

# WIPO



**SCT/2/3 Prov.**

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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**  
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## **STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS**

**Second Session**  
**Geneva, - .. to - .., 1999**

**DRAFT PROVISIONS ON THE  
PROTECTION OF WELL-KNOWN MARKS<sup>1</sup>**

*prepared by the International Bureau*

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<sup>1</sup> Additions and omissions are highlighted in the present text as follows: Articles 1 and 3 to 6 are shown as compared to document SCT/1/3, and Article 2 is shown as compared to document SCT/1/6, Annex I.

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Resolution

The General Assembly of the World Intellectual Property Organization (WIPO).

“*Recognizing* that protection for well-known marks must be provided, under the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), by ~~Parties~~ Member States that are bound to apply the relevant provisions of those treaties,

“*Recommends*, to each Member State of WIPO [and, where Member States of WIPO are members of intergovernmental organizations which have competence in the area of trademarks, to such organizations], to protect well-known marks in accordance with the provisions contained herein.

*Article 1*

*Definitions*

For the purposes of these Provisions:

(i) ~~“Party” means a State, or an intergovernmental organization which maintains an Office in which marks may be registered with effect in the territory of that organization;~~

(i) “Member State” means a State party to the Convention Establishing the World Intellectual Property Organization (1967), as amended in 1979;

(ii) “Office” means any agency entrusted by a ~~Party~~ Member State with the registration of marks;

(iii) “competent authority” means an administrative, judicial or quasi-judicial authority of a Member State which is responsible for determining whether a mark is a well-known mark, or for enforcing the protection of well-known marks;

(~~iii~~ iv) “territory” means, in the case of a State, the territory of that State, and in the case of an intergovernmental organization, the territory in which the constituting treaty of that intergovernmental organization applies;

(iv ~~v~~) “business identifier” means any sign used ~~intended~~ to identify a business;  
~~such as a trade name, business symbol, emblem or logo of a natural person, a legal person, an~~  
organization or an association;

(v ~~vi~~) “domain name” means an alphanumeric string that corresponds to a  
numerical address on the Internet.

PART I

DETERMINATION OF WELL-KNOWN MARKS

*Article 2*

*Determination of Whether a Mark is a*

*Well-Known Mark in the Territory of a Party Member State<sup>2</sup>*

(21) [*Factors for Consideration*] (a) In determining whether a mark is a well-known mark, the competent authority shall take into account all any circumstances from which it may be inferred that the mark is well known ~~shall be taken into account.~~

(b) In particular, ~~The~~ the competent authority ~~of the Party~~ shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning ~~the factors listed in Annex I.~~

~~— The factors referred to in Article 2(2)(b) include, but are not limited to, the following:~~

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
2. the duration, extent and geographical area of any use of the mark;

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<sup>2</sup> The substance of the introductory paragraph has been moved to the Resolution.

3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;

4. the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;

5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by ~~courts or other~~ competent authorities;

6. the value associated with the mark.

(c) The above factors ~~in Annex I~~, which are guidelines to assist the competent authority ~~of the Party~~ to determine whether the mark is a well-known mark in its territory, are not pre-conditions for reaching that determination. Rather, the ~~decision~~ determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant; in other cases some of the factors may be relevant; in still other cases none of the factors may be relevant. Additional factors that are not listed in ~~the Annex sub-~~ paragraph (b), above may be relevant, alone, or in combination with one or more of the factors listed in ~~the Annex sub-paragraph (b), above~~.

(42) [*Relevant Sector of the Public*] (a)<sup>3</sup> Relevant sectors of the public shall include, but shall not necessarily be limited to:

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

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

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

(b) Where a mark is determined to be well known in at least one relevant sector of the public in the territory of a Member State, the mark shall be considered by the Member State to be a well-known mark. ~~It shall be sufficient, for a mark to be considered to be a well-known mark in the territory of the Party, if that mark is well known in a relevant sector of the public in that territory.~~

[(c) Where a mark is determined to be known in at least one relevant sector of the public in the territory of a Member State, the mark may be considered by the Member State to be a well-known mark.]

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<sup>3</sup> The substance of the first sentence has been moved to paragraph (2)(b).

(d) ~~Notwithstanding sub-paragraph (a), a Party~~ A Member State may ~~shall~~  
~~be free to~~ determine that a mark is ~~considered to be~~ a well-known mark in its territory, even if  
~~it the mark~~ is not well known [or, if the Member States applies subparagraph (c), known] in a  
any relevant sector of the public in its territory.

(3) [*Factors Which Shall Not Be Required*] (a) A ~~Party~~ Member State shall not  
require, as a condition for determining whether a mark is a well-known mark:

(i) that the mark has been used, or that the mark ~~be~~ has been registered or  
~~used that an application for registration of the mark has been filed in;~~ or in respect of, the  
territory of the ~~Party~~ Member State;

(ii) that the mark ~~be~~ is well known in, or that the mark has been registered  
or that an application for registration of the mark has been filed in or in respect of, any territory  
other than the territory of the ~~Party~~ Member State; or

(iii) that the mark ~~be~~ is well known by the public at large in the territory of  
the ~~Party~~ Member State.

(b) Notwithstanding sub-paragraph (a)(ii), a ~~Party shall be free to determine~~  
~~that a mark which is not well known in its territory is nevertheless considered to be a well-~~  
~~known mark in its territory, on the grounds that the mark is well known in one or more other~~  
~~territories~~ Member State may, for the purpose of applying paragraph (2)(d), require that the  
mark be well known in one or more territories other than the territory of the Member State.

PART II

SCOPE OF PROTECTION

Article 3

*Protection of Well-Known Marks; Bad Faith*

(1) [Protection of Well-Known Marks] A Member State shall protect a well-known mark against conflicting marks, business identifiers and domain names, at least with effect from the time when the mark has become well known in its territory.

(2) [Consideration of Bad Faith] Bad faith may be considered as one factor among others in assessing competing interests in applying this Part.

*Article 4*

*~~Protection of Well Known Marks Against Conflicting Marks~~*

(1) [~~Conflicting with Marks~~] (a) ~~A well known mark shall be protected against any mark which is in conflict with it. A Party shall protect a well known mark at least with effect from the time when the mark has become well known in its territory.~~<sup>4</sup> (b) A mark shall be deemed to be in conflict with a well-known mark where that mark, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration, liable to create confusion, of the well-known mark, if the mark, or an essential part thereof, is used, or is the subject of an application for registration, or is registered, in respect of goods and/or services which are identical or similar to the goods and/or services to which the well-known mark applies.

(b) Irrespective of the goods and/or services for which a mark is used, is the subject of an application for registration, or is registered, that mark shall be deemed to be in conflict with a well-known mark where the mark, or an essential part thereof, constitutes a reproduction, an imitation, a translation or a transliteration, ~~liable to create confusion~~ of the well-known mark, and where at least one of the following conditions is fulfilled:

(i) the use of that mark would indicate a connection between the goods and/or services for which the mark is used, is the subject of an application for registration, or is registered, and the owner of the well-known mark, and would be likely to damage his interests;

(ii) the use of that mark is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark;

(iii) the use of that mark would take unfair advantage of the distinctive character of the well-known mark.

(c) A ~~Party~~ Member State shall not be required to consider a mark to be in conflict with a well-known mark, if that mark was used or registered, or an application for its registration was filed, in or in respect of its territory ~~{in good faith}~~, before the well-known mark became well known in its territory, except where the mark was used or registered, or the application for its registration was filed, in bad faith.

(2) [*Opposition Procedures*] If the applicable law allows third parties to oppose the registration of a mark, a conflict with a well-known mark under paragraph (1)(a) shall constitute a ground for opposition.

(3) [*Invalidation Procedures*] (a) The owner of a well-known mark shall be entitled to request, during a period which shall not be less than five years from the date on which the registration was published by the Office, the invalidation, by a decision of the Office or by a decision of a court, of the registration of a mark which is in conflict with the well-known mark.

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[Footnote continued from previous page]

<sup>4</sup> The third sentence has been moved to new paragraph (1)(c).

(b) If the registration of a mark may be invalidated *ex officio* by an Office or a court, a conflict with a well-known mark shall, during a period which shall not be less than five years from the date on which the registration was published by the Office, be a ground for ex officio invalidation of the said registration.

(4) [*Prohibition of Use*] The owner of a well-known mark shall be entitled to request the prohibition, by a decision of ~~a court or of any other~~ the competent authority ~~empowered by the applicable law to take such decisions~~, of the use of a mark which is in conflict with the well-known mark. Such request shall be admissible for a period which shall not be less than five years from the time the owner of the well-known mark had knowledge of the use of the conflicting mark.

(5) [*No Time Limit in Case of Registration Without Use or of Bad Faith*]  
Notwithstanding paragraphs (3) and (4), a ~~Party~~ Member State may not prescribe any time limit for requesting the invalidation of the registration or the prohibition of the use of a mark which is in conflict with a well-known mark if the conflicting mark was registered but not used, or if it was registered or used in bad faith. In determining bad faith for the purposes of this paragraph, the competent authority shall consider whether ~~A~~ the person who obtained the registration of or used a the mark which is in conflict with a well-known mark ~~shall not be deemed to be in bad faith, unless it is shown that~~ had, at the time of the registration or use of the conflicting mark, ~~this person had~~ knowledge of, or ~~had~~ reason to know of, the well-known mark.

*Article 5*

*~~Protection of Well Known Marks Against Conflicting Business Identifiers~~*

(1) [~~Conflicting with Business Identifiers~~] (a) ~~A well-known mark shall be protected against any business identifier which is in conflict with it. A Party shall protect a well-known mark at least with effect from the time when the mark has become well known in its territory.~~<sup>5</sup> (b) A business identifier shall be deemed to be in conflict with a well-known mark where that business identifier, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration of the well-known mark, ~~liable to create confusion,~~ and where at least one of the following conditions is fulfilled:

(i) the use of the business identifier would indicate a connection between the business for which it is used and the owner of the well-known mark, and would be likely to damage his interests;

(ii) the use of the business identifier is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark;

(iii) the use of the business identifier would take unfair advantage of the distinctive character of the well-known mark.

(b) A Party-Member State shall not be required to consider a business identifier to be in conflict with a well-known mark, if that business identifier was used or registered, or an

application for its registration was filed, in or in respect of its territory ~~[in good faith]~~, before the well-known mark became well known in or in respect of its territory, except where the business identifier was used or registered, or the application for its registration was filed, in bad faith.

(2) [*Cancellation*] (a) Where a conflicting business identifier is the subject of a registration, the owner of a well-known mark shall be entitled to request, during a period which shall not be less than five years from the date on which the registration of that business identifier was published, the cancellation, by a decision of ~~a court or any other~~ the competent authority ~~empowered by the applicable law to take such decisions,~~ of that registration.

(b) If the registration of a business identifier may be canceled *ex officio*, a conflict with a well-known mark shall, during a period which shall not be less than five years from the date on which the registration of the conflicting business identifier was published, be a ground for *ex officio* cancellation of the said registration.

(3) [*Prohibition of Use*] The owner of a well-known mark shall be entitled to request the prohibition, by a decision of ~~a court or of any other~~ the competent authority ~~empowered by the applicable law to take such decisions,~~ of the use of a business identifier which is in conflict with the well-known mark. Such request shall be admissible for a period which shall not be less than five years from the time the owner of the well-known mark had knowledge of the use of the conflicting business identifier.

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[Footnote continued from previous page]

<sup>5</sup> The third sentence has been moved to new paragraph (1)(b).

(4) *[No Time Limit in Case of Registration Without Use or of Bad Faith]*

Notwithstanding paragraphs (2) and (3), a ~~Party~~ Member State may not prescribe any time limit for requesting the cancellation of the registration or the prohibition of the use of a business identifier which is in conflict with a well-known mark if the conflicting business identifier was registered but not used, or it was registered or used in bad faith. In determining bad faith for the purposes of this paragraph, the competent authority shall consider whether A ~~the~~ the person who obtained the registration of or used a the business identifier which is in conflict with a well-known mark ~~shall not be deemed to be in bad faith, unless it is shown that had,~~ at the time of the registration or use of the conflicting business identifier, ~~this person had~~ knowledge of, or ~~had~~ reason to know of, the well-known mark.

*Article 6*

*~~Protection of Well Known Marks Against Conflicting Domain Names~~*

(1) [~~Conflicting with Domain Names~~] (a) ~~A well-known mark shall be protected against any domain name which is in conflict with it. A Party shall protect a well-known mark at least with effect from the time when the mark has become well known in its territory.~~<sup>6</sup> (b) A domain name shall be deemed to be in conflict with a well-known mark where that domain name, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration, ~~liable to create confusion,~~ of the well-known mark, and where at least one of the following conditions is fulfilled:

(i) the use of the domain name would indicate a connection between the holder of the domain name and the owner of the well-known mark, and would be likely to damage his interests;

(ii) the use of the domain name is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark, in particular, where that domain name has been registered with the primary intention of selling it to the owner of the well-known mark;

(iii) the use of the domain name would take unfair advantage of the distinctive character of the well-known mark.

(b) A ~~Party~~ Member State shall not be required to consider a domain name to be in conflict with a well-known mark if that domain name was registered ~~[in good faith]~~ before the well-known mark became well known in its territory, except where the domain name was registered in bad faith.

(2) [*Cancellation; Transfer*] The owner of a well-known mark shall be entitled to request, during a period which shall not be less than five years from the date on which the conflicting domain name was registered, the cancellation or the transfer, by a decision of a ~~court or any other~~ the competent authority ~~empowered by the applicable law to take such decisions,~~ of the domain name.

(3) [*No Time Limit in Case of Bad Faith*] Notwithstanding paragraph (2), a ~~Party~~ Member State may not prescribe any time limit for requesting the cancellation or the transfer of a domain name which is in conflict with a well-known mark if the conflicting domain name was registered in bad faith. In determining bad faith for the purposes of this paragraph, the competent authority shall consider whether ~~A~~ the person who obtained the registration of a ~~the~~ domain name which is in conflict with a well-known mark ~~shall be deemed to be in bad faith, if that person has had, at the time of the registration of the conflicting domain name, knowledge of, or reason to know of, the well-known mark, or~~ obtained the registration of the conflicting domain name with the primary intention of selling it to the owner of the well-known mark.

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[Footnote continued from previous page]

<sup>6</sup> The third sentence has been moved to new paragraph (1)(b).