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**PROTECTION OF WELL-KNOWN TRADEMARKS:
A COMPARATIVE ANALYSIS OF THE UNITED STATES AND
THE EUROPEAN UNION**

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I declare that I have compiled the paper independently
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ABSTRACT

The international companies are constantly facing challenges in the globalised market economy. The brand value is one of the most important assets that a company can have. For this reason, the legal protection of trademarks has a crucial role in the international business. In order to protect the well-known trademark of a company, the legal certainty is vital. Although the European Union has developed the harmonised legislation of the unitary trademark, the protection and enforcement of the rights of well-known trademark are not an unambiguous subject. This thesis examines whether the legal protection of well-known trademarks is sufficient safeguard international business in the European Union. The purpose of the thesis is to outline the issues of the legal protection of well-known trademark in the EU and to establish the possible means that it could be contributed to. The main argument is that the trademark protection is not sufficiently effective when it comes to the well-known trademarks. Even if the well-known mark can acquire prior rights in the region, the protection against dilutive acts may have some shortcomings. The thesis is carried out by reviewing and comparing the legal framework of trademark protection and case-law in the United States and European Union. In the light of this thesis, it is concluded that the legal protection in the EU lacks effectiveness and further harmonisation through elaboration is needed.

Keywords: well-known trademark, dilution, Paris Convention, comparative analysis.

INTRODUCTION

Trademark is a valuable asset of a company which connects the goods and services to the origin of them. The inherent value of the mark is a result of long-term investment for the business and it requires substantial amount of resources in order to improve it and also to preserve it. The main purpose of the trademark law is to protect the identification functions which bring additional value to the company.¹ As the evaluation of goodwill and reputation of the trademark is not oversimplified, it is also vulnerable to trademark infringements. Damaging the goodwill can cause irreparable detriments for the company. Therefore, the existence of legal means in intellectual property has been highly important to protect trademarks from infringements.

The international dimension of intellectual property has experienced an enormous development during the past centuries. Paris Convention, which established a Union for the protection of these rights is the biggest milestone in the trademark law.² The status of a well-known mark has been established in Article 6bis of the Convention. A well-known mark or famous mark refers to a legal doctrine that a trademark which is highly distinctive from others can trademark protection in the territory. However, there is no unified criteria for the recognition of it and it is not directly applicable in the legal systems. Due to the variety of its the legal definition and the impact of territorial principality, enforcing the rights of the mark may become time-consuming and costly. When it comes to the protection of well-known marks, the application of the doctrine may have various problem. Therefore, the businesses may be easily exposed to some legal issues, especially when it comes to cross-border transactions.

The protection of European Union trademarks support the equality of the goods and services, which is one of the fundamental principles of the Treaty. The European Union has contributed the legal system of trademark protection throughout the years with an aim of common benefit of all users of trademarks in the whole region. The aim of the legal framework is to secure the right of trademark owners to prevent the derogation of reputation embodied in the trademark. This is

¹ Bone, R. G. (2006). Hunting goodwill: history of the concept of goodwill in trademark law. *Boston University Law Review*, 86(3), 555.

² World Intellectual Property Office (WIPO) Paris Convention for the Protection of Industrial Property, 20 March 1883, Paris.

particularly important for the well-known trademarks; as the CJEU has established, the distinctiveness of the mark increases the probability of the trademark infringement.³ Nonetheless that the famous mark would be trademarked as an EUTM, the enforcement of the rights can still end up with contrary results. For instance, the recent ruling of trademark dispute between Adidas and H&M in the Netherlands is completely opposite to comparable case in Germany. These different outcomes in the national courts argue against the idea of the unitary mark.

The research question of this thesis is whether the trademark protection in Europe is sufficient particularly regarding the protection of well-known marks as established in Article 6bis of Paris Convention. Moreover, the thesis assesses how the well-known marks are protected from dilution in the EU. In order to do so, the legal framework of a well-known mark in EU is examined and compared to the United States. These differences are examined by case-law in EU Member States and US courts, particularly regarding the likelihood of confusion and dilution, which usually establish grounds for the protection of famous marks.

The subquestions of this thesis are following:

- 1) How is the well-known mark protection and enforcement regulated in the global level, in the European Union and in the United States?
- 2) What are the problems that a company faces to in Europe to protect and enforce a well-known trademark in Europe?
- 3) How does the application of Article 6bis Paris Convention and protection of well-known marks in general differ in the US legal system?

The hypothesis of the research is that, even if the well-known mark can acquire prior rights in the region, the protection against dilutive acts may have some shortcomings. One of the ways of contributing the EU legal framework could be the implementation of the US type of dilution assessment in the courts.

Firstly, the thesis describes the international legal framework of the well-known trademark. The second chapter gives an overview of the European trademark regulation. Subsequently, the legal framework of the well-known mark and the protection of it in the United States is discussed. The fourth chapter establishes some problems that may emerge in enforcing and protecting well-known trademark in Europe. The fifth chapter examines the case-law in the United States and European

³ Court decision, 11.11.1997. *Sabel v Puma*, C-251/95, ECLI:EU:C:1997:528, point 6.

Union relating to the subject. Also, possible solutions for the thesis problem will be analysed. The last chapter ends with conclusions, discussing about ways of protecting the trademark and also the impact of the difference between these two legal systems.

1. GLOBAL PROTECTION OF TRADEMARKS

International legal framework of intellectual property has grown during the past century and the protection of the rights certainly have progressively acquired international characteristics. Therefore, the obligations deriving from the international treaties have also brought importance to the domestic legislations.⁴ The research begins with explanation of the global protection for trademarks in order to give a comprehensive overview of the legal framework in the national level.

1.1. The Paris Convention

The Paris Convention for the Protection of Industrial Property adopted in 1883 constituted the grounds of international trademark law. The Convention states that a trademark is a sign to indicate one enterprise from those of others. Moreover, it gives the proprietor the exclusive rights to use the trademark. The Convention emphasizes the national treatment principle, which denotes the necessity of having the same protection in a Contracting state as the national person would have. This means that a foreign owner of the trademark must enjoy equal and no less than equal treatment as the owner of the trademark in the country.⁵

The Article 6(3) of the Paris Convention states that a mark registered in a country of Contracting state may enjoy the corresponding rights in any other of Contracting states. Where the mark has been registered as a trademark, the other Contracting states have an obligation to accept this trademark in their registry and provide protection for it. The Contracting state has a right to refuse the protection only if it infringes the rights of third parties. Therefore, the Convention thrives for the equality between the national and foreign owner of a trademark. However, this does not denote that the Members are obliged to extend their protection outside the borders; indeed, it signifies that the mark may enjoy the equal rights in the Member country according to the conditions of the domestic legislation. A vast number of countries establish the existence of the trademark based on

⁴ Morris, P. (2019). From territorial to universal – the extraterritoriality of trademark law and the privatizing of international law. *Cardozo Arts & Entertainment Law Journal*, 37(1), 34-35.

⁵ Takouche, A. (2019). Well-known, or not well-known: That is the question. The Paris Convention for the protection of industrial property's Article 6bis in the context of American trademark law. *UC Irvine Law Review*, 9(2), 505.

the use and commercial significance in the territory of the country. This can be difficult to prove for a foreign trademark whose owner has put the mark in commercial use only in the other Member countries. The differences in the domestic provisions may thus prevent another mark to be protected in the other country irrespective of the Convention.⁶ For instance, Danish trademark legislation provides protection already on the basis of the use of the mark, whereas the Estonian law requires that the trademark must have acquired certain level of knowledge in the Estonian population.⁷

1.2. TRIPS Agreement

The TRIPS (The Agreement on Trade-Related Aspects of Intellectual Property Rights) agreement established in 1994 created a harmonising legal instrument of the international intellectual property law. The purpose of this agreement was to enhance the prevention of distortions and impediments of intellectual property rights in the international trade. Moreover, the necessity of ensuring means and procedures of the cross-border enforcement for these rights are emphasized.⁸

The Agreement sets its minimum standards for the adaptation of international provisions among Members. Like the Paris Convention, also the TRIPS Agreement includes the “national treatment” obligation which signifies the prohibition of derogatory treatment for the nationals of other Members. Additionally, TRIPS establishes the “most-favoured-nation treatment” which prohibits the discriminatory behaviour towards these foreign nationals.⁹ These obligations constitute the basis for the rules of examining the rights of foreign trademarks.

1.3. The well-known mark doctrine in international law

When it comes to the well-known mark doctrine, Article 6bis of the Paris Convention which establishes rule for “well-known marks” is very important subject in the international trademark law when protecting trademarks across the borders. According to this article, the countries shall

⁶ *Ibid.*, 505-506.

⁷ von Bomhard, V., & Geier, A. (2017). Unregistered trademarks in EU trademark law. *Trademark Reporter*, 107, 687-688.

⁸ The World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), 33 I.L.M 1197, 15.4.1994.

⁹ Dave, S. (2001). Trips: International trademark law that promotes global trade. *Journal of Contemporary Legal Issues*, 12(1), 458-459.

give the right of a well-known mark to prohibit the use of a mark which is liable to create confusion. The well-known mark does not have to be necessarily registered in the country in question, which means that also the foreign marks are applied under this article. The Convention does not define precisely the characteristics of well-known mark and the definition is left to the Contracting States. However, Article 16(2) of the TRIPS elaborates the assessment of the well-known mark by providing that the knowledge of the mark for the relevant public and the knowledge in the contracting country in question should be taken into account. In the Joint Recommendation Concerning Provision on the Protection of Well-Known Marks, among any circumstances from which it may be concluded that the mark is well-known, also the authorities shall consider the degree of knowledge, duration, and geographical area of the mark. Moreover, the enforcement in other competent authorities are taken into consideration.¹⁰

¹⁰ *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* (1999). World Intellectual Property Organisation. Retrieved from: <https://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf> , 18 March 2020

2. TRADEMARK PROTECTION IN THE EUROPEAN UNION

Trademark law in Europe is often regarded to be more restricted than in the U.S. The differences in the civil and common law jurisdiction certainly has its footstep in these matters, which is crucial to remember when the trademark law is being examined in international level.¹¹

As the balancing of trademark law was an important issue in the European Community (anterior to European Union) integration process, the first regulation on Community trademarks was established in 1993.¹² The most recent legislation is the EU Trademark Regulation 2017/1001¹³. This paper will assess this Regulation since it is the most comprehensive and relevant source for the objective of this research.

The free movement of goods and services is a fundamental principle of the EU. One of the main aims of the Regulation is to promote the harmonised development of professional activities in the properly functioning internal market. Therefore, it seeks to create uniform protection by the EU trademarks and produce this for the entire area of the Union. The Regulation establishes the exclusive right of a trademark owner to prevent the use of the identical or similar mark. Moreover, a company is able to register an EU trademark, which provides uniform protection in the whole area of the EU. The purpose of the EU trademark is to provide means of protection and instruments in the entire European Union, irrespective of the frontiers.

¹¹ Pozen, R. C., & Hirsch, J. (2008). *US and EU Trademark Protection*. Retrieved from: https://edisciplinas.usp.br/pluginfile.php/4115991/mod_resource/content/1/US%20and%20EU%20trademark%20protection.pdf , 17 March 2020.

¹² Schovsbo, J. (2018). "Mark my words" Trademarks and Fundamental Rights in the EU. *UC Irvine Law Review*, 8(3), 563-564.

¹³ Regulation (EU) 2017/1001 of 14 June 2017 of the European Parliament and of the Council on the European Union trade mark, OJ L 154, 16.6.2017

2.1. The marks which enjoy protection in the European Union

According to Article 4 of the Regulation, any sign which represent the products and is able to distinguish itself from the others can be considered as a trademark by registration. This includes any representable sign, words, names, shapes, colours, designs, letters, numerals or sounds. The ability of being distinguished from other marks denotes the distinctiveness of the mark, which is an important matter when assessing possible infringements. Moreover, natural to well-known marks, even if the sign itself is not distinctive, it can acquire its distinctiveness through use.¹⁴

2.4. The well-known mark in the EUTMR

The status of “well-known mark” by the meaning of the 6bis of Paris Convention is not directly implemented in the Regulation, but it is included in the meaning of the earlier trademark. Article 8 of the relative grounds for refusal provides the right to oppose registration when the earlier mark has a reputation. Among others, the meaning of the “earlier mark” includes the registered EU trademarks which are well-known in the sense of Article 6bis of the Paris Convention. The proprietors of these marks are entitled to oppose for the registration of the marks, request for invalidity and prevent the use of the third parties. The right applies when the registration would take unfair advantage or be detrimental to the reputation of the mark. Also, Article 9 establishes the exclusive right to prevent the use of the mark by third parties based on the same conditions. In order to apply these rights in question, case-law has stated that the owner must demonstrate evidence which appoint the change in the consumer’s economic behaviour or alternatively, that there is a serious risk of this to happen.¹⁵

2.2. Trademark infringement

One of the main principles in the trademark infringement is that in order to infringe the trademark rights of another, one must use the identical or similar mark as a trademark. In other words, the

¹⁴ Bainbridge, D., (2015). *Intellectual Property Law*. (4th ed.) Harlow, England: Pearson Education Limited, 123.

¹⁵ Tyagi, M. (2017). *Unfair Advantages Associated with Likelihood of Confusion ad Dilution in Trademark Law*. (Master’s thesis) Uppsala University, Uppsala.

use of the mark must give an impression to the consumer that the mark connects the product to the origin of it. This use can emerge by selling, investing, or advertising the product. ¹⁶

Distinguishing the identity or similarity of the challenged mark is important when assessing the trademark infringement. The Court of Justice has stated that identical marks are the ones which are only slightly differing and these differences cannot be easily notified by the average consumer. The identical marks can be assessed as an infringement with no further research.¹⁷ However, when it comes to similar marks, the likelihood of confusion has a significant role. For instance, the likelihood of confusion is examined in adidas' cases where the challenged mark is consisted of two stripes or four stripes.

When the challenged mark is not identical with the senior mark, the consumer confusion must be demonstrated. The trademark infringement by similar marks is based on the assessment of likelihood of confusion. Acts of confusion signifies conduct which leads to the error of an average consumer regarding the origin of the goods or services. This is examined by the distinctiveness of the mark and similarity of it to the later mark. In detail, the average consumer means "reasonably well-informed, observant and circumspect."¹⁸ So far, the market survey in the relevant public has been considered as an effective mean to prove this.¹⁹ The notion of "relevant public" signifies the specific section of targeted consumers which is interested in the goods or services of the market in question.²⁰

2.3. Dilution in EU law

There is no literal notion for the dilutive acts in EU legislation. However, the dilutive acts are comparable to the use of the mark which take unfair advantage and is detrimental to the distinctiveness or the reputation of the mark. The protection against detriment is important since the purpose of it is to avoid the reduction of brand identity of the business and to avoid the deceptive associations.²¹ If there is a possibility that the use of the mark would harm the functions or take advantage of the well-known mark or trademark with reputation, it would probably breach the exclusive rights of the proprietor. According to CJEU, the detrimentality and unfair advantage

¹⁶ Bainbridge (2015), *supra nota* 14, 137.

¹⁷ *Ibid.*, 139.

¹⁸ *Ibid.*, 138-139.

¹⁹ von Bomhard, V., Geier, A. (2017), *supra nota* 7, 689.

²⁰ *Ibid.*, 683.

²¹ Burrell, R., Handler, M. (2016) Reputation in European Trade Mark Law: a re-examination. *ERA Forum* 17(1), 86.

can therefore constitute grounds of dilution.²² The main principle denotes that the more immediate is the connection to the earlier mark by the later mark, the more likelihood of detrimentality there is.²³ The case-law has brought some attributes of the dilutive acts. The judgment of Intel Corporation C-252/07 established an important rule that where the public does not connect a link between the trademark and the later mark, the use of the later mark does not create unfair advantage. CJEU established the following factors which can create this connection:

- i. the similarity between the marks;
- ii. similarity of the products;
- iii. the strength of the reputation of earlier mark;
- iv. the distinctiveness of the earlier mark; and
- v. the likelihood of confusion by the relevant public.²⁴

The detrimental use and unfair advantage are usually proven by market reports which refer to the famousness of the exploited mark. When it comes to the similarity of the signs, EU has lower standards for the similarity in comparison with the US.²⁵

²² Shchetinina, A. (2018) *The Dilution of a Trademark: A Comparative Study on EU and U.S. Law*. (Master's thesis) University of Vienna, Vienna.

²³ Onishi, H. (2015). *Well-known trademarks: A comparative study of Japan and the EU*. New York, US: Routledge, 111.

²⁴ Gielen, C. (2014). Trademark Dilution under European Law. *Trademark Reporter*, 104, 712-713.

²⁵ Fhima, I. S. (2011). *Trade mark dilution in Europe and the United States*. Oxford: OUP Oxford, 107.

3. TRADEMARK PROTECTION IN THE UNITED STATES

As already established in the previous chapter, the US legal system has a wider scope of protection for the trademarks. The Lanham Act of 1946²⁶ established rules for trademarks, service marks and unfair competition. According to the Lanham Act, trademark in its terms signifies any words, names, symbols, or designs. Moreover, the case-law has interpreted the shapes, sounds, fragrances and colours being eligible for the registration of the trademark.²⁷ This criteria proves that a business is able to protect a more exhaustive list of certain aspects essential to their business under this legal framework.

3.1. Trademark eligibility in the US

An important aspect in the US legal system is the requirement of the use of the trademark. This means that the trademark must be at least commercially used in order to qualify as a trademark. No registration is therefore required. The requirement provides a more extensive protection in comparison with the European legal system, which is based on the first-to-file system. Use in commerce is sufficient to establish the priority over another proprietor regardless of whether the trademark has been registered or not. This can be established by any type of use which has indicated the mark to the origin.²⁸ The Section 44 of the Lanham Act also gives possibilities to register the trademark based on use in another country. According to this, having a proof of registered mark in, for instance Australia, would be sufficient to fulfil requirements of US trademark registration. However, the territoriality principle is in contradiction with the foreign use basis.²⁹ Also, as it will be discussed in the fifth chapter, the case-law has established that some level of use must be established in US commerce in order to claim for rights of foreign mark.

²⁶ The Lanham (Trademark) Act, 5 of July 1496, 15 U.S.C §§ 105

²⁷ Lehrman, F. Z., Zissu, P. (2018) USPTO: Registration of Non-traditional Trademarks. Retrieved from <https://www.lexology.com/library/detail.aspx?g=25dbbf32-f376-430e-a2bb-6175c34c3344> , 7 May 2020.

²⁸ Pozen, R. C., & Hirsch, J. (2008), *supra nota* 11, 2.

²⁹ Lainer, Z. (201 6). Mouse vs. mau5: Implications of the Morehouse Defense in International Trademark Disputes. *Southern California Law Review*, 89(3), 675-677.

3.2. Trademark infringement in the US

The Lanham Act provides the rules for both registered and unregistered marks. Regarding the registered marks, Article 1114 states that the trademark violation is constituted by any reproduce of the mark which is likely to cause confusion, mistake or deception in the connection with the registered mark. Article 1125 of the Section 44 establishes the prohibition of false designation of origin, description and forbidden dilution. The unregistered marks are covered under the latter article. The plaintiff has the burden of proof to show that the mark is not functional and that the mark is famous.

Analysis of the likelihood of confusion in US defines the probability to cause confusion, mistake or deception to the senior mark.³⁰ The likelihood of confusion is assessed by the similarity of the products or services, the relative marketing channels, and possible overlap in the sales. In general, the main concern in the trademark infringement is the actual use of the mark by the infringer to promote the products.³¹

3.3. The well-known marks and dilution

Regarding the protection of the trademark in the United States, the concept of well-known mark as in the Paris Convention is not exhaustively established in the Lanham Act. The courts have applied this doctrine in some cases by interpreting the Section 44 of the Act. However, the consideration is depended on the territorial use of the mark in US.³²

For the well-known marks, the US legal system provides protection beyond the standard of likelihood of confusion.³³ This is called the trademark dilution. The likelihood of dilution, as established in the Trademark Dilution Revision Act 2006, provides famous trademarks the right to have protection from use that can blur the distinctiveness of the sign or create a negative impact for the reputation of the mark. Different to European legal protection, the dilution claim allows the famous trademark owner to receive remedies with no proof of likelihood of confusion. Instead, the

³⁰ Choi, M. J. (2019). The likelihood of exclusion: Economic disparity in the united states trademark system. *Journal of the Patent and Trademark Office Society*, 100(4), 603.

³¹ Dogan, S. L.; Lemley, M. A. (2007). *Grounding trademark law through trademark use*. Iowa Law Review, 92(5), 1677.

³² Barker, B. (2006). The power of the well-known trademark: Courts should consider Article 6bis of the Paris Convention an integrated part of Section 44 of the Lanham Act. *Washington Law Review*, 81(2), 364-367.

³³ International Trademark Association (2017). *Trademark Dilution*. Retrieved from: [https://www.inta.org/TrademarkBasics/FactSheets/Pages/Trademark-Dilution-\(Intended-for-a-non-legal-audience\).aspx](https://www.inta.org/TrademarkBasics/FactSheets/Pages/Trademark-Dilution-(Intended-for-a-non-legal-audience).aspx) , 18 March 2020.

owner must demonstrate the following matters: that the mark is famous and distinctive; that the challenged mark is commercially used; that the famous mark has been famous before later mark; and that the use is causing dilution.³⁴ Moreover, Article 1125 (c) of the Lanham Act enacts two concepts of dilutive acts, which are the blurring and tarnishment. Dilution by blurring refers to any use of senior mark which reduces the power of the mark. Tarnishment denotes the dilutive acts which particularly create associations to the senior mark which derogates the value of the company.³⁵

The dilutive acts can occur also in the cases where the mark has been used for goods or services which are not in competing with the famous mark. Among others, the factors of famous mark include the distinctiveness, the duration and extent of the use, advertising and publicity issues as well as the geographical dimension of the mark in the area.³⁶ Also the degree of knowledge of the mark is taken into account. Contrary to the European trademark assessment, US system examines the degree of knowledge of the public in general instead of targeted group of consumers.³⁷

Comparing the US legal system to European system, it can be seen that the US has applied the Paris Convention in their own manner in the Lanham Act. Moreover, there are some important differences which may have impact on the protection of famous marks in courts. For instance, the confusion is examined by the general public instead of targeted group of consumers as in Europe. Moreover, the US system does not require evidence of the actual dilution of the infringement. These issues will be illustrated and compared to European system in the case-law analysis.

³⁴ Choi (2019), *supra nota* 30, 604-605.

³⁵ Macías, W., & Cerviño, J. (2017). Trademark dilution: comparing the effects of blurring and tarnishment cases over brand equity. *Management & Marketing*, 12(3), 346.

³⁶ Malliaris, S. (2010). Protecting Famous Trademarks: Comparative Analysis of US and EU Diverging Approaches --The Battle Between Legislatures and the Judiciary. Who is the Ultimate Judge? *Chicago-Kent Journal of Intellectual Property*, 9(1), 46-47.

³⁷ *Ibid.*, 58.

4. ISSUES OF THE ENFORCEMENT AND PROTECTION OF WELL-KNOWN MARKS

As it can be seen in previous chapters, EU has somewhat developed the legal concept of the well-known mark according to Paris Convention. However, the legal framework lacks effectiveness in international protection. There are several reasons why the enforcement of trademark rights may become difficult for a business.

4.1. Territoriality principle

Since the Paris Convention does not have international consensus on the criteria of well-known mark, the implementation of the Article 6bis differs widely between the Contracting countries. The legal interpretation is affected by the territoriality principle. This principle establishes that the intellectual property rights are valid only according to the laws in the country in concern. Therefore, it gives priority for the nationals over the foreign trademark.³⁸ This does not denote that the countries must extend their protection outside their borders; indeed, the principle establishes the separate existence of a trademark between countries.³⁹

The principle does not exclude the trademarks of globally famous companies either. As mentioned before, Contracting states are not obliged to provide any protection for the well-known marks if it is not qualified as a trademark in the national legal scope. In other words, if the mark has not been registered or used in the territory, it can be very unlikely that the mark would acquire any rights to protection. For example, Indonesia, which is one of the contracting parties of the Paris Convention, had frequently declined the recognition of well-known marks such as Dior and Ikea before the amendment of the new law of 2016 which recognised the protection of unregistered well-known

³⁸ Handl, G. Zekoll, J., Zumbansen, P. (2012). Territoriality and Extraterritoriality in Intellectual Property Law. *Queen Mary Studies in International Law*, Leiden/Boston: Brill Academic Publishing, 1-3.

³⁹ Darnton, J. E. (2011). The coming of age of the global trademark: The effect of TRIPS on the well-known marks exception to the principle of territoriality. *Michigan State University College of Law International Law Review*, 20(1), 12.

trademarks.⁴⁰ This illustrates the problem that a company can face when they would like to register their famous trademark in another territory.

4.2. Problems in the protection of EU trademark

Nonetheless that EU has established common legal instruments on the trademark protection, the regulation states that the Union law cannot replace the laws of the Member States. For this reason, there are differences in the national jurisdictions. For instance, the Member States provide protection only for the EU trademarks with reputation over the national trademarks. This may impede the idea of the unitary mark which should be legally protectable in the whole European Union. Moreover, it creates uncertainty in enforcing the rights of EUTM in national courts.⁴¹

When the national laws are widely different between the Member States, the protection of the marks may become uncertain when it comes to the possible trademark infringements. For instance, the use of the mark in the territory is sufficient for the protection in Denmark, whereas in other countries like Estonia, this also requires a high level of knowledge in the population. Therefore, some national legislations do not protect trademarks beyond the Article 6bis Paris Convention whereas the others are having rather comprehensive criteria for it.⁴² This can be problematic for the businesses expanding from one Member State to another and can expose to the exploitation of the trademark particularly when the company is not highly recognised in the respective area.

In the Union level, the CJEU has referred to the comprehensive recognition of the well-known mark within the whole European Union.⁴³ However, referring to different rulings, it can be seen that the well-known status assessment has not taken into account the vast differences in the population sizes and thus it creates a controversy. This can be illustrated when comparing the *Pago* case, where CJEU interpreted a company to have a well-known status since it was sufficiently popular in Austrian territory. However, acquisition of knowledge in Tarragona, a city in Spain with

⁴⁰ Nugraha, A. (2016). *IKEA verdict: Another bad sign for intellectual property rights*. Retrieved from <https://www.thejakartapost.com/news/2016/03/04/ikea-verdict-another-bad-sign-intellectual-property-rights.html> , 17 March 2020.

⁴¹ Klimkevičiūtė, D. (2010). The legal protection of well-known trademarks and trademarks with a reputation: the trends of the legal regulation in the EU member states. *Societal Studies*, 3(7), 241.

⁴² von Bomhard, V., Geier, A. (2017), *supra nota* 7, 694.

⁴³ Dinwoodie, G. B. (2017). Territorial overlaps in trademark law: The evolving European model. *Notre Dame Law Review*, 92(4), 1680.

a population equivalent to Austria, was not sufficient in order to achieve the protection of a well-known trademark.⁴⁴

Particularly regarding the well-known trademarks, the territoriality issues have a crucial role in the assessment of the rights of intellectual property.⁴⁵ Proving the unfair advantage and detriment of the trademark can be difficult because the assessment contains many subjects which are dependent on the evidence linked to the territory. Moreover, among relevant goods or services, the distinctiveness acquired through use must be established according to the evidence in certain geographical area.⁴⁶ Since court decisions rely usually to consumer reports in the particular territory, the high level of knowledge in one Member State may not be sufficient basis to acquire legal protection in the other Member State.⁴⁷ Therefore, the most secure way to achieve effective protection of the EUTM in every Member State requires acquisition of knowledge separately in each country. As Dinwoodie concludes this, “the unitary mark is valid for the entire EU or not at all.”⁴⁸

4.3. Issues occurring from the lack of protection

At the end of the day, the EUTM regulation should give exclusive rights for the trademark owners to prevent the use of the third parties. However, as it can be deduced from the aforementioned issues, there are many challenges which can affect the effective protection of trademarks. The influence is vast particularly on the well-known marks, which are vulnerable to dilutive acts. Indeed, the territoriality principle has a crucial effect in companies which are seeking to enforce the trademark rights in EU. The principle is problematic since it causes differences in the interpretation for the well-known mark. It can make enforcement of the trademark rights in the whole region difficult. According to Morris, the significance of the territorial doctrine has decreased, and the international intellectual property law is slowly moving further to the more unified global legal framework.⁴⁹ However, it is certain that as long as there is no unified

⁴⁴ von Bomhard, V., Geier, A. (2017), *supra nota* 7, 681.

⁴⁵ Slováková, Z. (2008). International Private Law Issues regarding Trademark Protection and the Internet within the EU. *Journal of International Commercial Law and Technology.*, 3, 76.

⁴⁶ European Union Intellectual Property Office (2007). *Opposition guidelines*. Retrieved from: http://euipo.europa.eu/en/mark/marque/pdf/global_assessment-EN.pdf, 18 March 2020.

⁴⁷ von Bomhard, V., Geier, A. (2017), *supra nota* 7, 689.

⁴⁸ Dinwoodie (2017), *supra nota* 43, 1680.

⁴⁹ Morris, P. (2019), *supra nota* 4, 85.

recognition of international well-known marks, the uncertainty caused by the territoriality aspect keeps existing.

All of these issues create obstacles for businesses particularly when they are expanding their business and enforcing their trademark rights internationally. It is certain that due to the globalisation and internet, the need of expanding the trade mark rights across the countries is more vital than before. New businesses need trademarks that can be effectively protected from the misuse in the market.⁵⁰ It can be found difficult to trust in the legal system because there have been various outcomes by different analogies regarding famous marks and dilution in Europe. Moreover, the examination of unfair advantage and detriment is usually time-consuming and expensive. This is by the reason that the factors of the infringement are not unambiguous particularly when a third party is assumably using a mark which is similar to a well-known mark. As Choi points out, the lack of screening mechanism that could justify the fair use of the trademark leads to the situation where the cases always require confusion assessment.⁵¹

⁵⁰ Friedmann, D. (2016). The Uniqueness of the Trade Mark: A Critical Analysis of the Specificity and Territoriality Principles. *European Intellectual Property Review*, 38(11), 678.

⁵¹ Choi (2019), *supra nota* 30, 606.

5. CASE LAW ANALYSIS

This chapter includes an analysis of several cases involving the assessment of the status of well-known mark and its impact in examination of infringement by likelihood of confusion and dilution.

5.1. National or EU trademark prevailing over the foreign trademark

In order to demonstrate the ways how the use of the trademark by third parties is rejected, the case *Thomas Pink Ltd v. Victoria's Secret UK Ltds* is a good example for the analysis. The claimant was a men's clothing retailer and had ran its business in the United Kingdom since 1984. The company had a significant turnover and a flagship store in London under marks Thomas Pink and Pink. The American defendant, Victoria's Secret, is one of the most well-known women's underwear brands worldwide. The defendant launched a sub-brand named PINK focused on lingerie in the United States and opened the first store in London in 2012. Thomas Pink argued that the Victoria's Secret's mark was an infringement of his Community trademark rights and it caused likelihood of confusion. Moreover, this caused detriment to the luxury brand which had acquired valuable distinctiveness through the decades of use. The defendant denied the dilutive acts, relying on the fact that the use was a sole extension of the business which had already taken place for years in the United States. The use in the US was completely legitimated and there was no confusion by the consumers. The court agreed that Thomas Pink had acquired the distinctiveness through use in the UK and stated that an average consumer could get confused of the marks in question. Moreover, even if Victoria's Secret is a globally known brand and it might have acquired distinctiveness through use in US territory, it could not nonetheless be subject to rights as there were no commercial use in the UK territory.⁵²

This case proves that even if a foreign mark is famous and it has been used for years, it cannot necessarily have place in an EU Member State where an identical, nationally well-known mark exists. This is due to the reason that the court assesses the distinctiveness in the area in question –

⁵² Chancery Division, F.S.R. 40 (2014), *Thomas Pink Ltd v. Victoria's Secret UK Ltd.*

in this case, the United Kingdom – and how a UK average consumer would perceive the marks. In other words, Victoria's Secret as a foreign mark cannot get protection in a country in question if there is no any level of knowledge by commercial use occurred. Therefore, the Court statement supports the protection of EU trademarks.

The same subject has been examined in the United States District Court in case *Belmora LLC v. Bayer Consumer Care AG & Bayer Healthcare LLC*. The defendant had complained on the registration of FLANAX trademark by Belmora in the US and claimed that the use would deceive the consumers into thinking that the pain relief medicine is the same as the FLANAX sold in Mexico by Bayer. Bayer had not registered nor used the mark in the US. However, the commerce of the product in Mexico, Centre and South America was wide, and the product had been well-known in the Latin American market for decades. Therefore, the defendant argued that it could be assumed that a consumer could conclude that the FLANAX sold by Belmora would be the same as Bayer's product. One of the main issues was the question of whether the Lanham Act allows the owner of a foreign mark to acquire priority rights in the United States even if the mark is not registered or used in US commerce.⁵³

The District court answered no to this question. The reasoning behind this was based on the idea that the Paris Convention, particularly Article 6bis, is not self-executing and it can be only applied in the wording provided in the Lanham Act Section 44. As the section establishes that the rights of the foreign nationals are conformed with the provisions of the legislation, the interpretations of the Section 44 must be regarded with the principle of territoriality. The judgment argued that although the Paris Convention is, by some parts, a self-executing convention (e.g. in some instances regarding patents) the Congress had implemented the Convention in the Lanham Act by the scope of limits in the wording.⁵⁴

The Court also referred to the landmark case *Punchgini*. The claimant, *Punchgini*, was an Indian corporation which had established a famous restaurant named *Bukhara* in New Delhi in 1977. The defendant, *ITC*, opened a *Bukhara* -named restaurant in New York in 1986 and registered the trademark a year later. When *Punchgini* expanded their business to US territory, *ITC* brought a lawsuit against *Punchgini* on trademark infringement. This case concluded that although the US

⁵³ Eastern District Court of Virginia, 1:14-cv-00847-GBL-JFA, *Belmora LLC v. Bayer Consumer Care AG & Bayer Healthcare LLC v. Belmora, LLC, Jamie Belcastro, & Does 1-10, Inclusive*.

⁵⁴ *Ibid.*, p. 3-4.

trademark system is based on the priority of use, the Congress was not willing to create a famous mark exception for foreign marks. This means that the Congress did not intend to have a complete application of the Article 6bis in the US law. Moreover, the case law had established that in order to conduct a complete application of Article 6bis, this should require a clear expression from the Congress. Furthermore, granting rights to foreign national would certainly weaken the territoriality principle. The Court could not disregard the fact that the territoriality principle has ruled already over hundred years in the decisions, which makes the principle rather incontestable.⁵⁵

5.2. Exceptions to the territoriality principle

As it can be deduced, granting rights for the foreign well-known mark does not come up as with the purpose of the Paris Convention in the global level. These cases signify that the Courts cannot merely interpret Article 6bis in the litigation and they must treat the well-known mark doctrine within the scope of the territoriality principle. Also, when it comes to foreign marks, it can be concluded that the prior use of the mark does not have significance in US either. Therefore, expanding a famous business from the EU to the US or vice versa seems to imply some uncertainty. It has not appeared to the author that any initiatives in the future would change this matter. There has been exceptions to the territoriality principle in the United States. In *Grupo Gigante SA v. Dallo Co.* of United States Court of Appeals, a Mexican grocery store chain sued Californian company for the infringement of the “Gigante” trademark. The claimant had used the trademark for a long period of time in grocery stores in Mexico and further expanded their business to US. Dallo had an operating company in California under registered trademark Gigante. Later on, Grupo Gigante challenged Dallo for the use of the trademark.⁵⁶

The court emphasized that under the first-to-use system, the trademark rights are acquired by the use. However, the priority on rights depends on the territorial use in the United States and it excludes any other use outside the country. There is nonetheless an exception to the territoriality principle when the foreign mark has been used in commerce for a longer period in the US. Therefore, if the mark has already achieved a certain level of knowledge in the country over the mark which has been first used in the US, the foreign user may gain the priority.⁵⁷

⁵⁵ *Ibid.*, p. 27-31.

⁵⁶ United States Court of Appeals, Ninth Circuit, 391 F.3d 1088 (2004) *Grupo Gigante SA De CV v. Da llo & Co. Inc.*

⁵⁷ *Ibid.*,

Eventually, the famous mark exception was granted because Grupo Gigante's earlier use was sufficient and the level of knowledge in the Southern California was a basis for the exception. Moreover, the court reasoned that the operational areas of the defendant and the claimant were different and there was no competition between these two markets. Therefore, the Court concluded that both of the companies shall accept the use of the mark by one another.⁵⁸ The author would like to point out that the court had quite strictly excluded the possibility that there would be any competition between the parties. There are still two companies with same mark providing same goods within the same state. Nevertheless, the case pointed out that there can be an exception to the foreign mark but may not acquire absolute protection throughout the whole territory.

5.3. Level of knowledge requirement

The Grupo Gigante case showed that in some situations, the Court can decide on behalf of a trademark which is used and has acquired knowledge in a certain region in a country. Reflecting this to EU case-law, establishing a company in one city of EU Member State would not be sufficient in order to acquire knowledge in the territory. As in the case based in Spain, two persons had a dispute over a use of a word mark Fincas Tarragona in the real estate business. Mr Nieto Nuño had registered the word mark, whereas Mr Leonci Monlleo Franquet had established an agency in Tarragona under the same name. Nuño brought proceedings against Franquet, claiming that the use infringed his trademark rights and caused confusion. As Mr Franquet had used the trademark earlier and was well-known for his services, he pleaded to the Article 6bis of the Paris Convention. The operation of the business had happened only in one region of Spain.

The Court of Justice was referred for a preliminary ruling, mainly on the issue of whether the mark enjoys the protection of a well-known mark when there is a certain level of knowledge solely in, for instance, an autonomous community, region, district or city. As the defendant argued, requiring the knowledge in the whole territory of Spain or a substantial part of it is a form of discrimination against businesses in smaller geographical area. Also, the dispute occurs in a local context which means that the acquisition of the rights should be based only on the area in question. The Court of Justice reasoned that trademark cannot be required to be well-known in the whole territory of the Member State but at least in a substantial part of it due to the lack of precise definition of well-

⁵⁸ *Ibid.*

known mark criteria. When a level of knowledge is based on solely in one city and to its area around it, it cannot fulfil the “substantial part” in a customary meaning of the well-known mark.⁵⁹

The situation is more convenient if the mark can be proven to be well-known at least in one Member State. The case Benelli ruled on this issue. An Italian company Benelli Q.J.Srl brought an action against the Second Board of Appeal of OHIM for rejecting his opposition against registration of a trademark by a German company Demharter GmbH. Benelli had based the opposition on the grounds that the company has used a similar mark as non-registered mark and it was well-known in Italy. The General Court of European Union concluded that it cannot be required that a trademark which is not registered but is well-known in a Member State of European Union should establish evidence in order to prove the well-known criteria, such as the reputation or use, in another Member State. This means that it is sufficient that Benelli only provides evidence to prove that it has been well-known in Italy before the date of application for the registration by Demharter.⁶⁰

According to the Benelli case, if the company wants to enforce their community trademarks rights in another Member State, the evidence that proves that it has been well-known in at least one Member State suffices. However, the same circumstances could have been assessed from different point of view. As in the case Messi v. EUIPO, the famous football player Messi brought a suit against EUIPO for rejecting the trademark registration for Messi. According to EUIPO, the mark was too similar with an EU trademark Massi, a famous bicycle equipment company in Italy. The General Court found that it is “ wrong to consider that the reputation enjoyed by Mr Messi concerns only the part of the public which is interested in football and sport in general. Mr Messi is, in fact, a well-known public figure who can be seen on television and who is regularly discussed on television or on the radio.” The Court added that it would be unlikely that the goods would not be directly associated to the famous football player by the consumer. Moreover, the Court reasoned that even if the consumer would have never been familiar with the name, it would be a very untypical case in the targeted group of consumers.⁶¹

What can be concluded from these cases, it has not been comprehensively established whether the reputation in one Member State is sufficient to enforce the trademark rights in the whole region.

⁵⁹ Court decision, 13.09.2007. Nieto Nuño, C-328/06, ECLI:EU:C:2007:704

⁶⁰ Court decision, 2.02.2016. Benelli Q.J., T-169/13, ECLI:EU:T:2016:56

⁶¹ Court decision, 26.04.2018. Messi, T-554/14, ECLI:EU:T:2018:230

As mentioned before, the difficulties in defining the well-known status in EU is also problematic because the population sizes can be vastly different, and therefore one city in another country can be equivalent to the whole another Member State.⁶² Moreover, when it comes to the public perception, the dilutive acts are interpreted according to how the target consumer of the business would be impacted by the third-party use. As the unfair advantage is dependent on the link formed in the target consumer perception, possible difficulties can emerge with the business which is popular only in a small market, e.g. „niche famous“. Especially when the intervening party is operating in a completely different type of business, the link can be hard to prove. This can lead to the insufficient grounds when claiming trademark rights.⁶³

The Messi case illustrates that it can also be possible that even if the mark is well-known in a Member State, the EUTM cannot acquire protection against third-party use if the Court sees that the public more likely associates with foreign business. The public perception has a vast significance when the marks in dispute are not identical. If the EUTM is not exhaustively famous in the international level, it may not achieve rights over a foreign well-known mark. Therefore, the trademark protection is not unambiguous for a famous EU trademark. This is something which creates uncertainty in the trademark protection and also can create an obstacle for companies when it comes to the expansion of the business.

5.4. Unfair advantage and detriment

The analysis proceeds now to the examination of the unfair advantage and detriment caused by the use of the third parties. It can be unexpectedly difficult to prove unfair advantage and detriment of well-known marks in EU. The absolute rights granted from the trademark might require the evidence of the likelihood of confusion. Therefore, it is also necessary to assess and compare the examination of dilutive acts through “double identity” concept.

5.4.1. Double identity

The “double identity” is a concept which the case-law has developed when it comes to the interpretation of the reputation of the trademark. This concept is an important subject of examination when the possible unfair advantage or detriment is examined. CJEU has established

⁶² von Bomhard, V., Geier, A. (2017), *supra nota* 7, 681.

⁶³ Burrell, R., Handler, M. (2016) *supra nota* 21, 90.

in the case *L'Oréal v. Bellure* the guidelines on examining the possible harm done to the functions of the trademark. In this reference for a preliminary ruling, *L'Oréal* among others claimed that their trademark rights had been infringed by the *Bellure NV*. *L'Oréal* had produced and marketed famous fragrances trademarked as “Trésor” and “Miracle”. *Malaika* and *Starion* marketed imitations of various fine fragrances. *Malaika* and *Starion* used a comparison list attached in these products to appoint the relevant fragrances which the perfume is similar to, mentioning the names of the fragrances of the claimants as well. *L'Oréal* and others claimed that the use of this comparison list was an infringement of the trademark rights and that had an unfair advantage and detriment to the reputation of the claimants.⁶⁴

The Court concluded that in order to prove unfair advantage or detriment, the reputation of the mark must be considered by all relevant factors, such as strength of the reputation; distinctiveness of the mark; the similarity of the marks at issue; and the nature and degree of the goods or services.⁶⁵ This is an improvement to former case *Arsenal*, where the Court established that solely the origin function has importance in the trademark infringement cases. Case *L'Oréal v. Bellure* therefore provided a wider scope of means to reasoning of the infringement.⁶⁶ This certainly is supportive when it comes to the protection of trademarks in cases where the mark is not directly used in a “classic” infringement.

The ruling of CJEU in *L'Oréal v. Bellure* emphasized the importance of the advantage taken by the party over the detrimental use of the mark. CJEU interpreted that also functions which guarantee the quality, communication, investment of advertising of the goods or services is a subject of protection from the third party use. Therefore, the similarity of the nature of the products cannot have that much importance in the assessment of the infringement; the most crucial factor is the actual effect in the functions of the mark.

The judgment has had a crucial impact on the infringements according to the different functions which can be seen from the *Interflora* case as well. *Interflora* is a national trademark in the UK and it was also registered in the EU area. The mark is considered to have a vast reputation throughout the EU. The applicants claimed that the defendant, *Marks & Spencer*, had infringed the *Interflora* trademark by buying AdWords advertisements. This meant that when an online user

⁶⁴ Court decision, 18.05.2009, *L'Oréal and Others*, C-487/07, ECLI:EU:C:2009:378

⁶⁵ *Ibid.*, point 44.

⁶⁶ Pak, I. (2013) *The Expansion of Trademark Rights in Europe*. *IP Theory*, 3(2), 164.

makes a Google search with the word Interflora, advertisement of Marks & Spencer would occur. This was claimed to cause detriment to Interflora and have unfair advantage of the trademark. Mr Advocate General Jääskinen pointed out that selecting a keyword in order to contribute the advertising in search engine is indeed a subject to unfair advantage. The most significant factor is the intervention in the capacity of a mark to serve as a trademark.⁶⁷

Nonetheless that EU case-law has provided various functions which can be examined, the approach has some shortcomings. Infringement by functions such as advertising or investment can be hard to link with the dilution of famous marks. These infringements can be equally found with trademarks which are not enjoying reputation or are not well-known. In other words, the third-party use in these functions overlooks the definition of dilution.⁶⁸

5.4.2. Distinctiveness

The analysis has established some of the factors relating to the territoriality principle and the factors of the double identity in examination of the trademark infringement. Now the subject proceeds to the distinctiveness of the mark. When discussing about the cases relating to dilutive acts against well-known trademarks, the distinctiveness of the mark has a vast significance. If the trademark is not distinctive, it can be deduced that it has not acquired the level of knowledge by the consumers in the use of commerce. This leads to the lack of the well-known character, which has an impact on the factors of the trademark dilution.

Firstly, when thinking of proving the well-known trademark, it could be assumed that proving different ways where the mark emerge would be sufficient. For instance, this could be the use by the mark in the products, famous people stating that they support the mark and showing the billions worth of annual turnovers. Adidas is a great example of the famous mark. As the three-stripped mark has been used for decades in several products and worn by many professional athletes, the mark is certainly attractive and therefore is a subject to imitation as well. However, the following examples of cases are nonetheless in a slight controversy with each other.

In the case of the Cologne Higher Regional Court delivered on January 2005, Adidas had filed a lawsuit against Nike, which had sold jackets with two parallel stripes attached outside of the sleeves. Years before, Adidas had registered trademarks which represented the three same-

⁶⁷ Court decision, 22.09.2011. Interflora and Interflora British Unit, C-323/09, ECLI:EU:C:2011:604

⁶⁸ Burrell, R., Handler, M. (2016) *supra nota* 21, 89.

coloured parallel stripes which are attached outside of the trousers or sleeves in sportswear. By providing the sportswear containing two-stripped sign in the outer side of the sleeves, Nike was claimed of an infringement of trademark rights. The court stated that the three-stripped trademark was highly recognised mark and therefore was also subject of the likelihood of confusion with Nike's sportswear. Therefore, Nike did infringe the trademark rights of Adidas.⁶⁹

The case is similar with the recent judgment in the Hague Court of Appeal of 28th of January 2020 concluded the 23 years of trademark dispute between adidas and H&M. Adidas had filed a claim in against H&M which had sold a collection of sports clothing in 1997. The workout clothing contained two white parallel stripes attached on the sleeves of the shirts and on the sides of the trousers. Again, Adidas claimed that H&M had infringed the three-stripped trademark rights with this clothing. Contrary to the German case, the Court established that there was no trademark infringement, mainly because of the distinctiveness of the adidas trademark.⁷⁰

CJEU assesses the infringement by weighting importance for the capability of the sign to distinguish itself from the others. This is possible by creating a sign which is so unique that it easily differs from others. Also, the capability to distinguish may be acquired by the use. For instance, Adidas' trademark may have acquired this type of distinctiveness because of its use and its notoriety in the world.

The main issues in both of these cases were the distinctiveness of the three-stripped trademark. In the judgment, the German court stated that the mark is so well-known that it is certainly distinctive. This was reasoned by the facts that the three-stripped clothing has been sold for years and they have been strongly represented in advertisement and in sporting events. Many famous athletes had worn Adidas' clothing, including several football teams. Therefore, the public remembers the characteristics included in Adidas' mark. For these reasons, similar kinds of signs connect the sign into the three-stripped mark in the eyes of the consumer. Even if the consumer would not directly connect the two-stripped clothing to adidas, he or she would nonetheless interpret it as an indication of the origin. This reasoning supported Adidas' right to prevent the third-party use.

The Hague Court of Appeal also agreed that the three-stripped mark includes distinctive characteristics. However, the court interpreted that the distinctiveness of the three-stripped mark is based on a specific combination of stripes. In particular, the three-stripped mark is consisted of three parallel stripes with gaps which are equal to the width of stripes. This would mean that the three-

⁶⁹ Cologne Higher Regional Court, 6 U 37/05, 16.12.2005.

⁷⁰ Hague Court of Appeal, C/09/512851, 28.01.2020.

striped mark actually contains three stripes with two stripes formed by the gaps between the stripes. This combination creates a very specific entity of design. Therefore, the three-striped mark is so distinctive from the two stripes that it is very unlikely that the H&M's sign could interfere three-striped mark.

The Court of Hague stated that the degree of the distinctiveness of the mark is so high that the public perceives purely and simply the three stripes as Adidas' trademark. This is also supported with the argument that the public is very accustomed to stripes in the clothing. The Court of Appeal stated that even if it is assumed that Adidas is a well-known mark and it enjoys a large scope of protection, the case does not create grounds on likelihood of confusion. Therefore, the Hague Court came into a completely opposite outcome from the assessment than the Court of Cologne. Although this is different to CJEU's statement that the distinctiveness increases the exposure to confusion, the Hague decision is in conformity with studies which have proved the opposite to be true. In fact, some empirical findings establish that the distinctiveness does support the ability of a consumer to recognise the differences between a known mark and a similar mark.⁷¹

It can be concluded that these judgments had completely different outcomes based on the distinctive character. These cases are interesting since they have assessed the distinctiveness and well-known status of a trademark which is a globally well-known mark. However, the cases are supporting the idea that the distinctiveness of the trademark can either support the trademark against similar mark or it can be interpreted in such a detailed way that it cannot prevent the use of any similar marks. Therefore, it can create uncertainty of whether the well-known mark can enjoy right to prevent third-party use. In author's point of view, distinctiveness is an important aspect in the trademark claims, and therefore these types of different interpretations will likely cause uncertainty in the protection of famous marks. Moreover, the diversity in the interpretation of distinctiveness is problematic especially for the owners of non-inherently distinctive marks. As Pelikánová and Macgregor point out, the businesses experience that there are already so many EUTMs that they usually establish new marks which are weakly distinctive. From the aspect of competitiveness and interests of a business, this makes EU trademark registration unattractive.⁷² Perhaps one solution for this could be a more coherent approach to the analogy of whether a

⁷¹ Anemat, L. (2020) The Many Faces of the Average Consumer: Is It Really So Difficult to Assess Whether Two Stripes Are Similar to Three?. *International Review of Intellectual Property and Competition Law*, 51(2), 4.

⁷² Pelikánová, R. Macgregor, R. (2019) The Impact of the New EU Trademark Regime on Entrepreneurial Competitiveness. *Forum Scientiae Oeconomia*, 7(2), 64-65.

distinctive characteristics support or is against the trademark proprietor in cases where the third party has used a similar mark.

5.4.3. Strength of the reputation

The unfair advantage and detriment of the trademark is also based on the strength of the reputation of the trademark. Being one of the factors of the double identity, also the reputation affects the distinctiveness of the mark. For instance, adidas had based the distinctiveness on the use of the mark by famous athletes in advertisements and sports events. The reputation is also connected to the degree of knowledge by the relevant public when it comes to the trademark. However, no certain percent of knowledge to prove reputation or well-known status has been established in legislation or case-law.

Even if it is usual that the parties are relying on variety of market reports when proving the strength of the marks, there are several arguments that can tear the evidence down. One of the main implications in the ruling was the concept of the market leader effect. The market leader effect signifies that certain type of product is recognised as the market leaders' product irrespective of any recognisable signs or attributions entailed in it.⁷³ The market leader effect was one of the main reasons why the research was considered insufficient to establish likelihood of confusion. Therefore, it can be a major obstacle to overcome when it comes to proving the reputation of the trademark and its vulnerability to trademark misuse. It is also the reasons why sometimes courts dismiss the reports of one party or another or in turn, requests new information from an independent party.⁷⁴ Moreover, the difficulties to measure the actual behaviour of an average consumer from the aspect of psychology remain to this day.⁷⁵ For these reasons the reliance on surveys may have big differences between courts. Therefore, it is also to important to consider the type of the surveys and their effectiveness in practice in different courts.⁷⁶

As mentioned before, the EU system differs from the reputation examination in a way that instead of the general public as in US, only the knowledge of business' target group is assessed. This is an advantage for the owner of a „niche market“ where a particularly small market owner is able to prevent any other person from using the mark in trade. If the public would be examined as a whole,

⁷³ Jehoram, T. C., Van Nispen, C. (2010) *European Trademark Law: Community Trademark Law and Harmonized National Trademark Law*. Alphen aan den Rijn, Netherlands: Kluwer Law International.

⁷⁴ Gielen (2014), *supra nota* 24, 714.

⁷⁵ Zaichkowsky, J. L. (2020) *The Psychology Behind Trademark Infringement and Counterfeiting*. London, United Kingdom: Psychology Press.

⁷⁶ Stephens, K. (2012) Consumer surveys as evidence of trade mark infringement. [Blog post] Retrieved from: <https://www.twobirds.com/en/news/articles/2010/master-of-all-we-survey-1012> , 9 May 2020.

the acquisition of rights may become more difficult to the niche business.⁷⁷ The trademark Yellow & Black in the US is a good example of this. The US court concluded that although the company had a turnover of over 20 billion dollars and is known in the power tool industry since 1992, the trade dress was not sufficiently popular in the general public.⁷⁸ For these reasons, the concept of the relevant public is can be more convenient for the EUTM holder of a relatively smaller business.

5.4.4. Actual dilution

Examining the caselaw, one important difference between the trademark systems of US and EU occur. This is the significance of the potential dilution and actual dilution.

To begin with, the US legal system does not require any proof of actual injury. In an important case *Victoria's Secret v. Moseley*, the defendant had used name Victor's Little Secret as a name of a store. Victoria's Secret therefore claimed of the dilution, however, with a very little evidence. Indeed, there were no expert opinions and the only evidence was based on the experience of one person who had seen the defendant's ad. After years of battling, the Court of Appeals established that there was dilution regardless of minor evidence. Moreover, it reasoned that even if there would be no link between these two marks, the association of Victor's Little Secret to the well-known Victoria's Secret could be possible, almost automatic.⁷⁹ This ruling is different to the EU case-law because it does not conditionally require proof of actual dilution. One of the reasons of US interpretation is that the dilutive acts are not assessed from the aspect of consumer protection. This can be considered as more compatible with the TRIPS agreement when it comes to the protection of well-known marks.⁸⁰

Contrary to US system, EU case-law has established that there is a need to provide evidence of the harm for the reputation. In the preliminary ruling of *Intel*, a famous UK corporation challenged a marketing company CPM for registering INTELMARK and claimed that it would take unfair advantage of Intel. According to the CJEU, the detriment and unfair advantage must be proven by evidence. The factors such as vast reputation, similarity of the marks, the distinctiveness or the link connected in the consumers' minds are not sufficient to reliably assume that the reputation is harmed. Instead, the evidence of the change in the economic behaviour of the average consumer

⁷⁷ Tyagi, M. (2017), *supra nota* 15, 37-38.

⁷⁸ Jacobs-Meadsday, R. (2019, Aug 25). Proving Fame for Trademark Dilution Claims. [Blog post] Retrieved from: <https://www.lexisnexis.com/lexis-practice-advisor/the-journal/b/lpa/posts/proving-fame-for-trademark-dilution-claims> , 9 May 2020.

⁷⁹ Court of Appeals for the Sixth Circuit, No. 08-5793, *Victor Moseley and Cathy Moseley, dba Victor's Little Secret v. V Secret Catalogue, Inc.*

⁸⁰ Gielen (2014), *supra nota* 24, 716.

will likely establish the dilutive acts. Indeed, the Court stated that the existence of the link in the mind of consumers increases the possibility of dilution. However, the proprietor must nonetheless prove the actual and present injury to the mark.⁸¹

Also, in the *Interflora* case, the AG Jääskinen opined that the Court's statement that the unfair advantage is not depended on the harm caused to the reputation is problematic. This was reasoned by the idea that it would allow a trademark owner to prohibit the use of the competitor without any detriment suffered. The situation would be therefore difficult from the aspect of the competition and it could also impair the competitor from its consumers. Moreover, the AG emphasized that the main object of the market economy is to provide choices that the well-informed consumers can make according to their preferences.⁸² This illustrates well the different aspect in comparison with the US case-law, where the dilution is not examined from the consumers' point of view.

Additionally, the EUIPO Opposition Division concluded in recent *Superman* case that the necessity of established links in the consumers' minds for the injury is not unconditional. It is nonetheless the best mean of determining the injury caused to the trademark which is needed in order to establish the detriment.⁸³ Since there has been no other ways of proving this link in the relevant public, it could be said that this is an indirect precondition in the trademark litigation. Comparing this to the US system, it is certainly more time-consuming and expensive to prove the effect of dilution. However, as Macías and Cerviño point out, if the third-party use is not likely to cause reduction of product purchase by the intervened mark owner, preventing the use argues is not justified from the aspect of the economic harm theory.⁸⁴

⁸¹ Court decision, 27.11.2008. *Intel Corporation*, C-252/07, ECLI:E U:C:2008:655

⁸² *supra nota* 63, point 94.

⁸³ EUIPO Opposition Division, B3060398 7.4.2020.

⁸⁴ Macías, W., & Cerviño, J. (2017), *supra nota* 35, 348.

CONCLUSION

The thesis has given an overview of the legal protection of the well-known trademarks in the international legal framework, in the European Union and the United States. The thesis concludes that the trademark protection in Europe is not sufficient particularly regarding the protection of well-known marks. The court decisions are impacted by the perception of the public, which can lead to different outcomes irrespective of the EUTM rights. Moreover, the assessment of the distinctiveness of well-known trademark may vary in courts and therefore, the dilutive acts can be difficult to prove. Furthermore, European legal system emphasizes the consumers' aspect in the competition and therefore, there is higher standard of proving dilutive acts than in the United States. For this reason, the litigation may be more inefficient and expensive than in the US.

Firstly, the application of the well-known trademark doctrine of the Article 6bis of the Paris Convention is not completely fulfilled in neither of the legal systems. It can be said that the territoriality principle does prevail regarding the rights of well-known mark both in US and EU systems. The case-law has brought several aspects regarding the enforcement of these rights. Thomas Pink case showed that in Europe, the foreign mark which has not been in commercial use or registered cannot prevail over the national trademark. Even if the contested mark would be very famous outside the territory, the trademark which is first used or registered acquires priority. The Belmora case in the US came to the same conclusion in their judgment. Overall, the doctrine is not directly applicable in the jurisdictions. In author's point of view, it is a good thing in a sense that the EU trademark shall enjoy the unitary rights and it helps to fulfil the purpose of EU trademark, which is the right to prevent the use of the mark by third parties throughout the region. However, the Messi case shows that not always the well-known EU trademarks can acquire priority enforcement of the rights. If the public is likely to perceive the connection with the foreign mark instead of the EU trademark, the EU trademark will not be able to oppose it. This creates the uncertainty in the EU trademark enforcement and protection.

Another problem in the EU trademark rights is the protection against dilution. The well-known marks are vulnerable to the use that cause detriment and unfair advantage. The European case-law

has developed the legal framework when it comes to the intervention of the trademark rights. For instance, the L'oréal case demonstrated the wider scope of the functions of the trademark by which the use of the third parties can be caught.⁸⁵ However, as it can be seen in Adidas' cases, the courts may interpret the distinctiveness of the well-known mark in different ways. The judgment of the Court of Hague defined the distinctiveness of Adidas' in the manner which was contrary to the case in the Court of Cologne.⁸⁶ This creates uncertainty when it comes to the idea of harmonised and unitary trademark in the European level. In author's point of view, perhaps this would be a subject of improvement into a more coherent assessment in the national courts.

In addition, another important difference of the EU trademark protection against dilution to the US legal framework is the requirement to prove the actual dilution of the reputation. As the US system does not require proof of, i.e. loss of sales caused by the dilutive acts,⁸⁷ it may be easier to acquire protection against dilution. When it comes to the EU case-law, the requirement to prove of the actual harm to the reputation is relevant. It supports the idea that the competition will not be biased by allowing trademark owners to prohibit use without a reason of serious risk of actual harm. On the other hand, it is certainly an obstacle to overcome for the well-known trademarks in the enforcement of their rights. From the point of view of the owner of well-known trademark, this is clearly more time-consuming and costly than what it would be in the US, where the evidence is not required.

As it can be concluded from the analysis, the reason of the differences between these requirements rely on the aspects of the jurisdictions. The US legal system does not assess the dilutive acts from the point of view of the consumer, whereas the case-law in EU has emphasized that the main importance of the market economy is to provide as many options to the well-informed consumer as possible.⁸⁸ This is somewhat problematic issue for the company who should enjoy the protection of the EU trademark rights. It also seems that proving the unfair advantage and detrimental use of the EU trademark can be difficult due to the diversity of rulings. Therefore, the European trademark regulation could learn something from the US legal system in these perceptions.

For these reasons, nonetheless that European Union has established a comprehensive legal instrument in order to protect unitary mark for the whole region, the protection of the well-known

⁸⁵ *supra nota* 62.

⁸⁶ *supra nota* 65, *supra nota* 66.

⁸⁷ *supra nota* 75.

⁸⁸ *supra nota* 78.

marks is a subject of further improvement. This development need to focus on more effective ways to secure the EU trademark rights for the well-known trademarks in order to reduce the uncertainty that the company will like encounter in the international level. The coherence in the legal framework and jurisdictions could certainly contribute to the protection of the trademark and the means against dilutive acts. Ultimately, this is the purpose of the harmonised protection of the EU trademark regulation.

LIST OF REFERENCES

Scientific books:

1. Brainbridge, D., (2015). *Intellectual Property Law* (4th ed.) Harlow, England: Pearson Education Limited.
2. Fhima, I. S. (2011). *Trade mark dilution in Europe and the United States*. Oxford: OUP Oxford.
3. Jehoram, T. C., Van Nispen, C. (2010) *European Trademark Law: Community Trademark Law and Harmonized National Trademark Law*. Alphen aan den Rijn, Netherlands: Kluwer Law International.
4. Onishi, H. (2015). *Well-known trademarks: A comparative study of Japan and the EU*. New York, US: Routledge.
5. Zaichkowsky, J. L. (2020) *The Psychology Behind Trademark Infringement and Counterfeiting*. London, United Kingdom: Psychology Press.

Scientific articles:

6. Anemat, L. (2020) The Many Faces of the Average Consumer: Is It Really So Difficult to Assess Whether Two Stripes Are Similar to Three?. *International Review of Intellectual Property and Competition Law*, 51(2), 187-213.
7. Barker, B. (2006). The power of the well-known trademark: Courts should consider article 6bis of the Paris convention an integrated part of section 44 of the Lanham Act. *Washington Law Review*, 81(2), 363-390.
8. Bone, R. G. (2006). Hunting goodwill: history of the concept of goodwill in trademark law. *Boston University Law Review*, 86(3), 547-622.
9. Burrell, R., Handler, M. (2016) Reputation in European Trade Mark Law: a re-examination. *ERA Forum* 17(1), 85-99.
10. Choi, M. J. (2019). The likelihood of exclusion: Economic disparity in the united states trademark system. *Journal of the Patent and Trademark Office Society*, 100(4), 599-618.

11. Darnton, J. E. (2011). The Coming of Age of the Global Trademark: The Effect of Trips on the Well-Known Marks Exception to the Principle of Territoriality. *Michigan State International Law Review*, 20 (1), 11-32.
12. Dave, S. (2001). Trips: International trademark law that promotes global trade. *Journal of Contemporary Legal Issues*, 12(1), 458-463.
13. Dinwoodie, G. B. (2017). Territorial overlaps in trademark law: The evolving European model. *Notre Dame Law Review*, 92(4), 1669-1744.
14. Dogan, S. L.; Lemley, M. A. (2007). Grounding trademark law through trademark use. *Iowa Law Review*, 92(5), 1669-1702.
15. Friedmann, D. (2016). The Uniqueness of the Trade Mark: A Critical Analysis of the Specificity and Territoriality Principles. *European Intellectual Property Review*, 38(11), 678-686.
16. Gielen, C. (2014). Trademark Dilution under European Law. *Trademark Reporter*, 104, 693-730.
17. Handl, G. Zekoll, J., Zumbansen, P. (2012). Territoriality and Extraterritoriality in Intellectual Property Law. Queen Mary Studies in International Law, Leiden/Boston: Brill Academic Publishing, 1-3.
18. Klimkevičiūtė, D. (2010). The legal protection of well-known trademarks and trademarks with a reputation: the trends of the legal regulation in the EU member states. *Societal Studies*, 3(7), 229-256.
19. Lainer, Z. (2016). Mouse vs. mau5: Implications of the morehouse defense in international trademark disputes. *Southern California Law Review*, 89(3), 673-700.
20. Macías, W., & Cerviño, J. (2017). Trademark dilution: comparing the effects of blurring and tarnishment cases over brand equity. *Management & Marketing*, 12(3), 346-360.
21. Malliaris, S. (2010). Protecting Famous Trademarks: Comparative Analysis of US and EU Diverging Approaches --The Battle Between Legislatures and the Judiciary. Who is the Ultimate Judge? *Chicago-Kent Journal of Intellectual Property*, 9(1), 45-59.
22. Morris, P. (2019). From territorial to universal – the extraterritoriality of trademark law and the privatizing of international law. *Cardozo Arts & Entertainment Law Journal*, 37(1), 33-86.
23. Pak, I. (2013) The Expansion of Trademark Rights in Europe. *IP Theory*, 3(2), 158-166.
24. Schovsbo, J. (2018). “Mark my words” Trademarks and Fundamental Rights in the EU. *UC Irvine Law Review*, 8(3), 555-581.

25. Slováková, Z. (2008). International Private Law Issues regarding Trademark Protection and the Internet within the EU. *Journal of International Commercial Law and Technology*, 3, 76-83.
26. Takouche, A. (2019). Well-known, or not well-known: That is the question. The Paris Convention for the protection of industrial property's Article 6bis in the context of American trademark law. *UC Irvine Law Review*, 9(2), 495-530.
27. von Bomhard, V., & Geier, A. (2017). Unregistered trademarks in EU trademark law. *Trademark Reporter*, 107, 677-700.

EU and International legislations:

28. European Union Intellectual Property Office (2007). Opposition guidelines. Retrieved from: http://euipo.europa.eu/en/mark/marque/pdf/global_assessment-EN.pdf, 18 March 2020.
29. Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks (1999). World Intellectual Property Organisation. Retrieved from: <https://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf> , 18 March 2020
30. Regulation (EU) 2017/1001 of 14 June 2017 of the European Parliament and of the Council on the European Union trade mark, OJ L 154, 16.6.2017
31. The Lanham (Trademark) Act, 5 of July 1496, 15 U.S.C §§ 105
32. The World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), 33 I.L.M 1197, 15.4.1994.
33. World Intellectual Property Office (WIPO) Paris Convention for the Protection of Industrial Property, 20 March 1883, Paris.

Court decisions:

34. United States Court of Appeals for the Ninth Circuit, 514 U.S: 159 (1995), *Qualitex v. Jacobsen Products Co, Inc.*
35. Court decision, 11.11.1997. Sabel v Puma, C-251/95, ECLI:EU:C:1997:528,
36. United States Court of Appeals, Ninth Circuit, 391 F.3d 1088 (2004) *Grupo Gigante SA De CV v. Dallo & Co. Inc.*
37. Cologne Higher Regional Court, 6 U 37/05, 16.12.2005.
38. Court decision, 13.09.2007. Nieto Nuño, C-328/06, ECLI:EU:C:2007:704
39. Court decision, 27.11.2008. Intel Corporation, C-252/07, ECLI:E U:C:2008:655
40. Court decision, 18.05.2009, L'Oréal and Others, C-487,07, ECLI:EU:C:2009:378

41. Court of Appeals for the Sixth Circuit, No. 08-5793 (2010), *Victor Moseley and Cathy Moseley, dba Victor's Little Secret v. V Secret Catalogue, Inc.*
42. Court decision, 22.09.2011. Interflora and Interflora British Unit, C-323/09, ECLI:EU:C:2011:604
43. Chancery Division, F.S.R. 40 (2014), *Thomas Pink Ltd v. Victoria's Secret UK Ltd.*
44. Court decision, 3.9.2015. Iron & Smith, C-125/14, ECLI:EU:C:2015:539.
45. Eastern District Court of Virginia, 1:14-cv-00847-GBL-JFA (2015), *Belmora LLC v. Bayer Consumer Care AG & Bayer Healthcare LLC v. Belmora, LLC, Jamie Belcastro, & Does 1-10, Inclusive.*
46. Court decision, 2.02.2016. Benelli Q.J., T-169/13, ECLI:EU:T:2016:56
47. Court decision, 26.04.2018. Messi, T-554/14, ECLI:EU:T:2018:230
48. Hague Court of Appeal, C/09/512851, 28.01.2020.
49. EUIPO Opposition Division, B3060398 7.4.2020.

Other sources:

50. International Trademark Association (2017). *Trademark Dilution*. Retrieved from: [https://www.inta.org/TrademarkBasics/FactSheets/Pages/Trademark-Dilution-\(Intended-for-a-non-legal-audience\).aspx](https://www.inta.org/TrademarkBasics/FactSheets/Pages/Trademark-Dilution-(Intended-for-a-non-legal-audience).aspx) , 18 March 2020.
51. Jacobs-Meadsway, R. (2019, Aug 25). Proving Fame for Trademark Dilution Claims. [Blog post] Retrieved from: <https://www.lexisnexis.com/lexis-practice-advisor/the-journal/b/lpa/posts/proving-fame-for-trademark-dilution-claims> , 9 May 2020.
52. Lehrman, F. Z., Zissu, P. (2018) *USPTO: Registration of Non-traditional Trademarks*. Retrieved from <https://www.lexology.com/library/detail.aspx?g=25dbbf32-f376-430e-a2bb-6175c34c3344> , 7 May 2020.
53. Nugraha, A. (2016). *IKEA verdict: Another bad sign for intellectual property rights*. Retrieved from <https://www.thejakartapost.com/news/2016/03/04/ikea-verdict-another-bad-sign-intellectual-property-rights.html> , 17 March 2020.
54. Pozen, R. C., & Hirsch, J. (2008). *US and EU Trademark Protection*. Retrieved from: https://edisciplinas.usp.br/pluginfile.php/4115991/mod_resource/content/1/US%20and%20EU%20trademark%20protection.pdf , 17 March 2020.
55. Shchetinina, A. (2018) *The Dilution of a Trademark: A Comparative Study on EU and U.S. Law*. (Master's thesis) University of Vienna, Vienna.

56. Stephens, K. (2012) Consumer surveys as evidence of trade mark infringement. [Blog post]
Retrieved from: <https://www.twobirds.com/en/news/articles/2010/master-of-all-we-survey-1012> , 9 May 2020.
57. Tyagi, M. (2017). *Unfair Advantages Associated with Likelihood of Confusion ad Dilution in Trademark Law*. (Master's thesis) Uppsala University, Uppsala.

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