

*How notorious is the well-known trademark  
in law and jurisprudence?  
A European Perspective*

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# REPUTATION, WELL-KNOWN, NOTORIOUS, FAMOUS...

## DIFFERENT NOTIONS, DIFFERENT SCOPE OF PROTECTION

- Trademark with reputation / Marca de renombre (*marque de renommée* in French )

= **registered** trademark

### ➤ National European TM

Article 5.3 (a) – Article 10.2 © - DIRECTIVE (EU) 2015/2436 of December 16, 2015

### ➤ European TM

Article 8. 5 – Article 9.2 © - REGULATION (EU) 2017/1001 of June 14, 2017

Scope of protection: **beyond the principle of speciality**

- Well-known trademark / Marca notoriamente conocidas (*marques notoirement connues* in French)

= **non-registered** trademark

### ➤ Article 6 bis of the Paris Convention

Scope of protection :

- basic protection before EUIPO: identical / similar products and services
- optional extended protection : dissimilar products and services if unfair advantage [France : **beyond the principle of specialty** ]

# DIFFERENT REGIMEN, BUT DIFFERENT ASSESSEMENT? NOT REALLY!

- A well-known trademark is usually admitted as being “**better known**” than a reputed trademark  
Is that really the case?

- Criteria for a reputed (registered) TM  
See **General Motor v Yplon Chevy** (*Judgment of September 14, 1999, C- 375/97*)

Known

- by a **significant part of the public concerned** by the products and services that it covers
- throughout **the entire or a substantial part of the relevant territory**
  - **For a EU TM: 28 countries...**
- Criteria for well-known (non registered) TM: **Mostly the same criteria although**
  - ➔ **The whole public in general** versus “the concerned public”
  - ➔ **The whole territory** versus “a substantial part of the territory”

# COMMONPLACE FACTORS FOR REPUTED OR WELL-KNOWN TRADEMARKS

## Traditional factors

- Seniority of the use
- Intensity of the use
- Geographical extent of use
- Promotional and advertising investments
- Market share held by the prior trade mark

## Other factors

- Record of successful enforcement (i.e., decisions rendered by judicial or administrative authorities)
- Certifications and awards
- Licensing, merchandising and sponsoring
- Social Media impact

# A HEAVY BURDEN OF PROOF

- Principle: **burden of proof lies on plaintiff's shoulders**
- Evidentiary work is rarely rewarded – the French example
  - **Well-known trademark**
    - ✓ A “premium” category rarely acknowledged
    - ✓ Over **11 years**
      - ❖ **National Office**: 29 denied vs **3 accepted**
      - ❖ **Judicial Courts**: 6 denied vs **2 accepted**
  - **Reputed trademark in France**
    - ✓ No statistics available
    - ✓ Certainly more widely accepted
      - Not surprising – Existence of the TM does not have to be proven, unlike well-known TM
- Reputation is not a “forever status”  
Notoriety has to be re-established in each new matter  
Otherwise **loss of repute** : see MUST (de CARTIER) or CHRISTIAN LACROIX

# A FEW SUCCESS STORIES

- **Trademark with reputation at a European level**

- **NASDAQ** for stock exchange price quotation services

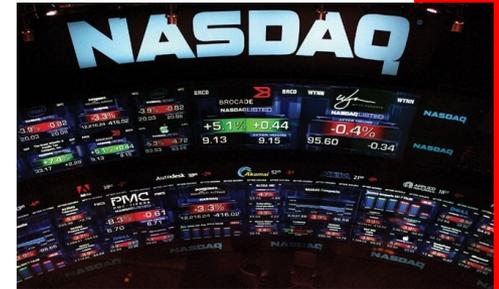
- ✓ massive use in newspapers / news channels

- ✓ substantial investments

- **KENZO** for cosmetics, perfume and clothing

- ✓ “extensive coverage” in the press

- ✓ volume of sales proved through invoices



- **Adidas’ three-stripe logo** -  for clothing

- **Trademark with reputation at national (French) level**

- **BOEING** (airplanes), **GIVENCHY** (handbags) **ARIEL** (bleaching preparations)

# AN EVEN FEWER SUCCESS FOR WELL-KNOWN TM

- No decision at a European level



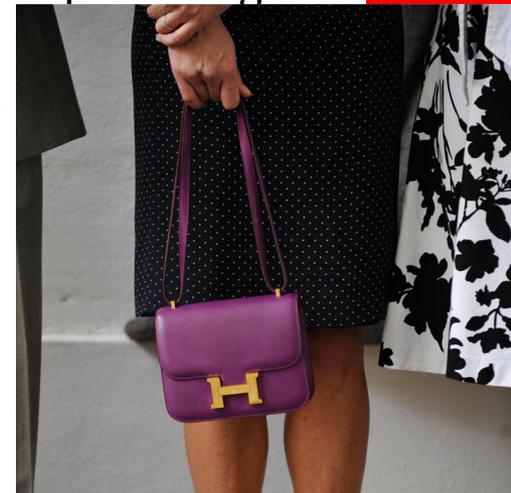
- National Court decisions

- Cannot be listed for all EU countries – very local a
  - See the Spanish **BIMBO** case (*Case T-277/12*)

The **BIMBO** word trademark (non registered) considered as well-known in Spain for packaged sliced bread

- National Offices – (again) French exemple – 3 cases

- **GAUMONT** for production and distribution of films and providing cinema facilities
- **X-MEN** for printed matter and cinematographic films
- **CONSTANCE** for HERMES's handbags



# IS THERE “SUPER” NOTORIOUS TM, WHICH NEED NOT TO BE PROVEN?

## • OBVIOUS FACTS / NOTORIOUS FACTS – WHAT IS THAT?

- Unknown notions in the French legal system:  
Judges are prohibited from using their personal knowledge
- But not unknown to other European countries

### ➤ Austria

- Obvious facts need no proof in civil proceedings (§ 269 ZPO)
- The VIVA case (*The Austrian Supreme Court, Decision of February 16, 2014, 4 Ob 189/ 14v*)

*Anyone from reliable sources without special knowledge must be able to safely inform about such facts. These include, above all, the empirical principles of general life experience, geographical facts, historical and political events as well as the current affairs (...)*

*However, in this specific case, the opposition mark [▼△▼▲ EUTM n°005.061.775] is even known to those members of the recognizing Senate, who undoubtedly are not among the circles addressed by the applicant's television station. In these circumstances, a counter-proof is virtually hopeless*

### ➤ Spain

**Artículo 281** Ley de Enjuiciamiento Civil - Objeto y necesidad de la prueba.

*4. No será necesario probar los hechos que gocen de notoriedad absoluta y general*

# THE “WELL-KNOWN FACTS” AT A EU LEVEL

- The European Court of Justice supports the « well-known facts » doctrine
  - **Well-known facts** = facts likely to **be known by anyone** or **which may be learnt from generally accessible sources** (*Case T-185/02, Picasso Estate v OHIM*)
    - PICASSO, one of the greatest painter of the XXth century = known fact
    - As a result, PICASSO not imitated by PICARO for cars
- Doctrine implemented by the EUIPO Board of Appeals
  - **SUPERMAN** case (*Case R 235/2006-2*) Not imitating prior MAN TM

*“the sign ‘SUPERMAN’ is **particularly well known** to the relevant public **as being the name of a ‘superhero’, a character known worldwide** through comics, films, television and numerous merchandising products (...) The Board is aware that ‘SUPERMAN’, is **one of the most famous, perhaps even the most famous, of various ‘superheroes’,** whose adventures have been read about in comics and followed in films and television for decades by both children and adults all around the world. **The fact that ‘SUPERMAN’ is a well-known character, is a generally known fact, which needs not to be proven** (...) When written together and when pronounced as a word, the word ‘SUPERMAN’ creates in the mind of the consumers a particular concept which is very well-known around the world (...)”*
  - **Nike** case (*Case R 554/2008-2*) -  sociés

# CONCLUSION

- Evidencing the notoriety / reputation remains the rule
  - Before EUIPO/ European Courts / National Courts
  - Notorious facts remains the exception
    - Facts, arguments and evidences submitted by the parties
    - Used to decide how the TM will be perceived by consumers rather than to decide the TM is notorious or not
- “Notorious facts:” A name given to a “non-formalized” practice?
  - ✓ The **HERMES** decisions – Reputation “not challengeable”
  - ✓ The **OLYMPIC GAMES** cases
    - “**Olympic**” = well-known trademark  
*“neither contested nor questionable”*  
(Paris First Instance Court, June 13, 2014)
    - “**Olympique**” = well-known trademark without evidence (Paris First Instance Court, April 10, 2014)
    - Isolated decisions



**THANK YOU FOR YOUR  
ATTENTION**

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