



**iam**®

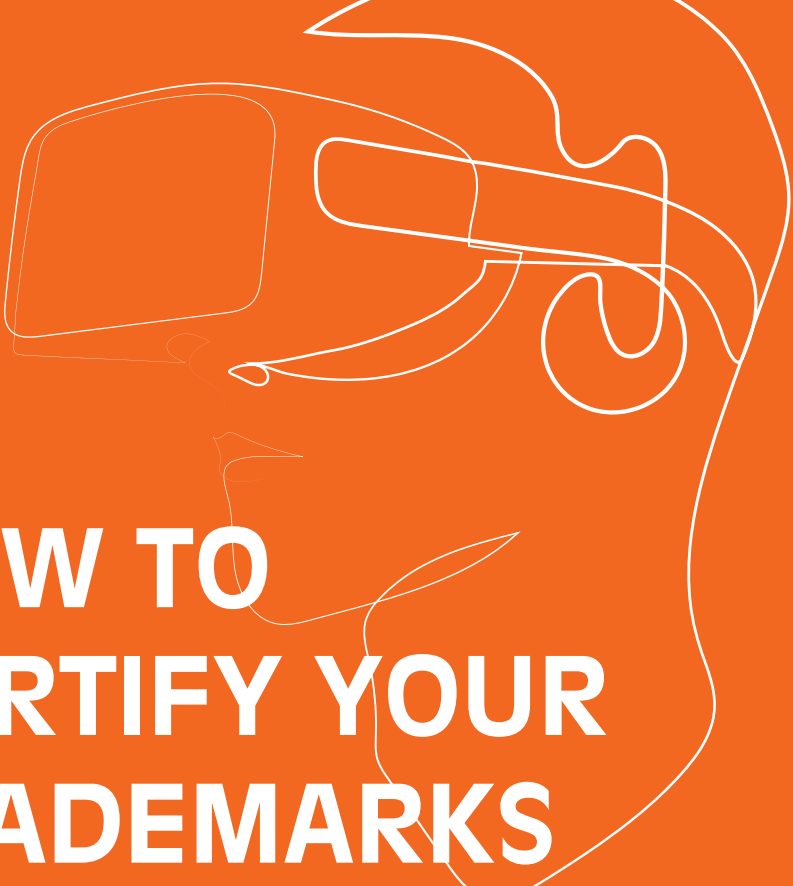
*Intellectual Asset Management*

# *Yearbook* **2017**

*Building IP value in the 21st century*

Protecting well-known trademarks in the European Union

Daan Wijnobel  
*NLO Shieldmark*



# HOW TO FORTIFY YOUR TRADEMARKS AND DESIGNS

Models and trademarks are a valuable asset in any business. They enhance a company's distinguishing capacity, boost its impact, strengthen its competitive position and make it more attractive to investors. Therefore, there is every reason to give Intellectual Property a prominent place in your business strategy. We can support you by protecting and enriching your models and trademarks, thanks to our extensive range of services and the expertise of our trademark and design specialists who find solutions where others don't. We are the largest consultancy in Intellectual Property in the Netherlands and Belgium and one of the most pioneering firms in Europe. If you would like to know more, visit [www.nloshieldmark.eu](http://www.nloshieldmark.eu)



European Patent &  
Trademark attorneys

[www.nloshieldmark.eu](http://www.nloshieldmark.eu)

# Protecting well-known trademarks in the European Union

By Daan Wijnobel, NLO Shieldmark

The basic principle of most continental countries in the European Union is that trademark protection is acquired through registration. However, the Paris Convention for the Protection of Industrial Property provides protection for unregistered trademarks, even when they are not used in certain territories, provided that they are well known.

This protection is rarely invoked in the European Union – perhaps because continental countries are unfamiliar with the concept of awarding protection without registration, especially for unused trademarks.

The website of the Benelux Office of Intellectual Property (BOIP), for instance, mentions that although it is possible to base an opposition on a well-known trademark, these trademarks are rare in Benelux. The trademark must be “very well-known”; having a simple reputation will not suffice.

Hence, the protection of well-known trademarks seems to fail in continental Europe, where it is unthinkable that a well-known trademark could not have been registered in the European Union.

This chapter analyses the possibilities of invoking well-known trademark protection during administrative proceedings and the benefits of doing so in specific circumstances.

## Legislative framework

The principle of well-known trademarks is based on Article 6*bis* of the Paris Convention, which mandates signatory states “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 [the Paris Convention] and used for identical or similar goods”.

EU Directive 2015/2436/EC and the EU Community Trademark Regulation (207/2009) recognise well-known trademarks as relative grounds for refusal – namely, as grounds for opposition. Hence, Article 8(2)(c) of the EU Community Trademark Regulation and Article 5(2)(d) of EU Directive 2015/2436/EC allow opposition based on trademarks which “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”.

These articles create the possibility of filing an opposition against a trademark application in the European Union, based on a well-known trademark. However, the conditions under which well-known trademark status is recognised remain uncertain.

Official guidelines have been drafted regarding the assessment of well-known trademark status, based on which a trademark can be considered ‘well known’ if it is well known among the relevant public, based on the circumstances of the case.

Interestingly, the same recommendation of the World Intellectual Property Organisation (WIPO) mentions that where a mark is well known in at least one relevant sector of the public in a member state, it “shall” be considered by the member state to be a well-known mark. Also, where a mark is known in at least one relevant sector of the public in a member state, it “may” be considered by the member state to be a well-known mark.

The legislation thus leaves the issue of well-known status to the discretion of the competent authority to determine, leaving room for a broad interpretation.

### Criteria for acquiring well-known status

As already stated, no specific legislative criteria exist for recognising a trademark as well known. Any trademark office or court can decide at its own discretion whether a trademark is considered well known in any specific territory.

As stated above, BOIP is generally hesitant to recognise trademarks as well known. However, the EU Intellectual Property Office (EUIPO) has proven to be more liberal in this respect, ruling as follows:

*In practical terms, the threshold for establishing whether a trade mark is well known or enjoys reputation will usually be the same. Indeed, although the terms 'well known' and 'reputation' denote distinct legal concepts, there is a substantial overlap between them, as shown by a comparison of the way in which well-known marks are defined in the WIPO recommendations with the way in which reputation was described by the Court of Justice in 'General Motors' (see judgment of 14/09/1999, C-375/97, 'General Motors Corporation'). In both cases, the assessment is principally based on quantitative considerations regarding the degree of knowledge of the mark among the public, and the thresholds required for each case are expressed in quite similar terms (well-known by the relevant sector of the public for well-known marks, as against known by a significant part of the relevant public as regards marks with reputation).*

Apparently, the EUIPO has taken the position that the term 'well known' can be considered as equivalent to the protection provided to trademarks 'with a reputation', further to the European Court of Justice (ECJ) *Chevy* case.

In *Chevy* the ECJ held that "the degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark"; whereas "the public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialized public, for example traders in a specific sector". Finally, the ECJ ruled that in Benelux, it is sufficient for the registered trademark to be known by a significant

part of the public concerned in a substantial part of the territory (which may consist of part of one of the countries comprising the territory).

Thus, in order to invoke protection of unregistered and unused trademarks in opposition proceedings in the European Union, the criteria that must be met are those with respect to trademarks with a reputation in a specific territory.

### Well-known trademarks

Given the EUIPO's apparently liberal interpretation regarding what can be considered a well-known trademark, it is interesting to see which trademarks have actually been recognised as such by the EUIPO.

#### Yellow Label

Yellow Label is a brand of champagne produced by Veuve Clicquot Ponsardin that bears a yellow label (specifically, Pantone 137C; see Figure 1).

Based on this label, Veuve Clicquot Ponsardin brought several successful actions against other parties which used the same colour for their labels, whether for champagne, beer or Italian sparkling wine.

Notwithstanding the question of whether the word mark YELLOW LABEL was distinctive in relation to champagne bearing a well-known yellow label, Veuve Clicquot Ponsardin and its affiliated companies held no registration for the word mark YELLOW LABEL for champagne.

After noticing that a third party, J E Borie SA, had applied for the word mark THE YELLOW

FIGURE 1. Yellow Label Champagne



Source: [www.veuve-clicquot.com](http://www.veuve-clicquot.com)

*“When invoking trademarks with a high level of descriptiveness or that may not have been genuinely used, invoking Article 6bis of the Paris Convention as a subsidiary ground is essential”*

LABEL in the European Union, Veuve Clicquot Ponsardin opposed the application based on the allegedly well-known word mark YELLOW LABEL in the United Kingdom owned by Moët Hennessy Champagne Services (MHCS), the parent company of Veuve Clicquot Ponsardin.

In order to substantiate the well-known status of the trademark, MHCS submitted several witness statements from persons inside the MCHS organisation and otherwise active in the champagne industry. MCHS also submitted:

- marketing and promotional activities;
- evidence that the public recognises Veuve Clicquot and the associated yellow colour; and
- several publications and statements evidencing that the subject champagne is commonly referred to as ‘Yellow Label’ in the course of trade.

The EUIPO granted well-known status to the YELLOW LABEL trademark in the United Kingdom, subsequently allowing the opposition.

### **Predator**

Predator is a brand of high-end, multimillion-pound luxury boats made by Sunseeker International Limited. After two films in the James Bond franchise featured Predator yachts, the brand received widespread media coverage.

Based on the well-known status of the trademark PREDATOR, Sunseeker successfully invalidated the EU registration PREDATOR in relation to luggage carriers for vehicles, vehicle bodies, vehicle seats and speedboats.

In order to substantiate the well-known status of the PREDATOR trademark, Sunseeker submitted:

- a witness statement by its managing director;
- a notification of a Queen’s Award for Enterprise for outstanding achievement in UK business in 2000;
- references in publications; and
- evidence of a presence at different trade fairs.

The EUIPO granted well-known status to the PREDATOR trademark, further noting that “the relevant public is rather narrow and, to prove the well-known character of the mark, it is not necessary to prove the recognition of the mark among the general public; rather, it is sufficient to prove it in relation to target consumers”.

### **Kickers**

In this case, opponent Societa’ Italiana Calzature Srl invoked Italian national trademark registration KICKERS against the EU part of an international registration. Interestingly, the opposition invoked only the national registration due to a procedural error (ie, it failed to “tick the relevant box in the opposition notice and failed to indicate the Member State in which the earlier trade mark is registered”).

The opponent provided:

- articles proving that Kickers sponsored a Formula 1 team and that its logo was shown on the suit and helmet of a Formula 1 driver;
- advertisements on television channels including Cartoon Network; and
- a market survey dating back to 1996, showing that Kickers was ranked fourth in the Italian market for children’s shoes.

The EUIPO recognised the KICKERS mark as well known in relation to children’s shoes. It admitted that the market survey was quite old and could not independently establish the well-known character of the mark beyond that date. However, in conjunction with the rest of the evidence, the EUIPO accepted that the opponent could maintain the well-known character of the mark in the years before the filing of the contested application.

Evidently, it is possible to obtain well-known trademark status in administrative proceedings before the EUIPO if the reputation of a trademark can be proven in a specific member state or territory. Indeed, it seems that well-known status can be obtained even if:

- the mark is not actually used as a trademark, but only referenced in the market (as with YELLOW LABEL);
- only a limited – but specific – part of the public has knowledge of the trademark (as with PREDATOR); or
- the opposing party forgets to tick a box during opposition proceedings (as with KICKERS).





### Daan Wijn Nobel

Trademark and design attorney

[wijnnobel@nlo.eu](mailto:wijnnobel@nlo.eu)

Daan Wijn Nobel is a trademark and design attorney at NLO Shieldmark. He graduated with distinction from *Vrije Universiteit Amsterdam*, where he specialised in IP law.

Mr Wijn Nobel advises and assists clients with respect to trademark rights, design rights, copyright, IP-related agreements and licences. He works for several national and international companies in different sectors. His work includes investigation of the availability of trademarks, representation during administrative proceedings and general IP-related advice. He is also responsible for drafting IP agreements in the event of infringement, cooperation and refusals.

### Benefit of acquiring protection for famous trademarks

Article 6*bis* of the Paris Convention can provide valuable ammunition in administrative and litigation proceedings.

For instance, when invoking trademarks with a high level of descriptiveness or that may not have been genuinely used, invoking Article 6*bis* of the Paris Convention as a subsidiary ground is essential. Even if the other party invalidates the invoked registered trademark or the proof of use is deemed insufficient in terms of the goods or services invoked, provided that the reputation or well-known status of the trademark in relation to the specific part of the public can be proven, the opposition or litigation can succeed.

This way, the strict criteria for “acquiring distinctive character through use” (in case of lack of distinctive character) and “genuine use” (in case of limited proof of use) can be avoided by proving the reputation/well-known status of the trademark in the specific sector and the knowledge of the specific public.

Practice shows that it is very difficult, if not impossible, to protect non-traditional trademarks (eg, three-dimensional, shape, sound and olfactory marks) through registration.

Case law indicates that the distinctiveness of non-traditional trademarks is not subject to stricter assessment; but in view of the perception of the public, it can be harder to prove distinctive character. These cases have precipitated a complex academic discussion regarding non-traditional marks, which has resulted in high and almost incomprehensible criteria for registration. Simply put, it is impossible to register non-traditional trademarks unless they meet distinctiveness criteria which are, in practice, unfeasibly strict.

Considering that Article 6*bis* of the Paris Convention supersedes the criteria for registration and use, an appeal to Article 6*bis* of the Paris Convention could be a solution with respect to non-traditional marks. If the reputation or well-known status of a non-traditional trademark can be proven under the above criteria, a successful claim on Article 6*bis* is available. It will be interesting to see whether the EUIPO will maintain its liberal interpretation with respect to the recognition of non-traditional trademarks.

### Conclusion

Contrary to the continental perception of registration, well-known trademark status can be invaluable in adversarial proceedings. EU case law suggests that the threshold for acquiring well-known trademark status is not as high as continental ideology would indicate.

In administrative and litigation proceedings, therefore, Article 6*bis* of the Paris Convention could prove to be a far more valuable tool for rights holders than is presently accepted. *iam*



### NLO Shieldmark

New Babylon City Offices  
Anna van Buerenplein 21a  
The Hague 2595 DA  
Netherlands

**Tel** +31 70 331 2500

**Fax** +31 70 352 7528

**Web** [www.nloshieldmark.eu](http://www.nloshieldmark.eu)