INTA Statement during the Forty-Ninth Session of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications

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On behalf of the International Trademark Association (INTA), thank you for the opportunity to be here today. As you no doubt know, INTA is a global association of brand owners and intellectual property (IP) professionals committed to elevating the understanding of and respect for IP rights to foster consumer trust, economic growth, and societal transformation. With over 38,000 members from more than 6,600 organizations from 182 jurisdictions, leadership, staff, and members have no doubt worked with each and every one of your offices here today.

We are grateful to have the opportunity to support the UKIPO's proposal as outlined in committee document SCT/49/3. As part of INTA's mission, the association is always seeking opportunities to advance the principles and objectives of trademark law not only to the benefit of our members, but to protect our members' most important constituents: consumers. The UKIPO's proposal for a survey to review well-known mark practices across the respective Member States will align with a priority area of trademark law of the utmost importance to INTA's corporate members and potentially highlight inconsistent practices that can be exploited to confuse global consumers.

Global protection of WKMs finds its origin in Article 6bis of the Paris Convention. Over a century ago, contracting parties of the Paris Convention agreed that the international trademark framework should be amended to address a growing concern – stopping the registration or use of trademarks that confuse consumers by mimicking famous brands, even if they are not, or not yet, "… protected in that country by a registration which would normally prevent the registration or use of the conflicting mark."[1] It was recognized that subsequent registration or use would not only result in unfair competition, but more importantly, would mislead, and therefore, harm consumers. It was with this perspective in mind that the TRIPS Agreement expanded the scope of WKMs protection, a scope that was subsequently clarified via guidance in the form of the 1999 Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.[2]

Notwithstanding this tripartite international structure, owners of trademarks that are well-recognized throughout the world face increasing difficulty navigating a diverging global landscape, putting their brands and global consumers at risk. The current system is proving less and less capable of fulfilling the intent behind the creation and expansion of the WKMs system. This is due in large part to the lag between global consumer awareness of a brand and protecting that brand in every potential market with trademark registrations.

New entrepreneurs and emerging companies born today will be first known by digital impression rather than physical presence, paid-for marketing, or even high in-market sales. Consumers in one market can easily learn of a foreign brand well before the brand is available in that market, even well before the brand anticipates entering that market. Yet our international trademark system expects the brand to immediately seek trademarks in every conceivable jurisdiction or remain exposed. Although Article 6bis was adopted to address this, today's systems of global commerce and information exchange have evolved far beyond what was imagined when WKMs protection was first introduced (1925) and subsequently amended (1934 and 1958). Even the more recently adopted Joint Recommendation does not fully reflect the commercial, informational,

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[1] Professor G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, 1968, p. 90, available at https://www.wipo.int/edocs/pubdocs/en/intproperty/611/wipo_pub_611.pdf.

[2] WIPO & Paris Union for the Protection of Industrial Property, Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks WIPO Doc. 833(E) (Sept. 29, 1999), available at https://www.wipo.int/edocs/pubdocs/en/wipo_pub_833-accessible1.pdf.

and consumer realities that have developed over the last twenty years, particularly in relation to digital channels and cross-border consumer perception.

Today's partially connected global trademark system is under increasing strain. Consumers, legitimate businesses, and governments are facing new difficulties, confusion, and resource constraints. And it is causing us to lose sight of the purpose and role of a trademark -- trademarks are meant to serve as a link between consumers and brand owners, relaying information on quality, source, price, and other characteristics of goods and services. At its core, a trademark (and trademark law) must serve consumers through trust built upon consistency and reliability, while maintaining an appropriate balance with fair competition and market access. WIPO's training manual -- "Introduction to trademark law and practice" -- prioritizes explaining the ways that trademarks serve the needs of consumers before summarizing their benefits to companies.[3] Divergent, and in some instances narrowly-applied or procedurally constrained, WKMs systems are now exposing consumers to manipulation and harm.

With that in mind, just a few months ago, INTA passed a board resolution outlining our perspective on the principles that serve as essential components of an effective WKM system.[4] At the core of the Board Resolution is a recognition that there exists both a significant lack of harmonization in how jurisdictions protect well-known marks and practical deficiencies that hinder their effective protection. Counterfeiters and bad faith actors have learned how to exploit gaps in the existing system and take advantage of the peculiarities of different legislation and standards to target well-known marks and shield their nefarious activities; this includes obtaining trademark registrations that are identical or confusingly similar to established well-known marks.

Thus, the Board Resolution's intent is to share a framework built upon the existing global framework that can be adopted across jurisdictions to better align these systems, while preserving appropriate flexibility, to ensure we continue to meet the objectives of this global framework.

I encourage you to read this statement outlining INTA's official position on this area that the association's member leaders believe is of critical importance.

One of the most significant challenges INTA members face is navigating the divergent analytical approaches by trademark offices across jurisdictions. While INTA firmly believes each jurisdiction is and should remain independent and base the granting of IP rights on jurisdiction-specific eligibility, INTA also firmly believes that jurisdictions can incorporate and rely upon the global framework in ways that maintain their own flexibility while ensuring consistent baselines and considerations. Take, for example, consideration of how to establish notoriety or fame of a particular mark. INTA members report that while the 1999 Joint Recommendation outlines a number of potentially relevant indicators to evaluate whether a mark is well known, some trademark offices treat those indicators as effectively mandatory, notwithstanding explicit acknowledgement in the Joint Recommendation that these are illustrative. This can significantly restrict the ability of a trademark owner to present evidence that they believe demonstrates that their mark is well known, particularly where such evidence reflects modern forms of consumer engagement, including digital presence and cross-border recognition.

INTA also believes that because of the unique challenges owners of WKMs face, they must have flexibility in their approach to protecting their marks against conflicting applications or registrations. This means that there should be mechanisms to challenge both potentially conflicting applications and registrations. This is not always the case, as some jurisdictions only allow challenges in the form of cancellation or invalidation. The purpose of a WKMs system is to prevent unfair competition and consumer confusion caused by association with a WKM. Consequently, to be effective, a WKMs system must prioritize preventing the registration of a conflicting mark – including, where appropriate, through ex officio examination by a trademark office – while maintaining efficient systems to challenge the conflicting mark, both before and after registration. It is imperative that trademark owners have a clear understanding of how to challenge potentially conflicting registrations and when these challenges are available.

Finally, a grey area within the WKM landscape is the extent to which a mark must be "connected to" the jurisdiction where WKM protection is sought. This may take the form of requirements that a mark be registered

[3] See Sections 1.1 – 1.5, pages 9 - 11. https://www.wipo.int/edocs/pubdocs/en/wipo_pub_653.pdf.

[4] https://www.inta.org/wp-content/uploads/public-files/advocacy/board-resolutions/111825-Well-Known-Marks-Protection-Updated-Framework-INTA-Board-Resolution.pdf.

or used within the jurisdiction in order to qualify as a WKM in that jurisdiction. Such requirements, particularly when applied rigidly or through disproportionate evidentiary burdens, may undermine the objectives and spirit of the global WKMs framework,[5] and may not fully reflect the speed with which information and brand association move in today's global economy. At the same time, greater clarity is needed to ensure that such connections are assessed in a balanced and proportionate manner. In some places these requirements are explicit, and in others they are reflected in practice or may be hidden behind overly formal burdens, resulting in third parties deceiving consumers or profiting from the goodwill or prestige these brands have achieved.

This lack of harmonization is particularly acute when we explore the margins of WKMs protection. For example, the legal framework governing "famous trademarks" or marks with a certain reputation is uncertain and inconsistently applied. Regional systems — such as within European Union — have adopted an increasingly stringent interpretation of the criteria that have traditionally justified granting famous trademarks a more favorable level of protection. While they provide enhanced protection for trademarks with a "reputation" extending beyond identical or similar goods and services covered by a registration, in practice the evidentiary thresholds and analytical approaches applied by offices and courts may result in a fragmented recognition of such reputation across specific goods and services and across jurisdictions, creating confusion and putting brand owners at risk.

On behalf of INTA and, in particular my colleagues comprising the Famous and Well-Known Marks Committee, I want to thank WIPO and all member state delegates for the opportunity to share our perspective and to thank the UKIPO for introducing its timely proposal for a study on WKMs protection. Each of you here today is instrumental in advancing our shared objective of ensuring effective global, regional, and national trademark systems. Together we can modernize and shape this system to improve coherence, enhance consumer protection, and contribute to sustainable economic growth.

[5] Professor G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property*, 1968, p. 91 (indicating that only 2 of 27 voting contracting parties voted against a proposed amendment that would have explicitly indicated use cannot be required), available at https://www.wipo.int/edocs/pubdocs/en/intproperty/611/wipo_pub_611.pdf. WIPO INTELLECTUAL PROPERTY HANDBOOK, 2004, p. 251 ("The effect of this Article is to extend protection to a trademark that is well-known in a member country ***even though it is not registered or used in that country***.") (emphasis added), available at https://www.wipo.int/edocs/pubdocs/en/intproperty/489/wipo_pub_489.pdf.