IP K 1401 .A6 F73 2001 c.3

Welcome to the Franklin Pierce Law Center

Franklin Pierce Law Center is a private, independent, ABA-accredited law school located in Concord, NH, with an enrollment of approximately 450 students. Students learn in a close, cooperative and informal environment. Our faculty members are committed to academic excellence and scholarship and to inspiring graduates to seek rewarding and successful careers. Since it's founding, Pierce Law has been recognized worldwide as a leader in the study of U.S. and international intellectual property law.

The Franklin Pierce Law Center's Student Intellectual Property Law Association (SIPLA) was formed to promote intellectual property issues and maintain a high standard of professionalism in the Pierce Law community. The organization brings Pierce Law students, faculty, alumni and members of the legal community together from the full spectrum of IP concerns, including: Patents, Copyrights, and Trademarks, and other areas of law affecting IP.

SIPLA sponsors this forum to promote an open dialogue of current issues in intellectual property and how these issues will affect the practice of intellectual property in the future. We have invited speakers from diverse areas of intellectual property, and hope you find their discussions informative and thought provoking.

Student Intellectual Property Law Association
Officers

Co-Chairs
Jenae Avalone — **Brad Chin** — **Leigh Willey**

Treasurer
James Larke

Secretary
Tom Holsten

3L Representative
Bill Lambert

2L Representative
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Chuck Meier

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Keshev Dhakad

Additional Forum Organizers:
Anne Yates
A.J. Bahou
Janet Moreira

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AGENDA

Saturday November 10, 2001

8:00 AM Registration & Continental Breakfast

9:00 AM **Welcome**
Keith Harrison, Vice Dean, *Franklin Pierce Law Center*

9:15 AM **AIPLA's Three Year Strategic Plan and the Role of the Law Student**
Ms. M. Andrea Ryan, Immediate Past President, American Intellectual Property Law Association, and Assistant General Counsel for Patents and Vice President, Wyth Ayerst Research, Cambridge, Mass.

10:00 AM **New Technologies and IP**
Mr. David Crosby, Associate, Mintz Levin Cohn Ferris Glovsky & Popeo, P.C., Boston, Mass.

10:45 AM Coffee Break

11:00 AM **Recent Developments in Biotechnology and Patent Law**
Dr. David Marsh, Partner, Arnold & Porter, Washington, D.C.

11:45 AM **Start-Up Companies: An Effective Means for Monetizing Innovations**
Mr. John Orcutt, Professor, Franklin Pierce Law Center, Concord, NH

12:30 Coffee Break

12:45 PM **Global Trademark Harmonization in the 21st Century: TRIPS and Beyond**
Mr. Clark Lackert, Partner, King & Spalding, New York, NY
Mr. Larry Tronco, Associate, King & Spalding, New York, NY

1:30 PM Lunch

M. Andrea Ryan

Biography

Ms. M. Andrea Ryan is the Immediate Past-President of the American Intellectual Property Law Association (AIPLA). Ms. Ryan currently serves as Assistant General Counsel for Patents and Vice President Wyeth-Ayerst Research in Cambridge, Massachusetts. Prior to joining Wyeth-Ayert, Ms. Ryan served as Vice President and Associate General Counsel, Intellectual Property, for the Warner-Lambert Company, Morris Plains, New Jersey. She was Of Counsel at White & Case before moving to Warner-Lambert and prior to that, an associate at Brumbaugh Donohue & Raymond in New York.

Ms. Ryan is a cum laude graduate in chemistry from Emmanuel College, Boston, Mass and Hofstra University School of Law. She is also a Past President of the New York Intellectual Property Law Association (NYIPLA).

Mr. David Crosby

Biography

Mr. David Crosby is an associate in the firm's Boston office and practices in the Intellectual Property Law Section. His work encompasses all aspects of intellectual property law including the acquisition and enforcement of patents, trademarks and copyrights. He is also experienced in client counseling regarding intellectual property strategies and has also been involved in patent, trademark and copyright litigation.

David's practice involves diverse high technology fields including Internet and electronic commerce, telecommunications, networking and remote access systems, medical laser systems, computer software and hardware systems, electronic systems manufacturing, and computer vision systems.

Before joining the firm, David was a Patent Examiner in the U.S. Patent and Trademark Office, where he examined patent applications in a broad range of fields including prosthetic devices, medical treatment systems, exercise equipment, manufacturing systems and computer training systems. While on detail in the international Division of the Patent Office for the assistant Commissioner for Patents, David designed and developed an interactive software environment that assisted the examiners in the preparation of reports under the Patent Cooperation Treaty. As a result of the improvement in the quality of the reports produced by this new system, David was awarded a Silver Medal from the U.S. Secretary of Commerce in 1992. Before attending law school, David worked in the computer industry as a software and systems engineer and a manufacturing engineer.

David has lectured on New Technologies and Intellectual Property at the Fletcher School of Law and Diplomacy. He is also a member of the Boston College Intellectual Property Inn of Court and the ACM.

David is admitted to practice in Massachusetts, and is registered to practice before the U.S. Patent and Trademark Office. He received his B.S. from the Rensselaer Polytechnic Institute, and his J.D. from New England School of Law.

New Technology and Intellectual Property

David F. Crosby, Esq.
Intellectual Property Section
dcrosby@mintz.com

I. The New Technology

1. The Personal Computer.
   - Desktop = Handheld
2. The Internet.
3. Data Compression, (i.e. MP3).
4. Data Encryption.
5. The Combination of the above.

II. Patents

1. The Rise of Business Methods
   - "Secret Prior Art"
   - Merrill Lynch
   - State Street Bank/Excel Comm.
   - Amazon v. Barnes and Noble
2. The Fall of Business Methods

III. Trademarks

1. Domain Names.
   - Cybersquatting
   - TMs v. Domain Names
2. Playboy v. Chuckelberry.
   (the Playmen Case)

IV. Copyrights

1. DMCA.
2. Digital Rights Management (DRM).
3. Napster.
4. Fair Use.

V. Conclusions & A Look Ahead

1. Patents
2. Trademarks
3. Copyrights
4. Trade Secrets
5. Technological Solutions

Dr. David Marsh

Biography

Dr. Marsh is a Partner with Arnold & Porter in Washington, D.C. His practice focuses extensively on intellectual property counseling, interferences and patent procurement, predominantly in the biotechnology area. He also manages multiple European Opposition proceedings, as well as represents clients in patent and other intellectual property litigation. As an Adjunct Professor at Georgetown Law School, Dr. Marsh teaches "Biotechnology and Patent Law." He has also written numerous articles on patent law, is a frequent speaker at conferences in the United States and Europe, and is an editor of *BioScience Law Review*.

Dr. Marsh carried out his graduate work in molecular biology at Cambridge, England and his post-doctoral work at Yale University. His research experience includes molecular biology, immunology, biochemistry, and mammalian and plant genetics.

Dr. Marsh received his J.D. (1995) from New York University School of Law. He also received a C.P.E. (1992) from Nottingham Law School, a Ph.D. (1989) from the Institute of Plant Science Research, and his B.Sc. (1985) from the University of London.

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Recent Developments in Biotechnology Patent Law

David R. Marsh
November 2001

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Any views expressed here are for educational purposes only and are not necessarily those of the author, Arnold & Porter, or any client of Arnold & Porter.

- *Mycogen Plant Science, Inc. v. Monsanto*, 252 F.3d 1306 (Fed. Cir. 2001)
- *Bayer AG v. Housey Pharmaceuticals, Inc.*, No. 01-148-SLR, 2001 WL 1346496, -- F.Supp.2d -- (D.Del. Oct. 17, 2001)
- *Bio-Technology General Corp. v. Genentech, Inc.*, 60 U.S.P.Q.2d 1430 (Fed. Cir. 2001)
- *Carnegie Mellon University v. Hoffman-La Roche*, 148 F. Supp.2d 1004 (N.D. Cal. 2001)
- *Hitzeman v. Rutter*, 243 F.3d 1345 (Fed. Cir. 2001)
- *Glaxo Wellcome, Inc. v. Genentech, Inc.*, 136 F. Supp.2d 316 (D. Del. 2001)
- *Morphosys AG v. Cambridge Antibody Technology Limited*, 158 F.Supp.2d 84 (D. D.C. 2001)

Mycogen Plant Science, Inc. v. Monsanto, 252 F.3d 1306 (Fed. Cir. 2001)

"Issue Preclusion"

Claim 1, U.S. Patent No. 5,567,600:

A method of designing a synthetic *Bacillus thuringiensis* gene to be more highly expressed in plants, comprising the steps of:

(a) analyzing the coding sequence of a gene derived from a *Bacillus thuringiensis* which encodes a pesticidal [insecticidal] protein toxin; [and]

(b) modifying a portion of said coding sequence to yield a modified sequence which contains a greater number of codons preferred by the intended plant host than did said coding sequence prior to modification, said modification comprising reducing the number codons having CG in codon positions II and III in a region between plant polyadenylation signals in said coding sequence;

(c) inserting said modified sequence into the genome of a plant cell; and

(d) maintaining said plant cell under conditions suitable to allow replication of said plant cell to produce additional plant cells having said modified sequence in the genome of said additional plant cells, wherein said synthetic *Bacillus thuringiensis* gene is expressed to produce a pesticidal protein toxin.

Bold = U.S. Patent No. 5,380,831

Mycogen (continued)

Amgen v. Genetics Institute, 98 F.2d 1328 (Fed. Cir. 1996)

Claim 1, U.S. Patent No. 5,322,837:

A pharmaceutical composition for stimulating production of red blood cells comprising a therapeutically effective amount of homogeneous human EPO protein characterized by a molecular weight of about 34,000 Daltons in a single band on SDS PAGE and movement as a single peak in reverse phase high performance liquid chromatography and a pharmaceutically acceptable vehicle.

Claim 1, U.S. Patent No. 4,677,195:

Homogeneous erythropoietin characterized by a molecular weight of about 34,000 Daltons on SDS PAGE, movement as a single peak on reverse phase high performance liquid chromatography and a **specific activity of at least 160,000 IU per absorbance unit at 280 nanometers**.

Mycogen (continued)

"102(g)"

"Made in this country by another who had not abandoned, suppressed or concealed"

- "death sequences" -- certain sequence motifs that were believed to prevent production
- "plant-like"

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Mycogen (continued)

- "Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a *process patented* in the United States shall be liable as an infringer ..." (35 U.S.C. § 271(g))
- Product imported after patent issues
- Process carried out prior to patent issuance

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Mycogen (continued)

Ajinomoto Co., Inc. v. Archer Daniel Midland Co., 228 F.3d 1338 (Fed. Cir. 2000)

- "Section 271(g) by its terms applies to unauthorized actions within the United States; it is irrelevant that the product was authorized to be produced outside of the United States. When the process is used abroad is the same as the process covered by a United States patent, liability for infringement arises only upon importation, sale or offers, or use in the United States as set forth in §271(g)."
- Claim 1, U.S. Patent No. 4,278,765:

A method for preparing bacterial strains which produce aminoacids comprising:

combining a chromosome DNA fragment of a donor bacterium containing genes controlling the synthesis of a selected aminoacid ...

transforming with said hybrid DNA molecule ...

to yield a bacterial strain possessing increased productivity of the selected aminoacid.

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Bayer AG v. Housey Pharmaceuticals, Inc., No. 01-148-SLR, 2001 WL 1346496 -- F.Supp.2d -- (D. Del. Oct. 17, 2001)

Claim 1, U.S. Patent No. 4,980,281:

A method of determining whether a substance is an inhibitor or activator of a protein ... which comprises:

(a) providing a first cell line ...

(b) providing a second cell line ...

(c) incubating the substance ...

(d) comparing the phenotypic response of the first cell line to the substance with the phenotypic response of the second cell line to the substance.

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Bayer (continued)

- Sell in the United States a drug that was determined to be an inhibitor or activator
- Import into or use in the United States knowledge and information reflecting the identification or characterization of a drug
- "271(g) addresses only products derived from patented manufacturing processes"

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Bio-Technology General Corp. v. Genentech, Inc., 60 U.S.P.Q.2d 1430 (Fed. Cir. 2001)

- Claim directed to a method for producing human growth hormone in bacteria
- Prior claim interpretation -- claims include met hGH and hGH

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Bio-Technology General (continued)

Jury Question:

"Has BTG proven by clear and convincing evidence that the '980 patent did not enable a scientist skilled in the art in July 1979 to make any mature human growth hormone of 191 amino acids?"

Genentech:

- Some met-hGH was processed by the bacteria to form hGH
- Met-hGH and hGH could be separated

BTG:

- met-hGH was processed outside bacteria

• • •

When reasonable scientists differ because scientific certainty is not available, the resolution of the dispute is in the hands of the trier of fact.

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Bio-Technology General (continued)

- "At best 6% hGH"
- "Principally" or "Mainly"
- Gene - 3^{191} or 3^{192}

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Carnegie Mellon University v. Hoffman-La Roche, 148 F.Supp.2d 1004 (N.D. Cal. 2001)

- Recombinant plasmids for the controlled expression of an enzyme identified as DNA polymerase I
- A process related to the construction of such plasmids
- Processes relating to the culturing of host cells containing such plasmids

(U.S. Patent Nos. 4,767,708 and 5,126,270)

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Carnegie Mellon (continued)

- Disclosed *E. coli* nucleic acid and amino acid sequences
- Roche argued that claims lacked written description under *University of California v. Eli Lilly*

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Carnegie Mellon (continued)

Regents of the University of California v. Eli Lilly, 119 F.3d 1559 (Fed. Cir. 1997)

- Rat insulin cDNA
- Human insulin cDNA
- Vertebrate or mammalian insulin cDNA

"structure, formula, chemical name or physical properties"

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Carnegie Mellon (continued)

- Carnegie argued that *University of California v. Eli Lilly* was inapplicable because it was not a novel gene
- Numerous types of bacterial genes
- Written description guidelines

"For inventions in an unpredictable art, adequate written description of a genus which embraces widely variant species cannot be achieved by disclosing only one species with the genus."

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Hitzeman v. Rutter, 243 F.3d 1345 (Fed. Cir. 2001)

- Prior art bacterial systems
- "HBsAg particle ... which has a sedimentation rate which is virtually identical to that of authentic 22 nm HBsAg particles"
- Board held that the sedimentation rate and size limitations were material

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Hitzeman (continued)

- Inherency - yeast would inherently produce particles
- Distinguished bacterial systems by stating that it was not reasonably predictable that HBsAg could be expressed in yeast

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Glaxo Wellcome, Inc. v. Genentech, Inc., 136 F.Supp.2d 316 (D. Del. 2001)

"Markman"

- "Composition of IgG_1"
- "Copper ions in an amount sufficient to degrade"
- "Degradation by the copper ion" and "copper ion mediated degradation"
- "Therapeutically effective"
- "CDR grafted"
- "chimeric"
- "whole glycosylated"

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Glaxo (continued)

"composition of IgG_1"

In an [A *stabilized*] *immunoglobulin composition of* [comprising] IgG sub 1 immunoglobulin ...

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Glaxo (continued)

"therapeutically effective"

In a method for treating a human suffering from a disease or disorder comprising administering a *therapeutically effective* amount of a whole glycosylated recombinant human chimeric or CDR-grafted or bispecific antibody effective in treating said disease or disorder in said human, **wherein the improvement** comprises an antibody glycosylated by a Chinese hamster ovary cell.

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Glaxo (continued)

"CDR grafted"



- "where the murine constant domains and the murine framework regions are all replaced by equivalent domains and regions of human origin"
- "a composite antibody, wherein parts of the hypervariable regions in addition to the CDRs are transferred"

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Glaxo (continued)

"chimeric"

- "The murine constant domains only are replaced by equivalent domains of human origin"
- "*Chimeric antibodies may have one or more further* modifications to improve antigen binding ability or alter effective functioning"
- *Cf:* Antibody that derives amino acid sequences from two distinct parents

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MorphoSys AG v. Cambridge Antibody Technology Limited, 158 F.Supp.2d 84 (D. D.C. 2001)

A method for obtaining a member of a specific binding pair ... the antigen binding site having binding specificity for an antigen which is a human self antigen for which specific antibodies **are not found in sera of humans** unimmunized with said self antigen the method comprising: (a) providing a *library of filamentous bacteriophage, ... containing* ***nucleic acid with sequence derived from a human*** unimmunized with said self antigen ... and (b) selecting ....

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MorphoSys (continued)

- "are not found in sera of humans"
- "are not present"
- *Cf:* "were not found" or "have not yet been found"

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MorphoSys (continued)

- "derived from"
- "acquired or obtained, actually or theoretically, directly from, or by modification of"
- *Cf:* "by reference to," human material

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MorphoSys (continued)

Indefiniteness

- "specific antibodies are not found in the sera of humans"
- literature search
- ELISA

Mr. John Orcutt

Biography

John Orcutt is a law professor at Pierce Law where he teaches classes in Business Associations, Mergers & Acquisitions, Securities Regulation and Start-up Companies. Professor Orcutt will be one of the professors teaching at Tsinghua University in Beijing this summer as part of Pierce Law's inaugural Intellectual Property Summer Institute in China.

Before coming to Pierce, Professor Orcutt spent eight years as both a corporate securities attorney and an investment banker. Most recently, Professor Orcutt was a Principal at Robertson Stephens, a leading Silicon Valley investment bank, where he was the head of its West Coast Telecom Services investment banking practice. He also served as Chief Administrative Officer of Robertson Stephens' M&A group and as its Associate General Counsel. Prior to joining Robertson Stephens, Professor Orcutt was a Corporate Finance Associate with Shearman & Sterling, serving in both its New York, NY and Paris, France offices, where he specialized in securities offerings by European companies that involved dual listings in the United States and Europe.

Professor Orcutt received both his J.D. and his B.A. from U.C. Berkeley.

Mr. Clark Lackert

Biography

Clark W. Lackert is a partner in the Intellectual Property Practice Group of King & Spalding in the New York, NY.

Mr. Lackert practices primarily in trademark, domain name, licensing and anti-counterfeiting matters, with a particular expertise in the international area. He supervises the trademark searching, filing, maintenance, litigation, and protection programs for several Fortune 200 multinational companies. He has worked in numerous acquisitions and divestitures involving intellectual property and he counsels on intellectual property management generally. In addition to the foregoing, Mr. Lackert is an arbitrator for the World Intellectual Property Organization (WIPO) in Geneva, Switzerland in connection with internet domain name disputes. Moreover, Mr. Lackert has been a consultant with the U.S. Government on implementation of the World Trade Organization TRIPs Agreement.

Recent representations include:

- Mr. Lackert supervised a multinational legal team in domain name litigation in Germany, obtaining an injunction against the defendant and the transfer of the pirated domain name.
- Mr. Lackert won an important appellate court decision in United Arab Emirates concerning trade name and trademark use and registration of a client's corporate name.
- Mr. Lackert counseled on global requirements for an international trademark licensing initiative of a multinational client of the firm.
- Mr. Lackert completed international intellectual property due diligence on several potential acquisitions for another client.
- Mr. Lackert worked with a name generation firm to analyze trademark availability and suitability for a major global rebranding project for a major U.S. corporation.

He is listed on the Global "Top 20" List of Trademark Lawyers in *Best of the Best 2001* published by Legal Media Group, and in *World's Leading Trade Mark Law Practitioners* and has chaired committees in the American Bar Association (ABA) and International Trademark Association (INTA) in the intellectual property area, currently serving as the Chair of INTA's Amicus Brief Committee. He also serves as Secretary on the Executive Committee of AIPPI, an international intellectual property association. A frequent lecturer, Mr. Lackert has addressed various meetings of the China Trademark Association, INTA, ABA, WIPO, Pharmaceutical Research and Manufacturers Association (PhRMA), Association of the Bar of the City of New York, Pharmaceutical Trade Marks Group (PTMG), AIPPI, Practicing Law Institute, New York County Lawyers Association, International Anti-Counterfeiting Coalition, Committee on

Intellectual Property Rights, Japan Trademark Association, New York State Bar Association, U.S. Patent and Trademark Office, and others on intellectual property issues. He has also lectured at Yale Law School, New York University Law School, and Temple Law School. He has authored a number of articles on the subject for such publications as the *Internet Law Journal*, *National Law Journal*, *Russian Patent Office Gazette*, *Middle East Commercial Law Review*, *Trademark World*, and *Columbia Business Law Review*. Mr. Lackert has studied French and Russian, and has been interviewed by *CFO Magazine* and *The New York Times*.

Mr. Lackert received his A.B., *cum laude*, from Cornell University and his J.D. from the State University of New York at Buffalo. He also holds a LL.M. in Trade Regulation from New York University.

Mr. Larry Tronco

Biography

Mr Tronco is an Associate in the Intellectual Property Practice group of King & Spalding in New York, NY.

Mr. Tronco received a B.S. from Creighton University and a J.D. from the Franklin Pierce Law Center.

Trademark Law Harmonization in the 21st Century: TRIPs and Beyond

CLARK W. LACKERT
LARRY H. TRONCO
King & Spalding
New York

Franklin Pierce Law Center Fall IP Forum 2001

Harmonization Factors: The Three T's

- Treaties
- Trade
- Technology

Focus for Today

- WTO TRIPs Agreement
- Madrid Protocol (Madrid System)
- Trademark Law Treaty (TLT)
- Harmonization of a Representative Trademark Law Issue: Famous Trademarks
- Supranational Trademark Law: ICANN UDRP

WTO TRIPs Agreement (1994)

- GATT (1949)
- Tokyo GATT Round (1970's)
- Punta del Este Resolution – Uruguay Round (1986)

TRIPs Outline

- Part I: General
- Part II: Standards
- Part III: Enforcement
- Part IV: Acquisition and Maintenance of IP Rights
- Part V: Dispute Prevention and Settlement
- Part VI: Transitional Provisions
- Part VII: Institutional Arrangements

TRIPs Part II: Articles 15-21

- Article 15: Trademark Definition
- Article 16: Rights Conferred
- Article 17: Exceptions
- Article 18: Term of Protection
- Article 19: Requirement of Use
- Article 20: Other Requirements
- Article 21: Licensing and Assignment

TRIPs Implementation Schedule

- January 1, 1995 (WTO Created)
- 1 year (Developed Countries)
- 5 years (Developing and Communist Countries)
- 10 years (Least Developed Countries)

TRIPs II

- The Doha (Qatar) Conference in Autumn 2002 will show the continuation of the effort by certain countries to create TRIPs II

The Madrid Protocol: Ten Questions

1. What is the Madrid Protocol?

- A 1996 addition to an 1891 international trademark application filing treaty (Madrid Agreement).

2. How does the Madrid Agreement work?

- Home country registration.
- Filing at WIPO in French only.
- Extends to all designated countries.
- One year examination period.
- Central Attack for five years.

3. Why did the Madrid Agreement need a protocol?

- The United States and other countries had serious problems with various aspects of the Madrid Agreement which have been addressed in the Protocol.

4. How does the Madrid Protocol work?

- Home country registration or application.
- Filing at WIPO in English or French.
- Extends to all designated countries.
- 18 month examination period.
- No Central Attack ("Transformation").

5. Which 49 countries are in the Madrid Protocol system?

- Antigua, Armenia, Austria
- Belgium, Bhutan, China
- Cuba, Czech Rep., Den.
- Estonia, Finland, France
- Georgia, Germany, Greece
- Hungary, Iceland, Italy
- Japan, Kenya, N. Korea
- Latvia, Lesotho, Liech.
- Lithuania
- Luxem., Mold., Monaco
- Morocco, Moz., Neth.
- Norway, Poland, Port.
- Romania, Russia, Sierra L.
- Sing., Slovakia, Slovenia
- Spain, Swaziland, Sweden
- Switz., Turkey, Ukraine
- U.K., Yugoslavia

6. What legal advantages for U.S. trademark owners are in the Madrid Protocol?

- One application at USPTO.
- One set of documents.
- One language.
- One fee.
- Expedited examination (18 months).
- One International registration.
- One renewal.

7. What cost advantages for U.S. trademark owners are in the Madrid Protocol?

- Official fees in filing.
- Official fees in recording assignments or changes of name.
- Attorney fees in time need to file international program.

8. What are the disadvantages of the Madrid Protocol system?

- Use as a supplemental system.
- Limited to basic application goods *and priority date.*
- Need local counsel if problems encountered.
- Need same owner worldwide.

9. Should I file directly or through the Madrid Protocol?

- For more extensive protection than USPTO, file directly.
- For quick filing with one priority date, *you may want Protocol.*
- For difficult countries with poor local agents, you may want Protocol.
- For different owners worldwide, may want direct filing.

10. When can U.S. trademark owners use the Madrid Protocol?

- United States may join in 2002.
- Can file trademark applications in the name of related companies domiciled in current Madrid Protocol countries.
- Can obtain USPTO registrations on important trademarks now in preparation for the Madrid Protocol.

TLT (1994) History

- **TRT (1970's; failed)**
- **TCT (1980's; failed)**
- **TLT (1990's: formal, procedural only)**

TLT "Maximum Requirements": Classification

- Multiclass
- *Nice (International) Classification*
- Prohibits overly broad wording of goods and services
- Classification has no substantive effect

TLT "Maximum Requirements": Powers of Attorney/Legalization

- One general power acceptable
- *Late filing permitted*
- No attestation, notarization, authentication, legalization (consularization), or other certification of documents required

TLT "Maximum Requirements": Term/Use/Types of Marks

- Ten (10) years
- Renewal cannot be conditioned on use
- Service mark and 3D mark registration required
- Collective/certification marks optional

TLT "Maximum Requirements": Assignments/Forms

- Assignment form simply signed by both parties
- No requirement to recite goodwill and/or business transfer
- TLT regs to create standard, global forms

Substantive Law Harmonization: the Famous Marks Case Study

- Paris Convention Article 6 bis
- INTA Resolution
- Paris Convention Aticle 10 bis
- NAFTA 1708
- EU Trademark Harmonization Directive (89/104/EEC) Art. 4
- Community Trademark Regulation (40/94) Art. 8
- Andean Community (New Section!)
- Mercosur
- African Union
- Pan American Convention

ICANN UDRP (1999)

UDRP Decisions Online

- www.dnlr.com
- http://cyber.law.harvard.edu/icann/search/udrp.asp
- http://arbiter.wipo.int/domains/decisions/index.html

ICANN UDRP October 24, 1999

- 1. Is UDRP applicable?
- 2. Policy
- 3. Rules
- 4. Supplemental Rules
- 5. Evidence

Which gTLDs and ccTLDs?

- .com
- .net
- .org
- .biz
- .info
- .ac (Ascension Is.)
- .ag (Antigua)
- .as (Am. Samoa)
- .bs (Bahamas)
- .cy (Cyprus)
- .fj (Fiji)
- .gt (Guatemala)
- .mx (Mexico)
- .na (Namibia)
- .nu (Niue)
- .pa (Panama)
- .ph (Philippines)
- .pn (Pitcairn Is.)
- .ro (Romania)
- .sh (St. Helena)
- .tt (Trinidad)
- .tv (Tuvalu)
- .ve (Venezuela)
- .ws (Western Samoa)

Selected UDRP Provisions

POLICY ¶ 2

YOUR REPRESENTATIONS

(a) Statements Accurate
(b) Non-infringement
(c) Not unlawful purpose
(d) Not use domain name in violation of regulations

POLICY ¶ 3

CANCELLATIONS, TRANSFERS, AND CHANGES

(a) Registrant's instructions
(b) Court's instructions
(c) Administrative Panel's instructions
(d) Comply with other dispute resolution

POLICY ¶ 4a

MANDATORY ADMINISTRATIVE PROCEEDING

1. Domain name identical or confusingly similar to trademark
2. Registrant has no legitimate rights
3. Domain name registered AND used in bad faith

POLICY ¶ 4b. EVIDENCE OF REGISTRATION AND USE IN BAD FAITH

1. Primarily for selling in excess of out of pocket expenses
2. Prevent trademark owner from reflecting mark in domain name
3. Primarily for purpose of disrupting competitor's business
4. Attempt to attract users to your website by creating likelihood of confusion

POLICY ¶ 4c. HOW TO DEMONSTRATE YOUR RIGHTS TO AND LEGITIMATE INTERESTS IN THE DOMAIN NAME IN RESPONDING TO A COMPLAINT.

1. Using or planning to use name in domain name or domain name in bona fide business
2. Commonly known by this name
3. Legitimate non-commercial or fair use of the name

POLICY ¶ 4e. INITIATION OF PROCEEDING AND PROCESS OF SELECTION OF ADMINISTRATIVE PANEL.

The Rules of Procedure state the process for initiating and conducting a proceeding and for selecting the panel that will decide the dispute (the "Administrative Panel").

POLICY ¶ 4k. AVAILABILITY OF COURT PROCEEDINGS

Either party may initiate legal proceedings. ICANN will wait 10 days after being informed of the Administrative Panel's decision before implementing the decision.

RULE 3 THE COMPLAINT

Guidelines.

RULE 4 NOTIFICATION OF COMPLAINT

Begins administrative proceeding.

RULE 5 THE RESPONSE

20 days to respond.

RULE 10 GENERAL POWER OF THE PANEL

1. Panel shall conduct proceeding as appropriate under Policy and Rules
2. Equal treatment of parties and opportunity to be heard (due process)
3. Move proceeding along expeditiously but may extend deadlines under exceptional circumstances
4. Shall decide admissability, relevance, materiality, and weight of evidence
5. Can consider multiple domain names issues

RULE 11 LANGUAGE OF PROCEEDINGS

Language of registration agreement unless specified otherwise

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RULE 12
FURTHER STATEMENTS

The Panel can request additional evidence from either of the parties.

RULE 13
IN-PERSON HEARINGS

No hearings unless the Panel decides so in its discretion and as an exceptional matter.

RULE 15
PANEL DECISIONS

Panel shall decide within 14 days from its appointment and render a written decision.

RULE 16
COMMUNICATION OF DECISION TO PARTIES

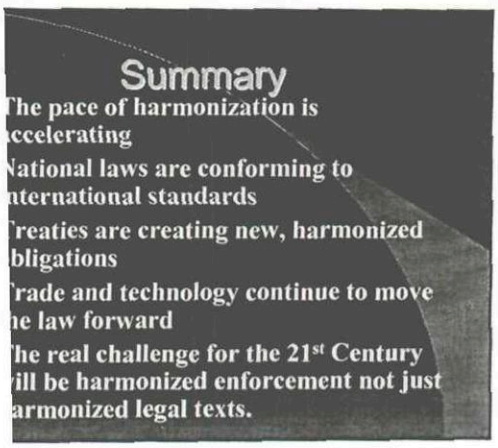
Within 3 days after the Provider receives decision, it shall notify parties.

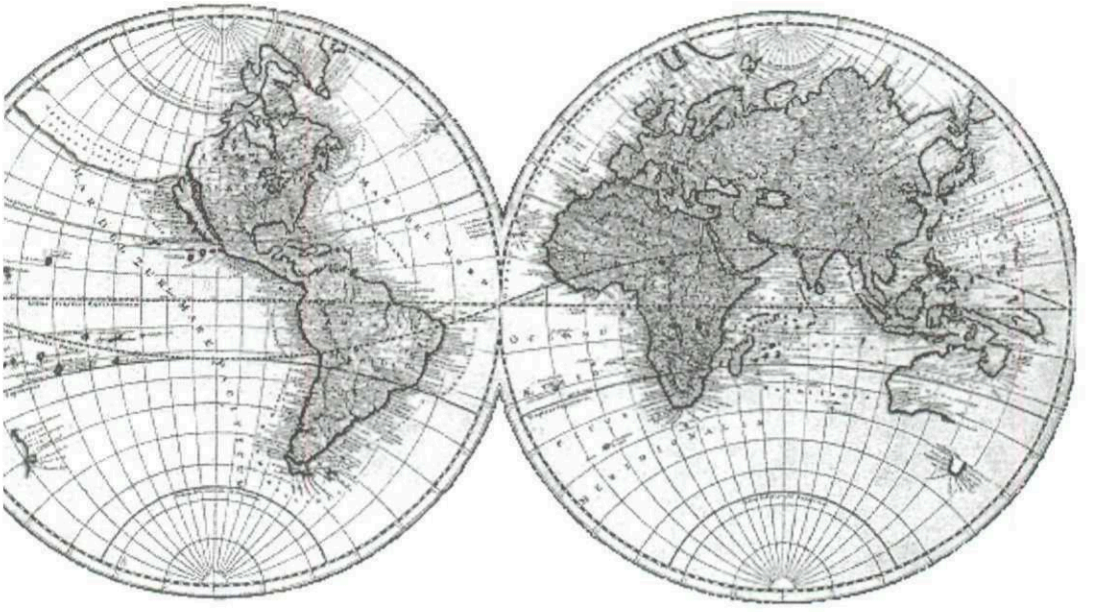
RULE 19
FEES

US$ 1500 for 1 person panel
US$ 3000 for 3 person panel

SUPPLEMENTAL RULE 10
WORD LIMITS

Complaint: 5000 words
Response: 5000 words
Decision: No Limit


Summary
The pace of harmonization is accelerating
National laws are conforming to international standards
Treaties are creating new, harmonized obligations
Trade and technology continue to move the law forward
The real challenge for the 21st Century will be harmonized enforcement not just harmonized legal texts.



Trademark Law Harmonization in the 21st Century: TRIPs and Beyond

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anklin Pierce Law Center Fall IP Forum 2001

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)DUCTION

We are now forming One World, the Global Village, the New World Order. We are united through CNN, WTO, faxes, jets, computers, the internet, and satellites. Most business people now speak English. Anyone es not think "globally", i.e., beyond our national borders, will be lost in the New Economy. Since intellectual y (IP) forms an integral part of the economy, IP assets are themselves being "globalized". As these assets are zed, IP law, and in particular, trademark law is also become globalized, or in other words, "harmonized".

The major engine behind global trademark harmonization is the World Trade Organization TRIPs ("Trade Aspects of Intellectual Property") Agreement of 1994, effective January 1, 1995. However, there are other it work today which will make the 21st Century a time of significant change for trademark law. In fact, the rademark law of 2101 will be quite different from its counterpart in 2001. These other forces are treaties and ogy-driven global institutions such as ICANN. Each of these issues needs to be examined separately.

WTO TRIPs Agreement

From Punta del Este, Uruguay in 1986 to Marrakesh, Morocco in 1994, the General Agreement on Tariffs de (GATT) has been seen intellectual property law experts as a new way to strengthen trademark rights. On 1, 1995, a new "World Trade Organization" (WTO), with expanded powers, replaced GATT.

The General Agreement on Tariffs and Trade was created in 1947. The WTO currently has over 130 rs accounting for approximately 90% of world merchandise trade and is based on several major economic es, the most important of which is the "most favored nation" (non-discrimination) principle. There are ons for the reduction of customs and duties restrictions, fair not free trade, and for national treatment of goods. GATT also incorporates a dispute resolution procedure. GATT views trademark counterfeiting and ual property irregularities as distortions of legitimate trade. Its solution, therefore, involves confronting the elated aspects of intellectual property" "(TRIPs)" in order to maintain a "level playing field." Added to the discussions, were two new GATT innovations, namely, trade in services and "TRIMs" ("trade-related ent measures").

Although GATT covers the complete spectrum of trade in goods (and now services) between contracting the three Articles that are of specific interest to the trademark experts are Article XX(d) concerning rks and Articles XII:3(c)(iii) and XVIII: Section B(10) which govern restriction of imports. A review of ovisions indicates that GATT deals with anti-counterfeiting and broad issues of protection of intellectual / rights in only a general and tangential manner.

GATT's involvement in anti-counterfeiting and intellectual property is essentially a political development. nally, the World Intellectual Property Organization (WIPO) had been considered the proper forum for ng intellectual property matters at the international level. WIPO currently administers such international ual property treaties as the Patent Cooperation Treaty, the Madrid Trademark Treaty and the Berne ht Convention, among many others. However, because of WIPO's perceived ineffectiveness in combatting eiting and the increased importance in the world of intellectual property as a "commodity", it was inevitable TT would become involved in seeking a solution to combatting counterfeiting and raising worldwide im standards" for intellectual property protection.

In the Tokyo GATT Round of the 1970's, and later in the early 1980's, it was seriously debated if GATT e the proper tool to help foster trademark rights. Slowly, efforts in creating a GATT "anti-counterfeiting ere replaced by work to create "minimum standards" for intellectual property protection. The pro-GATT reached fruition in the so-called Punta del Este Resolution of 1986, which states:

> "In order to reduce the distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade, the negotiations shall aim to clarify GATT provisions and elaborate as appropriate new rules and disciplines.
>
> Negotiations shall aim to develop a multilateral framework of principles, rules and disciplines dealing with international trade in counterfeit goods, taking into account work already undertaken in GATT.

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These negotiations shall be without prejudice to other complementary initiatives that may be taken in the World Intellectual Property Organization and elsewhere to deal with these matters".

After the TRIPs were placed on the GATT agenda, the Geneva Round of negotiations marked the first true ? GATT negotiators into the intellectual property forum. The negotiating plan established for the Geneva reaffirmed the Punta del Este Resolution. Of course, the TRIPs Agreement came within the authority of the TO.

The most significant difference, then, between the Paris Convention and the TRIPs Agreement is the ment mechanisms of WTO and the TRIPs Council which must monitor the implementation of TRIPs.

In most countries, the TRIPs Agreement is not self-executing, and thus it needs to be implemented into w. Part II of TRIPs, encompassing Articles 15 through 21, has had a profound impact of global trademark ls. The other major sections of TRIPs, Parts III-V, will seriously impact how trademark rights are enforced. ıbstantive article on trademark standards should be independently examined to determine its effects on ization.

15

ble Subject Matter

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking ose of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words g personal names, letters, numerals, figurative elements and combinations of colours as well as any ıtion of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of ishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired use. Members may require, as a condition of registration, that signs be visually perceptible.

Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other , provided that they do not derogate from the provisions of the Paris Convention (1967).

Members may make registrability depend on use. However, actual use of a trademark shall not be a n for filing an application for registration. An application shall not be refused solely on the ground that l use has not taken place before the expiry of a period of three years from the date of application.

The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle ration of the trademark.

Members shall publish each trademark either before it is registered or promptly after it is registered and ford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an nity for the registration of a trademark to be opposed.

nts on Article 15: These provisions may seem quite ordinary, but in fact they are radical for many parts of ld, particularly the developing world. Many commentators, for example, have stated that 15(4) imposes the on on countries to implement service mark registration.

16

Conferred

The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the consent from using in the course of trade identical or similar signs for goods or services which are identical ar to those in respect of which the trademark is registered where such use would result in a likelihood of on. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be ed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the ity of Members making rights available on the basis of use.

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

Article 6 *bis* of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are ır to those in respect of which a trademark is registered, provided that use of that trademark in relation to ds or services would indicate a connection between those goods or services and the owner of the registered : and provided that the interests of the owner of the registered trademark are likely to be damaged by such

s on Article 16: This article forms the heart of the trademark changes of TRIPs. Article 16(1) can be seen ling a "first in time, first in right" claim against geographical indications in TRIPs Articles 22-24. ', Article 16(2) extends famous mark protection to services, and perhaps most importantly, Article 16(3) the concept of famous mark dilution protection on a global basis.

7
ıs

may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive ɔvided that such exceptions take account of the legitimate interests of the owner of the trademark and of ies.

s on Article 17: This article extends the fair use concept to all WTO members.

8
Protection

;istration, and each renewal of registration, of a trademark shall be for a term of no less than seven years. tration of a trademark shall be renewable indefinitely.

s on Article 18: The effect of this Article has been to harmonize the length of trademark registrations , they were from five to twenty years). Most countries have now harmonized at ten years.

9
ıent of Use

If use is required to maintain a registration, the registration may be cancelled only after an uninterrupted ' at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are y the trademark owner. Circumstances arising independently of the will of the owner of the trademark ɔnstitute an obstacle to the use of the trademark, such as import restrictions on or other government ents for goods or services protected by the trademark, shall be recognized as valid reasons for non-use.

When subject to the control of its owner, use of a trademark by another person shall be recognized as use of nark for the purpose of maintaining the registration.

ts on Article 19: The prima facie abandonment term for non-use has been harmonized at three years or ıe U.S. is now at three years and most countries are at five years). Also, licensing regulations have been ue to Article 19(2).

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20
equirements

of a trademark in the course of trade shall not be unjustifiably encumbered by special requirements, such as ı another trademark, use in a special form or use in a manner detrimental to its capability to distinguish the ır services of one undertaking from those of other undertakings. This will not preclude a requirement ing the use of the trademark identifying the undertaking producing the goods or services along with, but linking it to, the trademark distinguishing the specific goods or services in question of that undertaking.

ıts on Article 20: This Article addresses the restrictions on trademark use which many countries have l, most importantly, the always threatened Mexican linking requirements (i.e., using a foreign trademark ɔcal trademark).

21
ıg and Assignment

's may determine conditions on the licensing and assignment of trademarks, it being understood that the ory licensing of trademarks shall not be permitted and that the owner of a registered trademark shall have to assign the trademark with or without the transfer of the business to which the trademark belongs.

ıts on Article 21: This Article is important since it abolishes compulsory licensing and the need to transfer of ıess (in French, the fonds de commerce, in German, the Geschaeftsbetrieb).

Apart from these substantive clauses, the procedural sections of the TRIPs Agreement (Parts III-V) are also ıt. Without entering into great detail, these provisions are very influential on how IP rights are understood ırced globally.

IES

Apart from the TRIPs Agreement, which is a treaty among the WTO member states, other treaties are the international trademark landscape, and will move trademark harmonization beyond TRIPs in the 21st The most influential treaties are the Madrid Agreement and Protocol, and the Trademark Law Treaty. eaties interact with trademark and we will focus on one specific topic, famous trademarks, with these other

Agreement and Protocol

The INTA has produced an excellent FAQ on the Madrid Protocol as follows:

1. What is the Madrid Protocol?
The Madrid Protocol of 1989 ("Protocol") was adopted in order to introduce new features into the system of the international registration of marks ("the Madrid Agreement"). The new features remove the difficulties that were preventing certain countries from adhering to the Madrid Agreement. The Protocol has been in force since April 1, 1996 and now has 54 members.

2. What are the differences between the Madrid Agreement and the Madrid Protocol?

As compared with the Madrid Agreement, the Protocol introduces the following main innovations:

(a) The applicant may base his application for international registration on a pending national application, rather than having to wait for a national registration.

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(b) Each national trademark office has eighteen months (or longer, in the case of oppositions) to notify the World Intellectual Property Organization ("WIPO") of objections to the international registration (rather than twelve months).

(c) Each national trademark office may receive higher fees than under the Madrid Agreement, thus applicants should expect to pay more for trademarks filed under the Protocol, but still considerably less than filing independent national applications.

(d) In the case of a rejection or cancellation of a national application, an international registration under the Protocol may be transformed into national applications, benefiting from the original filing date or priority date, within three months from the date of cancellation.

(e) Applications under the Protocol may be in either French or English, whereas the Madrid Agreement permits only French.

(f) It is also envisaged that the Office for Harmonization in the Internal Market (OHIM) will become a party to the Protocol, thus enabling international registrations to be based on Community Trade Mark applications, or to receive European Community protection through an international registration.

3. Who is entitled to apply?

Applicants that are nationals of Contracting States; applicants that have a real and effective industrial or commercial establishment in one of the Contracting States; and applicants that have a domicile in one of the Contracting States. The international application is filed at the International Bureau of WIPO through the office of origin of the basic application or registration

4. How long does it take to obtain registration?

The actual international registration can occur rather fast. However, the national registrations under the Protocol can take as long as eighteen months (and possibly longer). Once registered, international trademarks are valid for ten years.

ark Law Treaty

Procedurally, the TLT will harmonize and revolutionize trademark practice in the 21st Century. As the AQ states: The myriad requirements and formalities of the more than 200 trademark jurisdictions around the mpose horrendous costs in time, paper work and unnecessary fees for trademark owners. To address this ı, the World Intellectual Property Organization (WIPO), after five years of drafting and negotiations, deftly lelegates to a Diplomatic Conference in Geneva on October 27, 1994 to conclude the Trademark Law Treaty

The TLT's objective is to streamline Trademark Office procedures, thus enabling practitioners to focus on ection and defense of marks and not the currently unnecessary and almost endless paper work. TLT also costs. The treaty will accomplish these objectives by:

- setting a maximum list of requirements for trademark applications and registrations concerning such matters as filing dates, requests for name and address changes, assignments and renewals;
- standardizing forms for applications, powers of attorney, and changes of name, address and ownership;
- prohibiting requirements for notarization or other certification of any signature, except in the case of surrendering a trademark registration;
- prohibiting any requirement for certificates or extracts from a register of commerce;

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- making one request sufficient for changes of name, address or ownership for several registrations or applications;
- requiring the acceptance of general powers of attorney; and
- adopting the International Classification of Goods and Services.
- came into force on August 1, 1996 and has 26 members.

The wide diversity of Trademark Office requirements and procedures throughout the world re in ious paper work and costs to trademark owners. The Trademark Law Treaty would significantly streamlines rk protection by harmonizing requirements and simplifying administrative procedures. The TLT provisions nefit trademark owners by saving time and effort in the preparation and filing of trademark applications and s, in the execution and recordal of assignments and by the suppression of formal legalization of documents.

In the mid-1980s, the World Intellectual Property Organization, encouraged by various trademark owner ctitioner associations, recognized the need for harmonization of national trademark laws. This ambitious substantive trademark law harmonization was pursued during the first and second session of a Committee of on the Harmonization of Laws for the Protection of Marks, which took place at WIPO's Geneva ırters in December 1989 and June 1990. However, no further meetings were scheduled due to the inclusion lectual property in the Uruguay Round of negotiations of the General Agreement on Tariffs and Trade).

In 1991, WIPO submitted a new draft tentatively entitled Treaty on the Simplification of Administrative ıres Concerning Marks to a Committee of Experts in June 1992. The new approach of concentrating on ization of formalities was welcomed by the delegates from over 60 countries represented on the Committee, as nongovernmental organizations representing trademark owners and practitioners. Such formalities are stly and paper intensive, and would be easier to harmonize in the short term than substantive law. Moreover, eved that harmonization of formalities would facilitate harmonization of substantive matters in the future.

With the sixth and final meeting of the Committee of Experts in December 1993, the draft treaty, ons and standardized forms were greatly improved. While the vast majority of member states of the tee of Experts supported the provisions of the treaty, some Latin American members objected to eliminating ies such as legalization. In October 1994, the revised draft treaty, including regulations and standard forms, mitted to a Diplomatic Conference. There were very few objections to the substance of the treaty other than rovision allowing a vote for the European Union in addition to its member states. This was resolved by ing the provisions for a TLT Union and Assembly. On October 27, 1994, the draft was overwhelmingly d by the delegates with the name Trademark Law Treaty and signed by 36 countries. By the October 27, adline, 51 countries signed the treaty. The TLT came into force on August 1, 1996, following ratification by isite number of countries.

um Requirements

Only those requirements expressly permitted by the treaty (e.g., the number of copies of the mark, name of ıtative, declaration of intent to use) may be imposed for trademark applications, assignments, powers of , establishing a filing date, requests for changes of name and address or change in ownership and for s. These are "maximum" requirements. Trademark Offices may impose fewer requirements at their on, but not additional requirements.

fications

Multiple Class System

The Trademark Law Treaty requires national Trademark Offices to accept a single application covering one classes of the International Classification of Goods and Services, and to issue a single Certificate of ıtion covering one or more classes. This "multiclass" system saves trademark owners significant time and Rather than having separate files with separate correspondence and other documents concerning a single different classes, a single file and certificate of registration and other documents will suffice.

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The furnishing of a certificate of or extract from a Register of Commerce or Secretary of State may not be . Similarly, Chamber of Commerce certificates regarding the scope of a trademark owner's business and registration in the home country also would be eliminated.

ıl of Trademark Registrations

Ten-year Term

Several important, somewhat substantive provisions of the treaty regarding renewals will greatly simplify rk Office requirements around the world. The first is fixing initial and renewal periods for registrations at ;. This will eliminate costs to trademark owners resulting from shorter renewal periods and help remove od" or unused marks of no interest resulting from longer renewal periods. This also reflects a worldwide the ten-year term as evidenced in recent updated trademark laws in many countries and the European ıity Trade Mark Regulation.

No Examination or Proof of Use

Other significant provisions concerning renewals include the prohibition on Trademark Offices from re-ıg the trademark registration as to substance or requiring proof of use as a condition for renewal. Thus is greatly simplified by merely submitting a renewal application reciting the registration number. r, Trademark Offices may not make renewal dependent on the furnishing of proof of use.

Marks

The TLT Diplomatic Conference adopted several substantive provisions concerning service marks. ıng parties must register service marks and must apply the provisions of the treaty to service marks. r, the TLT removes a gap in the Paris Convention by providing that Convention's provisions regarding ks such as those relating to well-known marks are to be applied to service marks. Thus the TLT in effect he Paris Convention in this regard.

f Marks; Collective, Associated and Defensive Marks

The TLT applies to marks consisting of "visible signs." Three dimensional marks are included, but not ıs, sound marks or olfactory marks. Although service marks are covered by the TLT, the treaty does not collective or certification marks. When a country joins the TLT, it may "declare" that the treaty does not ıssociated or defensive marks.

'd Forms

The regulations to the TLT establish standard forms for requests for registration, renewal, change of name ıs, or change of ownership, or a power of attorney. Whenever such requests are presented in a manner as for in the treaty's regulations, they must be accepted by the Trademark Office.

ıents

In the case of assignments, the office cannot ask for any further evidence if the request for recordal (signed ɔlder or the new owner) is accompanied by an uncertified certificate of transfer or an uncertified transfer t drawn up in the form as prescribed in the TLT regulations and signed by both the holder and the new No country can require that a trademark assignment form recite whether the transfer is with or without . This administrative provision as to the content of assignment forms does not change substantive law on ;r. Moreover, trademark owners are free to add a recitation as to a goodwill transfer. National offices can re, however, such a recitation.

'd Changes in National Law

Some countries, especially in Latin America and the Middle East, will need to amend their national laws, rly in the area of notarization and legalization, to comply with the TLT. For most countries, however, the ɔrovisions are largely compatible with national law and thus only minor conforming amendments would be /.

To make the TLT acceptable to the greatest number of countries, a country when joining the treaty may : following reservations, which, depending on whether a country is considered "developing" or not, will ithin a certain number of years, but no later than the year 2004 -- ten years after the initial signing of the

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- Multiclass applications/registrations may not be accepted or divided.
- Separate powers of attorney may be required for each application or registration.
- Certification may be required for the signature on a power of attorney or application.
- Changes in name, address or ownership, or correction of a mistake may relate only to one application or registration.
- A declaration and/or evidence of use must be furnished on the occasion of a renewal.

eaties: ***Famous Trademarks***

There are many other treaties which will shape the future of trademark law in the 21st Century. However, not permit reviewing them all. Rather, I want to focus on one hot issue, famous trademarks, and determine e treaties interact with the same issue in different ways. What are famous trademarks and why do they nore protection than standard trademarks? How do treaties extend protection for famous trademarks? the limitations of these treaties? These are questions which have been extensively debated over the last nd today we will focus on the major issues in this debate.

TIONS

Our modern concept of the "famous" trademark finds its codification in Article 6 *bis* of the Paris on, where the French expression "notoirement connue", literally, "notoriously known", or in better English, own" is used. As the case law and statutory provisions have progressed in this century, we now have a lge of definitions which has created a significant challenge to the owner of a famous trademark. Although I review treaty definitions today, case law has ranged from the words "famous" to "highly reputed" to nown" to "well-known", among other definitions.

To make sense of these definitions is virtually impossible, since judges are apt to make up a new term as new decision is rendered on the subject. What the case law has confronted is the scope of protection for a , and when it should be extended beyond the standard trademark/goods limitation, the so-called "principle ity" set forth in the famous Ritz Hotel French Supreme Court case (Charles of the Ritz Group Ltd. v. Ritz oldings Ltd., Cour de Cassation, Chambre Commerciale, Pourvoi N# 84-13.615, Arret N# 388, May 27, that case, the question was asked when protection for the word RITZ should extend beyond hotels to other l services, i.e., beyond the "special" hotel services for which it is known. As a general principle, the more vn a trademark, the wider scope of protection it is afforded due to an increased likelihood of confusion as or sponsorship (particularly in today's climate of licensing and merchandising well-known luxury marks as haracters). Accordingly, well-known marks have a wider scope of protection than standard trademarks heir expanded reputation creates more likelihood of confusion as to origin as well as sponsorship. Beyond l of confusion problem, certain jurisdictions have added a dilution concept, which is more akin to a right than the likelihood of confusion public injury theory. In view of these theories, we can attempt to ll marks which have a reputation beyond the ordinary as "well-known". A special class of "well-known" rther can be classified as having extra protection beyond that for identical or similar goods. Such s generally are known as "famous" trademarks which would be entitled to dilution protection.

Just when we feel satisfied that we understand that "famous" marks are extremely "well-known" marks, ernational bodies create more confusion. The European Union Trademark Harmonization Directive EC), which harmonized basic elements of the European Union member countries' law, creates protection which have a "reputation" (Article 4(3)). These "reputation marks" are protected in the United Kingdom tion against infringement by similar and dissimilar goods (Section 10(3)) whereas "well-known marks" are ected against infringement for identical and similar goods (Section 56). Moreover, the World Trade ion Trade Related Aspects of Intellectual Property Agreement ("TRIPs Agreement") (1994), which we ss shortly, permits protection of "well-known" marks against dissimilar goods, further confusing the issue Australia in its new trademark statute). Moreover, local statutes may use words such as "well-known", , etc. in contradictory ways, making it important to carefully analyze what the word means in a particular

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Beyond the issue of the definition of a well-known trademark, the question arises as to whether service
ır trade names (corporate names) are also protected internationally under the definition of a well-known
ark". The answer is "no". Usually, most international treaties protect well-known trademarks in the
ıal sense, i.e., marks used on goods. This is probably due to the Paris Convention, which only protects well-
narks for goods. Trade names, although protected theoretically under Article 8 of the Paris Convention, are
:ected under the well-known mark concept. The WTO TRIPs Agreement extended well-known mark
ɔn to service marks (Article 16(2)), but the issue of well-known trade names is left open, presumably to local
:ation.

For our purposes, therefore, the best international standard expression is still "well-known", found in the
ɔnvention. Beyond that, the word "famous" as a type of "well-known" mark has gained acceptance.
ly, new treaties such as the TRIPs Agreement will speed harmonization of protection of well-known
rks. However, I would be very careful how the particular term describing the "famous" mark is used. Let us
:us on the specific treaties which give protection for well-known trademarks, beginning with the most
ıt, the Paris Convention.

DWIDE TREATIES: PARIS CONVENTION (1883)

DUCTION

As you know, the most influential international convention on the question of patents and trademarks is the
l Paris Convention (International Convention for the Protection of Industrial Property (Stockholm text), July
', 21 U.S.T. 1583, 24 U.S.T. 2140). In theory, the Paris Convention contains enforceable provisions for the
ɔn of intellectual property. In practice, it is useful and enforceable only after having been incorporated into
v. Dr. Frederick Mostert, a former President of INTA, has eloquently characterized the Paris Convention as
gentium" or "law of nations" of intellectual property concepts in his excellent article in The Trademark
· ("Well-Known and Famous Marks: Is Harmony Possible in the Global Village?" 89 TMR 103 (1996)). I
Paris Convention a set of core values, principles and goals which create the "International Ten
ıdments" on the subject. Unfortunately, the Paris Convention, although relatively uncontroversial, is still
ersally accepted. Perhaps one of the more widespread stated excuses for not joining the Paris Convention is
ill burden developing countries by making intellectual property "cost more". In any event, most important
s are members.

As is the situation with all treaties, the Paris Convention is not self-executing in most countries.
ıgly, if a particular country is a signatory to the treaty, the provisions will need to be implemented by
ɔn. Traditionally, most countries, including the United States, have taken a "minimalist" approach, i.e.,
: the minimum changes we need to make to implement a new treaty. In the United States, the major
e of the Paris Convention can be found in Lanham Act Section 43 on unfair competition and Lanham Act
44 on foreign applicant filings without proof of use before registration.

LE 6 *BIS*

Given this background, let us now examine what the Paris Convention states about well-known marks. The protection for well-known marks is found in Paris Convention Article 6 *bis*, which states:

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

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

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(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith."

gh the language of this article has been extensively analyzed through the years, the key words in the article ell-known in that country", i.e., the trademark must be not just well-known internationally but well-known in ticular country with the exception of Argentina and Brazil. Very importantly, the article does not state that rk be "used" in that country. Accordingly, from a theoretical point of view, Article 6 *bis* should protect arks which are well-known in a particular country without use. Unfortunately, this interpretation of Article 6 not been widely accepted. Instead, countries have accepted the old British line of cases from *Crazy Horse* lin v. Pavilion Properties [1967] RPC 581) to *Budweiser* (Anheuser-Busch Inc. v. Budejovicky Budvar NP FSR 413. In those cases, the maxim "no local business, no local goodwill" has been emphasized since the onvention protections for well-known marks were placed within old common law passing off concepts. In ases, passing off would only be shown if local goodwill were harmed and local goodwill could only be shown local use. Accordingly, although the "floor" of international protection for well-known trademarks is set the Paris Convention, the lack of protection for well-known trademarks due to local additional restrictions red the basic flaw in this treaty, namely, that it has no "teeth" and is subject to wide ranges of interpretation ing on who is reading it. As such, interpreting the Paris Convention is akin to interpreting the acements of the Oracle of Delphi.

Since owners of well-known trademarks have been injured by these additional restrictions, INTA decided action by adopting a Board of Directors Resolution on September 18, 1996 on the issue of whether tion and local use was required. The Resolution states:

"ACTION REQUESTED: The Issues and Policy Committee requests that the Board of Directors approve a on: (1) encouraging all countries to protect 'well-known' trademarks and service marks (collectively) on the basis of reputation alone without requiring registration and/or actual use in the form of sales of r services bearing the marks in that particular jurisdiction; and (2) recommending factors to be considered in ning whether or not marks are 'well-known'.

WHEREAS, lack of consistency in protection of "well-known" marks, including imposition of use nents within a particular jurisdiction, fosters public deception and commercial dishonesty, as well as poses ward risk that a company will be precluded from doing business under its own mark in a jurisdiction y because the strength of its reputation has led to a pirating of its mark; and

WHEREAS, despite international convention and multilateral treaty provisions, many countries do not sufficient protection to well-known marks; and

WHEREAS, many countries apply different and conflicting criteria for determining what constitutes a own mark;

BE IT RESOLVED, that the International Trademark Association endorses protection of well-known without requiring registration and/or actual use in the form of sales of goods or services bearing the mark in diction in question if such mark has sufficient local reputation to be considered 'well-known'.

BE IT FURTHER RESOLVED, that the International Trademark Association endorses consideration of the ng factors as criteria for establishing a 'well-known' mark:

(a) The amount of local or worldwide recognition of the mark;

(b) The degree of inherent or acquired distinctiveness of the mark;

(c) The local or worldwide duration of use and advertising of the mark;

(d) The local or worldwide commercial value attributed to the mark;

(e) The local or worldwide geographical scope of the use and advertising of the mark;

(f) The local or worldwide quality image that the mark has acquired;

(g) The local or worldwide exclusivity of use and registration attained by the mark and the presence or absence of identical or similar third party marks validly registered for or used locally on identical or similar goods and services".

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lingly, it is hoped that local authorities will begin to move in the direction of the Healthy Choice case in lia (ConAgra Inc. v. McCain Foods (Aust) Pty. Ltd. 23 IPR 193, (New South Wales District Court, 1993) and Donald's case in South Africa (Case. No. 547/95, Supreme Court of South Africa, August 27, 1996), i.e., ıe the international fame of the mark and the extent of reputation locally, with less emphasis on local use.

Beyond the question of whether the trademark must be in use, we should examine the related issues of the ɔf protection of Article 6 *bis*. Article 6 *bis* only protects a well-known trademark for the "identical or similar . Accordingly, Article 6 *bis* is not a dilution (dissimilar goods) article. At its essence, Article 6 *bis* addresses ıe of whether trademark rights arise out of reputation whether or not a trademark is used and/or registered. If l-known trademark is registered, presumably the well-known trademark owner can use the registration to halt ıcy. The problem which Article 6 *bis* addresses, therefore, is the situation where a pirate has used and/or ed the legitimate owner's trademark before the well-known trademark has been used or registered in a ar jurisdiction. Moreover, protection focuses on cancelling a registration, opposing an application or ıg use. Damages and other remedies are generally not available. Article 6 *bis* is even more relevant than was created in 1926, since today we have the technological capabilities for reputation to precede use and/or tion as never before. It is unlikely that the delegates in The Hague seventy years ago foresaw global satellite ;, worldwide computer networks or routine jet travel.

However relevant it is today, Article 6 *bis* does not protect service marks or famous marks from dilution re innovations of the WTO TRIPs Agreement discussed later). Moreover, it is not self-executing (the United m adapted enabling legislation in 1994), and is unnecessarily burdened with local use requirements.

Our final question for Article 6 *bis* is to whom must the trademark be "well-known". As in other key :s, the Paris Convention is silent. The usual interpretation of the person(s) who must know the trademark are vant potential purchasers of the particular goods, not the public at large (which is of course harder to prove). 'RIPs Agreement Article 16(2) codifies this general perception in what it calls the "relevant sector of the

As was noted earlier, Article 6 *bis* extends trademark rights to marks which have not yet been used or ɔd, if they have the requisite "reputation". Accordingly, the owner of the well-known trademark must prove ıood of confusion with its marks, or as Article 6 *bis* states, that the "trademark constitutes a reproduction, n or translation liable to create confusion with a mark considered by the competent authority of the country tration or use to be well-known in that country". Since Article 6 *bis* is not a dilution statute, blurring, ıent, injury to reputation, unjust enrichment, free-riding, and other dilution theories are not essential to its

Accordingly, Article 6 *bis* creates an international floor of protection for well-known trademarks against ɔgistration on identical or similar goods from trademarks which are reproductions, imitations or translations. ve leave the Paris Convention, we should look at one more article, namely, Article 10 *bis*.

LE 10 *BIS*

Since many famous mark cases involve unregistered trademarks, particularly for dissimilar goods, we focus on another form of protection, namely, unfair competition and its Paris Convention embodiment, 10 *bis*.

Article 10 *bis* states:

"(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited:

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;

2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;

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3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods."

We should not forget that additional protection is given to famous trademarks through general concepts of ompetition, particularly dilution. Of course, one serious limitation of unfair competition is the requirement parties be in competition, which is not true in most cases of piracy. Although the Paris Convention, as tered by The World Intellectual Property Organization (WIPO), created the international legal framework protection of well-known trademarks, it would take the TRIPs Agreement, through the rival World Trade ation (WTO), to enforce the law. Rather than seeing the end of potentially irrelevant Articles 6 *bis* and 10 O has brought new vitality to these provisions.

NAL TREATIES: NAFTA (1992)

Perhaps the most widely-known regional treaty to protect well-known trademarks is the North American ıde Agreement (NAFTA), a treaty based on the TRIPs principles and, in many cases, actual text.
The relevant NAFTA section is Article 1708(6), which states that:
"Article 6 *bis* of the Paris Convention shall apply, with such modifications as are necessary, to services. In determining whether a trademark is well-known, account shall be taken of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Party's territory obtained as a result of the promotion of the trademark. No Party may require that the reputation of the trademark extend beyond the sector of the public that normally deals with the relevant goods or services."

A careful reading of NAFTA Article 1708(6) indicates that it is very similar to TRIPs Article 16(2), with tional restriction that the country cannot require that the trademark reputation extend beyond the relevant Although NAFTA has been overshadowed by WTO TRIPs (even though WTO TRIPs generally has less ɔn), it should not be underestimated, particularly because NAFTA principles are being considered for the the new Free Trade Area of the Americas (FTAA), i.e. the new Western Hemisphere Economic Community ed for 2005. NAFTA Article 1708(6) also extends the Paris Convention to services and discusses the ge by the relevant sector of the public, including promotion considerations. Since NAFTA protection is hought of as stronger than TRIPs protection, NAFTA protection of well-known trademarks can be seen as enting TRIPs protection, not duplicating it.
In one important aspect, however, NAFTA protection is less than TRIPs protection, namely, protection of ɔwn (famous) marks for dissimilar goods. NAFTA does not provide any equivalent provision for TRIPs 6(3), and thus does not address the dilution issue at all. Accordingly, NAFTA is seen as one more layer of otection for well-known trademarks, even through protection from the treaty must come from implementing ɔn, not the treaty per se.

NAL TREATIES: EUROPEAN HARMONIZATION DIRECTIVE (1989) AND EUROPEAN UNITY TRADEMARK (1994)

The increased pace of harmonization brought about by treaties has been exemplified by developments in ɔpean Union. Two important innovations on the well-known trademark issue are the European Trademark ization Directive (89/104/EEC) and the Community Trademark Regulation (40/94).
The European Union, formerly the European Community (or Communities), had the task of harmonizing ɛmark laws of the then ten trademark jurisdictions, now thirteen. In defining an "earlier trade mark" which flict with a new trade mark application or registration (Article 4 (1)), Article 4(2)(d) of the Directive states

"Trade marks which, on the date of application for registration of the trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the trade mark, are well known in a Member State, in the sense in which the words 'well known' are used in Article 6 *bis* of the Paris Convention".

Additionally, Articles 4(3) and 4(4)(a) discussed a new "animal", marks of "reputation", as follows:
"Article 3. A trade mark shall furthermore not be registered or, if registered, shall be liable to be declared invalid if it is identical with, or similar to, an earlier Community trade mark within the meaning of

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paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier Community trade mark is registered, where the earlier Community trade mark has a reputation in the Community and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trade mark.

Article 4. Any Member State, may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

(a) the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;"

, Article 5(2) states:

"Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar o, the trademark in relation to goods or services which are not similar to those for which the trade mark is egistered, where the latter has a reputation in the Member State and where use of that sign without due ause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade nark."

ated previously at least in the United Kingdom interpretation, "reputation" marks are entitled to dilution whereas "well-known" marks are not, although "reputation" marks must be registered.

Moreover, this Directive formed the basis of several of the Community Trademark provisions in the n, the most important being defining "earlier trade mark" which will conflict with a new trade mark or registrant (Article 8 (1)):

1. Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered:

(a) if it is identical with the earlier trade mark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trade mark is protected;

(b) if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes likelihood of association with the earlier trade mark."

Article 8(2)(c): "Trade marks which, on the date of application for registration of the Community rade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the Community trade mark, are well known in a Member State, in the sense in which the words 'well known' re used in Article 6 *bis* of the Paris Convention."

lly, Article 8(5) states:

"Furthermore, upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with or similar to the arlier trade mark and is to be registered for goods or services which are not similar to those for which the arlier trade mark is registered, where in the case of an earlier Community trade mark the trade mark has a eputation in the Community and, in the case of an earlier national trade mark, the trade mark has a eputation in the Member State concerned and where the use without due cause of the trade mark applied or would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier rade mark."

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er: Article 9 (1) (c) states:

"1. A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:...

(c) any sign which is identical with or similar to the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the latter has a reputation in the Community and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark."

Accordingly, in the multilateral European situation, we need to examine both "well-known" trademarks : to Article 6 *bis* of the Paris Convention and "reputation" ("famous") trademarks under the European ization Directive and Community Trademark (CTM). In both instances, the European courts and Office of ization of the Internal Market (OHIM), i.e., the Community Trademark Office, must begin to create their sprudence on how these legal terms will be applied in the EU context.

NAL TREATIES: ANDEAN PACT (1969)

The established South American trading bloc, the Andean Pact (Pacto Andino), comprised of Bolivia, a, Ecuador, Peru and Venezuela, has important provisions on well-known trademarks which should be l, specifically, Articles 83-85 of Decision 344 of the Cartagena Agreement (1993) are significant:

"Article 83. In addition, those signs that, in relation to the right of third parties, exhibit any of the following impediments, may not be registered as marks:...

(e) They are similar, to the point of causing confusion, to a well-known mark, regardless of the class of goods or services for which registration is requested.

This provision shall not apply when the applicant is the legitimate holder of the well-known mark.

Article 84. To determine whether a mark is well-known, the following criteria, among others, shall be taken into account:

(a) The extent to which it is known among the consumer public as a distinctive sign of the goods or services for which it was granted;

(b) The degree and the range of dissemination and of publicity or promotion of the mark;

(c) The age of the mark and its continuous use;

(d) An analysis of the production and marketing of those products distinguished by the mark.

Article 85. In order to facilitate the protection of well-known marks, the appropriate national offices shall establish a suitable notification and reporting system."

Our review of these provisions will indicate that there is a need to prove that the offending mark "causes n", but that the protection for the well-known trademark is not limited to any particular goods or services in tration context. Additionally, Article 84 sets forth certain criteria for determining when a mark is well- he most unusual of which is the analysis of the products and marketing of those products distinguished by . Finally, Article 85 focuses on setting up an appropriate information and reporting system.

The emphasis of the Andean Pact treaty is on denying registration of pirated marks, but the owner of a wn trademark will still need a registration on its well-known mark to stop offending use. Without such on, it will not be possible to intervene until a registration has been obtained.

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AL TREATIES: MERCOSUR (1991)

n addition to the Andean Pact, a new South American trading area has emerged, namely, Mercosur Comun del Sur— Southern Common Market), established with five countries in Southern South America, Argentina, Brazil, Chile (joining), Paraguay and Uruguay. As is the case in many trading areas, for he European Union, harmonized intellectual property rights follow a harmonized market. In the case of the relevant provisions of the Intellectual Property Rights Protocol are:

"Article 9. Non-registrable trademarks...

4) The member countries will prohibit in particular the registration of a sign which imitates or reproduces totally or partially, a trademark that the applicant evidently could not claim ignorance of, as belonging to an owner established or domiciled in any of the member countries and susceptible of causing confusion or association.

5) Article 6 *bis* of the Paris Convention for the Protection of the Industrial Property will be applied mutatis mutandis to services. To determine the notoriety of the trademark for the purpose of such rule, it will be taken into account the knowledge of the sign in the pertinent sector of the market including the knowledge in each member country, in which the protection is claimed, acquired by the effect of the publicity of the sign.

6) The member countries will provide in their territories protection to trademarks of nationals of other member countries, which have acquired a degree of exceptional reputation, against their reproduction or imitation, in any line of business, as long as there is a possibility of damage."

he Mercosur provisions parallel the TRIPs provisions, and thus should be understood in this context. unlike the Andean Pact countries, the Mercosur countries, particularly Argentina and Brazil, have a long f protecting well-known trademarks and presumably the national protection will supplement any Mercosur

AL TREATIES: AFRICAN UNION (1962/1977)

he so-called African Union, Organisation Africaine de la Propriété Intellectuelle (OAPI), covering Benin, aso, Cameroon, Central African Republic, Chad, Congo, Djibouti, Gabon, Guinea, Ivory Coast, Mali, ı, Niger, Senegal and Togo, is governed by the Bangui Agreement (1977), the successor to the Libreville t (1962). The Bangui Agreement has one specific well-known mark provision, namely, Article 8, Annex rticle states:

The owner of a well-known mark within the meaning of Article 6 bis of the Paris Convention for the rotection of Industrial Property may claim the annulment, on the national territory of one of the member tates, of the effects of the filing of a mark liable to create confusion with his own. Such action may not be ıken after the expiration of a period of five years from the date of application, where the latter was made in ood faith."

ly, the African Union treaty protection links into the Paris Convention definition of a well-known mark, ar limitations.

AL TREATIES: PAN AMERICAN CONVENTION (1929)

lthough this treaty is often ignored by trademark practitioners, it may be helpful in certain circumstances. ıle, Article 7 states:

Any owner of a mark protected in one of the Contracting States in accordance with its domestic law, who ıay know that some other person is using or applying to register or deposit an interfering mark in any other f the Contracting States, shall have the right to oppose such use, registration or deposit and shall have the ght to employ all legal means, procedure or recourse provided in the country in which such interfering ıark is being used or where its registration or deposit is being sought, and upon proof that the person who using such mark or applying to register or deposit it, had knowledge of the existence and continuous use

any of the Contracting States of the mark on which opposition is based upon goods of the same class, the ›poser may claim for himself the preferential right to use such mark in the country where the opposition is ade or priority to register or deposit it in such country, upon compliance with the requirements tablished by the domestic legislation in such country and by this Convention."

›ion is not a "well-known" mark article per se, but it does focus on prior rights based on knowledge of the This article may be interpreted as a bad faith provision, which is not a usual criteria for well-known ction, but may be helpful in certain circumstances.

:AL TREATIES

ı addition to multilateral treaties concerning trademarks, countries such as the United States have ı initiatives to protect intellectual property on a bilateral basis. The United States has been quite in having these treaties executed with its trading partners, some of whom are not members of any other he WTO. A standard provision in the U.S. concerning well-known marks in Article 7(4)(d) of the ›greement is:

Each Party shall refuse to register or shall cancel the registration and prohibit use of a trademark likely to ause confusion with a trademark of another which is considered to be well-known. In determining hether a trademark is well-known, account shall be taken of knowledge of the trademark in the relevant ector of the public, including knowledge in that Party obtained as a result of the trademark's promotion. A arty shall not require that the reputation of the trademark extend beyond the sector of the public which ormally deals with the relevant goods or services."

›s another example, the China-U.S. Intellectual Property Agreement of 1995 obligated China to protect n trademarks. Pursuant to the Agreement, the Chinese State Administration for Industry and Commerce ed the "Provisional Regulation on the Confirmation and Administration of Well-Known Trademarks" on 4, 1996. This regulation provides an official recognition mechanism for well-known trademarks, although pretations of the Provisional Regulation indicate that the claimed well-known mark must be registered in ich is not required in Paris Convention Article 6 *bis*). However, official recognition of the well-known ı trademark will provide protection against dissimilar goods (Article 8).

The foregoing has shown that well-known trademarks are protected within the framework of many treaties, important being the Paris Convention and TRIPs. Essentially, well-known trademarks are protected if ıfficient local reputation, although countries do not require actual use in some cases. The trend is for more ı due to TRIPs, but TRIPs will still take many more years to fully implement in the developed world, and ;er in the developing world where long phase-in periods are permitted under TRIPs.

From the foregoing analysis concerning famous trademarks, which can also be analyzed for other issues olor trademarks, service marks, and others, that treaties, whether self-executing or not, will play a major e new century.

New Technologies

Perhaps the most startling developments have come with new technologies such as the internet. Since ce has no borders, a new type of global arbitration on domain names, the Uniform Dispute Resolution JDRP) of 1999, has created a truly global trademark "common law".

What is the **UDRP**? It is a global set of rules for determining domain name disputes.

Uniform Domain Name Dispute Resolution Policy

(As Approved by ICANN on October 24, 1999)

›se. This Uniform Domain Name Dispute Resolution Policy (the "Policy") has been adopted by the Internet ›ion for Assigned Names and Numbers ("ICANN"), is incorporated by reference into your Registration ›nt, and sets forth the terms and conditions in connection with a dispute between you and any party other the registrar) over the registration and use of an Internet domain name registered by you. Proceedings under ›h 4 of this Policy will be conducted according to the Rules for Uniform Domain Name Dispute Resolution he "Rules of Procedure"), which are available at www.icann.org/udrp/udrp-rules-24oct99.htm, and the administrative-dispute-resolution service provider's supplemental rules.

Representations. By applying to register a domain name, or by asking us to maintain or renew a domain gistration, you hereby represent and warrant to us that (a) the statements that you made in your Registration ent are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe

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· otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful ;; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is sponsibility to determine whether your domain name registration infringes or violates someone else's rights.

:ellations, Transfers, and Changes. We will cancel, transfer or otherwise make changes to domain name tions under the following circumstances:

subject to the provisions of Paragraph 8, our receipt of written or appropriate electronic instructions from 1 or your authorized agent to take such action;

)ur receipt of an order from a court or arbitral tribunal, in each case of competent jurisdiction, requiring :h action; and/or

)ur receipt of a decision of an Administrative Panel requiring such action in any administrative ıceeding to which you were a party and which was conducted under this Policy or a later version of this licy adopted by ICANN. (See Paragraph 4(i) and (k) below.)

/ also cancel, transfer or otherwise make changes to a domain name registration in accordance with the terms Registration Agreement or other legal requirements.

datory Administrative Proceeding.

ragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative ling. These proceedings will be conducted before one of the administrative-dispute-resolution service rs listed at www.icann.org/udrp/approved-providers.htm (each, a "Provider").

Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event t a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of ıcedure, that

(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith.

he administrative proceeding, the complainant must prove that each of these three elements are present.

Evidence of Registration and Use in Bad Faith. For the purposes of Paragraph 4(a)(iii), the following :umstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of registration and use of a domain name in bad faith:

(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

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How to Demonstrate Your Rights to and Legitimate Interests in the Domain Name in Responding a Complaint. When you receive a complaint, you should refer to Paragraph 5 of the Rules of Procedure determining how your response should be prepared. Any of the following circumstances, in particular without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, ll demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Selection of Provider. The complainant shall select the Provider from among those approved by ANN by submitting the complaint to that Provider. The selected Provider will administer the proceeding, ept in cases of consolidation as described in Paragraph 4(f).

nitiation of Proceeding and Process and Appointment of Administrative Panel. The Rules of cedure state the process for initiating and conducting a proceeding and for appointing the panel that will ide the dispute (the "Administrative Panel").

Consolidation. *In the event of multiple disputes between you and a complainant, either you or the* mplainant may petition to consolidate the disputes before a single Administrative Panel. This petition ll be made to the first Administrative Panel appointed to hear a pending dispute between the parties. s Administrative Panel may consolidate before it any or all such disputes in its sole discretion, provided the disputes being consolidated are governed by this Policy or a later version of this Policy adopted by ANN.

Fees. All fees charged by a Provider in connection with any dispute before an Administrative Panel suant to this Policy shall be paid by the complainant, except in cases where you elect to expand the ministrative Panel from one to three panelists as provided in Paragraph 5(b)(iv) of the Rules of cedure, in which case all fees will be split evenly by you and the complainant.

Our Involvement in Administrative Proceedings. We do not, and will not, participate in the inistration or conduct of any proceeding before an Administrative Panel. In addition, we will not be ble as a result of any decisions rendered by the Administrative Panel.

Remedies. The remedies available to a complainant pursuant to any proceeding before an Administrative el shall be limited to requiring the cancellation of your domain name or the transfer of your domain ne registration to the complainant.

Notification and Publication. The Provider shall notify us of any decision made by an Administrative el with respect to a domain name you have registered with us. All decisions under this Policy will be blished in full over the Internet, except when an Administrative Panel determines in an exceptional case edact portions of its decision.

Availability of Court Proceedings. The mandatory administrative proceeding requirements set forth in agraph 4 shall not prevent either you or the complainant from submitting the dispute to a court of mpetent jurisdiction for independent resolution before such mandatory administrative proceeding is mmenced or after such proceeding is concluded. If an Administrative Panel decides that your domain ne registration should be canceled or transferred, we will wait ten (10) business days (as observed in the ation of our principal office) after we are informed by the applicable Provider of the Administrative el's decision before implementing that decision. We will then implement the decision unless we have

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eived from you during that ten (10) business day period official documentation (such as a copy of a nplaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the nplainant in a jurisdiction to which the complainant has submitted under Paragraph 3(b)(xiii) of the les of Procedure. (In general, that jurisdiction is either the location of our principal office or of your lress as shown in our Whois database. See Paragraphs 1 and 3(b)(xiii) of the Rules of Procedure for ails.) If we receive such documentation within the ten (10) business day period, we will not implement Administrative Panel's decision, and we will take no further action, until we receive (i) evidence isfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has :n dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or lering that you do not have the right to continue to use your domain name.

)ther Disputes and Litigation. All other disputes between you and any party other than us regarding your name registration that are not brought pursuant to the mandatory administrative proceeding provisions of ph 4 shall be resolved between you and such other party through any court, arbitration or other proceeding y be available.

Involvement in Disputes. We will not participate in any way in any dispute between you and any party an us regarding the registration and use of your domain name. You shall not name us as a party or otherwise us in any such proceeding. In the event that we are named as a party in any such proceeding, we reserve the raise any and all defenses deemed appropriate, and to take any other action necessary to defend ourselves.

ıtaining the Status Quo. We will not cancel, transfer, activate, deactivate, or otherwise change the status of nain name registration under this Policy except as provided in Paragraph 3 above.

sfers During a Dispute.

Transfers of a Domain Name to a New Holder. You may not transfer your domain name registration ınother holder (i) during a pending administrative proceeding brought pursuant to Paragraph 4 or for a iod of fifteen (15) business days (as observed in the location of our principal place of business) after h proceeding is concluded; or (ii) during a pending court proceeding or arbitration commenced arding your domain name unless the party to whom the domain name registration is being transferred ees, in writing, to be bound by the decision of the court or arbitrator. We reserve the right to cancel any ısfer of a domain name registration to another holder that is made in violation of this subparagraph.

Changing Registrars. You may not transfer your domain name registration to another registrar during a ıding administrative proceeding brought pursuant to Paragraph 4 or for a period of fifteen (15) business 's (as observed in the location of our principal place of business) after such proceeding is concluded. ıu may transfer administration of your domain name registration to another registrar during a pending ırt action or arbitration, provided that the domain name you have registered with us shall continue to be ject to the proceedings commenced against you in accordance with the terms of this Policy. In the event t you transfer a domain name registration to us during the pendency of a court action or arbitration, such ɔute shall remain subject to the domain name dispute policy of the registrar from which the domain ne registration was transferred.

y Modifications. We reserve the right to modify this Policy at any time with the permission of ICANN. We :t our revised Policy at <URL> at least thirty (30) calendar days before it becomes effective. Unless this ıas already been invoked by the submission of a complaint to a Provider, in which event the version of the n effect at the time it was invoked will apply to you until the dispute is over, all such changes will be binding ɔu with respect to any domain name registration dispute, whether the dispute arose before, on or after the e date of our change. In the event that you object to a change in this Policy, your sole remedy is to cancel main name registration with us, provided that you will not be entitled to a refund of any fees you paid to us. ised Policy will apply to you until you cancel your domain name registration.

As a WIPO arbitrator, called "panelist", I have written many decisions which are enforced by ICANN. ;lobal technologies which affect trademarks, which require global solutions, are probably in progress. ;h we still live in a world which takes the "territorial" approach to trademark law, this might not be the ı in 2101.

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rademark law harmonization, on a global basis, is just beginning to gain momentum. New TRIPs which are being implemented into national legislation, new treaties such as the TLT or Madrid Protocol gaining signatories, or new global legal solutions for new technologies, such as the ICANN UDRP, are of the iceberg. National law, for the near future, will remain the primary source of trademark rights, but nal laws will be more harmonized yielding predictability and level playing field internationally. Once the tion is completed, we may decide to take the next step and create a truly supranational law on trademarks. nent, however, harmonization is a sufficient challenge for all of us.

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