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Kung-Chung Liu, Xinliang Tao and Eric Wang*

The Use and Misuse of Well-Known Marks Listings**

Introduction

In order to extend protection to marks already known but not registered in the country where protection is sought, the Paris Convention introduced in 1925 the “well-known” marks regime in Article 6bis. Article 6bis limits the protection by prohibiting other parties from registering or using confusingly similar marks on identical or similar goods (excluding services) .¹ With the Agreement on Trade-Related Aspects of Intellectual Property rights, the World Trade Organization further applied Article 6bis of the Paris Convention to services and dissimilar goods or services (Article16 (2) and (3)) . As of December 2008 the Paris Convention had 173 contracting parties and the WTO 153 members. As a consequence, the term “well-known” mark is widely used by countries the world over. However, since neither the Paris Convention nor the TRIPS Agreement defined the term, the practices of recognizing and protecting well-known marks now varies significantly from country to country.²

The continual strengthening of the protection for well-known marks has been one of the features of international trademark development in the post-TRIPS era. In many countries well-known marks can now be granted full trademark right and protection merely from the fact that they are well-known; well-known marks can also be protected against dilution or even the likelihood thereof,³ and against comparative advertising that is discrediting or denigrating.⁴ However, for market late-comers

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¹ Ellen Winner & Aaron Denberg, “International Trademark Treaties with Commentary” 50 (Oceana Publications, New York 2004).

² Frederic Mostert, Famous and Well-Known Marks, 2004 (2nd Edition), INTA NY,1-5. Daniel Gervais, The TRIPS Agreement – Drafting History and Analysis, 2.160 (3rd Edition., 2008).

³ According to the US Trademark Dilution Revision Act of 2006, the owner of a famous mark shall be entitled to an injunction against another person who commences to use a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark.

⁴ According to Article 4 (d), Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising (codified version), comparative advertising that discredits or denigrates the trade marks, trade names, other

seeking a new trademark, there is no clear way to determine if a particular mark is well-known. Without this certainty the applicant cannot calculate the risk of having the trademark application rejected or even the risk of liability through the infringement upon or the dilution of a well-known mark.

Therefore, with various jurisdictions establishing different ways of listing well-known marks, the variant listing methods have resulted in divergent effects. This paper examines the various practices of listing well-known marks and points out how listings can be misused. It evaluates the pros and cons of different models of listing well-known marks. With the aim of maximizing the use and minimizing the misuse of listings, this paper concludes by advocating the creation of a centralized on-line database of well-known marks cases recognized in the past five years.

I. Different Ways of Listing Well-Known Marks

Our study shows that Japan, the People's Republic of China (PRC), the Russian Federation (RF), Ukraine, Finland, and the Czech Republic have all developed some type of listing regime for well-known marks.⁵ These listing practices can be classified into two main groups: ex-ante approval listings and ex-post inductive listings. Ex-ante approval listings can have legal effect (Japan, PRC, RF and Ukraine) or not (Finland and International Association for the Protection of Intellectual Property (AIPPI) Japan). Ex-post inductive listings of well-known marks can be found in the Czech Republic and are without legal effect.

A. Ex-ante Approval Listing

1. With Legal Effect

A prototype of ex-ante approval listings of well-known marks with legal effect was proposed in 2003 by Lars Smith of the Louisville University Law School. According to Smith, a "Fame Register" should be established and maintained by the United States Patent and Trademark Office (USPTO), a Register that is independent from the Principal Register and the Supplemental Register. Applicants who believe that they are in position of a famous mark may file an application with USPTO

distinguishing marks, goods, services, activities or circumstances of a competitor, shall not be allowed.

⁵ One informal survey of well-known mark registries has been done by Jonathan Richards & Michael M. Ballard ("Well-Known Marks") and presented to the American Intellectual Property Association Spring Meeting Chicago, Illinois, 4 May 2006.

requesting that the mark be included in the Fame Register. In contrast to Principal Register applications where USPTO has the burden of proof that a mark is not entitled to registration, applicants for inclusion in the Fame Register bear the burden of proving that their mark is famous and thus entitled to a registration.⁶ During the application process, any party with standing may initiate an opposition to challenge the fame determination before registration is issued.⁷ If the application is published and not successfully opposed, the application will be subject to automatic review by the Trademark Trial and Appeal Board (TTAB). Automatic review by the TTAB is warranted because of the import and potential significance of fame registration.⁸ Registration on the Fame Register affords the owner nationwide protection for ten years from the date of registration and can be renewed.⁹ Fame registration should be subject to cancellation on all the grounds listed in Section 14 of the Lanham Act, U.S. Congress. In addition, Section 14 should be amended to include a new subsection that would permit petitions to cancel fame registration at any time on the grounds that the mark is not, or is no longer, famous.¹⁰ However, none of the countries covered below has adopted Smith's design completely.

a. Japan: Publication of well-known marks registered as defensive marks

Japan is a member of the Paris Convention (1899) and the WTO (1995). Its Trademark Act and Act Against Unfair Competition provide protection for well-known marks.¹¹ Article 4(1)(x) of the Trademark Act makes unregistrable "a trademark which is well-known among consumers as indicating the goods or services pertaining to the business of another person or a trademark similar to it and such trademark is to be used for those goods or services or goods or services similar to them." When a well-known mark is registered, it acquires an exclusive right to use the mark for the designated goods or services, just like any other trademarks that are not well-known or have not been used at the time of filing trademark registration application.

Beginning from 1959 the owner of a registered well-known mark has been further allowed by Sec. 64 of the Trademark Act to register that mark as a defensive mark, without having the intention of using it for goods or services dissimilar to the

⁶ Lars Smith, Implementing a Registration System for Famous Trademarks, 93 *Trademark Reporter*, 1118, 1131 (2003).

⁷ Smith, *supra* note 6, at 1134.

⁸ Smith, *supra* note 6, at 1137.

⁹ Smith, *supra* note 6, at 1150.

¹⁰ Smith, *supra* note 6, at 1140.

¹¹ Klaus Hinkelmann, "Gewerblicher Rechtsschutz in Japan," Carl Heymanns Verlag, (2nd Edition, 2008), marginal note. 504.

designated goods or services of the registered well-known mark, in order to prevent other parties from using the mark and thereby causing confusion.¹² Compared with 513 defensive marks registrations in 1982,¹³ the Japan Patent Office now recognizes 955 well-known marks in the application process for defensive marks and publishes them in both Japanese and English on its website.¹⁴

b. The People's Republic of China

The protection of well-known marks in the PRC has gone through at least three stages. In the first stage case-by-case protection was afforded by government authorities (from March 1985 to August 1996): The Trademark Law was not enacted until 1982 and took effect on 1 March 1983. The 1982 Trademark Law was silent on the subject of well-known marks. However, scholars and the administration derived the obligation to protect well-known marks from China's accession to the Paris Convention on 19 March 1985. There has been occasional registration of internationally well-known marks that were deemed descriptive in nature.¹⁵ In the second stage (from August 1996 to December 2001) "active and wholesale approval of well-known marks" was made exclusively by the Trademark Office under the State Administration for Industry and Commerce (TMO). In the early 90s, with widespread consumer appraisals and award contests to establish "famous brands" and "excellent quality products," the TMO was quite concerned that the power of recognizing well-known marks was in danger of slipping away into private hands. That concern led to the promulgation of Interim Provisions on Establishment and Administration of Well-Known Marks on 14 August 1996, which empowered exclusively the TMO and its review authority – the Trademark Review and Adjudication Board (TRAB) – to recognize well-known marks wholesale on its own initiative. The decisions of both the TMO and the TRAB are final and judicially non-reviewable.¹⁶

From December 2001 onward commenced the third stage of passive and dual recognition by the TMO and People's Middle Courts. Article 13(2) of the 2001

¹² Teruo Doi, Japan (released in 2007), in Mostert, "Famous and Well-Known Marks," 4-250.

¹³ Christopher Heath, "The Protection of Well-Known Marks in Japan," in: Christopher Heath & Kung-Chung Liu (eds.), "The Protection of Well-known Marks in Asia," 83 (2000).

¹⁴ http://www.ipdl.inpit.go.jp/homepg_e.ipdl (last visited 19 March 2009).

¹⁵ Peter Feng, "Protection of Well-Known Marks in China," in Heath & Liu supra note 13, at 31-32. Chuntian Liu, "The Formation and Development of Well-known Marks" (in Chinese), presented at the Forum on Legal Protection of Well-known Trademarks, hosted by the IP Tribunal Supreme People's Court of PRC and IP School East China University of Political Science and Law, 7-8 September 2008, Shanghai, China.

¹⁶ Feng, supra note 15, at 34-35.

Trademark Law prohibits the registration of a mark for use on non-identical or dissimilar goods if it is a reproduction, imitation or translation of the well-known mark of another person that has been registered in Mainland China, and if it misleads the public and is likely to create prejudice to the interests of the well-known mark registrant.¹⁷ According to Article 5(1) of the Regulations for the Implementation of Trademark Law,¹⁸ the TMO and TRAB have the authority to determine well-known marks upon request. The determination of the TMO and TRAB can be appealed to the Beijing People's Middle Court. The Rules on the Recognition and Protection of Well-Known Marks provide that within one year from the date on which an application has been rejected no application that is based on the same circumstances for the same mark can be filed (Art. 9). It further grants a general presumptive effect to the recognized well-known marks by allowing the industry and commerce authorities to rely on the (well-known marks) records in dispute cases, on the conditions that the scope of protection involved is basically the same and that the opposing party does not dispute that marks at issue are well-known or disputes without evidence rebutting the renown of the marks (Art. 12). The TMO publishes every six months on its website well-known marks it and TRAB have recognized. These records extend as far back as 25 February 2004.¹⁹ However, the publication makes no reference to the cases in which the marks were recognized as well-known.

On the other hand, according to Supreme People's Court's 2001 Interpretation About Some Legal Problems Involving the Application of Law on Domain Name Disputes in Civil Cases (Art. 6) and 2002 Interpretation About Some Legal Problems Involving the Application of Law on Trademark Disputes in Civil Cases (Art 22) , the People's Middle Courts have the right to recognize well-known marks in disputes involving trademarks and domain names. In contrast to recognition by the TMO and TRAB, the recognition of a well-known mark by the People's Middle Courts is only valid for the individual case. It is to be noted that the People's Middle Courts do not publicize well-known marks that they have recognized.

¹⁷ Article 13(2) of the Trademark Law of the PRC: "Where a trademark, in respect of which an application for registration is filed for use on dissimilar goods, is a reproduction, imitation or translation of the well-known mark of another person that has been registered in China, misleads the public and is likely to create prejudice to the interests of the well-known mark registrant, its application shall be rejected and its use prohibited."

¹⁸ Article 5(1) of the Implementation Regulations of Trademark Law: "Where a dispute arises during the registration or review and adjudication procedure and one party to this dispute believes that its trademark constitutes a well-known trademark, it may ask the TMO and TRAB to determine whether it is the case and in affirmative determination of which to refuse the registration application or to cancel the trademark registration which is in violation of Article 13 of the Trademark Law. The requesting party shall submit evidence to prove that its trademark constitutes a well-known trademark."

¹⁹ <http://sbj.saic.gov.cn>

c. Russian Federation: granting indefinite period of legal protection

The Soviet Union, as predecessor to the RF, became a member of the Paris Convention on 1 July 1965. The FR is now seeking membership in the WTO.²⁰ The first Russian Trademark Law of 1992 included certain protection for marks considered “well-known” without spelling out the terms as such. It was not until March 1998 with the promulgation of the Decree of the Government of the RF No. 367, "On the Formation of Supreme Patent Chamber of Russian Agency for Patents and Trademarks," that the Supreme Patent Chamber of Federal Service for Intellectual Property, Patents and Trademarks (Rospatent) was empowered to recognize well-known marks upon application.

In 2002, the Russian Trademark Law was amended. According to Article 19.1, at the request of a legal entity or a natural person a trademark can be recognized as well-known on the territory of the RF if such trademark, as a result of its intensive use at the date indicated in the application became widely known in the RF among consumers in respect of the designated goods. Article 19.2 provides that the legal protection for a well-known trademark shall be granted on the basis of a decision of the Board on Patent Disputes rendered in response to an application. A trademark recognized as well-known shall be entered in the List of Well-Known Trademarks in the RF. A certificate for a well-known trademark shall be issued by Rospatent within a month after the date of entering the trademark in the List. The legal protection of a well-known trademark shall have an indefinite period.²¹ Nevertheless, this does not secure a well-known trademark against cancellation of recognition due to non-use or the fact that the trademark was recognized well-known with violations of the requirements of the law.

The 2002 Trademark Law as a whole has been replaced by Part IV of the Civil Code, namely Articles 1508 (replacing Art.19.1) 1509 (replacing Art. 19.2) , which came into force on 1 January 2008. To date, there are 73 well-known marks on the List.²²

d. Ukraine: recognition effective throughout the ten-year period of the certificate

²⁰ Eugene Arieivich & Janet Hoffman, Russian Federation (release in 2007), in Mostert, supra note 2, at 4-295.

²¹ Arieivich & Hoffman, supra note 20, at 4-305 and 306.

²² <http://www.fips.ru> (last visited 19 March 2009) .

Ukraine became a member of the Paris Convention and WTO on 25 December 1991 and 16 May 2008 respectively. Article 25 (1) of the Ukraine's 2003 Trademark Law for the first time provides for the recognition of well-known marks: The protection afforded to a well-known mark is provided according to Article 6bis of the Paris Convention and the 2003 Law and is based on the recognition of the mark as a well-known mark by the Appellate Chamber of the State Department of Intellectual Property, Ministry of Education and Science, or by the courts.

The decision of the Appellate Chamber on the recognition of a well-known mark in Ukraine may be protested in courts. From the date on which a mark is recognized as well-known by the Appellate Chamber or the courts, it is protected in the same way as a registered mark in Ukraine. The protection for well-known marks extends to the goods and services that are dissimilar to those for which the mark is well-known, provided that the use of the mark by another person would indicate a connection between its user and the well-known mark owner and the latter's interests would probably be damaged by such use.

The recognition of a well-known mark has not just a case-by-case effect, rather a general effect throughout the validity period of the trademark certificate, i.e. ten years. To date, there are 32 recognized well-known marks published on the website of the Ukrainian Intellectual Property Institute (Ukrpatent).²³

2. Without Legal Effect

a. Finland: purely additional information service

Finland is a member of the Paris Convention (1921) and the TRIPS Agreement (1995). In June 2007 the National Board of Patents and Registration of Finland (NBPR) decided to accept the proposal by a committee set up to study the situation of well-known trademarks in Finland by establishing the List of Trademarks with a Reputation in Finland. The acceptance of applications began in August 2007. The List is a database separate from the Trademark Register.²⁴ The purpose of the List is to provide an additional information service to all who need information about reputable marks; it is helpful in particular for commerce, industry and agents to conduct preliminary examinations or tests of confusing similarity of trademarks.²⁵

²³ <http://www.ukrpatent.org/cgi-bin/searchWKM> (last visited 19 March 2009)

²⁴ Tuulimarja Myllymäki (Legal Advisor, NBPR), "List of Trademarks with a Reputation in Finland," 1 IPR Info, 41(2008).

²⁵ Myllymäki, *ibid.*

The List is thus without legal effect and cannot be taken to a court of law or any other independent judicial organ. If the NBPR does not admit a trademark to the List, or removes a trademark already entered in the List, the right holder may only request a re-examination.²⁶

An application fee of 1,700 euros must be paid before the application will be processed. The proofs of reputation must be submitted by the applicant. To be accepted as proof, a market survey carried out by an impartial organization must accompany the application in its entirety. If the mark is admitted to the List, the applicant must pay an entry fee of 800 euros. An entry in the List will remain in force for five years. It may be renewed for another five years, provided that the application fee and entry fee are paid and proofs of reputation are submitted. Anyone may request that an entry to be removed from the List on the grounds that the entry was a priori or a posteriori contrary to the conditions in Sec. 6(2) of the Finnish Trademarks Act. A fee of 500 euros must be paid.¹⁴

Given the costs and application burden of the List, its practical use is very limited, only to that of notification. When the NBPR finds a confusing similarity between a later mark and the mark in the List while processing a trademark application, it will notify the applicant and the owner of the earlier trademark, regardless of the class(es) in which the mark is sought to be registered. However, the NBPR will not take the information in the List into consideration even in the registration/examination process. It is up to the owner of the earlier trademark whether to oppose the registration of a later mark, and the final outcome of an opposition will not automatically change the information contained in the List¹⁵. Nevertheless, the List may have relevance in the trademark trials as part of evidence; it may also broaden the actual scope of protection granted for well-known marks by discouraging small and medium companies from pursuing their trademark applications.¹⁶

To date, there has been a total of 74 applications, dwindling from 53 in the last four months of 2007 to 17 in 2008 and further to only 4 in the first three months of 2009, and only 25 marks have been admitted to the List and published on the website of the

²⁶ Myllymäki, *supra* note 24, at 42.

¹⁴ NBPR, Receipt of applications for entry into the "List of Trademarks with a Reputation" began on 15 August 2007, available at: <http://www.prh.fi/print/en/uutiset/775.html> (last visited 19 March 2009).

¹⁵ Myllymäki, *List of Trademarks with a Reputation in Finland*, 41.

¹⁶ Mia Pakarinen, *The Great Reputation of Your Brand Can Be Registered in Finland*, IPR Info, issue no 1/2008, 43-44.

NBPR.¹⁷

b. International Association for the Protection of Intellectual Property Japan

For the purpose of preventing the piracy of Japanese trademarks in other Asian countries, AIPPI Japan published “Famous Trademarks in Japan” in 1970. The second and third edition was published in 1998 and 2004 respectively, with the latter listing 2195 famous marks. Up to now, AIPPI Japan does not intend to accept applications for inclusion in the fourth edition. The trademarks included in this book are exclusively trademarks that are 1) owned by Japanese nationals (both natural and legal persons), 2) registered with Japan (including pending applications), and 3) those for which the owners have requested inclusion.¹⁸ To formalize the list after receiving requests and fees, AIPPI Japan has entrusted the Trademark Selection Committee for Famous Trademarks in Japan, which consists of “people of learning and experience as well as patent attorneys and representatives of related industries who have been recommended by intellectual property related bodies,”¹⁹ to check the appropriateness of those marks and objectively recognize the famous trademarks. The resulting list is understandably criticized as unreliable,²⁰ and could not be possibly recognized by other countries as a default list of well-known marks in their territories.

B. Ex-post Inductive Listing

The Czech Republic is a case in point for ex-post inductive listing. It has been a contracting party to the Paris Convention since 1908 after the accession of Austria-Hungary, and a member of the WTO since 1995. The original Czech Trademark Act established a system of declaring a famous trademark with legal effect. However, the current Trademark Act, effective since 1 April 2004, does away such system and provides a transitional provision in Sec. 52(9) for the declared famous marks. According to Sec. 7(1)(c) and (d) of the Trademark Act, the proprietor of an earlier well-known trademark may oppose the registration of a younger trademark in the register by filing opposition procedures with the Intellectual Property Office (IPO). The IPO maintains on its website an on-line database called List of Well-Known

¹⁷ <http://www.prh.fi/en/tavaramerkit/tavaramerkkitietokannat.html> (last visited 19 March 2009)

¹⁸ AIPPI Japan, *Famous Trademarks in Japan*, 7- 8 (3rd ed., 2004).

¹⁹ According to the e-mail sent by Keiko Kawakami (IKEUCHI, Sato & Partner Patent Attorneys) to the first author of this paper on 18 August 2008, members of the editing committee of *Famous Trademarks in Japan* are members of the Trademark Selection Committee for Famous Trademarks in Japan.

²⁰ Heath, *The Protection of Well-Known Marks in Japan*, 73-74.

Trademarks, which to date contains 303 well-known marks. It is clearly stated that this database is an informative summary of trademarks. The notoriety of trademark relates only to the procedure in which this notoriety was claimed and does not exempt its owner from the onus of proof in the event of newly filed objections or requests for cancellation.²¹

II. Misuse of the Listing of Well-Known Marks

Like all institutions, the listing of well-known marks can be misused as in the case of the PRC.

A. The Fast-Growing Number of Well-Known Marks

From 1996 to 2003 the Chinese TMO recognized some 289 well-known marks. Between 2004 and July 2008, it continued to recognize well-known marks in much greater quantity, with a total of around 945.²² During 1996-2003 only six well-known marks were recognized by the courts in infringement cases. However, the number of well-known marks recognized by the courts also rose sharply between 2004 and 2006, reaching 191 in total. It is alarming that the judicial practice of recognizing well-known marks extends to remote regions of the PRC, such as Tibet and Qinghai.

B. Alienation of the Listing of Well-Known Marks

As a result, the listing of well-known marks in the PRC has deviated from its original purposes in an astonishing way. Once the courts recognize a well-known mark or the TMO lists one on its website, the mark right holder will without exception take the mark out of the case context in which it was recognized and advertise it throughout China. This exaggerated advertising allegedly helps the sale of goods and services bearing such marks. On top of this, owners of well-known marks can receive subsidies from various levels of government and even political fringe benefits. It all adds up to be an irresistible temptation for mark owners to get their marks recognized or listed as well-known, one way or another. One outrageous way is that right holders, attorneys, infringers and even judges sometimes collaborate to fake well-known marks out of sham cases.²³

²¹ <http://isdvapl.upv.cz> (last visited 19 March 2009). However, the list does not include the marks that were declared famous with legal effect under the 1988 Trademark Act.

²² According to Xinliang Tao, "The Erroneous Area and Maze of Recognizing Pan-Well-known Marks" (in Chinese) presented at the Forum on Legal Protection of Well-known Trademarks, hosted by the IP Tribunal Supreme People's Court of PRC and IP School East China University of Political Science and Law, 7-8 September 2008, Shanghai, China.

²³ Zhonghua Deng, "Legal Thoughts on Controlling the Recognition of Well-known Marks by the

In the same frenzy, governments, especially at the provincial level, view the listing of marks owned by companies registered and operating in their territories as an achievement and join with trademark owners to pursue the recognition of well-known marks. This practice creates moral hazards for officials both within and without the TMO. To make things worse, intermediate organizations dedicated to the creation of well-known marks emerge, brokering between trademark owners and officials. A fever for well-known marks has swept across the nation and threatens to result in a hypertrophy of “well-known marks” that are in fact not well-known at all.

For this reason the Supreme People’s Court worriedly demands that “the abuse of the protection system of well-known marks be prevented and eradicated” and that “the recognition of well-known marks not be included in the tenor of court decisions.”²⁴ It also vows to implement “the report system (for lower courts to report the adjudicated well-known mark cases to the Supreme People’s Court) as soon as possible.”²⁵

III. Evaluation of Well-Known Marks Listings

A. The Ex-ante Approval Listing

The foremost merit of the ex-ante approval listing with legal effect lies in the certainty that it promises, and the avoidance of case-by-case determination of a well-known mark that would accrue great costs and burden to right holders. However, certainty comes only when sufficient time, quality manpower and resources are in place. Even if these three elements were in place, it would still be a long time before certainty could cover a substantial part of the market. And when it does, the renewal process will have to commence. What the RF permits — indefinite protection — seems to contravene the basic trademark principle. In addition, this model is bound to lose touch with changing market conditions. It will artificially prolong the life of marks that are no longer well-known, inhibit the emergence of new marks, and itself become an object of contention among interested parties, leading to extra disputes and litigations. The Czech Republic’s experience of converting from declaration of famous marks with legal effect to an informative summary of well-known trademarks is arguably illustrative enough of the impracticability of a well-known mark register

Judicial” (in Chinese) , 261 Journal of Law Application (in Chinese) 17 (12th Issue, 2007) .

²⁴ Statement of the former Deputy Director of the Supreme People’s Court Jianmin Cao, available at: news.wenweipo.com/2008/02/19/IN0802190139.htm (last visited 19 March 2009).

²⁵ According to <http://www.well-knownmark.com/xinwenjiaodian/xinweiijaodian/200801/252.html> (last visited 19 March 2009).

with legal effect.

A purely informative ex-ante approval and listing by NBPR Finland is itself a schizophrenic contradiction. On the one hand, NBPR Finland establishes the List with great efforts and, on the other hand, it is instructed not to take the List into consideration in any of its decision. This could help to explain why NBPR Finland is receiving a shrinking number of applications. A purely informative ex-ante approval and listing by private entities such as AIPPI Japan runs the risk of lacking standard operation procedures, selection transparency, and regular updating.

The international trademark community, being aware of the above-mentioned difficulties and dangers, tends to look at the ex-ante approval and listing of well-known marks with either reservations²⁶ or outright rejection;²⁷ otherwise, it avoids altogether taking a position in the debate for or against such a model.²⁸

B. The Ex-Post Inductive Listing

Ex-post and inductive listing of well-known marks via a database is of rather low cost and therefore quite feasible, because IPOs will not be required to invest extra manpower and no additional matching burdens (such as the high fee to finance extra manpower) will be demanded of the right holders. The flipside of this model in the eyes of those who prefer the ex-ante approval listing model is that it does not provide absolute certainty. However, a well-structured ex-post inductive database of cases in which well-known marks have been recognized can help to reduce uncertainty by providing public access to collected information. After all, not every mark is as well-known as Coca Cola. Such an ex-post inductive database is all the more desirable in light of ever-expanding protection and ever-growing number of well-known marks, something particularly true in those countries where the renown

²⁶ The Law Committee of European Communities Trade Mark Association has expressed its reservations about establishing a special register for well-known marks in its 2005 position paper on the creation of a special register for well-known trade marks. Available at http://www.ecta.org/com6_pp.php (last visited 19 March 2009) .

²⁷ During the first meeting of the World Intellectual Property Organization (WIPO) Committee of Experts on well-Known Marks in 1995, it was already obvious that many countries would not be in favor of setting up some type of international registry for well-known marks. See Mostert, *supra* note 2, at 1-5 and 6.

²⁸ In its 2005 resolution regarding well-known marks, the Board of Directors of the International Trademark Association recommends only that countries electing to establish well-known mark registries design and operate them in a manner that affords legal certainty concerning rights in well-known marks and apply the principles of the WIPO Provisions for the protection of well-known marks. Available at http://www.inta.org/index.php?option=com_content&task=view&id=1383&Itemid=153&getcontent=3 (last visited 19 March 2009) .

required of well-known marks is low. It is therefore worthwhile to design an on-line mechanism that would provide useful information on how and when well-known marks have been recognized.²⁹

IV. Recommendation: Creation of a Centralized On-Line Database of Cases in Which Well-Known Marks Have Been Recognized

It is recommended that IPOs establish and maintain a database of cases of recognized well-known marks. The database should have the following characteristics: non-misleading, all-inclusive and centralized, user-initiative, as well as informative and time-sensitive.

- Non-misleading: The database should not be named as a “Register of Well-Known Marks” or a “ Database of Well-Known Marks.” Such nomenclature leads to the misconception that listed marks were and still are well-known and that nonlisted marks were and still are not well-known. It also abets the type of misuse by right holders that can be observed in Mainland China. Rather, “Database of Well-Known Marks Cases” would be a more appropriate title. In addition, database users should be reminded of the fact that many well-known marks remain unlisted simply because they have not been disputed.
- All-inclusive and centralized: The database should include all decisions that provide recognition to well-known marks, whether made by an IPO (in rejection, opposition, and invalidation cases) , by courts of all instances and competences, by the competition authority (such as Fair Trade Commission), or by the administrator of domain names. As a result, there should be no need to link with or look up other databases. The more inclusive the database, the more transparent will be the recognizing organization’s decisions and reasoning. An all-inclusive and centralized database will also compel recognizing organizations to do a better job.
- User-initiative: The database should enable users to set their own search parameters (by using software such as Microsoft Office Excel), and remind them that they need to assess case by case whether listed marks are still well-known.
- Informative: The more informative the database, the less likely it is to be misused. Therefore, information such as the case context and key reasons why listed marks were recognized as well-known should be included. Users should be able to search the full text of every decision.
- Time-sensitive: The database should consider the time-sensitiveness of well-known marks recognition by limiting the time frame of collected cases, preferably not prior

²⁹ The same can be said of other marks with stronger reputations, such as “marks with reputation” in the European Union and “marks that have been established in trade,” “marks making headway in the traffic,” or “marks known in the country” in the German Trademark Act.

to half the term (or the last five years) of trademark protection. Five years is generous for today's internet world. Unlimited case listing of recognized well-known marks could mislead users by bringing back to life long dead and forgotten marks.