awareness, which will be estimated through a quantitative grasp of *the use of a trademark*, will be utilized to judge the distinctiveness of a trademark.

- (i) A trademark actually in use and goods or services for which it is used;
- (ii) The start of its use, the length of its use, or the area where it is used;
- (iii) The volume of production, certification or delivery and a scale of business (number of stores, an area of business, an amount of sales, etc.);
- (iv) The method, frequency and contents of advertising;
- (v) The number of times of appearance in general newspapers, trade journals, magazines and the internet, and contents thereof;
- (vi) The outcome of the questionnaire regarding consumers' awareness of the trademark". [Emphasis added].

Assessments of marks being 'well-known' are implicit in Items 3(1) and (2) of Chapter II of the Guidelines as 'judgment of a mark being obtained "its distinctiveness"¹⁰³¹'.

So, *concept* of 'syuchi-syohyo' being distinctiveness needs to be evidenced. However, it has already been argued that distinctiveness might well be more related to geographical extent; whilst according to Item noted above, *level of consumers' awareness*, that is to say, the recognition or knowledge of the mark seems to be important. This is where a key inconsistency in the Japanese approach is found, it is submitted.

A brief observation relating to Item 3 Chapter II: Article 3(2) of the JPO Guidelines will now be set out. This Item is followed up by the Items 3(2)(i)-(viii) of Chapter II:

¹⁰³¹ It is referred to Item 3(1) of the JPO Guidelines and Chapter 2: Article 3(2) Articles 2(3)(1) and (2) of the JPO Guidelines. Item 3 of Chapter III: Article 4(1)(3) Part 8: Article 4(1)(10) of the JPO Guidelines.

Article 3(2) of the JPO Guidelines¹⁰³². It is interesting to note that a similarity between criteria set out in Items 3(1)(1)-(6) and Article 2(1) and those of the WIPO Recommendation can be noticed.

The first factor is related to one of the *preconditions* of (well-known) trade mark – *commercial use*. Again here, a strong emphasis on *commercial use* can be confirmed¹⁰³³. The second factor is very similar to Article 2(1)(b)(2) of the WIPO Recommendation, thus it is submitted the temporal and geographic criteria are proxies for distinctiveness. The third factor can be also similar to Article 2(1)(b)(3) of the WIPO Recommendation, and it is submitted that these might well indicate distinctiveness acquired through use. The fourth and the fifth factors can be said to be similar to Article 2(1)(b)(3) of the WIPO Recommendation and it is submitted that these are proxies to distinctiveness. The last factor might be considered to be similar to Article 2(1)(b)(1) of the WIPO Recommendation; and recognition and awareness of the marks are synonyms of distinctiveness (*concept*).

In addition, it is explained that first criteria is fundamental to over-arching the following criteria. Secondly, it is known that the earlier the mark starts being used, and the longer the mark is used, the more well-known the mark becomes to consumers; thirdly, the wider geographically a mark is used, the more well-known a mark tends to be, although nature of a trademark shall be taken into consideration; fourthly, the more the products or service are sold, the better the understanding of products to which a trademark is attached, is expected; finally, the more a mark is promoted and advertised, the more consumers are aware of the mark¹⁰³⁴.

¹⁰³² See Appendix 5. Items 3(2)(i)-(viii) of Chapter II: Article 3(2) of the JPO Guidelines. these can be outlined that the above *facts* need to be proved *by a method using evidence* such as: (i) written publications, (ii) invoices, delivery slips, order slips, bills, receipts, account books, pamphlets, etc; (iii) evidence of marks being in actual use; (vi) evidence of marks being advertised certificate by an advertisement agency; broadcasting agency, publisher or printer; (v) a certificate by a trade association, follow traders or consumers; (vi) a certificate by a public organisation; (vii) tangible publications that show mark being well-known and advertised; and (viii) questionnaires to show the knowledge of consumers. These are an unofficial translation done by the author of this thesis is introduced due to avoidance of terminological confusion to readers and to keep the same pitch of her points and arguments.

¹⁰³³ See Chapter 2, Section 2.3.3.

¹⁰³⁴ See the JPO, *supra* note 984.

The author submits the following critiques¹⁰³⁵.

Firstly, criteria to assess whether a mark is well-known or not, are provided without ‘syuchi-syohyo’ being conceptually and comprehensively defined. What seems more bewildering is that distinctiveness of a mark (*shikibetsu-ryoku*¹⁰³⁶)¹⁰³⁷ will be assessed so as to prove if the mark is well-known or not. At this point, this author ponders why the JPO Guidelines do not simply use a ‘highly distinctive mark’ instead of ‘syuchi-syohyo’? Thus, again, it seems rather inarticulate and there remains a question of how applicable these are to assess ‘syuchi-syohyo’.

To what extent a mark obtains distinctiveness to the consumer might well be considered as an overriding factor to be considered, according to the interpretation of Item 3(1). This may be because it is stated that “especially the level of consumer’s awareness will be utilised to judge the distinctiveness of a trademark”¹⁰³⁸. However, this analysis remains a matter of mere speculation by this author.

Secondly, it is necessary to take account of the criteria – this appears to be a bundle of factual evidence; in other words, the outcome might be varied case by case, which seemingly causes uncertainty and inconsistency in law. For example, the assessments of a mark being distinctive are examined on the ground of the factual evidence, and the following is required to be evidenced: (i) a mark is widely well-known in the area; (ii) a mark is well-known amongst relevant consumers. Equally importantly, the JPO Guidelines state ‘taking the following points into consideration’¹⁰³⁹, this implies an assessment of ‘syuchi-syohyo’ is utterly dependant on each case. Furthermore, in a case of assessing ‘syuchi-syohyo’, it is also explicitly stated that factors listed in the Guidelines are not always overriding factors, thus other considerations can be taken into account of assessing ‘syuchi-syohyo’¹⁰⁴⁰.

¹⁰³⁵ Since a successful registration of a trademark is required to have an intention of use. Tokyo High Court, Heisei 13nen, (Gyo Ke) 48go, Chiteki syoyukan hanketsu sokuho 322-10555.

¹⁰³⁶ The Japanese term for ‘distinctiveness’ is 識別性 (*shikibetsu-ryoku*). The first two parts of the *kanji* symbols imply distinctive; the last part is equivalent to ‘-ness’.

¹⁰³⁷ See Item 3(1) of Chapter II: Article 3(2) of the JPO Guidelines.

¹⁰³⁸ *Ibid.*

¹⁰³⁹ *Ibid.*, Items 3(1)(i)-(vi).

¹⁰⁴⁰ Tokyo High Court, Heisei13, (Ne) 5748go, sokuho 325-10758.

Thirdly, it might be arguable that the submission of the factual evidence is paramount that the determination of ‘syuchi-syohyo’ is based on the factual criteria. In other words, ‘syuchi-syohyo’ seems not to be legally and conceptually defined. This author has strongly argued throughout this thesis that, as a first step, it might well be necessary to conceptually define ‘well-known trade mark’ in the international level; thus bringing a mutual understanding of ‘well-known trade mark’ throughout the different jurisdictions. Hence, protection of ‘well-known trade mark’ will become flexible, thus controllable, which will bring consistency into the law. By following this transformation, protection for ‘syuchi-syohyo’ will become intuitively consistent. Some might discourage ‘well-known trade mark’ to be legally defined first at the international level, and then local (a conceptual definition of ‘syuchi-syohyo’) shall be followed.

Also, taking into account of all fact-based criteria above, ‘syuchi-syohyo’ protection in Japan is believed to be *a matter of fact*; not a matter of law¹⁰⁴¹. Thus, *factual evidence* is required to be submitted so as to show the degree of well-knownness or famousness under the JPO Guidelines¹⁰⁴², if is dealt within the Trademark Act domain¹⁰⁴³, although, the degree of well-knownness is expected to be varied case by case due to individual factual evidence and considerations¹⁰⁴⁴.

Of course, there are a significant number of cases in which evidence was employed to prove ‘syuchi-syohyo’,¹⁰⁴⁵ Various examples of evidence which are submitted to the Court are actual figures of sales and profits, the length of advertising campaigns the number of catalogues being published and delivered to the consumers and the number of actual owners of goods to which a *syohyo* is attached¹⁰⁴⁶. The actual number of

¹⁰⁴¹ Daihan, syo3nen 3gatus 10ka, (O) 1131, Daihan, syo4nen 11gatsu 30nichi, syo 4nen, (O) 850. Amino, M, *supra* note 402 at 351. The same opinion was shared by Mostert, F, W, *supra* note 49.

¹⁰⁴² See Items 3(1) and (2) of Chapter 2 Article 3(2) of the JPO Guidelines.

¹⁰⁴³ The dominant academic theory of well-known trade marks are still in the domain of the Unfair Competition Prevention Act. See Section 5.2.3.

¹⁰⁴⁴ A case-by-case approach seems to be in favour of the Japanese scholars. See, for example, Amino, M, *supra* note 402, and Harima, Y, *Syohyo ho – riron to jissai* – (Tokyo, Roppo syuppan-sha, 1982); Manada, S, ‘chomei hyoshiki no mondai no syoso’ (1967) 13 *Journal of Kanazawa University* 2-54 at 13.

¹⁰⁴⁵ Kudo, K, *Syohyo shinsa kijyun no kaisetsu* (Tokyo, Hatsume-kyokai 2004) at 175.

¹⁰⁴⁶ Tokyo High Court, Syowa 36nen, (Gyo Na) dai 35go, shinketsu torikeshi-syu 460. Also, Tokyo High Court, Showa 53 nen (Gyo Ke) dai 22go, shinketsu sorikeshi-syu 709.

sales and the length of the mark in use are known as effective evidence to be granted a ‘*syuchi-syohyo*’¹⁰⁴⁷.

The detailed examination of how to assess each criterion is beyond the scope of this thesis. In the administrative context, the assessment of well-knownness of *syohyo* is utterly dependant on the considerations made by trademark examiners. However, it seems rather difficult for examiners to gather all the facts relating to these assessments, therefore, *syohyo* owners normally need to demonstrate all the fact for establishing the well-knownness to examiners¹⁰⁴⁸. It is interpreted in Japan that whether or not a *syohyo* is ‘likely to cause confusion’ should be assessed by not only the *syohyo* *per se*, but also circumstances in the business world¹⁰⁴⁹. A couple of questions, which are submitted by this author, are: “is it really just a matter of fact?” and “are legal requirements out of the question here in relation to the criteria of ‘*syuchi-syohyo*’?” These questions are not yet explicitly answered.

Although a detailed consideration of the Japanese jurisprudence is beyond the scope of this thesis, a couple of cases, to which Articles 4(1)(10) and 4(1)(19) had applied (equivalent to Articles 8(5)¹⁰⁵⁰ and 9(5)¹⁰⁵¹ of the CTMR) will be fully introduced here.

It should be remembered here that use of a famous mark in the context of comparative advertising does not amount to either trade mark infringement or an act of unfair competition *unless* it contains non-false information about the famous mark.

The *DDC jiken* is known¹⁰⁵² as the very first case which dealt actively with providing guidance as to the factor of ‘well-knownness (*syuchi*)’ under Article 4(1)(10). At the time of the claim (1982), Article 4(1)(19) had not been introduced (it was introduced in 1996). It is speculated that¹⁰⁵³ this case might otherwise have been brought under Article 4(1)(19). A brief introduction of the case is, therefore, vital here. A *syohyo* in

¹⁰⁴⁷ Kudo, K, *supra* note 1041 at 177.

¹⁰⁴⁸ Shibuya, T, *Trademark Law – Theory and Practice* (Tokyo, Tokyo University Press, 1973).

¹⁰⁴⁹ Tamura, Y, *supra* note 357 at 55.

¹⁰⁵⁰ It is a relative ground for refusal (see Chapter 4 Section 4.3.1).

¹⁰⁵¹ It is a right conferred to trade mark proprietors (see Chapter 4, Section 4.3.3).

¹⁰⁵² See, the case note of this case. Matsumoto, T, ‘*DDC jiken*’ (2007) 11 *Jurist* 26-27.

¹⁰⁵³ Matsumoto, T, ‘*DDC jiken*’ (2007) 11 *Jurist* 26-27 at para 4.

question was ‘DDC’ in relation to service in coffee, cocoa, tea, beverages, and ice. A defendant claimed that a registration of a mark ‘DDC’ is made against Articles 4(1)(10) and (15), thus this registrations shall be refused.

A defendant (X) operates a company processing, selling coffee, and running coffee shops since March 1959. In the 1970s X’s trading area was around *Setonaikai* area including 470 coffee shops in *Hiroshima*, 40 shops in *Okayama*, 15 shops in *Yamaguchi* and had business and trading relations with 30% of the existing coffee shops around that area, and held more than 50% of market share in the coffee making industry. A mark of X ‘DDC’ has been used in, and attached to, for instance, the package of the coffee, uniforms of employees, business cards, company’s vehicles, and also advertisements in billboards, newspapers and magazines the since about 1936. A monthly cost of such advertising reached over ¥300000 (equivalent to £1,500), which shows a strong commitment and determination in expanding their business.

The judge dismissed a claim and held that a defendant’s mark cannot be considered as being well-known (*syuchi*) before the date of Y’s trademark application (18 March 1971). X appealed. The High Court upheld the District court.

It is held that:

“whether X’s mark ‘DCC’ through use has obtained recognition as X’s indication of X’s coffee among a significant part of relevant trading circles, it is known in *only* 30% of the main trading circles...the percentage of X’s mark being known in neighbouring area, such as Yamaguchi and Okayama is anticipated to be less than 30%, therefore X’s mark is not considered to be well-known under Article 4(1)(10)”¹⁰⁵⁴.

The main point of this case was to examine to what geographical well-knownness (*syuchi*) is required so as to grant protection under Article 4(1)(10). It was found that significantly higher level of well-knownness (*syuchi*) compared to Article 2(1)(i) of the Unfair Competition Prevention Act is required; so a mark is required to be well-

¹⁰⁵⁴ Unofficial English translation of this judgement is introduced here due to a lack of official English translation.

known at least all neighbouring area in trade. This was heavily criticised and reducing the level has been recommended by legal schools.

Accordingly, the *L'AIR DU TEMPS* jiken¹⁰⁵⁵ has shown a possibility of well-known marks (*syuchi-syohyo*) being protected against dilution and free-ride under Article 4(1)(15). This case was also brought under Article 2(1)(i) of the Unfair Competition Prevention Act¹⁰⁵⁶.

Y submitted a trademark application ‘レールデュタン¹⁰⁵⁷’, in relation to equipping materials in 21 May 1986. Y is a trade mark proprietor of a fresh word mark ‘L'AIR DU TEMPS’ in relation to perfumery. Y alleged that a mark ‘L'AIR DU TEMPS’ had been famous among relevant consumers and traders, thus registration of such comprises infringement of Articles 4(1)(11) and (15).

The court rather importantly held that:

“the aim of Article 4(1)(15) is to prevent free-riding on well-knownness and fame of marks and dilution of well-known and famous marks, and to protect a trademark’s reputation in the course of trade; and ultimately to protect consumers’ interests, by ensuring trademarks as an indication of origins being protected.

A registration of trademarks, which causes a likelihood of confusion to the trademark proprietor’s mark in a broader sense, shall be refused under Article 4(1)(15)”.

This reasoning posed, in the view of this author, a few fundamental points needed for further clarification.

¹⁰⁵⁵ *L'AIR DU TEMPS* jiken, Supreme Court, Heisei 10nen (gyo ke) 85go, minsyu 54kan 6go 1848, hanji 1721go 141.

¹⁰⁵⁶ *Ibid.*

¹⁰⁵⁷ ‘レールデュタン’ is a Japanese *kata-kana* script of ‘L'AIR DU TEMPS’.

- (i) Although the Article above provides a stronger protection to well-known marks, by applying the broader notion of likelihood of confusion, proof of likelihood of business association is required.
- (ii) The aim of Article 4(1)(15) is now defined to prevent free-riding and dilution. Is this broader notion applicable also to ordinary marks?
- (iii) A purpose of Article 4(1)(19) becomes empty if well-known trade marks are accorded protection under Article 4(1)(15)?

Although it has been over 10 years since Article 4(1)(19) was added, there is still a lack of cases to which it has been applied. Thus further observation is necessary to answer the points raised above.

*Manhattan Portage jiken*¹⁰⁵⁸ addressed very recently an issue under Article 4(1)(19). The defendant X is a proprietor of a registered word trademark ‘Manhattan Portage’ in relation to bags and luggage (Nice Classification No.21), and this trademark application was made in 1988. The claimant Y is a US company in producing and selling bags. Y had been used a figurative sign, containing the word ‘Manhattan Portage’ in relation to bags, since 1983. Y brought an action against X claiming that Y’s sign had been well-known among consumers, thus Article 4(1)(19) was applied. X’s mark is very similar to Y’s mark, and Y’s mark was used for unfair purposes, therefore, this registration shall be invalid.

The Tokyo High Court accepted Y’s claim and held that X had a knowledge of Y’s sign, which was still unregistered, since 1988, as Y and X had a meeting to discuss a possibility of licensing, and X’s use of the Y’s sign comprised a use for unfair purposes. In this case, disappointingly, a comprehensive definition of ‘unfair purpose’ was not provided by the Court.

Above all, Japanese jurisprudence has shown some uncertainty and a less cohesive approach to ‘*syuchi-syohyo*’ against ‘*kondo*’.

¹⁰⁵⁸ *Manhattan Portage jiken*, Tokyo High Court, Heisei 14nen (gyo Ke) 514go (unreported).

5.3.4 Summary

So far in Section 5.3, the author of this thesis has attempted to explore the conceptual definition of ‘‘syuchi-syohyo’ in both the Act (Section 5.3.1) and the JPO Guidelines¹⁰⁵⁹ (Sections 5.3.2-5.3.3) with reference to the Definition Model.

We now briefly summarise that, with the Definition Model, the conceptual definition of ‘syuchi-syohyo’ is not explicitly set out either in the Act¹⁰⁶⁰ or the JPO Guidelines. Much inference must be employed in applying the Definition Model, with particular concern as to the scope and clarity of *concept* of ‘syuchi-syohyo’. The apparently case-by-case and fact-dependent approach of the courts to this issue appears indicative of the view that ‘syuchi-syohyo’ status is a matter of fact, and the lack of a comprehensive and precise definition here, in the view of this author, this cannot be helpful for certainty and consistency in the law.

With reference to the JPO Guidelines, it has been argued that *concept* of ‘syuchi-syohyo’ is implicitly present, and some similarity to the WIPO Recommendation here can be found. Moreover, a strong emphasis on *commercial use* (one of the *preconditions*) seems to be one of the distinctive characteristics of the Japanese approach. In short, a *syuchi-syohyo* appears to be examined on a case-by-case basis. In terms of a legal definition or more explicit guidance as to *syuchi-syohyo* status, this author concludes that a *syohyo* must be highly distinctive in a (poorly defined) geographic area and also by the scale of sale (with reference to an uncertain definition of consumers). What is clear to this author is by *syuchi-syohyo* status in Japan can be achieved by *locally* well-known *syohyo*¹⁰⁶¹, and that *syohyo* well-known on a national scale, but only to a small number of consumers¹⁰⁶². Further, the JPO Guidelines do state that the extent of the recognition of the mark can be either national or local¹⁰⁶³.

¹⁰⁵⁹ General information: the Japanese Patent Office, *supra* note 984, Amino, M, *supra* note 402, Tamura, Y, *supra* note 357.

¹⁰⁶⁰ See Articles 4(1)(10) and (19) of the Japanese Trademark Act.

¹⁰⁶¹ It is clear that not only can a *syohyo* be well-known not only throughout the country, but also it can be recognised in certain areas (see Item 1 Chapter III: Article 4(1)(3) Part 8: Article 4(1)(10) of the JPO Guidelines).

¹⁰⁶² The JPO Guidelines states that ‘syuchi-syohyo’ includes ‘a trademark which is widely recognised among end-consumers but also traders in the industry. Traders in industry (in Japan) are included in the assessment of distinctiveness, as well as Japanese consumers (see JPO, *supra* note 984).

¹⁰⁶³ *Ibid.*

The author has submitted that *concept* (distinctiveness) is interpreted geographically, but it is not entirely and conceptually clear, since there is significant inconsistency both in the Acts and jurisprudence.

Items 3 and 6 of Chapter III: Article 4(1)(3) Part 8: Article 4(1)(10) of the JPO Guidelines do suggest¹⁰⁶⁴ that there is a test to assess *concept* of ‘syuchi’ therein¹⁰⁶⁵. The term ‘syuchi-syohyo’ is then explicitly addressed in both Chapter III: Article 4(1)(3) Part 8: Article 4(1)(10)¹⁰⁶⁶, and Chapter III: Article 4(1)(3) Part 17: Article 4(1)(19)¹⁰⁶⁷ of the JPO Guidelines. Here, in order to assess if the mark is well-known or not under Article 4(1)(19) of the Japanese Trademark Act, the JPO Guideline (supplement to Article 4(1)(19)) indirectly refers the reader to Chapter II: Article 3(2) of the JPO Guidelines. What is of significance here is that Chapter II: Article 3(2) of the JPO Guidelines speaks of successful assessments of *syohyo* requiring distinctiveness. Thus, this would appear to confirm the *concept* of *syuchi-syohyo* identified in Section 5.3.1.2 above¹⁰⁶⁸. More generally, the explicit linking of *syuchi* to distinctiveness supports one of the assumptions made by this author in this thesis¹⁰⁶⁹. Here it seems that (in the Japanese context at least) we have (i) some evidence that this assumption is reasonable; (ii) express recognition that both ‘trade mark’ and ‘well-known trade mark’ both have to be distinctive, and; (iii) it is just the extent of said distinctiveness which differs between ‘trade mark’ and ‘well-known trade mark’ (i.e. in terms of *concept* they are qualitatively similar and quantitatively dissimilar).

Finally it should be noted that the Act or the JPO Guidelines do not seem to contain any specific reference to the *preconditions* in relation to ‘syuchi-syohyo’ in the explicit manner (although, as argued above, these *preconditions* can be implied).

¹⁰⁶⁴ See Appendix 3.

¹⁰⁶⁵ As Item 3 suggests, in order to assess if the trade mark is *syuchi* or not, we shall refer to Items 3(1) and (2) of Chapter 2 (Article 3(2)) of the JPO Guidelines. Item 3 states that “*To prove a trademark’s being well known* under the provision of this paragraph, the provisions of *Items 3(1) and (2) of Chapter 2 (Article 3(2)) of the Guidelines* apply *mutatis mutandis*.” [Emphasis added by this author.]

¹⁰⁶⁶ See Appendix 3.

¹⁰⁶⁷ See Appendix 4.

¹⁰⁶⁸ Taking into account the comments of the paragraph above, the slightly expanded version of this can thus be stated as follows: ‘*Syuchi-syohyo*’ comprises *syuchi*, which constitutes a high level of geographically-defined distinctiveness, amongst consumers and the relevant traders in relation to goods or services in connection with the business of the trademark right holder in Japan, or abroad.

¹⁰⁶⁹ See Chapter 1, Section 1.7.

Assuming that ‘*syuchi-syohyo*’ protection in practice is a matter of fact, not law, to what extent can this author’s critique and conceptualisation of ‘*syuchi-syohyo*’ be useful in considering the scope of ‘*syuchi-syohyo*’ protection? This author considers that it is useful, providing a basis both for comparison (see Chapter 6 generally) and for recommendation of reforms (see Chapter 7).

It has been submitted by the author of this thesis that *concept* of ‘*syuchi-syohyo*’ – geographical extent-oriented distinctiveness – does appear to play an overriding role in assessing *syuchi-syohyo* status in the JPO Guidelines¹⁰⁷⁰. It is also submitted that there are a number of limitations to this, particularly in practice, therefore it is also submitted that the JPO Guidelines might well be reviewed and changed as required

Although it can be, in fact, argued that there is a definition of ‘*syuchi-syohyo*’ in the Japanese law, with reference to the Definition Model, this author has argued that *concept* of ‘*syuchi-syohyo*’ is largely implicit and the more detailed guidance to this is to be found in the JPO Guidelines¹⁰⁷¹. Given the absence of a clear and consistent notion of *concept* of *syuchi-syohyo* in the Law and the Guidelines, it is for this reason that it is concluded that *syuchi-syohyo* is not clearly and conceptually defined.

The author further submits that this lack of a clear definition of *syuchi-syohyo* can only impact on the certainty of the scope of the protection of *syuchi-syohyo* against *kondo no osore* (a likelihood of confusion) in a negative manner. This consideration of *kondo* is the aim of Section 5.4.

5.4 What Constitutes ‘Confusion’? – the National Level

Having criticised the definition of ‘*syuchi-syohyo*’, the main focus of this Chapter will now move to the exploration of ‘*kondo*’ (confusion) and critical analysis of the protection of *syuchi-syohyo* against *kondo*¹⁰⁷².

¹⁰⁷⁰ See Items 3(1)(i)-(vi) and Items 3(2)(i)-(viii) of Chapter II: Article 3(2) of the JPO Guidelines.

¹⁰⁷¹ *Ibid.*

¹⁰⁷² See Table 1 for the review of the Japanese terms.

5.4.1 Historical Background of ‘*Kondo*’

As briefly noted in Section 5.2.1, the Japanese trademark system has a long-established history, and it is in this context that confusion theory has been developed.

The historical context of *kondo* can be summarised as follows – the equivalent old Article to the current Article 4(1)(15) of the Japanese Trademark Act¹⁰⁷³ is reported to be traced back to Article 2(1)(11) of the Trademark Act of 1921¹⁰⁷⁴.

According to the judicial custom and the original aim of the Trademark Act of 1921¹⁰⁷⁵, Article 4(1)(15) had a public benefit aspect¹⁰⁷⁶ and this is related to its applicability with other provisions that used public benefit principles to prevent confusion, such as the Articles 4(1)(8) and (9)¹⁰⁷⁷ of the Trademark Act of 1921.

In contrast, the most current Trademark Act includes the phase, “other than the trademarks mentioned in paragraphs (5) to (14)”¹⁰⁷⁸, thereby making it clear that this provision does not overlap with other provisions. However, there is criticism that because this provision (Article 4(1)(15)) concerns the protection of both public and personal (or private) perspectives, it would be more appropriate to apply this provision in the same overlapping manner as was seen in the Trademark Act of 1921¹⁰⁷⁹.

Moreover, *kondo* theory was set out to prevent any confusion of sources, because when a *syohyo* causes confusion to consumers, equally, it was seen to damage the origin function¹⁰⁸⁰, a principle trademark function in Japan¹⁰⁸¹ (and also such actions

¹⁰⁷³ Act No.127 of 1959 amended by Act No.16 of 2008.

¹⁰⁷⁴ *Supra* note 906. The Act of 1921 is no longer available as the primary material level.

¹⁰⁷⁵ Harima, Y, *supra* note 1040.

¹⁰⁷⁶ In the current approach, no public interest is recognised.

¹⁰⁷⁷ Harima, Y, *supra* note 1040.

¹⁰⁷⁸ See Article 4(1)(15) of the Japanese Trademark Act.

¹⁰⁷⁹ Toyosaki, M, *Kogyo syoyuken* (Tokyo, Yui-kaku 1980) at 373.

¹⁰⁸⁰ See the most current case regarding origin function as the primary function of trademarks. *Syohyo “AJ”* and *syohyo ho 3jyo 1kou jiken* (a trademark “AJ” and Article 3(1) of the Trademark Act case) Intellectual Property High Court, Heisei 19nen, (Gyo Ke) 10243. See Uki, R, ‘*Syohyo “AJ”* and *syohyo ho 3jyo 1kou jiken*’ (2008) 12249 *Tokkyo News* at 1-6.

¹⁰⁸¹ Doi, K, ‘*syohyo ho 4jyo 1kou 15jyo ni kiteisusu kondo no igi*’ (1995) 4 *Chizai Kanri* 59-593.

were seen as decreasing sale volumes for *syohyo* owners and raised issues of unfair competition¹⁰⁸²).

Under the Trademark Act of 1921, for example, the use of following was allowed: a use of the *syuchi-syohyo* ‘SANTRY’,¹⁰⁸³ (famous for alcoholic and non-alcoholic beverages) for shirts and trousers and a use of the *syuchi-syohyo* ‘PARKER’,¹⁰⁸⁴ (famous for pens, stationary) as used for bones, horns and ivory. It was considered that no confusion was confirmed as there was no business connection or no relation with the business channels¹⁰⁸⁵.

5.4.2 The Japanese Trademark Act

This Section will critically examine Article 4(1)(15) of the Japanese Trademark Act which relates to the legal principle of modern ‘*kondo*’.

The purpose of Article 4(1)(15) of the Japanese Trademark Act (the current law) is understood as being the protection of the *private* domain¹⁰⁸⁶ and the prevention of confusion¹⁰⁸⁷, since it directly protects the *syohyo* owner’s position. As noted previously, this is similarly the case for Articles 15(1)¹⁰⁸⁸, 43(2)¹⁰⁸⁹, 46(1)(1)¹⁰⁹⁰, the absolute grounds of refusal of registration of trademarks, the opposition grounds of the trademark registration, and grounds for invalidation of trademark registration.

¹⁰⁸² *Ibid.*

¹⁰⁸³ A *syohyo* ‘SANTRY’ is well-known for both alcoholic and non-alcoholic beverages.

¹⁰⁸⁴ A *syohyo* ‘PARKER’ is well-known for pens, stationary.

¹⁰⁸⁵ The debate if the Article 4(1)(15) is regulated for public or private domain is still controversial amongst academics; some argue it is for mainly trademark owners because it prevents confusion, although the detailed examination of this is beyond the scope of this section. Moreover, the protection of the public interests is guaranteed by introducing Article 4(1)(16) as follows: Article 4(1)(16) of the Japanese Trademark Act: is likely to mislead as to the quality of the goods or services.

¹⁰⁸⁶ Tamura, Y, *supra* note 357 at 76.

¹⁰⁸⁷ Ono, S, *supra* note 370 at 393.

¹⁰⁸⁸ Article 15 of the Japanese Trademark Act. It states that “Where an application for trademark registration falls under any of the following items, the examiner shall render a decision to the effect that the application is to be refused: (i) the trademark pertaining to an application for trademark registration is not registrable pursuant to the provisions of Articles 3, 4(1), 7-2(1), 8(2), 8(5), 51(2) (including the case of its mutatis mutandis application under Articles 52-2(2)), 53(2) of this Act or Article 25 of the Patent Act as applied mutatis mutandis under 77(3) of this Act.”

¹⁰⁸⁹ *Supra* note 990, Article 43(2) of the Japanese Trademark Act.

¹⁰⁹⁰ *Supra* note 991, Article 46(1)(1).

It appears to be the intention of the legislature to provide the broader scope of legal protection than that of Article 4(1)(10)¹⁰⁹¹ to *syohyo* alone. The influence here does seem to be Article 16(3) of GATT TRIPS¹⁰⁹² (there is a notable similarity here).

Article 4(1)(15) is+ also known as a so-called ‘blanket provision’ as it covers Articles 4(1)(10)¹⁰⁹³ to (14)¹⁰⁹⁴.

+

Articles 4(1)(10) to (14)¹⁰⁹⁵ describe examples of classic scenarios when two marks are confused, and Article 4(1)(15) intends to cover marks which are not explicitly covered by Articles 4(1)(10) to (14).

In addition to this, an explicit distinction drawn in the original Japanese text between the expression ‘cause confusion [混同: *kondo*]’ and ‘mislead [誤認: *gonin*]’ are

¹⁰⁹¹ See Tatsumura, Z, ‘Fusei kyoso boshi ho niokeru kondo gainen nokyakkan ka – wagakokuni okeru Post sale confusion ni tsuiteno kaisyakuronnteki taiou’ *IP annual Report 2006* (Tokyo, Syoji jimu 2006) at 297-310.

¹⁰⁹² Article 16(3) of GATT TRIPS. Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use. It is similar to the provision stipulated in Article 16(3) of GATT TRIPS in that the scope of goods or service is not required to fall within a mutually identical or similar scope.

¹⁰⁹³ The provision of Article 4(1)(10) serves to reject a third party’s unauthorised application of copied trademark and invalidate its registration in case that the covered goods are identical or similar to goods or services to which the well-known trademark has been used by its true owner.

¹⁰⁹⁴ Tamura, Y, *supra* note 357 at 55.

¹⁰⁹⁵ Articles 4(1)(10)-(14) of the Japanese Trademark Act: (1) Notwithstanding the preceding Article, no trademark shall be registered if the trademark; (10) is identical with, or similar to, another person's trademark which is well known among consumers as that indicating goods or services in connection with the person's business, if such a trademark is used in connection with such goods or services or goods or services similar thereto; (11) is identical with, or similar to, another person's registered trademark which has been filed prior to the filing date of an application for registration of the said trademark, if such a trademark is used in connection with the designated goods or designated services relating to the said registered trademark (refers to goods or services designated in accordance with Article 6(1) (including cases where it is applied *mutatis mutandis* pursuant to Article 68(1)), hereinafter the same), or goods or services similar thereto; (12) is identical with a registered defensive mark of another person (refers to a mark registered as a defensive mark, the same shall apply hereinafter), if such a trademark is used in connection with designated goods or designated services relating to the defensive mark; (13) is a trademark of another person (excluding those which had not been used by the said person for a period of one year or longer from the date the trademark right became extinguished) the right to which has been extinguished for a period of shorter than one year from the date of the extinguishment of the said trademark right (or the date on which a ruling to the effect that the trademark registration is to be rescinded or a trial decision to the effect that the trademark registration is to be invalidated is rendered, the same shall apply hereinafter) or a trademark similar thereto, if such a trademark is used in connection with the designated goods or designated services in connection with the trademark right of such other person or goods or services similar thereto; (14) is identical with, or similar to, the name of a variety registered in accordance with Article 18(1) of the Agricultural Seed and Seedlings Act (Act No. 83 of 1998), if such a trademark is used in connection with seeds and seedlings of the variety or goods or services similar thereto.

drawn¹⁰⁹⁶: it is here that in Japan, a differentiation between *kondo* and so-called dilution is drawn¹⁰⁹⁷ (nevertheless, it is usually officially stated that dilution is protected under Article 2(1)(2) of the Unfair Competition Prevention Act¹⁰⁹⁸). So, it is clear that the definition of *kondo* does not include notions akin to ‘misleading’ and is thus distinct from dilution. It should be noted that Article 4(1)(19) is understood¹⁰⁹⁹ to be set out to “prevent dilution and so-called free-ride to well-known (trade) marks¹¹⁰⁰, and thus to protect distinctiveness of (trade) marks, and thus to enhance the maintenance of *goodwill*¹¹⁰¹ established by trademark owners in the course of trade and ultimately protect the interest of consumers”. [Emphasis is added]¹¹⁰².

Returning to *kondo*, Article 4(1)(15) of the Japanese Trademark Act is translated thus:

“Article 4 (1) notwithstanding the preceding Article, no trademark shall be registered if the trademark:

(15) is likely to *cause confusion* in connection with the goods or services *pertaining to a business of another person (except those listed in items (10) to (14) inclusive).*”

Although ‘confusion’ (*kondo*) is explicitly present, this author submits that there is not a clear and comprehensive definition of ‘*kondo*’ here. The most useful guidance provided herein is that ‘*kondo*’ is stated to exclude that in Items (10)-(14). As was

¹⁰⁹⁶ See Article 4(1)(16) of the Japanese Trademark Act: (1) notwithstanding the preceding Article, no trademark shall be registered if the trademark: (16) is likely to mislead as to the quality of the goods or services.

¹⁰⁹⁷ See Miyazaki, M, *supra* note 929 at 100.

¹⁰⁹⁸ See Article 2(1)(2) of the Japanese Unfair Competition Prevention Act. “Article 2 (1) The term “unfair competition” as used in this Act means any of the following: (2) acts of using as one’s own an indication of goods or business that is identical or similar to another person’s famous indication of goods or business, or the act of assigning, delivering, displaying for the purpose of assignment or delivery, exporting, importing or providing through an electric telecommunication line the goods using such an indication;...”

¹⁰⁹⁹ See Aoki, H, *Chiteki zaisan ken toshiten no brand to design* (Tokyo, Yuhikaku, 2007) at 36-37.

¹¹⁰⁰ However, this current importation and implication of Article 4(1)(15) seems insufficient for well-known trademark protection, when so-called *free-ride* in particular, occurs. Now, the current statutory framework of confusion theory will be examined. The term *free-ride* will be explained shortly. It should be noted here that the term ‘*free-ride*’ will be used throughout this thesis. JPO *kogyo syoyukan seido hyakunen shi* (Tokyo, Hatsumei Kyokai, 1985) at 488.

¹¹⁰¹ No term ‘*goodwill*’ is employed within the Japanese Trademark Act. See Article 1 of the Japanese Trademark Act, the term ‘*business confidence*’ is used instead.

¹¹⁰² See Ono, S, *supra* note 370 at 391; and Aoki, H, *supra* note 1095.

briefly noted in Section 5.4.1, Article 4(1)(15) is said to be an inclusive Article which goes beyond the scope of Articles 4(1)(10)-(14) of the Japanese Trademark Act.

These are known as empirical rules to Japanese lawyers. It is thus generally understood that a mark which causes any confusion indicates a trademark which is not categorised in Articles 4(1)(10)-(14) of the Japanese Trademark Act. The subject matter of Articles 4(1)(10)-(14) is set out in the next paragraph.

Firstly, Article 4(1)(10) provides that protection to the *syuchi-syohyo* extends to unregistered marks; Article 4(1)(11) applies to a *syohyo* which is similar/identical to an earlier mark for similar/identical goods or service. (This is known as a classic example of a *syohyo* which causes *kondo* by empirical rules¹¹⁰³. Also, this Item is considered as one of the exemplars where the *kondo no orore* is highly likely to occur in a subjective manner¹¹⁰⁴). Article 4(1)(12) applies to a *syohyo* which is identical to an earlier *bogo hyosyo*; Article 4(1)(13) applies to protect a mark whose registration is invalid for less than one year, and; Article 4(1)(14) to a mark which is registered under the ‘Plant Variety Protection and Seed Act (*syubyo-ho*:種苗法)¹¹⁰⁵,

Although no clear and comprehensive definition of ‘*kondo*’ is provided within the law, one interesting point needs to be made here: ‘*kondo*’ must occur *in the course of trade*. As might have been noticed, in Japanese jurisdiction, a great emphasis is placed on terms such as in ‘*in the course of trade*’ or ‘*trade mark in business use*’¹¹⁰⁶. This is regarded by this author to be tantamount to ‘*commercial use*’¹¹⁰⁷, and these points further emphasise the importance of *commercial use*, in general, in the Japanese Trademark Act.

In addition to the above, Article 37 of the Japanese Trademark Act provides the following situation as acts deemed to constitute infringements, and it also contains a similar function to Article 9(1)(b) of the CTMR.

¹¹⁰³ Ono, S, *supra* note 370 at 391.

¹¹⁰⁴ *Ibid* at 264.

¹¹⁰⁵ Act No.83 of 1998. An English translation of a full text of this law is to be found at <http://www.cas.go.jp/jp/seisaku/hourei/data/PVPSA.pdf>. (Last accessed on 12 January 2010).

¹¹⁰⁶ See for example, Article 2(3) of the Japanese Trademark Act.

¹¹⁰⁷ See Chapter 2, Section 2.2 for the explanation of the Definition Model.

At this stage, the author rather briefly makes a comparison of the Japanese legal approach to ‘*kondo*’ and ‘*syuchi-syohyo*’. Although there is no clear and comprehensive definition of ‘*kondo*’ in the Act, the nexus of *kondo* does appear to be within a legal definition and framework, rather than a case-by-case, fact-orientated approach (as in the definition of ‘*syuchi-syohyo*’).

5.4.3 The JPO Guidelines

Next, the author of this thesis will seek further guidance in the JPO Guidelines in relation to the definition of ‘*kondo*’ in the Act.

The relevant Article here is Chapter III: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines¹¹⁰⁸. This appears to speak of more information in terms of assessing ‘*kondo*’ than Article 4(1)(15) of the Act¹¹⁰⁹ and interestingly this proviso partly comprises a part of ‘*syuchi-syohyo*’¹¹¹⁰. As will be heavily criticised by this author later in this Section, this part appears to be rather confusing, since there seems no conceptual definition of ‘*kondo*’ provided therein.

The aim of the noted Item is to demonstrate clearly that confusion over the indication of origins includes a likelihood of association, thus the broader interpretation of ‘*kondo*’ (indirect confusion as to the source of origin) is said to be employed¹¹¹¹. It was generally understood that confusion between two identical or similar *syohyo* occur when the mark indicates similar or identical goods or services (direct confusion as to the source of origin), thus although a *syohyo* A is similar to the *syohyo* 1, the *syohyo* A is used to distinguish goods X, and the *syohyo* 1 is so to do goods Y (indirect confusion, where no confusion as to the source of origin is recognised)¹¹¹².

¹¹⁰⁸ Chapter III: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines is provided in full in Appendix 6.

¹¹⁰⁹ See Section 5.4.2.

¹¹¹⁰ See Item 3 of Chapter III: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines.

¹¹¹¹ *Ibid*, the first part of Item 1.

¹¹¹² Syowa 32, shinpan dai 564go (known as SANTRY shirts jiken).

Returning to the examination of the Guidelines, a brief structure of Part 13 can be set out by this author as follows¹¹¹³:

“(i) it is stated that confusion includes likelihood of actual confusion over the source of goods or service and likelihood of association; (ii) examples of anticipated cases where likelihood of confusion and association is likely to occur are illustrated; (iii) factors to assess confusion are addressed; (iv) factors to assess confusion to a mark which partly includes famous mark (*chomei-syohyo*¹¹¹⁴) are also separately indicated; and (v) application of the different criteria to assess famous mark is highlighted”.

Firstly, two different types of *kondo* can be recognised, namely, likelihood of confusion and likelihood of association¹¹¹⁵; secondly factors to assess likelihood of confusion are explicitly set out¹¹¹⁶; thirdly, there is a different treatment in assessing *kondo* when a mark in question contains a part of a *syuchi-syohyo* and a *chomei-syohyo*¹¹¹⁷; and finally, in any ways, a strong emphasis on trademark use can be seen in assessing whether there is a ‘*kondo*’¹¹¹⁸.

It is very clear that *kondo* in question shall only apply to “*the source of goods and services*”¹¹¹⁹. As this point has been examined¹¹²⁰, *kondo* as to the source of origin seems to have originated from the primary function of *syohyo*, which, in Japan, is predominantly understood to be the indication of origin.

A notable aspect of the Japanese trademark regime, in the view of this author, is the different legal treatment of *syuchi-syohyo* (as opposed to *syohyo*) where a third party includes a *syuchi-syohyo* in an application for register. Specifically, the existence of

¹¹¹³ See Appendix 6 for the full text of Chapter III: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines.

¹¹¹⁴ Japanese *kanji* symbols for *chomei-syohyo* is 著名 商標.

¹¹¹⁵ Item 1 of Chapter III: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines. See Appendix 6. The term ‘likelihood of association’ is regarded as the EU Community Trade Mark term (see Chapter 5). For the sake of simplicity, the identical term will be also employed in this Chapter.

¹¹¹⁶ *Ibid*, Item 2 of.

¹¹¹⁷ *Ibid*, Item 4.

¹¹¹⁸ *Ibid*, Item 7.

¹¹¹⁹ *Ibid*, see the title.

¹¹²⁰ See Chapter 2, Section 2.2.2 for a brief explanation of trade mark function, although the detailed examination of trade mark function is beyond the scope of this thesis.

kondo is automatically assumed here¹¹²¹. It might thus be said that the Japanese law takes a strongly pro-*syuchi-syohyo* stance in this regard. More centrally to this thesis, it is felt by this author that the Japanese trademark jurisdiction appears to provide more generous and specific protection to *syuchi-syohyo* against confusion than is provided for trade marks of repute against confusion in the CTM regime. Nevertheless, it still must be conceded that the precise scope of the protection of *syuchi-syohyo* against *kondo* is not clear.

5.4.3.1 A Test of ‘*Kondo*’ – the JPO Guidelines

A further treatment of the JPO Guidelines is provided in this Section. Given the lack of clarity as to the definition of *syuchi-syohyo*, it is felt important also to specifically address the treatment of *syuchi-syohyo* against *kondo* more generally in the context of *syohyo*; and this is the purpose of this Section. According to the Guidelines, similar to the assessments of distinctiveness (*concept*) of *syohyo*, there are five fact-based criteria to assess *kondo* of a *syohyo*.

Generally speaking, it is accepted that the assessment of *kondo* is *not* undertaken by examining the trademark *per se*, but by making a comparison between *syohyo* and the third party’s *syohyo* taking into account all practical and commercial considerations¹¹²². Due to an inclusive nature of Article 4(1)(15) of the Japanese Trademark Act, unregistered *syohyo*, well-knownness of *syohyo*, and relationship to trade names are of concern; it is thus viewed as regulation of competition aspects of *syohyo*¹¹²³.

It is clearly set out that in order to judge if there is a *kondo no osore* in the course of business, all the relevant factors including the actual business situation and its transaction needs to be taken into consideration¹¹²⁴. Also, it should be noted that obviously, the assessments of *kondo no osore* do vary case-by-case (this author would like, in future research, to carry out an empirical study of each *kondo no osore* in Japan, but such research is clearly beyond the scope of this thesis).

¹¹²¹ See Item 3 of Chapter 3: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines.

¹¹²² See Ono, S, *supra* note 370 at 386.

¹¹²³ Toyosaki, M, *supra* note 1075 at 369.

¹¹²⁴ Item 7 of Chapter 3: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines.

The following is provided:

“2. To judge the liability of a trademark “likely to cause confusion in connection with the goods or services pertaining to a business of another person” the following *factors are comprehensively taken into consideration*.

- (a) *A degree of trademark being well-known (the degree or dissemination of advertisement, publicity, etc.);*
- (b) Whether the other person’s trademark is a *creative mark*.
- (c) Whether the other person’s trademark is a *house mark*.
- (d) Whether there is *the possibility of multiple businesses*.
- (e) Whether there is *any relationship between goods, services or goods and services*.

However, the judgment of above (a) may *not be well known throughout the country*.” [Emphasis added]¹¹²⁵.

The first criterion is known to include a degree of famous-ness or ‘syuchi’ of marks¹¹²⁶. Historically speaking, it is widely understood that a higher standard of well-knownness of marks than that of Article 4(1)(10) of the Japanese Trademark Act was required, the higher standard of a near-nationwide scope of well-knownness, as this Article can be applied to situations where dissimilar goods or services are at issue. However, the requirement that marks be highly well-known is not an absolute requirement, thus the proviso was added to confirm that this was so. This rather more generous standard of protection of *syuchi-syohyo* (i.e. protection even where the mark is not well-known throughout Japan¹¹²⁷) has been applied in recent cases. Note that

¹¹²⁵ The last proviso was added in 1997 to provide more guidance to the criterion (a).

¹¹²⁶ It is submitted that the well-known trademarks are too famous to be confused; therefore the possibility of the likelihood of confusion becomes smaller. Therefore, the conclusion is that well-known trademark is not dealt with in confusion doctrine. However, Article 4(1)(15) is applied based on the assumption that because well-known trademarks contain stronger distinctiveness and attractiveness to consumers than that of ordinary marks, the possibility of causing the likelihood of confusion might also be greater. It can be therefore inferred that Article 4(1)(15) is implemented as the protector of well-known trademarks in Japan.

¹¹²⁷ Tokyo High Court, Heisei 9nen, (Gyo Ke) dai 323go, sokuho 283-8377, and; Tokyo High Court, Hisei 9nen, (Gyo Ke) dai 266go, sokuho 286-8524.

here again we have some correlation between *kondo* and *concept* (distinctiveness) of *syuchi-syohyo*.

The next criterion to be considered is if a mark is a so-called coined mark, such as ‘LEXUS’,¹¹²⁸ ‘SANRIO’,¹¹²⁹ and ‘SONY’¹¹³⁰. It is generally said that if a mark is coined, distinctiveness of the mark tends to be stronger than that of a generic mark i.e. ‘APPLE’ or ‘OASIS’.¹¹³¹

The third criterion to be considered is if a mark is a house mark or not¹¹³², examples of such being ‘MITSUBISHI’ or ‘HONDA’¹¹³³. For example, in the registered word trademark ‘NINTENDO WII’¹¹³⁴, ‘NINTENDO’ is a house mark and ‘WII’ is known as a pet mark¹¹³⁵; in ‘TOYOTA COROLLA’¹¹³⁶, ‘TOYOTA’ is a house mark¹¹³⁷ and ‘COROLLA’ is a pet mark. Although pet marks are generally seen as being less distinctive than house marks, all factors are to be taken into consideration in assessing distinctiveness ((well-known) *syohyo concept*) of pet marks¹¹³⁸.

The fourth criterion to be considered is that of a possibility of expanding business, for example, the proprietor of ‘BRIDGESTONE’,¹¹³⁹ tyres might start producing automobiles. Examples of this have occurred in recent times, e.g. ‘PRADA’,¹¹⁴⁰ has launched a new line for mobile phones.

¹¹²⁸ The word mark ‘LEXUS’ is granted as a registered *syohyo* in Japan; the Japanese Trademark Registration Number 2141029.

¹¹²⁹ The word mark ‘SANRIO’ has been granted as a registered *syohyo* in Japan; the Japanese Trademark Registration Number 1273271.

¹¹³⁰ The word mark ‘SONY’ has been granted as a registered *syohyo* in Japan; the Japanese Trademark Registration Number 491710.

¹¹³¹ See Ono, S, *supra* note 370 at 393; and Kudo, K, *supra* note 1041 at 315.

¹¹³² The classifications and explanations of ‘trade mark’ *syohyo* in Japan are to be found in Chapter 2, Section 2.3.3.

¹¹³³ See *supra* note 293.

¹¹³⁴ The word mark ‘NINTENDO WII’ has been granted as a registered *syohyo* in Japan; The Japanese Trademark Registration Number 4992561.

¹¹³⁵ The definition of ‘pet-mark’ is introduced by Ono, S, *supra* note 370 at 14-15.

¹¹³⁶ The word mark ‘TOYOTA COROLLA’ is granted as a registered *syohyo* in Japan; The Japanese Trademark Registration Number 1338848.

¹¹³⁷ See Appendix 2 and Chapter 2, Sections 2.2.1-2.2.2 for the illustration of an example of the registered word trade mark ‘TOYOTA’.

¹¹³⁸ Supreme Court, the Third Petty Bench, Heisei 10nei, (Gyo Hi) dai 85go, Hanrei joho 1721go at 141 (known as the L’Air Du Temp jiken), see *infra* notes 1086 and 1093 for a main discussion.

¹¹³⁹ The word mark ‘BRIDGESTONE’ is granted as a registered *syohyo* in Japan; The Japanese Trademark Registration Number 3002230.

¹¹⁴⁰ The word mark ‘PRADA’ is granted as a registered *syohyo* in Japan; the Japanese Trademark Registration Number 5737696.

Finally, the similarity between categories of goods and services, in which trademarks are used, ought to be considered (this criterion was introduced in 1992). For example, an association between watches and clothes was found to satisfy this criterion, since they are two related categories of use¹¹⁴¹.

Even where all these criteria are satisfied, it does not mean that a court will find that there has been *kondo no osore*: the judgement must be made on a comprehensive basis and all relevant factors needs to be considered from the perception of the average consumer¹¹⁴². Thus, there does not seem to be any dominant criterion, and it is submitted by this author that there seems no overriding criterion for the determination of ‘*kondo*’, which – as a result – means that the scope of *kondo* is somewhat uncertain.

Now, Item 5 of Chapter III: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines will be critically examined; since this author argues that this is where the strongest protection for ‘*syuchi-syohyo*’ can be found in modern *kondo* theory.

“...*a combination of another person’s registered trademark “well known among consumers” and other characters or diagrams are, in principle, handled so that it may cause confusion in the source of the goods or services...*”¹¹⁴³ [Emphasis added by this author].

As noted in Section 5.3.1, Article 4(1)(19) of the Japanese Trademark Act was intended to introduce more protection for *syuchi-syohyo*: here, *kondo* is automatically assumed to arise when part of a *syuchi-syohyo* is employed in a trademark application by a third party. The introduction of Article 4(1)(19) was felt to be necessary as, earlier there was not a consistent or cohesive approach to *kondo* in this context¹¹⁴⁴.

¹¹⁴¹ Tokyo High Court, Showa 63nen, (Gyo Ke) dai 100go, shinketsu rotikeshi-syu (6) P399 (known as PIAGE sya jiken).

¹¹⁴² *Ibid.*

¹¹⁴³ The relevant text of Chapter III: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines is to be found in Appendix 6.

¹¹⁴⁴ Kudo, K, *supra* note 1041 at 315.

How Article 4(1)(19) of the Japanese Trademark Act operates in practice can be illustrated in the exemplars set out below of successful and unsuccessful trademark applications where a *syuchi-syohyo* formed part of the trademark application in question.

A trademark application for a word mark ‘NOEL.VOGUE’ for women’s wear was not granted, it was stated that there was *kondo no osore* that the consumer might mistakenly think there was a business or commercial relation between a *syuchi-syohyo* ‘VOGUE’ (which is a well-known fashion magazine) and the mark in the trademark application¹¹⁴⁵. A trademark application for ‘ROYAL PRINCE POLO CLUB’ was refused as a *kondo no osore* was found in relation to the *syohyo* ‘POLO’,¹¹⁴⁶ by means of the same principle, namely, confusion of business or commercial relation between two marks was established¹¹⁴⁷. Also, a trademark application for ‘ILANCEL’ was refused by reference to the *syohyo* ‘LANCEL’ using the same reasoning as these first two cases¹¹⁴⁸. An exemplar that concerned Japanese *kanji* symbols, was an application for ‘金盃菊正宗 (kinpai-kikumasanune)’ for alcoholic beverages (in this case, refined *sake*), was refused for a *kondo no orore* with the *syohyo* ‘菊正宗 (kikumasanune)’ (for refined *sake*) for the same reasons¹¹⁴⁹. There are a great many other such cases.¹¹⁵⁰.

However, when a *syuchi-syohyo* is too famous to be confused, it has been noted that a finding of *kondo no osore* might actually become less likely¹¹⁵¹. Therefore, the Japanese Trademark Act cannot be regarded as fully addressing *syushi-syosyo* in

¹¹⁴⁵ Tokyo High Court, Heisei 9nen, (Gyo Ke) dai 278go, hanjirei jiho 1669go at 129.

¹¹⁴⁶ Tokyo High Court, Heisei 11nen, (Gyo Ke) 290go, Sokuho 297-9181.

¹¹⁴⁷ There are a significant number of cases with regard to the famous trademark ‘POLO’, at least 53 litigations reported between 1999 and 2003.

¹¹⁴⁸ Tokyo High Court, Heisei 11nen, (Gyo Ke) dai 217go, Sokuho 298-9218.

¹¹⁴⁹ Tokyo High Court, Heisei 13nen, (Gyo Ke) dai 494go, Sokuho 32-10797.

¹¹⁵⁰ There are a great number of cases considering *kondo*. Listing all relevant examples here are beyond the scope of this section, thus limited number of examples includes: ‘LOREAL’ and ‘LÓREAL’; ‘MEIJI’ and ‘Meiji’; ‘Polo club’ and ‘Polo By Ralph Lauren’; ‘alfredo versace’ and ‘VERSACE’; ‘ホテルゴーブルリツ (Hotel gorful Ritz)’ and ‘RITZ’; ‘レールデュタン (transliteration: l’air du temp)’ and ‘レールデュタン. L’AIR DU TEMPS’; ‘イルガスロン (Transliteration: il gas ron)’ and ‘ガスロン(Gas ron)’; ‘パーソニー (Transliteration: per sony) and ‘ソニー(SONY)’; ‘カゼコーラック(Kaze-korakku)’ and ‘コーラック(korakku)’ ゲラン/GUERIN’ and ‘ゲラン/ GUERLAIN’; ‘主婦乃友 (shuhu no tomo)’ and ‘主婦の友 (shuhu no tomo)’; ‘住友美人 (Sumitomo bijin)’ and ‘住友 (sumitomo)’; ‘ヤハタパネル (yahata panel)’ and ‘YAHATA’.

¹¹⁵¹ Doi, K, ‘Syohyo ho 4jyo 1kou 15jyo ni kiteisu kondo no igi’ (1995) 4 *Chizai Kanri* 589-593.

relation to *kondo* doctrine. In relation to this point, the author of this thesis would like to remind the reader that a *syuchi-syohyo* is meant to grant superior protection than the ordinary *syohyo* in the Trademark Act.

Above all, it might well be concluded that ‘*syuchi-syohyo*’ might enjoy the stronger protection under Article 4(1)(15) of the Japanese Trademark Act¹¹⁵², although assessments of ‘*syuchi-syohyo*’ and *kondo* are based on non-exclusive fact-based criteria¹¹⁵³, thus assessments and results of ‘*syuchi-syohyo*’ and *kondo* are likely to vary case-by-case¹¹⁵⁴.

5.4.4 ‘*Kondo*’ – Practice

So far, this author believes, it can be said that there is no clear and consistent definition of *kondo* in the context of *syuchi-syohyo* to be found in the Act or the Guidelines. A critical consideration of how legal commentators view *kondo* is the purpose of this Section, thereafter this author will turn to a critical consideration of *syuchi-syohyo kondo* practice.

In the administrative context, the assessment of *syuchi-syohyo* is left to the trademark examiner¹¹⁵⁵. However, it seems rather difficult for examiners to gather the required evidence for these assessments, therefore, *syohyo* and *syuchi-syohyo* owners do need to be pro-active here¹¹⁵⁶. In Japan that whether or not *syohyo* or *syuchi-syohyo* is at risk of *kondo* is to be assessed by not only considering marks and goods and services *per se*, but also the circumstances in the business world¹¹⁵⁷. In determining *kondo*, the similarity of marks and/or the similarity of goods or services are not absolute factors. It is enough to judge whether there is a concrete likelihood of confusion with goods or services connected with another person’s business. Particularly, in the case of a

¹¹⁵² Ono, S, *supra* note 370 at 393. Having said this Article is intended to protect well-known trademarks, the majority of legal academics still consider that well-known trademark protection should be dealt with in Article 2(1)(1) of the Japanese Unfair Competition Prevention Act.

¹¹⁵³ Assessments of *kondo* is examined by the distinctiveness criterion (equivalent to ‘well-knownness’).

¹¹⁵⁴ Nishi, H, ‘Chomei syohyo wo hukumi syohyo to dedokoto kondo no osore’ (2002) 52 *Chizai Kanri* 361-371 at 369.

¹¹⁵⁵ Yamamoto, Y, *Yosetsu Fusei kyoso boshi ho* (Tokyo, Hatsumei kyokai, 2003) at 65-67 and 101-108. Thus the individual views of the examiner in question may be a factor to be considered.

¹¹⁵⁶ Doi, K, *supra* note 1077.

¹¹⁵⁷ Katsume, T, ‘Syohyo ho niokeru kondo gainen no bunse’ (1996) 3 *Patent* 25-31 at 26.

syuchi-syohyo, *kondo* can extend beyond the range of similar goods or services, and can apply to dissimilar goods and services where these are areas where the business affected could diversify.

As demonstrated in Sections 5.4.1-5.4.2, a broad approach to ‘*kondo*’ is deemed to be in favour in the Japanese courts, e.g. a registration for the word *syohyo* ‘SONY’ for food products was refused on grounds of *kondo* with ‘SONY’ (the *syuchi-syohyo* for electronic equipment)¹¹⁵⁸. In the context of this exemplar, the author would like to note the introduction of Article 4(1)(19) in 1996 and the implementation in 1997, as opposed to the earlier *syuchi-syohyo* under Article 4(1)(15) (which can be seen as equivalent to Articles 2(1)(5) and (11) under the old law of the Trademark Act of 1921¹¹⁵⁹).

Some further exemplars might be instructive. A *syohyo* registration of a mark ‘常盤 ハワイアンセンター (jyoban Hawaiian centre)’ for printed matters, identical to the earlier well-known service *syohyo* ‘常盤ハワイアンセンター (jyoban Hawaiian centre)’ for spa resorts, was refused (A mark ‘常盤ハワイアンセンター (jyoban Hawaiian centre)’ was advertised in various means and printed in leaflets, calendars, postcards and so on, thus ‘常盤ハワイアンセンター (jyoban Hawaiian centre)’ was well-known as a name of the spa resort¹¹⁶⁰). Other interesting cases, which are regarded as being exemplars of the modern, stronger protection for *syuchi-syohyo*¹¹⁶¹, show *kondo* in the context of endorsement of *syohyo* – trademarks (a trademark merchandising relation) was recognised. For example, the registration of a mark ‘GIANTS’ for beverages was refused due to the *syuchi-syohyo* for the baseball team ‘GIANTS’: it was held that there was *kondo* here as consumers might assume that there was an endorsement relation between drinks bearing the mark ‘GIANTS’ and

¹¹⁵⁸ Showa 40nen 10gatsu 20ka, Showa 36nen shinpan dai 654go (known as SONY FOOD jiken). See *infra* note 1083 for a more detailed explanation. In this case, such an interesting comment, in the view of this author, can be found: “*Trademarks are said to be alive*; the substance of trademarks changes over time; thus characteristics of trademarks, inevitably change.” This comment is, in the view of this author, very interesting, since it implies the functions of trademarks might be the subject of change.

¹¹⁵⁹ See Section 5.2.1.

¹¹⁶⁰ Showa 56nen 8gatsu 11nichi, Showa 50nen shinpan dai 6097go 2119go.

¹¹⁶¹ See Kudo, K, *supra* note 974 at 167.

the baseball team ‘GIANTS’, thus causing indirect confusion as to the source of origin¹¹⁶².

This author has noted that in trademark cases, increasingly broader interpretations of *kondo* are being employed¹¹⁶³. *Kondo* is being found where consumers will be mistakenly led to believe that there is some business connection or association including a parent-subsidiary relationship, business affiliation, and affiliate companies in terms of product merchandising¹¹⁶⁴, in other words, it can be said that Japanese courts are likely to interpret ‘*kondo*’ generously and broadly.

Furthermore, it is directly confirmed by the Supreme Court that:

“...trademarks which are liable to cause confusion in Article 4(1)(15) including a so-called likelihood of indirect confusion, where consumers mistakenly believe there is a business connection i.e. parent-subsidiary relationship, group companies, business corporate relationship in terms of product merchandising, and associated companies between two marks in question. This broader interpretation is to satisfy the aim of Article 4(1)(15), which is to prevent free-riding on well-known and/or famous marks, and dilution. By doing so, it protect a distinguishing function of trademarks, trademark owners reputation and goodwill, and hence ultimately protect interests of consumers. Taking into consideration the modern business environment, such as product merchandising, where the same trademark is used by different licensees, an establishment of famous so-called brands, and the fact that effective (well-known and famous) trademark life tends to fluctuate according to changes in time and economy¹¹⁶⁵. As a consequence, in order to provide the appropriate protection for well-known and famous mark owners, a

¹¹⁶² Tokyo High Court, Heisei 9nen, (Gyo Ke) dai 139go, Tokkyo News Heisei 10nen 6gatu 25, 29nich and 7gatsu 1ka.

¹¹⁶³ SONY FOOD jiken, *supra* note 1154. A *syohyo* application ‘SONY’ for food and noodles, which is identical to the earlier *syohyo* ‘SONY’ (famous for electric equipment), was refused as a result of the broader interpretation of *kondo* being employed.

¹¹⁶⁴ The Supreme Court, Showa 56nen, 9(O) dai 1166 go, hanrei jiho 1119go at 34.

¹¹⁶⁵ *Ibid.*

likelihood of indirect confusion shall be regarded as a ground for refusal...”¹¹⁶⁶

Further, the Court continued:

“...An existence of a likelihood of confusion shall be comprehensively judged by the perception of average consumers’ attention, and the following shall be taken into considerations:

- (i) Similarity between two marks¹¹⁶⁷;
- (ii) A degree of mark being well-known and mark being coined; and
- (iii) Similarity between products or services, purposes and methods of which marks are in use and a range of the targeted consumers”¹¹⁶⁸.

A critical comparative analysis of confusion and *kondo* will be developed in Chapter 6, but it can be noted here that the Japanese judicial approach to *kondo* does seem rather similar to that taken by the ECJ (see Chapter 4). The criteria submitted by both jurisdictions are very similar. In this respect, despite the differences noted in this Chapter, there may be strong similarities in the approach to confusion in the CTM system and *kondo* in the Japanese system.

The author would like to provide further examples of *kondo* cases. A recent judicial decision affirmed the applicability of Article 4(1)(15). The *syohyo* in question was comprised of a *kanji* symbol ‘*kome*’ (an English translation is rice: 米) in a circle and

¹¹⁶⁶ L’Air Du Temps jiken, *supra* note 1134.

¹¹⁶⁷ A brief note regarding to the Japanese linguistic point to assess the similarity between two marks, needs to be noted here: As was previously noted in Section 6.2.2, the Japanese linguistic exercises shall be undertaken as for the further understanding of the Japanese position in *kondo* doctrine. In spoken Japanese, there is no distinction between English alphabet ‘R’ sound and ‘L’ sound for native Japanese speakers. In addition, the ‘TH (θ)’ sound does not exist in the Japanese language. The ranges of trademarks can be unlimited since the written Japanese trademarks can be comprised of the combination of *Kanji* symbols, *Hira-kana*, *Kata-kana*, and English alphabets (and/or pictorial symbols). Placing this in written Japanese trademarks, therefore, can be confusing since, for example, there is a difference between ‘R’ and ‘L’ as in pictorial symbols, but *not* in when pronounced (an appellation). Placing the Japanese Trademark Act in its *linguistic* context has a significant impact on our understanding of the assessment of *kondo* in Japan. Armed with this knowledge, we can now turn to the overriding subject of this thesis, ‘*kondo*’.

¹¹⁶⁸ L’Air Du Temps jiken, *supra* note 1134.

the wording ‘*maruyone*’ (“rice in a circle,” in *kata-kana* beneath the circle.)¹¹⁶⁹ Another recent judicial decision denied the applicability of Article 4(1)(15) of the Japanese Trademark Act. In this case, the decision was made based on the fact and the Court ruled that there was no *kondo* between the registered *syohyo* ‘NOVIGEN’ (in *kata kana*: ノービゲン, used for a vinyl house cleaner) and the famous ‘Bigen’ (in *kata-kana*: ビゲン) for hair dying cream¹¹⁷⁰. In another case, the applicability of Article 4(1)(15) was also denied since there was no *kondo* between ‘Sanansonii’ (in *kata-kana*: サナンショージ) and ‘SONY’ (in *kata-kana*: ソニー)¹¹⁷¹. Finally, a lower appellate decision applying Article 4(1)(15) considered the possibility of *kondo* between ‘PORA’ (in *kata-kana*: ポーラ), which is an abbreviation of ‘PORALOID’ (in *kata-kana*: ポラロイド), and ‘POLA’. It was decided that ‘PORA’ is not fixed as the abbreviation of “Polaroid”¹¹⁷², thus there was no *kondo* between the two *syohyo*.

Another interesting example of the assessment of *kondo* is to be found in a case known as the ‘*L’Air du Temps*’ jiken¹¹⁷³ under the Unfair Competition Prevention Act.

Although the consideration of this Act is beyond the scope of this thesis, the author notes this decision because the approach taken by the Court here appears, in the view of this author, to be very dissimilar in wording but similar in principle to the ECJ global appreciation approach in the CTM confusion¹¹⁷⁴. There are three main points that can be taken from the *L’Air du Temps* jiken (case):

- The following can give rise to a risk of *kondo*: the business of commercial organisations being connected in terms of close business relations, such as parent-subsidiary companies or family companies with the other party or in a relationship of subordination to the group involved in commercial operations employing the same labelling. That is to say, risk of confusion is perceived in a broad sense;

¹¹⁶⁹ Tokyo High Court, Heisei 8nen, 2gatsu 15nichi, 250-7077go.

¹¹⁷⁰ Tokyo High Court, Heisei 7nen, 11gatsu 22nichi, 27kan 4go at 855.

¹¹⁷¹ Tokyo High Court, Heisei 8nen, 3gatsu 27nichi, 250-7123go.

¹¹⁷² Tokyo High Court, Heisei 8nen, 2gatsu 7ka, 250-7027go.

¹¹⁷³ *L’Air Du Temps* jiken, *supra* notes 1134 and 1164. This interpretation is very similar to the ECJ decision, that is to say, global appreciation approach.

¹¹⁷⁴ See Chapter 5.

- The aim of Article 4(1)(15) is stated: it is intended to preserve the business trust of the third party using the *syohyo*, and also to protect the interests of consumers by preventing said third party from ‘free-riding’ in relation to a *syuchi-syohyo* (and, thus, to prevent the dilution of said *syuchi-syohyo*);
- The consideration of a risk of *kondo* must be a comprehensive one, considering (i) the extent to which there is similarity between the *syuchi-syohyo* and the third party’s *syohyo*; (ii) the labelling employed (and the extent to which the labelling of the earlier *syohyo* is generally known and the extent of its originality); (iii) the extent to which the designated goods or services of the applicant’s mark are related to the *syuchi-syohyo* in terms of character, use, or purpose, and (iv) other conditions with a bearing on business such as similarities in terms of dealers in the goods and the intended consumers (but this depends on the extent to which said dealers and consumers generally pay attention to the *syohyo*)¹¹⁷⁵.

A likelihood of *kondo* including likelihood of association seems to occur where a defendant misappropriates the advertising value of *syohyo* and uses it on his non-competing but related goods¹¹⁷⁶, where such use might create a false impression in the mind of consumers, in relation to the origin including the sponsors and affiliations¹¹⁷⁷. It is said that a claim for *kondo* in relation to sponsorship serves to protect the reputation of the goods and goodwill of the trademark owner¹¹⁷⁸. Also it was determined that the Trademark Act provides a legal protection for business goodwill¹¹⁷⁹. However, it might be elucidated that the current criteria determined by the case seems confined as to assessing the confusion.

Use of a similar *syohyo* by the defendant on its non-competing goods may lead the consumer to believe that the trade mark owner has some business connection with – or in fact sponsors – the defendant’s goods¹¹⁸⁰. This exposes the trade mark owner to

¹¹⁷⁵ *L’Air Du Temps* jiken, *supra* note 1134.

¹¹⁷⁶ JPO, *supra* note 984.

¹¹⁷⁷ Mostert, F, W, *supra* note 62.

¹¹⁷⁸ Tamura, Y, *supra* note 357 at 55.

¹¹⁷⁹ Katsume, T, *supra* note 1153 at 26.

¹¹⁸⁰ *Ibid.*

the likelihood that ill-repute of the defendant's goods will be visited upon the trademark owner's goods¹¹⁸¹, and such a situation may lead to *kondo* being found. Nevertheless, all this must be considered in the context that *kondo* is not comprehensively defined and that the judicial approach to *kondo* doctrine seems heavily influenced by the old law.

Finally, examples of evidential materials includes materials showing marketing activities (sales volume, monetary sales amount, etc.), business scale (company size, number of employees, number of stores, annual turnover etc.), distribution of posters, advertising through newspapers, magazines or television, results of storefront surveys, a fact of receiving a recommendation from an association and so forth, and a certificate of the fact by a public organisation. Not only in the case of *syuchi-syohyo* but also in normal cases as well, there are many times when a vast amount of evidence is required to show advertising activities, marketing status and so forth¹¹⁸².

Surveys (questionnaires) of the general public are considered as strong evidence for the purpose of evaluating if a trademark is well-known or famous, and there are some countries that adopt a system whereby *syohyo* are evaluated according to a percentage of their popularity¹¹⁸³.

It is submitted, in summary, that in the view of this author, the protection for '*syuchi-syohyo*' against *kondo* seems unclear and uncertain.

5.5 Conclusion

The main aim of this chapter has been to explore the Japanese framework of protecting '*syuchi-syohyo*' against *kondo* and to assess the efficacy of this.

As the lack of clarity on the definition of 'well-known trade mark' (see Chapter 3), 'trade mark of repute' (see Chapter 4) and '*syuchi-syohyo*'(see this Chapter), in the

¹¹⁸¹ Tamura, Y, *supra* note 357 at 55.

¹¹⁸² Yamamoto, Y, *supra* note 1151 at 65-67 and 101-108.

¹¹⁸³ See Item 3(1)(vi) of *o* Chapter III: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines.

view of this author, seems to address the essential question of ‘what constitutes ‘well-known trade mark’ by reference to the definition of ‘trade mark’ (see Chapter 2).

In this Chapter, in a similar structure to that taken in Chapter 4, the interpretation of ‘*syuchi-syohyo*’ and the protection afforded to ‘*syuchi-syohyo*’ against *kondo* was the main theme. It was mentioned that a Japanese translation of ‘well-known trade mark’ is ‘*syuchi-syohyo*’; and the transliterated term ‘*syuchi-syohyo*’ has been applied in this Chapter.

The examination of the Japanese approach to the protection of ‘*syuchi-syohyo*’ against *kondo* and the assessment of the certainty of the same in this Chapter infers to the conclusion that ‘*syuchi-syohyo*’ protection against *kondo* in Japan is not certain; and thus lacks clarity.

However, this author has submitted that not having a clear and comprehensive definition of ‘*syuchi-syohyo*’ and *kondo* might well be the casual causation of uncertainty.

The following have been presented:

- (i) The absence of any particular legal treatment of the protection afforded to ‘*syuchi-syohyo*’ against *kondo* in the Trademark Act (see Sections 5.3 and 5.4);
- (ii) Alternative routes available to protect ‘*syuchi-syohyo*’ against *kondo* seem to be in favour in Japan (see Section 5.2.3);
- (iii) The strong emphasis on non-exclusive criteria to determine whether and when a *syohyo* becomes a ‘*syuchi-syohyo*’ (see Sections 5.3.2-5.3.3), and;
- (iv) The strong emphasis on non-exclusive criteria to determine whether and when a *syohyo* is bound to be confusing identity and similarity (see Section 5.3.3).

Whether this lack of certainty and clarity is an acute problem, this is also not clear on the findings of this Chapter.

In the next Chapter, Chapter 6, a critical comparison of mainly (i) the definitions of ‘trade mark of repute’ and ‘*syuchi-syohyo*’, and confusion and *kondo*, and; (ii) the scope and clarity/certainty of protection afforded to both ‘trade mark of repute’ and ‘*syuchi-syohyo*’ against confusion and *kondo* will be undertaken.

This author will then consider what can be learned from these two systems in terms of the future development of well-known trade mark protection.

Chapter 6 Comparative Analysis

6.1 Introduction

Thus far, arguments have been presented relating to:

- (i) The definitions of ‘well-known trade mark’ at a national (i.e. Japan, see Chapter 5), a regional (i.e. the CTM, see Chapter 4) and the international levels (see Chapter 3)¹¹⁸⁴, and;
- (ii) That the protection of trade marks of repute and *syuchi-syohyo* against confusion (in the EU) and *kondo* (in Japan) can be criticised.

In particular, in Chapter 2, the definition of ‘trade mark was considered, and in Chapter 3 critical consideration was given to the definition of ‘well-known trade mark’ at the international level. The protection of trade marks of repute against confusion and *syuchi-syohyo* against *kondo* were then critically considered in Chapters 4 and 5.

Now, a critical comparison between the positions set out in the CTM system and the Japanese trademark system will be carried out. It should be noted that although the avowed aim of this thesis is to critically compare the scope and degree of certainty of the protection afforded to trade marks of repute/*syuchi-syohyo* against confusion/*kondo*, the implicit purpose of this comparison is to consider what can be learned from these two systems in terms of the future development of well-known trade mark protection.

This Chapter is structured as follows:

- Comparison of the scope, clarity and function of well-known trade mark protection in the EU CTM system and Japan will first be undertaken;

¹¹⁸⁴ This author has, more particularly, pointed to the deficiencies and uncertainties of the same.

- Critical consideration as to how these two jurisdictions differ in their approach to trade marks of repute and *syuchi-syohyo*, and, confusion and *kondo* will be offered;
- Then, consideration and comparison as to the similarities between these two jurisdictions as to in their approach to trade marks of repute against confusion (and of *syuchi-syohyo* against *kondo*) will be offered, and finally;
- Some consideration of the question: is it necessary (or helpful) to have clear and comprehensive definitions of ‘well-known trade mark’ and ‘confusion’?

This author employs comparative legal analysis¹¹⁸⁵ in this Chapter. Needless to say, a detailed examination of the merits and (various) methodologies of comparative law *per se*, or indeed comparative trade mark law in particular, is beyond the scope of this Chapter. However, given that the author has chosen to utilise comparative methodology, it seems appropriate to note here some of the generally-accepted benefits of comparative law: (i) as an aid to legislators¹¹⁸⁶; (ii) as a tool of construction¹¹⁸⁷; (iii) as an component of the curriculum of the universities and law schools¹¹⁸⁸, and; (iv) as contribution to the systemic unification of law¹¹⁸⁹. Furthermore, it can be said that the method of comparative law “...can provide a much richer range of model solutions than a legal science devoted to a single nation, simply because the different systems of the world can offer a greater variety of solutions...”¹¹⁹⁰: it is here that the central benefit of comparative methodology to this thesis is to be found – in other words, the author hopes to enhance her ability to

¹¹⁸⁵ See for example, Hoechke, M, *supra* note 75. Also see Saidov, A, *Comparative Law* (London, Wildy, Simmons & Hill, 2003).

¹¹⁸⁶ By following the methodology the two questions will be asked in the end of this chapter:

- Whether it will work in the country in its country of origin;
- Whether it will work in the country where it is proposed to adopt it.

¹¹⁸⁷ It is said that it must be said that comparative law has a much greater role to play in the application and development of law than that courts yet allow, the situation is rather better when uniform laws are being interpreted, such laws normally resulted from international conventions, governmental co-operation, or *supranational* or international legislation, and since the underlying aim is to unify the law, their construction and development must be geared to this goal. See Zweigert, K, and Kötz, H, *supra* note 75 at 19.

¹¹⁸⁸ It is evaluated that the aim of this unification is to reduce or eliminate, so far as desirable and possible, the discrepancies between the national legal systems by inducing them to adopt common principles in law. One of advantages of unified law is that it makes international legal business easier. See *ibid* at 23.

¹¹⁸⁹ *Ibid* at 15.

¹¹⁹⁰ *Ibid*.

critique and offer possible directions for legal reform of well-known trade marks by making a comparison of the EU and Japanese systems.

Now that advantageous aspects of comparative analysis have been noted, this author will now undertake the comparison of EU and Japanese trademark laws.

6.2 ‘Well-Known Trade Mark’

In Chapter 3, ‘well-known trade mark’ within the international statutes¹¹⁹¹ was critically examined. The conclusion made by this author was that the notion of ‘well-known trade mark’ is not clearly and consistently defined at the international level: so, we do not know from this exactly what a ‘well-known trade mark’ *is*. In short, the international regime provides an imperfect yardstick by which to judge the definitions of trade marks of *repute* and *syuchi-syohyo* (to be found in the CTM and Japanese systems, respectively). Consequently, the Definition Model, as developed in Chapter 2, becomes the *de facto* yardstick by which this author compares these concepts analogous to ‘well-known trade mark’ (although, obviously, consideration of the international guidance on defining ‘well-known trade mark’ remains important).

6.2.1 The Definition Model

Before undertaking the comparison of the definitions of ‘trade marks of *repute*’ and ‘*syuchi-syohyo*’, this author would like to remind the reader of the contents of the Definition Model¹¹⁹²:

- Well-known trade mark *form* consists of trade mark *type* and trade mark *context*;
- Well-known trade mark *concept*, is a high level of distinctiveness, and;
- The two *preconditions* are *graphical representation* and *commercial use*.

¹¹⁹¹ The relevant laws here are the Paris Convention (Chapter 3, Section 3.2.1), GATT TRIPS (Chapter 3, Section 3.2.2) and the WIPO Recommendation (Chapter 3, Section 3.2.4).

¹¹⁹² See Chapter 2, Section 2.2.

This author has submitted that, as with ‘trade mark’, ‘well-known trade mark’ *form* (*type* and *context*) should be defined inclusively and should take an incremental approach, thus allowing the subject-matter of trade marks to change in reflection of economic and social changes. (Well-known) trade mark *concept*, unlike trade mark *form*, should – it is submitted – be defined in such a manner so as to invite legal certainty.

Now, a reconsideration of the definition of ‘well-known trade mark’ at the international level will be presented.

6.2.2 ‘Well-Known Trade Mark’ – the International Level

A composite definition of ‘well-known trade mark’ at the international level proposed by this author and derived from the Paris Convention¹¹⁹³, GATT TRIPS¹¹⁹⁴ and the WIPO Recommendation¹¹⁹⁵ has been offered¹¹⁹⁶. The fact that it was necessary to mosaic or combine these three instruments so as to provide a picture of the definition of ‘well-known trade mark’ at the international level is, it is submitted, *de facto* evidence of the lack of clarity and certainty claimed in Section 6.2 above. The composite definition is:

‘Well-known trade mark *form* explicitly includes registrable trade marks, service marks, business identifiers and domain names. Well-known trade mark *concept* lies in the consideration of to what extent a mark is well-known (well-knownness) which

¹¹⁹³ This author sets out a summary of the Paris Convention as follows: no comprehensive and conceptual definition of ‘well-known trade mark’ is provided. *Form* of well-known trade mark, it is submitted that guidance in the Paris Convention as to the *form* of ‘trade mark’ can be used to infer the *form* of ‘well-known trade mark’. It is submitted that *concept* of ‘trade mark’ is present, however, there are no provisions on *concept* that are particular to well-known trade marks, so, exercising the assumption that we can infer the latter through the former, we can say that (well-known) trade mark *concept* is distinctive character, and that such distinctive character needs (at least) to be national in nature. See Chapter 3, Section 3.2.1.

¹¹⁹⁴ This author outlines the summary of GATT TRIPS as follows: In Article 16 of GATT, TRIPS both *form* (*context*) and *concept* of ‘well-known trade mark’ can be recognised. Firstly, the *form* of ‘well-known trade mark’ recognised is limited to *context* (there is no explicit reference to *type*): i.e. the reference to service marks in Article 16(2). Secondly, at first reading, *concept* of ‘well-known trade mark’ in the Definition Model does not appear to be found in GATT TRIPS as the term ‘distinctiveness’ is not used. However, unlike in the Paris Convention, some explicit guidance as to when a mark is well-known is provided, that is recognition of marks. See Chapter 3, Section 3.2.2.

¹¹⁹⁵ In the view of this author, this division is necessary as the WIPO Recommendation is not legally binding. See further Chapter 3, Section 3.2.4 for nature of the WIPO Recommendation.

¹¹⁹⁶ See Chapter 3, Section 3.2.4.

is submitted to relate to distinctiveness. Factors that may be used in assessing whether a mark is well-known or not include: the degree of knowledge or recognition of the mark in the relevant sector of the public; the duration, extent and geographical area of any use of the mark, promotion of the mark, trade mark registration or applications, a record of successful enforcement of rights in the mark, and the value of the mark.¹¹⁹⁷.

The above noted composite definition of ‘well-known trade mark’ contains some elements of the Paris Convention, GATT TRIPS and the WIPO Recommendation. As was examined in Chapter 3, with reference to the Definition Model, ‘well-known trade marks’ under the Paris Convention are simply trade marks that are well-known in the country of registration or use. Thus, there is no explicit specific guidance as to *form* or *concept* of ‘well-known trade mark’ here. ‘Well-known trade marks’ under GATT TRIPS are trade marks (including service marks) for which there is sufficient knowledge in the relevant sector of the public (including knowledge obtained as a result of promotion of the trade mark). Service marks are explicitly included. There is some attention to *context of form* and the *concept* lies in knowledge. However, (well-known) trade mark *preconditions* are not addressed in GATT TRIPS. The composite definition also contains some elements of the WIPO Recommendations in particular, the criteria as to assess whether the mark is well-known or not¹¹⁹⁸.

6.3 A Comparison of ‘Trade Mark of Repute’ and ‘*Syuchi-Syohyo*’

There is, thus, no single international instrument that clearly defines ‘well-known trade mark’, although the WIPO Recommendation does provide a significant amount of guidance as how to determine whether a particular mark is well-known. Perhaps (although a causal relationship is not evidenced in this thesis), this is the reason for the lack of clarity to be found in the local definitions of ‘well-known trade mark’ that are considered in this thesis: ‘trade mark of repute’ under the CTMR¹¹⁹⁹; and ‘*syuchi-syohyo*’ under the Japanese Trademark Act¹²⁰⁰.

¹¹⁹⁷ See Chapter 3, Section 3.3.

¹¹⁹⁸ Article 2 of the WIPO Recommendation.

¹¹⁹⁹ Articles 8(5) and 9(1)(c) of the CTMR.

¹²⁰⁰ Articles 4(1)(10) and 4(1)(19) of the Japanese Trademark Act.

The author will now consider and compare the extent to which the definitions of ‘trade mark of repute’ and ‘syuchi-syohyo’ in the CTM and Japanese systems match the various elements of the Definition Model.

6.3.1 The *Form* of ‘Trade Mark of Repute’ and ‘Syuchi-Syohyo’

In Chapter 4, ‘well-known trade mark’ at the regional level – under the CTM – was examined, and the fact that the terminology of ‘well-known trade mark’ is not used in the EU regime, has been noted. The term ‘trade mark of repute’ is used instead within the EU trade mark regime, and this term is regarded by this author as being equivalent to ‘well-known trade mark’ (although she does accept that there is a possibility that there are substantive as well as terminological differences)¹²⁰¹.

Now, this author will compare Article 8(5)¹²⁰² and corresponding Article 9(1)(c)¹²⁰³ in the CTMR¹²⁰⁴ and with Articles 4(1)(10) and 4(1)(19) of the Japanese Trademark Act relating to *form*. By way of introduction, thus author would like to note that the CTM Guidelines do provide a significant amount of explanatory comments regarding ‘trade mark of repute’, but that a very different structure and approach is taken in the equivalent JPO Guidelines¹²⁰⁵.

With respect to the CTM system, ‘trade mark of repute’ is outlined in Article 8(2)¹²⁰⁶, and includes: community trade marks¹²⁰⁷ defined in Article 4 of the CTMR¹²⁰⁸, marks being registered under the Benelux Trade Mark Office¹²⁰⁹ and international instrument¹²¹⁰, and well-known marks stated in the Paris Convention¹²¹¹. Community trade marks include signs under Article 3 of the CTMR, but excluded under Article

¹²⁰¹ For example, see *supra* note 642.

¹²⁰² Article 8(5) of the CTMR.

¹²⁰³ *Ibid*, Article 9(1)(c).

¹²⁰⁴ *Ibid*, Articles 8(5) and 9(1)(c).

¹²⁰⁵ See Appendices 2-6 for the relevant JPO Guidelines.

¹²⁰⁶ Article 8(2) of the CTMR.

¹²⁰⁷ *Ibid*, Article 8(2)(a)(i).

¹²⁰⁸ See Article 4 of the CTMR (any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.)

¹²⁰⁹ *Ibid*, Article 8(2)(a)(ii).

¹²¹⁰ *Ibid*, Article 8(2)(a)(iii).

¹²¹¹ *Ibid*, Article 8(2)(c).

^{7¹²¹²} is subject-matter such as mere description of the indications of trade origin or goods¹²¹³, a mark which has become common¹²¹⁴, inevitable shapes of the goods for technical reasons¹²¹⁵ or substantive value¹²¹⁶, emblems or national escutcheons¹²¹⁷ and geographical indication of wine or spirits¹²¹⁸. As public policy considerations are omitted in the definitional emphasis of the Definition Model, this author submits that *form* of a trade mark of repute in the CTM is thus:

- (i) *Type in form.* This includes any signs, including symbols, logos, slogans, get-up, personal names, designs, letters, numerals and the shape of goods or of their packaging¹²¹⁹ (see Chapter 4, Section 4.3.1.1) and;
- (ii) *Context in form.* This includes trade marks, service marks, geographic marks¹²²⁰, and certification marks¹²²¹ (see Chapter 4, Section 4.3.1.1).

One of the trade mark *preconditions (graphic representation)* is present in EU CTM system.

With reference to the Definition Model, *form (type and context)* of ‘syuchi-syohyo’ can be found within Articles 4(1)(10)¹²²² and 4(1)(19)¹²²³, it includes unregistered trade marks and any registered trademarks under Article 2(1) of the Japanese Trademark Act. This author submits that *form* of a *syuchi-syohyo* is thus:

- (i) *Types in form.* This includes ‘syohyo’ under Article 2(1) of the Act, such as characters, figures, signs, or three-dimensional shapes, or any combination thereof, or any combination thereof with colours, and;

¹²¹² *Ibid*, Article 7.

¹²¹³ *Ibid*, Article 7(1)(c).

¹²¹⁴ *Ibid*, Article 7(1)(a) and (d).

¹²¹⁵ *Ibid*, Article 7(1)(e)(i).

¹²¹⁶ *Ibid*, Article 7(1)(e)(ii).

¹²¹⁷ *Ibid*, Article 7(1)(i).

¹²¹⁸ *Ibid*, Article 7(1)(j).

¹²¹⁹ See *supra* note 254.

¹²²⁰ See *supra* notes 256 and 269.

¹²²¹ Phillips, J, *supra* note 37 at 604.

¹²²² The equivalent Japanese laws are in full: “Article 3 (1)(10) is identical with, or similar to, another person’s trademark which is well known among consumers as that indicating goods or services in connection with the person’s business, if such a trademark is used in connection with such goods or services or goods or services similar thereto;”

¹²²³ Article 4(1)(19) of the Japanese Trademark Act.

- (ii) *Context in form.* This is essentially the same as that to be found in relation to *syohyo* in Article 2(1) of the Japanese Trademark Act, and this therefore includes character marks, design marks, symbol marks, colour marks, three-dimensional marks, combined marks; and *context of form* of ‘trade mark’ includes merchandising marks, service marks, business marks, collective marks, geographical indications, grade marks, manufacturer marks, retailer marks, certification marks, family marks, coined marks, stock marks, and promotional marks (see Chapter 2, Section 2.3.3)¹²²⁴.
- (iii) Returning to trade mark *type in form* of ‘*syuchi-syohyo*’ – it is as that for *syohyo*, and as such is relatively narrow (see Article 2)¹²²⁵.

The trade mark *precondition of commercial use* is present in the Japanese trademark system.

Comparison of the CTM and Japanese Trademark regimes leads to the following inferences:

Overall, well-known trade mark *form* (*type* and *context*) in the CTM and the Japanese law are relatively similar in terms of well-known trade mark *form*; it can be said that *syuchi-syohyo form* in the Japanese Trademark Act is narrower than that of ‘trade mark of repute’ in the CTM, since non-traditional trade marks are highly likely to be excluded in the Japanese system (see Chapter 2, Section 2.3.3 and Chapter 5, Section 5.3.1.1), whilst the CTM system does recognise these marks as being part of a well-known trade mark *type* (see Chapter 2, Section 2.3.2, and Chapter 4, Section 4.3.1.1). It may therefore well be said the CTM approach seems to have a more flexible scope of well-known trade mark *form* than that of the Japanese trademark regime.

¹²²⁴ Trade mark subject matters are narrowly indicated in the Japanese law whilst the future expansion of trade mark subject matter in the EU regime is implicit in Article 4 of the CTMR. The non-traditional trademarks are highly unlikely to be protected. See also Item 4 of Part 2: Principal Paragraph of Article 3(1) of the Guidelines. In Japan, the functional aspects of trade marks can have an impact on the classification of trade marks. The legal aspect of ‘trade marks’ are seen in the statutory definition of ‘trade mark’ such as signs, symbols, characters, etc; see Article 2 of the Japanese Trademark Act. The functional aspect can be classified as character marks, design marks, symbol marks, colour marks, three-dimensional marks, combined marks with related to merchandising marks, service marks, business marks, collective marks, geographical indications, grade marks, manufacturer marks, retailer marks, certification marks, family marks, coined marks, stock marks, promotional marks. In the EU regime, on the other hand, the lesser categorisation of ‘trade mark’ can be seen.

¹²²⁵ See *supra* notes 292 and 997.

6.3.2 The *Concept* of ‘Trade Mark of Repute’ and ‘*Syuchi-Syohyo*’

This author has concluded¹²²⁶ that *concept* of ‘trade mark of repute’ under the CTMR can be implicitly defined as reputation and distinctive character (as noted above, such trade marks have to have *a reputation* in the Community or Member States, and the *distinctive character* or *the repute* of such marks is protected) (see Chapter 4, Section 4.3.1.2).

The Japanese Act does not directly speak of *concept* of ‘*syuchi-syohyo*’ therein, but the author has concluded that this can be inferred from *syohyo concept* as set out in Article 2 of the Japanese Trademark Act (i.e. distinctiveness¹²²⁷). It should be noted here that ‘distinctiveness’ is implicit in the *kanji* scripts for *syohyo*, and this term forms part of the phrase ‘*syuchi-syohyo*’). *Syuchi-syohyo concept* can also be implicitly defined as might be a high level of distinctiveness amongst consumers, with this distinctiveness being tested in relation to the geographical scope of knowledge, rather than by knowledge *per se*, of the *syuchi-syohyo*. Thus, this author proposes that ‘*syuchi-syohyo*’ *concept* constitutes a high level of geographically-defined distinctiveness amongst consumers (see Chapter 5, Section 5.3.1.2).

As a result, this author concludes that *concepts* of ‘trade mark of repute’ and ‘*syuchi-syohyo*’ are substantively similar: both relate to a highly level of distinctiveness which is derived from consumer knowledge. However, where these two regimes differ is that *concept* is approached from a broad knowledge perspective in the CTM¹²²⁸, whereas in Japan a narrower approach to consumer knowledge that relies on the geographical extent of knowledge¹²²⁹ is taken.

This author submits that the narrower approach of the Japanese law to *concept* is mitigated in practice by the alternative routes to *syuchi-syohyo* protection that were earlier noted¹²³⁰. As detailed consideration of these other routes is beyond the scope

¹²²⁶ Please see Chapter 4, Section 4.3.4.

¹²²⁷ See Chapter 2 Section 2.3.3.

¹²²⁸ See Chapter 4, Section 4.3.3.

¹²²⁹ See Chapter 5, Section 5.3.2.

¹²³⁰ See Chapter 5, Section 5.2.3.

of this thesis this author will in the next paragraph return to her critique of *concept* under the trade mark laws of the CTM and Japan. In any case, this author would argue that ‘*syuchi-syohyo*’ should be appropriately protected under the trademark laws, and she does not regard the fact that protection is available elsewhere to excuse the limited scope of the definition of *syuchi-syohyo* under the Trademark Act.

Despite the overall similarity, differences can be found in the approach to *concept* of ‘trade mark of repute’ and ‘*syuchi-syohyo*’. At this point, the author would like to postulate a possible philosophical difference (please note that in Chapters 4 and 5, this author largely considered legal, policy and practice aspects of the CTM and Japanese systems). This author is not in a position in this thesis to evidence this suggested philosophical difference, but she would like to note it here for interest and for the sake of completeness. One foundation for this suggested philosophical difference, it is submitted by this author relates to trade mark function¹²³¹. Here, the CTMR does explicitly refer to the indication of trade origin function¹²³², whilst there is no such equivalent explicit reference made in the Japanese Trademark Act¹²³³. The second such foundation is the difference in *concept* referred to above: the difference here between ‘trade mark of repute’ and ‘*syuchi-syohyo*’ (namely that in Japan this notion relates more narrowly to geographical scope). From these two observations, this author wonders whether the philosophy behind *concept* for trade marks of repute it might be ‘trade mark-oriented’ in the indication of origin sense, whereas in Japan this might be more usage, and therefore more ‘consumer-oriented.’ As a result, the Japanese definition of ‘*syuchi-syohyo*’ might, despite the narrower legal scope of the same, actually be interpreted in a more consumer-friendly way than the definition of ‘trade marks of repute’ in the CTM. These are suggestions that this author would like to pursue in more detail in future research.

Now moving to the *preconditions*, in the CTMR explicit reference is made *graphic representation* in Article 4 but *commercial use* is not stated within Article 4 of the

¹²³¹ Please note, as specified in Chapter 2, Section 2.4 that critical analysis of trade mark function is beyond the scope of this thesis.

¹²³² *Supra* note 745, and see Chapter 4, Section 4.3.3. There is no equivalent proviso in the Japanese law to the Preamble of the CTMR.

¹²³³ However, the reader has already been made aware that there is a strong implicit emphasis on indication of origin as one of trade mark functions in the Japanese Act, *supra* note 1003 and see Chapter 2, Section 2.2.3.

CTMR. In contrast, in Japan *commercial use* is explicitly present in the Japanese Act¹²³⁴, but *graphic representation* is not explicit (being, instead, linguistically implicit, as seen in Chapter 2, Section 2.3.3). This author suggests that the different position on *commercial use* probably has very little import in practice: in relation to *commercial use*, in the CTM, as marks cannot be registered in bad faith and non-use can be a ground for trade mark revocation¹²³⁵. In relation to made *graphic representation*, the real issue for this author is that this explicit criterion appears to be interpreted very strictly in the CTM system, whereas the equivalent implied criterion in Japan is more generous (here, please see Chapter 2, Section 2.2.3).

6.3.3 A Test of ‘Trade Mark of Repute’ and ‘*Syuchi-Syohyo*’

The aim of this Section is to look at the *test* of ‘trade mark of repute’ and ‘*syuchi-syohyo*’ as opposed to the definition of the same, since it has been submitted that ‘trade mark of repute’¹²³⁶ and ‘*syuchi-syohyo*’ are not conceptually or comprehensively defined in laws; but assessed and determined by the non-exclusive fact based criteria.

The following similarities and dissimilarities can be submitted:

- (i) In the CTM, non-exclusive fact-based criteria seems to be developed by the cases (see Chapter 4, Section 4.3.3), whilst in Japan, criteria are explicitly stated in the JPO Guidelines (see Chapter 5 Section 5.3.2). This author also made the reader aware of the differences in function as between the CTM Guidelines (see Chapter 4.3.2) and the JPO Guidelines;
- (ii) Although the location or source of these factors are different, the ‘trade mark of repute’ criteria (see Chapter 4, Section 4.3.3) and ‘*syuchi-syohyo*’ criteria (see Chapter 5 Sections 5.3.2-5.3.3) contain similar elements, but there have a different emphasis: Under the EU CTM regime, this author has submitted that

¹²³⁴ Article 2 of the Japanese Trademark Act.

¹²³⁵ See Article 50 of the CTMR. Thus, although *commercial use* is not an explicit element of the definition of a ‘trade mark of repute’, it is relevant to the trade mark registration process and is relevant to the continued protection of marks in the CTM.

¹²³⁶ The *El Corte Ingles*, *supra* note 700.

‘trade mark of repute’ seems to be assessed based on knowledge threshold requirements, that is to say, to what extent trade marks are known. Under the Japanese trademark regime, *syuchi-syohyo* appears to be geographically defined: an assessment as to the geographical extent the *syohyo* is known. This difference might be explained by the nature of the CTM system¹²³⁷, and the practical context. This author speculates that if ‘trade mark of repute’ were assessed geographically, that this might prove to be unhelpful as a trade mark of repute is an exclusive right that is effective in all EU member states. The Japanese trademark regime, however, as a national system, thus encounters fewer problems here. It might be interesting to see if, in the future, the Japanese trademark regime takes a more CTM (knowledge based) approach, and how that would affect ‘*syuchi-syohyo*’ protection in Japan.

- (iii) Although the following point is slightly outside the scope of the main aim of this thesis, this author submits that the recent *Bellure* case¹²³⁸ does reflect the main differences, in the view of this author, in the CTM and the Japanese trademark systems.

Under the *Bellure* case, it was concluded that use of a ‘trade mark of repute’ might consist of trade mark infringement under Article 9(1)(c) of the CTMR¹²³⁹. If a factually-similar case to *Bellure* case was brought under the Japanese Trademark Act, the outcome would almost certainly be different, that is to say, no infringement would be found. This author suggests that this is because it is accepted in Japan that use of ‘*syuchi-syohyo*’ in a comparative advertising context does not constitute trademark infringement under the Trademark Act (although it might well be actionable under the Unfair Competition Prevention Act). This is simply because ‘(*syuchi*) *syohyo*’ would not be commercially used in such a sense. As was noted, Japan puts rather strong emphasis on the trademark *precondition – commercial use*: this is a very good exemplar of how this emphasis affects the scope of ‘(*syuchi*) *syohyo*’ protection. It can thus be inferred that Japanese law shows a narrower

¹²³⁷ See Chapter 4, Section 4.2.2.

¹²³⁸ The *Bellure*, *supra* note 652.

¹²³⁹ See Chapter 4, Sections 4.3.3 and 4.4.3.

scope of protection afforded to ‘syuchi-syohyo’ than that of trade marks of repute in the CTM regime.

Now that the key differences and similarities between the CTM and the Japanese trademark regimes have been demonstrated, this author would like to consider the efficacy of the two approaches.

In neither jurisdiction does the jurisprudence provide a conceptual and comprehensive definition of ‘trade mark of repute’ or ‘syuchi-syohyo’. This author has submitted that the absence of such a definition might be a causal factor of uncertainty and lack of clarity in ‘trade mark of repute’ or ‘syuchi-syohyo’ protection.

In relation to the test of assessing whether trade marks/syohyo are ‘trade mark of repute’ or ‘syuchi-syohyo’, criteria have been developed by case law in EU¹²⁴⁰, but are to be found in the JPO Guidelines¹²⁴¹. Although the two sets of criteria seem rather similar to each other (and they are assessed by non-exclusive fact-based criteria), in order to encourage more a consistent and harmonised assessment of ‘trade mark of repute’ or ‘syuchi-syohyo’, this author takes the view that the Japanese approach (providing the clear list in the Guidelines) seems more constructive here.

In terms of ‘trade mark of repute’ being knowledge based, and ‘syuchi-syohyo’ being geographically based, this author understands why these two different approach have been developed, and she submits that these two approaches seem to function effectively, thus these difference seems to be justifiable. In fact, as suggested above, a geographically-defined ‘trade mark of repute’ might not work well in the EU regime.

Finally, this author would like to raise an interesting difference between EU and Japan regarding *Bellure* type claim (see above).

The approach taken by ECJ in *L'Oréal SA v Bellure NV*¹²⁴² seems very different to how such a dispute would be considered in Japan (under both the Trademark Act and

¹²⁴⁰ See Chapter 4, Section 4.4.3.

¹²⁴¹ See Chapter 5, Section 5.3.2.

¹²⁴² The *Bellure* *supra* note 652.

Unfair Competition Prevention Act). Use of a well-known trade mark in, for example, a price comparison list would *not* constitute either trade mark infringement or be actionable under the unfair competition law in Japan.

This author has already raised a concern that the *Bellure* decision seems to be gone too far; and that the decision seems to have muddled EU trade mark and unfair competition laws. Here ECJ confirmed that proprietor of well-known trade mark can enjoy higher level of protection, unlike in the *Intel* decision where it was held that the trade mark proprietor must show evidence of changes in consumer behaviour. These two very different outcomes need, in the view of this author, to be reconciled somehow.

Bellure was a successful trade mark infringement claim under the CTM system, it would almost certainly not have succeeded in the Japanese system, where it would also be examined under the Unfair Competition Prevention Act (see Chapter 5, Section 5.2.3). This author would like to note here that the outcome in *Bellure* might encourage owners of ‘trade marks of repute’ to seek the broader protection. However, this author takes the view that allowing the *Bellure*-type claims under the CTM seems to go beyond the proper scope of a trade mark law. This author submits that the Japanese trademark regime providing the narrower scope of protection to *syuchi-syohyo* seems more appropriate here.

To what extent the *Bellure* case might influence Japanese trademark is difficult to judge. However, the Japanese Trademark Act provides a narrow scope of protection to trade marks¹²⁴³. Furthermore, the Japanese Act and academic theory have both sought to strike a fine balance between trade mark proprietors’ rights and the encouragement of free competition. This author would be concerned to see the importing of the *Bellure* approach to the narrowly defined Japanese trademark regime. However, this author also criticises Japanese trademark act and jurisprudence for being excessively narrow, and for developing a system which pays less attention to commercial value and to the advertising function of well-known trade marks.

¹²⁴³ See Chapter 2 Section 2.2.3.

Therefore, an ideal situation might well be somewhere in the middle ground between the *Bellure* decision and the Japanese approach.

6.4 A Comparison of ‘Confusion’ and ‘Kondo’

Now the author would like to begin the critical comparison of confusion (*kondo* in Japan). In this Section, the author would like to make some over-arching points, before returning to more specific comparisons in the next Section.

Although no comprehensive and conceptual definitions of confusion and *kondo* seem to be provided in either the EU or the Japanese laws, there is some guidance to assess situations where there is any confusion and *kondo* or not. The means of providing protection against *kondo* in Japan differs from that of the CTMR, it is submitted. The Japanese Trademark Act provides (incrementally) hypothetical situations where *kondo* is likely to occur¹²⁴⁴, this is not so under the CTMR. This author, as argued in Chapter 5, considers that this is the key characteristic of *kondo*. Further, in the Japanese Trademark Act, Article 4(1)(15) regulates the situation outside the scope of the Articles 4(1)(10)-(14). However, this author wonders if there would there be any occasions where ‘*kondo*’ was caused outside of the scope of Articles 4(1)(10)-(14) – would this be useful or effective protection? It is difficult to answer this (the Japanese Trademark Act dose not state or consider the likelihood of association therein). Nevertheless, despite the apparent greater scope of *kondo* (as compared to confusion), no comprehensive definition of ‘*kondo*’ is provided within the law. However, it can be said that the Japanese Trademark Act still provides more detailed legal information with regard to ‘*kondo*’ than the CTMR does in relation to confusion.

6.4.1 A Test of ‘Confusion’ and ‘Kondo’

Much like ‘mark of repute’ and ‘*syuchi-syohyo*’, there is no clear and comprehensive definition of confusion or *kondo*. Although this author does concede that, in both cases, the tests for these notions may require a factual approach, she submits that clear and comprehensive definitions of the same could only increase clarity and consistency

¹²⁴⁴ See Articles 4(1)(10)-(14) of the Japanese Trademark Act.

for the application of said tests. In relation to confusion, unlike the CTMR, the Japanese law does provide reasonably clear guidance as to the test for *kondo vis-à-vis* the JPO Guidelines (see Chapter 5, Section 5.4.3). In contrast, the primary source of the CTM test is ECJ jurisprudence (see Chapter 4, Section 4.1). A cursory view of this might lead one to conclude that the difference in the source of the confusion and *kondo* tests is simply a reflection of the types of jurisdictions at issue, but (i) although Japan is a civil law country, the EU is not a common law jurisdiction, so this conclusion is questionable, and (ii) the source of the tests may have influenced the clarity of the test contents: this author submits that the piecemeal development of ECJ jurisprudence has not lead to a clear and consistent test of confusion in the CTM system, whereas the Japanese approach appears a little clearer.

Thus, at this stage, this author believes that a composite of the various guidelines provided in these cases to establish confusion can be collated and submits that it is the following: ‘likelihood of confusion’ can include likelihood of (business¹²⁴⁵) association¹²⁴⁶, and likelihood of confusion cannot be presumed; confusion has to be positively found¹²⁴⁷. Likelihood of confusion shall be assessed globally¹²⁴⁸, taking into account all the relevant factors.

Three dominant factors of the global appreciation are¹²⁴⁹:

- (i) the recognition of the trade mark on the market;
- (ii) the association which can be made with the used or registered sign, and;
- (iii) the degree of visual, phonetic¹²⁵⁰ (and or aural¹²⁵¹) and conceptual (which might occur by images with analogous to semantic content if the mark is distinctive¹²⁵²) similarity between the trade mark and the sign and between the

¹²⁴⁵ *Canon v Metro*, *supra* note 742 at 29-30.

¹²⁴⁶ *Sabel v Puma*, *supra* note 736 at 26.

¹²⁴⁷ *Marca Mode v Adidas*, *supra* note 751 at 41.

¹²⁴⁸ *Sabel v Puma*, *supra* note 736 at 22.

¹²⁴⁹ *Ibid.*

¹²⁵⁰ *Canon v Metro*, *supra* note 742.

¹²⁵¹ *Sabel v Puma*, *supra* note 736 at 23.

¹²⁵² *Ibid.*

goods or services identified¹²⁵³ focusing on distinctive and dominant component¹²⁵⁴.

Point (iii) the degree of similarity of the marks, needs to be assessed by overall impression of the marks from the average consumers¹²⁵⁵, – reasonably well-informed and reasonably observant (the average consumer perceives a mark as a whole, but does not proceed to analyse its various details¹²⁵⁶) and circumspect¹²⁵⁷ – viewpoint. The following range of non-exclusive factors may be relevant in assessing similarity:

- The nature of the goods and services;
- The intended purpose;
- Method of use, and;
- Competitive relationship¹²⁵⁸.

Returning to Point (i), the more distinctive the earlier mark, the greater will be the likelihood of confusion¹²⁵⁹, and trade mark of repute should enjoy broader protection than mark of less repute¹²⁶⁰. Overall assessments of ‘distinctive character’ shall be assessed by the greater or lesser capacity of the mark to identify the goods or services¹²⁶¹.

The following range of non-exclusive factors¹²⁶² may be relevant in assessing ‘distinctive character’ variously:

- Inherent characteristic of the marks (if the mark contains any descriptive elements);
- The market share;
- To what extent the mark is known;

¹²⁵³ *Ibid* at 22.

¹²⁵⁴ *Ibid*.

¹²⁵⁵ *Ibid* at 23, and *Lloyd v Klijzen*, *supra* note 750 at 26.

¹²⁵⁶ *Sabel v Puma*, *supra* note 736.

¹²⁵⁷ *Lloyd v Klijzen*, *supra* note 750 at 26.

¹²⁵⁸ See *supra* note 843.

¹²⁵⁹ *Sabel v Puma*, *supra* note 736 at 24.

¹²⁶⁰ *Canon v Metro*, *supra* note 742 at 18.

¹²⁶¹ *Ibid* at 22.

¹²⁶² *Ibid* at 23.

- To what geographical extent the mark is known;
- To what extent the mark is in use;
- The amount invested in promoting the mark, and;
- The proportion of the relevant section of the public that identifies the goods and services.

The above factors can be referred to by the given percentages when a mark has a strong reputation¹²⁶³.

Although no comprehensive and conceptual definition of *kondo* is provided in the Japanese law, a few Articles provide useful guidance herein.

It is thus generally understood that a mark which causes any confusion indicates a trademark which is not categorised in Articles 4(1)(10)-(14) of the Japanese Trademark Act. The subject matter of Articles 4(1)(10)-(14) is set out in the next paragraph. In contrast, the Japanese concept of *kondo* appears to be broader, and reference here is made both to *syohyo* and *syuchi-syohyo*, and can be summarised as follows:

Kondo is expected to occur when a *syohyo* in question is identical or similar to:

- (i) (un)registered *syuchi-syohyo* (Article 4(1)(10));
- (ii) a registered *syohyo* (Article 4(1)(11));
- (iii) a registered defensive *syohyo* (Article 4(1)(12));
- (iv) a *syohyo*, which is revoked after less than a year (Article 4(1)(13));
- (iv) a registered *syohyo* under the *syubyo-ho* (種苗法) (Article 4(1)(14)), and;
- (v) a *syohyo*, which does not apply within the items noted above (Article 4(1)(15)).

The criteria to assess if there is a *kondo* or not are clearly stated in the JPO Guidelines, although, it should be noted that obviously, the assessments of *kondo no osore* do vary case by case.

¹²⁶³ *Lloyd v Klijzen*, *supra* note 750 at 29.

The following is provided¹²⁶⁴:

- (i) a degree of trade mark being well-known (degree of advertising and publicity, but a *syohyo* need not to be well known nationally).
- (ii) if a *syohyo* is a creative (coined) mark or not;
- (iii) if a *syohyo* is a house mark or not;
- (iv) if a *syohyo* has a future possibility of multiplying the business, and;
- (v) if there is relationship between the goods or service which a *syohyo* is attached to;

As summarised above and critically discussed in Chapter 5, Section 5.3.2, in Japan the Guidelines provide that *kondo* is assessed comprehensively with reference the five fact-based criteria noted above. As was noted in Chapter 5, Section 5.3.3, this approach can be criticised for a lack of clarity and certainty, although the JPO Guidelines clearly set out the criteria, assessments of ‘*syuchi-syohyo*’ and *kondo* are based on non-exclusive fact-based criteria, thus assessments and results of ‘*syuchi-syohyo*’ and *kondo* are likely to vary case by case.

In contrast, in the CTM likelihood of confusion is a mainly jurisprudential test and includes likelihood of association and is to take the form of a global approach with one ‘catch all’ provision relating to distinctiveness and another relating to similarity (between the marks and between the goods and services). As was noted in Chapter 4, Section 4.4.3, this approach can be criticised for providing no explicit guidance as to the legal principle of ‘confusion’, although it is true that we do have a range of fact-based non-exclusive guidelines for establishing whether confusion is present, but there is not a clear and comprehensive legal definition of confusion, and there is certainly no explicit guidance (or definitions) pertaining to confusion in the context of trade marks of repute.

How, then, do the *kondo* and confusion approaches compare? In terms of similarities, there is an over-arching similarity: both require the consideration of fact-based criteria be undertaken in the context of an open and pro-confusion consideration (the Japanese

¹²⁶⁴ Item 7 of Chapter 3: Article 4(1)(3) Part 13: Article 4(1)(15) of the JPO Guidelines.

‘comprehensive’ approach and the CTM ‘global appreciation’). Other similarities include: non-factual criteria listed by EU cases and in the JPO Guidelines, that is to say, confusion and *kondo* are judged by the similar criteria. This author submits some harmonised approach to confusion and *kondo* can be found although trade mark laws still take a national based approach. It can be observed that it is rather interesting that there is no suggested Guideline with relation to confusion and *kondo* at the international level, unlike ‘well-known trade mark’ suggested by the WIPO Recommendation (see Chapter 3, Section 3.2.4).

However, there are differences in the confusion/*kondo* approaches. For examples,

- Japan provides criteria within the JPO Guidelines, whilst in the CTM, the criteria is developed by cases;
- Concept of *kondo* seems clearer under the Japanese Trademark Act (Articles 4(1)(10)-(15)) than that of the CTMR (since various types of *kondo* are recognised and addressed within the Act)¹²⁶⁵;
- Japan seems to provide a more instructive approach to *kondo*, contrary to the CTM system;
- The CTM seems to provide a more detailed and informative approach to the global appreciation of confusion (the EU jurisprudence provides more instructive guidance on global appreciation test i.e. how to apply for the context; but there seems to be a lack of *criteria* which needs to be considered. Japan, on the contrary, shows very little indication in how to assess *kondo*, whilst the Guidelines provides a list of criteria needed to be considered when *kondo* is assessed)¹²⁶⁶, whilst the Japanese Guidelines seems be more simplified and conclusive, and thus seem to be lacking information;
- Japan provides a different, but unclearly defined treatment between *syohyo* and *syuchi-syohyo* against *kondo*, whereas in the CTM, this differentiation seems not explicit and;
- (Article 37 of the Japanese Trademark Act provides more precious causes of actions regarding trademark infringements in comparison with Article 9 of the CTMR).

¹²⁶⁵ See Chapter 5, Section 5.4.2.

¹²⁶⁶ See Chapter 4, Section 4.4.4.

With relation to confusion and *kondo* between the CTM and the Japanese trademark systems, this author prefers the Japanese approach to the CTM, because this author submits that the concept of *kondo* can be drawn from the Japanese Trademark Act, thus it seems clearer than that of the CTMR.

The author has been submitted that ‘trade mark of repute’/‘*syuchi-syohyo*’ protection against confusion and *kondo* seems to be lacking clarity and thus seems uncertain. It is also submitted that no comprehensive and conceptual definitions of ‘trade mark of repute’/‘*syuchi-syohyo*’ and confusion and *kondo* might be a causal cause of this uncertainty.

It should be however, emphasised that although neither does provide any comprehensive or conceptual definitions of confusion and *kondo*, assessment of confusion in the CTM system seems more indicative and detailed than in the Japanese system. However, combined with the fact that there is no specific legal treatment of the protection of marks of repute against confusion, this must mean that the scope of protection of trade marks of repute against confusion in the CTM system is inherently unclear.

To conclude, this author, from the above noted reasons, would prefer the Japanese to the CTM approach.

6.4.2 Summary

So far, similarities and dissimilarities of ‘trade mark of repute’ and ‘*syuchi-syohyo*’ against confusion and *kondo* in the CTM and the Japanese trademark system has been critically compared and examined. The following are submitted: both the CTM and Japanese trademark laws take rather similar approaches to both confusion and *kondo*; as no comprehensive and conceptual definitions of those terms are provided in the laws, though assessments of the same are provide by cases and the Guidelines. To conclude, this author submits that the Japanese approach is preferable as the concept of *kondo* seems clearer than confusion doctrine in the CTM system.

6.5 Conclusion

In this Chapter, the author has attempted to critically compare the definitions afforded to ‘trade mark of repute’ and ‘*syuchi-syohyo*’ and ‘confusion’ and ‘*kondo*’.

She has concluded that in terms of definitions offered the scope of ‘*syuchi-syohyo*’ is narrower than that of ‘trade mark of repute’ by virtue of a more restrictive approach to *type in form, and concept*.

Turning to the tests or general approach used for determining well-known status in these two jurisdictions, this author submits that, although both of them are rather similar, an assessment of ‘trade mark of repute’ seems to be based on the knowledge threshold requirement, whereas the ‘*syuchi-syohyo*’ seems to be based on the geographic threshold requirement. Moreover, the Japanese system seems to take more concise and indicative approach to assessment of ‘*syuchi-syohyo*’ than the CTMR. However, the scope of protection afforded to ‘trade mark of repute’ seems to be broader than that of the Japanese trademark regime. In this point, the EU system takes a broader approach to the scope of ‘trade mark of repute’ protection. Overall, this author prefers the Japanese narrower approach as it seems more precise and constructive and seems appropriate.

In terms of defining confusion/*kondo*, the Japanese law seems to take a narrower approach than that of the CTM system. In terms of the tests for confusion/*kondo* the CTM approach is more indicative, than that of the Japanese approach, as the EU cases provide guidelines (the global appreciation test) in greater detail. Overall, this author prefers the Japanese approach because this author submits that the concept of *kondo* can be drawn from the Japanese Trademark Act thus it seems clearer than that of the CTMR. Also legal treatment for ‘*syuchi-syohyo*’ against *kondo* is clearer in the Japanese trademark regime than it is for ‘trade mark of repute’ against confusion in the CTM regime.

Overall, the author would like to suggest that the following comparisons can be drawn in relation to the certainty of the scope of protection of, respectively, trade marks of repute and *syuchi-syohyo* against confusion and *kondo*:

- (i) The *legal origins* of this protection. In the CTM, much is defined in the case law (see Chapter 4, Sections 4.3.3 and 4.4.3), whereas in Japan it is the JPO Guidelines that are more important. This author argues that this means that protection for marks of repute against confusion has developed, and is, developing in an inherently piecemeal fashion, whereas in the Japanese system, although there are some uncertainties (see Chapter 5 Sections 5.3.2 and 5.4.3), protection (in the Guidelines) has been developed in an inherently more systematic context. Further, the JPO Guidelines can be reviewed and changed as required (e.g. see Chapter 5, Section 5.3.4). However, for the CTM, the greater emphasis on the EU courts (and waiting for suitable OHIM appeals and/or preliminary references on similar provisions in the Directive) means that this process must be less predictable and is more reactive;
- (ii) The *specificity* of this protection. Although, clearly, the protection of trade marks and *syohyo* against confusion and *kondo* is well-established, if not always clear (a lack of clarity that, given the assumption made in this thesis re. the relationship between trade marks and well-known trade marks, has import for marks of repute and *syuchi-syohyo*), the extent to which confusion/*kondo* explicitly applies to trade marks of repute/*syuchi-syohyo* is less clear. Here, this author submits the Japanese law takes clearer approach to ‘legal treatment for ‘*syuchi-syohyo*’ against *kondo* than that of ‘trade mark of repute’ against confusion and;
- (iii) In the *key areas of uncertainty* as to scope of protection. There can be said to be three such area, it is submitted by this author:
 - a. In terms of certainty as to the *definition* of well-known trade mark’ and, in Japan ‘*syuchi-syohyo*’. As earlier evidenced (see Chapter 4, Section 4.3 and Chapter 5, Section 5.3) the scope of the former is particularly uncertain;
 - b. In terms of certainty as to the *appropriateness* of the approach to identifying ‘well-known trade mark’ and ‘*syuchi-syohyo*’. As earlier evidenced (see Chapter 5, Section 5.3), it is very clear that *syuchi-syohyo* status is judged with reference to a geographically-drawn expression of *concept*, but the indicators of ‘trade mark of repute’

status include proxies for distinctiveness, together with a reference to value (see Chapter 4, Section 4.3): it is submitted that the latter is not appropriate. Clearly ‘*syuchi-syohyo*’ is the narrower concept, and;

- c. In terms of the *suitability* of confusion/*kondo* as a form of protection for trade marks of repute and *syuchi-syohyo*. As noted in relation to *kondo* (see Chapter 5, Section 5.4.4), there is the argument that the more well-known a mark, the less likely it is that consumers will be confused: here, it is submitted, third parties may be taking unfair advantage of the well-known mark, but this is not usually relevant or sufficient for a finding of confusion (or *kondo*). As one might reasonably expect the scope of protection for well-known marks to increase the more well-known they are, this argument raises a fundamental (and uncertain) question: is confusion a suitable doctrine for protection of well-known marks? Would a broader scope of dilution-type provisions be more suited to the protection of well-known trade marks? The suitability of confusion/*kondo* as a form of protection for trade marks of repute and *syuchi-syohyo* is implicit in the overall thrust of this thesis, but perhaps this should be questioned¹²⁶⁷. Nevertheless, this is a question that should be equally posed to each jurisdiction in question.

In the next and final Chapter, the author will revisit the hypothesis and briefly consider the main findings of this thesis and the limitations thereto. The author will also, in the next Chapter, briefly set out suggestions for legal reform.

¹²⁶⁷ This, it is submitted, is a topic for a future research project. The scope of this thesis relates to uncertainty as to protection of well-known marks (*vis-à-vis* confusion), not the *appropriateness* of confusion in this context.

Chapter 7 Conclusion

7.1 Introduction

The main thrust of this thesis has been to explore the efficacy of well-known trade mark protection against confusion and *kondo* in, respectively, the EU¹²⁶⁸ and Japan¹²⁶⁹. This author has also undertaken a detailed comparative analysis of these two jurisdictions on this topic. Further, a critical examination of well-known trade mark protection at the international level has been also undertaken, as this is an area that has been subject to some international harmonisation¹²⁷⁰.

7.2 Contributions

The author submits that in the course of completing these national, international and comparative critical analyses, contributions to the literature have been made in three areas:

- A detailed comparative analysis of well-known trade mark protection against confusion in the EU and Japan (this can also be said to be a novel contribution, as to this author's knowledge there is no such analysis of the Japanese law on this point in the secondary literature, and as a result no such comparative analysis had been undertaken);
- Employing an etymological approach to the analysis of the relevant Japanese laws. This approach, implicit to native Japanese and fluent Japanese readers, it is hoped will aid non-Japanese speakers to further understand Japanese law;
- Development of the Definition Model. This Model, it is submitted, is of import and interest as it both conceptualises¹²⁷¹ the definitions of 'trade mark' and 'well-known trade mark', and offers a concise yet simple structure for analysing and understanding these two key trade mark notions¹²⁷².

¹²⁶⁸ See Chapter 4.

¹²⁶⁹ See Chapter 5.

¹²⁷⁰ See Chapter 3, in particular the examination of the Paris Convention (Section 3.2.1), GATT TRIPS (Section 3.2.2) and the WIPO Recommendation (Section 3.2.4).

¹²⁷¹ Thus constituting a theoretical contribution to the literature.

¹²⁷² The author would submit that this constitutes a pragmatic contribution to not only trade mark literature, but also (possibly) to trade mark beneficiaries.

At this point, the author would like to make some further points relating to the contributions made by this thesis.

With regard to the comparative analysis, this author does concede that this analysis has its limitations (for example, the author has not investigated national, as well as regional, EU trade mark law), but this author hopes that this thesis, nevertheless, provides some food for thought for the reader as to the nature and definition of well-known trade marks, the protection of such marks against confusion and the treatment of these two areas in the CTM and the Japanese trademark systems.

With regards to the use of etymological methodology, in Chapter 1, Section 1.5 and in Chapter 5, it is submitted, the importance of language in studying the Japanese Trademark Act is illustrated. To the knowledge of this author, the emphasis on and explanation of the role of etymology in determining the meanings of ‘*syuchi-syohyo*’ and ‘*kondo*’ is not known in the published literature, and thus this does make a novel contribution to the same (and also, it is submitted, the insights gained from employing this methodology justifies its use in the context of the more traditional legal methodology of statutory interpretation). Further, in setting out (in particular, in Chapter 5) background and relevant Japanese trademark literature, this author hopes that she has made some small contribution to a greater understanding of the Japanese Trademark Act¹²⁷³. Although the non-Trademark Act routes to protection of *syuchi-syohyo* are not subject to detailed consideration in this thesis, the outline of these routes provided in Chapter 5, Section 5.2.3 will, it is hoped, also be of interest to non-Japanese readers.

With regard to the Definition Model, although, as conceded in Chapter 2, Section 2.1, this Model was born of practical necessity¹²⁷⁴, the development¹²⁷⁵ and use of the

¹²⁷³ To this end, and to aid further research by non-Japanese speakers, the author has ensured that in the Bibliography, the secondary Japanese literature is represented in (her own) English translation, as well as in Japanese and transliterated forms.

¹²⁷⁴ As has been submitted, and evidenced, there is no single authoritative and comprehensive definition of ‘well-known trade mark’ in the international trade mark regime. Nevertheless, it cannot be said that well-known trade mark protection is *entirely* uncertain, as at the international level (incomplete) guidance as to the definition of ‘well-known trade mark’ and detailed (if not comprehensive) guidance as to determining well-known trade mark status is to be found, collectively, in the Paris Convention, GATT TRIPS and the non-binding WIPO Recommendation (see Chapter 2,

Definition Model, it is submitted, does provide a useful tool for critical consideration of the definitions of ‘trade mark’ and ‘well-known trade mark’. It is submitted that the Definition Model provides a simpler way to conceptualise both ‘trade mark’ and ‘well-known trade mark’, and it may be beneficial for not only trade mark practitioners, but also trade mark beneficiaries (that is, trade mark proprietors and consumers). The author submits that the Definition Model has worked reasonably well in fulfilling this role within this thesis. However, she does accept that a small further refinement or clarification of the Definition Model would be beneficial. Therefore, with reference to Diagram 2 (in Chapter 2, Section 2.2.1) she would suggest that it would be appropriate to make the following small change to the Definition Model:

- As *per* the discussion in Chapter 2, Section 2.3.1.4, and second assumption made by this author (see Chapter 1, Section 1.7), trade mark *concept* should be defined so as to include both inherent and acquired distinctiveness. Thus trade mark *concept* is defined as ‘distinctiveness, both inherent and acquired’. Logically, therefore, well-known trade mark *concept* would be defined as ‘a high level of distinctiveness (both inherent and acquired distinctiveness, or just acquired)’.

In this way, it can be seen that the Definition Model has been both tested, and refined in the course of this thesis. Through the application of the Definition Model, it has been illustrated that there is no authoritative and comprehensive definition of ‘well-known trade mark’ in the international trade mark regime¹²⁷⁶, or within the CTM¹²⁷⁷ and Japan¹²⁷⁸. Nevertheless, the key benefit in the application of the Definition Model here is that it allowed this author to go further than mere description, to clear conceptualisation of the current definitions of ‘well-known trade mark’, in the

Section 2.3.1.5). Further, it has been submitted, and evidenced, that the analogous concepts in the CTM (the CTMR) and Japan (the Japanese Trademark Act) similarly are not clearly and comprehensively defined. Finding a means of consistently comparing and critiquing the various definitions was one of the challenges faced by this author. To enable this, and to help in the conceptualisation of what a ‘well-known trade mark’ is, and how it should be defined, the Definition Model was proposed, and applied, by this author. This author has found the application of the Definition Model to be useful, and hopes that the readers of this thesis hold a similar view.

¹²⁷⁵ See Chapter 2, Section 2.2.

¹²⁷⁶ See Chapter 3, Sections 3.1-3.2, and Chapter 6, Section 6.2.2.

¹²⁷⁷ See Chapter 4, Section 4.3.1, and Chapter 6, Section 6.3.

¹²⁷⁸ See Chapter 5, Sections 5.3.1.1-5.3.1.2, and Chapter 6, Section 6.3.

international trade mark regime¹²⁷⁹ and in the CTM¹²⁸⁰ and in Japan¹²⁸¹. As a result of the critical analysis, comparison and critique of the definition of ‘well-known trade mark’, this author’s preferred definition would reflect that set out in the Definition Model. Therefore, in terms of improving current legal definitions of ‘well-known trade mark’, this author would like to see a clearer definition of ‘well-known trade mark’. Perhaps further reform of the WIPO Recommendation might be the correct forum for this, and this author’s preferred definition of ‘well-known trade mark’ would be:

“A mark which has acquired highest distinctiveness through use.”

As can be seen, this author’s preferred definition of ‘well-known trade mark’ places great importance on acquired distinctiveness. This explicit focus on acquired distinctiveness in this *definition* would, it is submitted, mean re-visiting the criteria for *assessing or testing* well-known trade marks, for example, re-visiting the non-exclusive factors of the WIPO Recommendation. This is an area in which this author intends to undertake further research, and her future research on developing new criteria for assessing well-known trade mark status is likely to focus on trying to develop more comprehensive factors for determining whether sufficient distinctiveness has been acquired to merit well-known trade mark status. Her initial thoughts in this area are that in determining whether a mark is well-known or not, acquired distinctiveness needs to be central to the criteria. Further, this author also hopes to undertake research on the topic of infringement of well-known trade marks in the future.

7.3 Main Findings

The hypothesis can be said to be partly proved: well-known trade mark protection can be said to be inherently uncertain, as there is no comprehensive or conceptual definition of well-known trade mark at the international and EU levels, or in national Japanese law. Further, whilst the tests of confusion (albeit there is little CTM

¹²⁷⁹ See Chapter 3, Section 3.2.

¹²⁸⁰ See Chapter 4, Section 4.3.

¹²⁸¹ See Chapter 5, Section 5.3.

guidance as to how this applies to marks of repute) and *kondo* are relatively clear, it is in the *application* of these tests that there is uncertainty - in practice, these tests are simply not predictable.

It is also submitted by this author that the assumptions made at the beginning of this thesis (Chapter 1, Section 1.7) are reasonable. For example, the assumption made by this author that distinctiveness is at the heart of 'well-known trade mark' would appear to be merited by the focus on acquired distinctiveness (e.g., see Section 7.1 above).

Now, the main findings in the EU and Japan respectively are summarised.

Protection of well-known trade marks against confusion in the CTM is inherently uncertain¹²⁸² because it essentially operates on a case-by-case basis, namely both 'trade marks of repute' and 'likelihood of confusion' are essentially a *factual* question in the current law, whereas in the view of this author, it is submitted that this should be supplemented by clear legal definitions of 'trade mark of repute' and 'likelihood of confusion'. (See the suggested definition of 'well-known trade mark' above, re. the former. This author intends to consider how the definition of and for confusion might be reformed in future research). So, a question can be posed here: is it necessary to have a conceptual definition of 'well-known trade mark' in order to determine the scope of protection for such marks in practice? This author believes that such a definition could only help certainty, but whether such a definition is a precondition for such certainty (and indeed, whether true certainty could ever be achieved here) are also issues for future research.

Returning to the thesis, the current EU approach to both defining well-known trade marks and protecting such marks against confusion can be said to have the advantage of flexibility. However, this advantage – in the personal view of this author – may well be outweighed by the uncertainty that results. This uncertainty, it is submitted, has only been increased by the divergent policy messages as to the protection of trade

¹²⁸² See Chapter 4, Section 4.4 and Chapter 6 Section 6.3.

marks of repute sent out by the *Intel* and *Bellure* decisions (see Chapter 4, Section 4.4.3).

Albeit a case more concerned with dilution than confusion, this author has criticised the *Bellure* case in particular (see Chapter 4 Section 4.4.4)¹²⁸³, nevertheless, collectively, *Intel* and *Bellure* can be seen as creating uncertainty as to the scope of protection afforded to marks of repute in general. Why? Given that there is no clear definition of ‘mark of repute’, the narrow/*Intel* and broader/*Bellure* approaches create uncertainty, if not conflict, as to the scope of protection for marks of repute: an uncertainty which can only raise further questions as to the extent to which such marks are protected against confusion (as well as dilution).

Turning to the protection of *syuchi-syohyo* against *kondo* in Japan: as in the CTM this is also uncertain, for much the same reason – the test for *syuchi-syohyo* status is a factual one¹²⁸⁴: this is hardly surprising, as these tests are necessarily applied on a case-by-case, rather than a principled, basis. However, the degree of uncertainty is, in the view of this author, rather less than in the CTM. Why? Largely because the scope of protection afforded to trade marks (including *syuchi-syohyo*) against *kondo* is explicitly addressed in the JPO Examination Guidelines for Trademarks (whereas in the CTM, there is no specific treatment of marks of repute in relation to confusion). Further, in Japan, proof of confusion is not required. In other words, the proprietor of a *syuchi-syohyo* (and also the proprietor of a famous mark) is in a simpler position than he would be in Europe, as he is not required to *evidence* likelihood of confusion. Although the JPO Guidelines are clear, this author would like to highlight that there is a lack of cases to further support this point.

¹²⁸³ This author has submitted that, in the context of dilution, in the *Bellure* decision *the importance of the advertising function of marks of repute was inadequately recognised and interpreted*. As a result, this author argues that protection of marks of repute against dilution has become more uncertain. If the *Bellure* approach is to be favoured in the EU in the future, clearly a broader scope of protection would be offered to ‘trade mark of repute’. This would be unfortunate, in the view of this author, because *Bellure* unhelpfully confuses the legal relationship between trade marks and comparative advertising, and trade mark law and unfair competition law. This can only result in further uncertainty. This author wonders whether the scope of the protection for ‘trade mark of repute’ would be better determined by reference to a conceptual definition of marks of repute, rather than a ever-widening notion of the function(s) of marks of repute.

¹²⁸⁴ See Chapter 5, Sections 5.4.3.1 and 5.4.5.

Returning to the issue of the definition of the concept of well-known trade mark, it should be emphasised that there is no comprehensive definition of *syuchi-syohyo* either in the Japanese Act or the JPO Guidelines. Nevertheless, the detailed factual approach to protection of *syuchi-syohyo* against *kondo* appears to result in more certainty as compared to the equivalent CTM provisions. Therefore, well-known trade mark protection may be made more certain by detailed guidelines and a factual approach. Unsurprisingly, this author prefers the Japanese to the CTM approach in this regard (her reasons for this will be explained in more detail shortly), whilst still maintaining her own view that:

- (i) A clear conceptual definition of ‘marks of repute’ and ‘*syuchi-syohyo*’ would further increase certainty, and;
- (ii) If ‘confusion’ and ‘*kondo*’ had clear legal definitions, as well as factual tests, still greater certainty would result.

That the CTM and Japanese systems for protecting trade marks of repute and *syuchi-syohyo* against confusion and *kondo* are, in many ways, very similar must, however, be conceded. Clearly, the relevant laws may reflect influences from the international regime¹²⁸⁵ and, interestingly, some influence of the CTM regime on the Japanese system can also be seen (thus it could be said that there is both horizontal, as well as vertical, influence on the Japanese law). However, despite some apparent similarities, the author has shown that practice in Japan still diverges from the position within the CTM (e.g. see Chapter 5, Section 6.3.3 and 6.4.1). So in relation to protection of trade marks of repute and *syuchi-syohyo* against confusion and *kondo*, there are significant differences between these regimes in practice, if not in the Regulation and Act themselves. Another difference between the EU and Japan flows from the latter’s emphasis on trade marks being in commercial use in the course of trade (see Chapter 2 Section 2.3.3) in the Trademark and the Unfair Competition Prevention Acts. This surely limits the scope of protection accorded to both ordinary and well-known trade marks in Japan. It is interesting to observe that this emphasis on use in the course of

¹²⁸⁵ See Chapter 4, Section 4.3.1 for EU; and Chapter 5, Section 5.3.1 for Japan.

trade in Japan means that it would be highly unlikely that a *Bellure*-type case would ever appear before a Japanese court¹²⁸⁶.

Above, this author has stated her preference for the Japanese approach to protecting well-known trade marks against confusion over the CTM approach. Nevertheless, it is interesting to observe that much of what constitutes the detail in these approaches is to be found in EU trade mark jurisprudence and the JPO Guidelines, rather than in the CTM Regulation and the Japanese Trademark Act. The reasons for this author's preference for the Japanese approach include:

- *A more systematic approach to the protection of well-known trade marks against confusion.* The JPO Guidelines specifically address the issue of trade marks (including *syuchi-syohyo*) and *kondo* as opposed to the incremental approach developed through CTM jurisprudence. The former is necessarily more systematic than the latter, and the probable result is that the Japanese approach is more certain than that of the CTM. A systematic approach (and greater certainty) must be of benefit to trade mark practitioners, and trade mark owners and consumers as a whole, and for this reason this author prefers the Japanese approach;
- *Definition of 'well-known trade mark'.* As has been seen in Chapters 4 and 5, the respective definitions of *syuchi-syohyo* and 'mark of repute' can both be criticised (and this author would propose that clearer definitions of these terms be introduced). Nevertheless, this author would have a slight preference for the current approach to *syuchi-syohyo* for two reasons. First, in Japan the equivalent term to 'well-known trade mark' is actually used (CF the terminological uncertainty in Europe of opting for the term 'mark of repute'). Second, the geographically-defined concept of *syuchi* (well-knownness) can be seen as setting a higher standard than mere 'reputation' in the CTM. The Japanese approach would seem to be more selective, setting a higher standard. This author believes that this is appropriate and, for these two reasons

¹²⁸⁶ Indeed, the author would be interested in carrying out future research on the role of 'use' in trade mark infringement.

(terminological certainty and higher standard) prefers the current Japanese approach to that of the CTM, and;

- *Complexity: trade mark law and unfair competition law.* In Japan there is a clear delineation in the respective roles of trade mark law and unfair competition law in protecting all trade marks, including *syuchi-syohyo*. The Japanese Trademark Act (*syohyo ho*) and the Japanese Unfair Competition Prevention Act (*fusei kyoso boshi ho*), respectively, protect a narrow category of registered signs/marks and a broader category of signs, with (in terms of the Definition Model) trade mark *form* dictating the relevance of unfair competition law in Japan: this is a very clear division and unfair competition considerations would simply not be seen in a trade mark case in Japan. In contrast, at least in the *Bellure* decision, in the CTM and the EU Comparative Advertising Directive¹²⁸⁷, which can be regarded as a species of unfair competition law, this author regards the decision as being unhelpful and unclear. This author prefers the simple elegance of the Japanese approach here.

Having set out the main contributions and findings, the author now turns to the issue of legal reform.

7.4 Recommendations for Reform

In part-proving the hypothesis of this thesis, the author (it is submitted) has identified areas of uncertainty as to the protection of well-known trade marks against confusion in the CTM and Japanese trademark systems. Should, as this author believes, this uncertainty be problematic, the next step would be legal reform.

In the view of this author, a range of legal reforms in this area might be undertaken. Recognising that achieving legal reform, whether at the national, regional or international levels is invariably time-consuming and difficult, she first addresses pragmatic reforms that would be (relatively) easy to achieve. Then she lists more far-reaching reforms.

¹²⁸⁷ Council Directive 84/450/EEC of 10 September 1984 relating to the approximation of the laws, regulations and administrative provisions of the Member States concerning misleading advertising.

First, relatively straightforward ways in which reform could take place include:

- For WIPO to amend, develop or replace the Recommendation in two key respects. First, by introducing this author's preferred definition of 'well-known trade mark'¹²⁸⁸. Second, by re-visiting the non-exclusive factors for testing whether a trade mark is well-known: the author does not yet have concrete proposals in this area, but would suggest that acquired distinctiveness needs to play a more prominent role here;
- For OHIM to introduce explicit guidance on the protection of marks of repute against confusion. Such reform would ideally take the form of (an improved version of) the JPO *Kondo* guidelines, and;
- The JPO *Kondo* guidelines to be updated in general. One example of this is that this author would like to see *syuchi-syohyo* status having a broader evidence base (in particular, commercial use should be extended to specifically include evidence of Internet and advertising use of the alleged *syuchi-syohyo*).

Second, more ambitious potential reforms include:

- For this author's preferred definition of 'well-known trade mark' to be introduced into both the CTMR and the Japanese Trademark Act;
- Reform of Articles 8(1)(b) and 9(1)(b) of the CTMR and Articles 4(1)(15) of the Japanese Trademark Act so as to provide clearer definitions of confusion and *kondo*, and greater clarity and certainty as to how these concepts apply to trade marks of repute and *syuchi-syohyo* (in addition to the present provision for trade marks and *syohyo*). The author does not have specific recommendations here, and;
- Substantive reform of the international trade mark regime in order to provide a clear and comprehensive definition of 'well-known trade mark'. The starting

¹²⁸⁸ This is: "A mark which has acquired highest distinctiveness through use." To this author's knowledge, no reform or review of the WIPO Recommendation is planned and no second Recommendation is planned. However, one of these routes would surely be more realistic rather than over-hauling all the relevant international legal treaties.

point for such a definition would be this author's preferred definition of 'well-known trade mark', but the reforms should go further to address all aspects (i.e. trade mark *form*, *concept* and the *preconditions* should all be addressed) of the Definition Model developed in this thesis. Again, author does not have specific recommendations here.

Overall, in considering (and part-proving) the hypothesis that well-known trade mark protection against confusion in both the EU Community Trade Mark (the CTM) system and the Japanese trademark system is uncertain, this author has had the opportunity to consider a relatively narrow and novel aspect of well-known trade mark protection, that of protection of well-known trade marks against confusion in the CTM and Japanese systems.

The result is a comparative law thesis that employs some non-traditional methodology (such as etymological methodology). Further, it is a comparative law thesis which, by the effort and emphasis placed on the definition of 'well-known trade mark', does evidence that there is a lack of clarity as to the definition of 'well-known trade mark'. Further, uncertainty as to the scope of protection that confusion (and in Japan, *kondo*), offers such marks is also presented. As to why the scope of protection of well-known trade marks against confusion is uncertain, it is difficult to come to a definitive conclusion. Clearly, laws or guidelines explicitly addressing the issue of confusion in well-known trade marks would help. More fundamentally, it is submitted that the introduction of clear and comprehensive definitions of both 'well-known trade mark' (in the CTM – trade mark of repute – and in Japan – *syuchi-syohyo*) and confusion (in Japan - *kondo*), as well as further guidelines, is needed. The reader will note that this author has conceptualised (in the form of the Definition Model) and critiqued and compared the various definitions of well-known trade mark, trade mark of repute and *syuchi-syohyo*, but has not drafted an 'ideal' definition of well-known trade mark. Similarly, no 'ideal' definition of confusion or *kondo* is offered in this thesis. This is simply because this author is not skilled in statutory or treaty drafting and thus believes it more appropriate for her to set out general areas for reform (see the points made earlier in this Section).

Appendix 1: Defining ‘Trade Mark’

Law	Form of ‘trade mark’(trade mark type and context)	Concept of ‘Trade Mark’ (What is Trade Mark)	Trade Mark Preconditions (Graphic representation and Commercial Use)
International Law			
The Paris Convention	<p><i>Trade mark type</i> – signs and indicationsⁱ. <i>Trade mark context</i> – indications of source or appellations of originⁱⁱ; well-known trade marksⁱⁱⁱ; service marks^{iv}; collective marks^v, and trade names^{vi}</p>	Distinctiveness ^{vii} .	No reference.
The TLT	<p><i>Trade mark type</i> – visible marks, also includes three-dimensional marks^{viii} and excludes hologram marks, non-visible signs, sound marks, and olfactory marks^{ix}. <i>Trade mark context</i> – marks relating to goods^x, service marks^{xi}.</p>	No reference.	Graphic (visual) representation.
The Singapore Treaty	<p><i>Trade mark type</i> – no reference. <i>Trade mark context</i> – e.g. service marks are protected^{xii}.</p>	No reference.	No reference.

GATT TRIPS	<p><i>Trade mark type</i> – signs, words, personal names, letters, numbers and figurative marks, combination of colours, and combination of signs^{xiii}.</p> <p><i>Trade mark context</i> – trade marks^{xiv}, service marks, geographical indication might also be included herein^{xv}</p>	<p>‘Signs which are capable of <i>distinguishing</i>’. It is to be noted that Article 15(1) distinguishes between what might be conceptualised as inherent distinctiveness (‘capable of distinguishing’) and acquired distinctiveness (‘where signs are not inherently capable of distinguishing the relevant goods or service, members may make registrability depend on distinctiveness acquired through use’).</p>	<p><i>graphic representation</i>^{xvi}</p>
Regional – the CTMR	<p><i>Trade mark type</i> – any signs, including symbols, logos, slogans, get-up, personal names, designs, letters, numerals and the shape of goods or of their packaging^{xvii}.</p> <p><i>Trade mark context</i> – <i>context in form</i> includes trade marks, service marks, geographic marks and certification marks^{xviii}.</p>	<p>Distinctiveness^{xix}.</p>	<p><i>Graphic representation</i>^{xx}.</p>
National – the Japanese	<p><i>Trade mark type</i> –</p>	<p>Distinctiveness^{xxiii}.</p>	<p><i>Commercial use</i>^{xxiv}.</p>

Trademark Act	<p>characters, figures, signs, three-dimensional shapes or any combination thereof^{xxi}.</p> <p><i>Trade mark context</i> – trade marks or goods marks with a trade mark is attached to the goods, and service marks^{xxii}.</p>		
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Appendix 1: Defining ‘Trade Mark’

Law	<i>Form of ‘trade mark’(trade mark type and context)</i>	<i>Concept of ‘Trade Mark’ (What is Trade Mark)</i>	<i>Trade Mark Preconditions (Graphic representation and Commercial Use)</i>
International Law			
The Paris Convention	<p><i>Trade mark type</i> – signs and indications^{xxv}.</p> <p><i>Trade mark context</i> – indications of source or appellations of origin^{xxvi}, well-known trade marks^{xxvii}, service marks^{xxviii}, collective marks^{xxix}, and trade names^{xxx}</p>	Distinctiveness ^{xxxii} .	No reference.
The TLT	<p><i>Trade mark type</i> – <i>visible</i> marks, also includes three-dimensional marks^{xxxii} and excludes hologram marks, non-visible signs,</p>	No reference.	<i>Graphic (visual) representation.</i>

	sound marks, and olfactory marks ^{xxxiii} . <i>Trade mark context</i> – marks relating to goods ^{xxxiv} , service marks ^{xxxv} .		
The Singapore Treaty	<i>Trade mark type</i> – no reference. <i>Trade mark context</i> – e.g. service marks are protected ^{xxxvi} .	No reference.	No reference.
GATT TRIPS	<i>Trade mark type</i> – signs, words, personal names, letters, numbers and figurative marks, combination of colours, and combination of signs ^{xxxvii} . <i>Trade mark context</i> – trade marks ^{xxxviii} , service marks, geographical indication might also be included herein ^{xxxix}	‘Signs which are capable of <i>distinguishing</i> ’. It is to be noted that Article 15(1) distinguishes between what might be conceptualised as inherent distinctiveness (‘capable of distinguishing’) and acquired distinctiveness (‘where signs are not inherently capable of distinguishing the relevant goods or service, members may make registrability depend on distinctiveness acquired through use’).	<i>graphic representation</i> ^{xl}
Regional – the CTMR	<i>Trade mark type</i> – any signs, including symbols, logos, slogans, get-up, personal names, designs, letters, numerals and the shape of goods or of their packaging ^{xli} . <i>Trade mark</i>	Distinctiveness ^{xlii} .	<i>Graphic representation</i> ^{xliv} .

	<i>context – context in form</i> includes trade marks, service marks, geographic marks and certification marks ^{xlii} .		
National – the Japanese Trademark Act	<p><i>Trade mark type</i> – characters, figures, signs, three-dimensional shapes or any combination thereof^{xlv}.</p> <p><i>Trade mark context</i> – trade marks or goods marks with a trade mark is attached to the goods, and service marks^{xlvi}.</p>	Distinctiveness ^{xlvii} .	<i>Commercial use</i> ^{xlviii} .

Appendix 2: Illustrations of the Definition Model

<i>Well-known and valuable Trade Mark</i>		
<i>Form</i>	COCA-COLA	TOYOTA
<i>Context</i>	A Trade mark (for a product).	A trade mark (for a product).
<i>Types</i>	A combination of a word mark and colour combination. The word is represented in a stylised manner applying the colour red on a white background with combination of the colour red.	A logo, which in this case comprise a figurative element consisting of a two-dimensional, circular graphic representation of circles and a colour silver elements.
<i>Concept</i>	A highly distinctive nature, which enables consumers to select 'COCA-COLA' drink from other Cola drinks.	A highly distinctive nature, which enables consumers to distinguish 'TOYOTA' cars from those of other competitors.

Appendix 3: An Annotated¹²⁸⁹ Version of the JPO Trademark Examination Guidelines Relating to *Syuchi-Syohyo*: Chapter III: Article 4(1)(3) Part 8: Article 4(1)(10)

1. “Trademark which is well known among consumers” as prescribed in this paragraph includes *not only a trademark which is widely recognized among end consumers* but also a trademark which is *widely recognized among traders in the industry* and also includes not only a trademark which is known *throughout the country* but also a trademark which is *widely recognized in a certain area*.
2. A trademark to be cited for the application of the provision of this paragraph needs to be widely recognised among domestic consumers in Japan at a time when an application for the registration of a trademark is filed (refer to Article 4(3).).
3. *To prove a trademark's being well known under the provision of this paragraph, the provisions of Items 3(1) and (2) of Chapter II (Article 3(2)) of the Guidelines apply mutatis mutandis.*

¹²⁸⁹ Emphasis added in the text provided by the author.

Appendix 4: An Annotated¹²⁹⁰ Version of the JPO Trademark Examination Guidelines Relating to Well-known Trademarks Article 4(1)(19): Chapter III: Article 4(1)(3) Part 17: Article 4(1)(19)

For example, trademarks presented below fall under the provision of this paragraph.

- (a) A trademark of which the registration is sought to, taking advantage of a well-known foreign trademark or a trademark similar thereto being not registered in Japan, force its purchase, prevent a market entry by the owner of that foreign trademark or force the owner of that foreign trademark to conclude an agent contract
- (b) A trademark identical with or similar to a trademark well known throughout Japan, for which an application is filed with an intention to dilute the distinctiveness of the well-known trademark to indicate the source of goods or impair the reputation, etc. of the trademark owner, however the trademark of that application *per se* is not liable to cause confusion over the source of goods.

2. Trademarks “well known among consumers” as stipulated in this paragraph not only mean trademarks widely known to final users but include trademarks widely recognized among traders.

3. Trademarks “well known among consumers … abroad” as stipulated in this paragraph need to be *well known in the countries they originate from* but *not necessarily need to be well known in multiple countries outside those countries*. Nor do they in Japan.

4. A judgment on an “unfair purposes” needs to be made with full consideration given to the following materials, if available.

- (a) Materials proving a fact that *another person’s trademark is well known among consumers* (the period, scope, frequency of its use);
- (b) Materials showing that a well-known trademark is composed of a *coined word* or particular in composition;
- (c) Materials proving a fact that the owner of a well-known trademark has a *concrete plan* to make a market entry in Japan (such as, for example, exportation to Japan, sales in Japan, etc.);
- (d) Materials proving a fact that the owner of a well-known trademark *has a plan to expand its business* in the near future (such as, for example, the start of a new business, development of its business in new areas, etc.);
- (e) Materials proving a fact that the owner of a well-known trademark is forced to accept a demand from a trademark applicant for the purchase of a trademark in question, the conclusion of an agent contract, etc, and;
- (f) Materials showing that a trademark, if used by its applicant, is liable to impair credit, reputation, consumers-attractiveness built up in a well-known trademark.

5. A trademark in correspondence to (1) and (2) is considered to guess what the trademark is used with unfair intention.

¹²⁹⁰ Emphasis added in the text provided by the author.

- (1) A trademark which is identical or very similar to a well-known trademark in other countries or a trademark well-known throughout Japan.
- (2) The above-mentioned well-known trademark is composed of a coined word or particular in composition.

6. Judgment of whether the trademark is well known or not apply mutatis mutandis Article 3(8) (Article 4(1)(x)) of the guidelines.

Appendix 5: An Annotated¹²⁹¹ Version of the JPO Trademark Examination Guidelines Relating to *Distinctiveness* Chapter II: Article 3(2)

3. (1) Judgment as to whether a trademark has come to gain its distinctiveness through use will be made, taking the following points into consideration. Specifically, the level of consumers' awareness, which will be estimated through a quantitative grasp of the use of a trademark, will be utilized to judge the distinctiveness of a trademark.

- (i) A trademark actually in use and goods or services for which it is used;
- (ii) The start of its use, the length of its use, or the area where it is used;
- (iii) The volume of production, certification or delivery and a scale of business (number of stores, an area of business, an amount of sales, etc.);
- (iv) The method, frequency and contents of advertising;
- (v) The number of times of appearance in general newspapers, trade journals, magazines and the internet, and contents thereof;
- (vi) The outcome of the questionnaire regarding consumers' awareness of the trademark.

(2) The above facts need to be proved by a method using evidence, including:

- (i) Printed matter (newspaper clippings, magazines, catalogues, leaflets, etc.) carrying advertisements, public notices, etc.;
- (ii) Invoices, delivery slips, order slips, bills, receipts, account books, pamphlets, etc.;
- (iii) Photographs, etc. showing the use of a trademark;
- (iv) A certificate by an advertisement agency, broadcasting agency, publisher or printer;
- (v) A certificate by a trade association, fellow traders or consumers;
- (vi) A certificate by a public organization, etc. (the state, a local public entity, a foreign embassy in Japan, a Chamber of Commerce and Industry, etc.);
- (vii) Articles in general newspapers, trade journals, magazines and the internet;
- (viii) Outcome reports of the questionnaire intended for consumers regarding awareness of the trademark.

However, due consideration will be given to the objectivity of the questionnaire with respect to the conductor, method, and respondents.

(3) Judgment as to whether a trademark has come to gain its distinctiveness through use will be made with consideration given to the frequency of use by people other than the applicant ("other than the applicant and the members" in the case of a collective trademark), and the status of use.

¹²⁹¹ Emphasis added in the text provided by the author.

Appendix 6: An Annotated¹²⁹² Version of the JPO Trademark Examination Guidelines Relating to *Kondo* Chapter III: Article 4(1)(3) Part 13: Article 4(1)(15)

2. To *judge* the liability of a trademark “likely to cause confusion in connection with the goods or services pertaining to a business of another person” the following *factors are comprehensively taken into consideration*.

- (a) How much the other person’s trademark *is known* (the degree or dissemination of advertisement, publicity, etc.);
- (b) Whether the other person’s trademark is *a creative mark*;
- (c) Whether the other person’s trademark is *a house mark*;
- (d) Whether there is *the possibility of multiple businesses*, and;
- (e) Whether there is *any relationship between goods, services or goods and services*.

However, the judgment of above (a) may not be well known throughout the country.

3. *To prove a trademark’s being well known as in Item 2(a) above, the provisions of Items 3(1) and (2) of Chapter II (Article 3(2)) of the Guidelines apply mutatis mutandis.*

5. A combination of another person’s registered trademark “well known among consumers” and other characters or diagrams are, in principle, handled so as that it may cause confusion in the source of the goods or services, including those trademarks which the description of the composition of appearance is well united or conceptually related.

However, exemptions will be made when a part of the well known trademark of another party consists of a segment of an established word, or, when it is clear that the source will not be confused in relation to the designated goods or designated services.”

¹²⁹² Emphasis added in the text provided by the author.

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ⁱ Article 6ter(1)(b) of the Paris Convention.

ⁱⁱ *Ibid*, Article 1(2).

ⁱⁱⁱ *Ibid*, Article 6bis.

^{iv} *Ibid*, Article 6sexies. Service marks are recognised, but there is no obligation to protect them.

^v *Ibid*, Article 7bis.

^{vi} *Ibid*, Article 8.

^{vii} *Concept of ‘trade mark’* is both indirectly stated and is implicit within the Article 6quinquies B(ii) of the Paris Convention as follows: marks, which are “...devoid of any distinctive character”; and marks which “...consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language...”.

^{viii} Article 1(1)(a) of the TLT.

^{ix} *Ibid*.

^x *Ibid*, Article 2(2)(a).

^{xi} *Ibid*.

^{xii} Article 2(2)(a) of the Singapore Treaty.

^{xiii} Article 15(1) of GATT TRIPS.

^{xiv} *Ibid*.

^{xv} Article 22 of GATT TRIPS.

^{xvi} *Ibid*, Article 15(1).

^{xvii} Article 4 of the CTMR.

^{xviii} *Ibid*.

^{xix} *Concept of ‘trade mark’* can be found in the criterion that signs have to be capable of being distinguishing the goods or services of one undertaking from those of others: i.e. trade mark *concept* is distinctiveness.

^{xx} Article 4 of the CTMR.

^{xxi} Article 2 of the Japanese Trademark Act.

^{xxii} *Ibid*.

^{xxiii} Distinctiveness is implicitly present in the *kanji* symbols.

^{xxiv} Article 2 of the Japanese Trademark Act.

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