

Resolution

Question Q214

Protection against the dilution of a trademark

AIPPI

Noting that:

- 1) In previous questions, AIPPI has studied issues relating to the extended protection of certain marks, such marks being characterized in different terminology (such as “well-known” marks protected without registration under the Paris Convention, marks with a “reputation” protected under Community trademark law, or “famous” marks under US law), leading to the adoption of
 - a. The resolution of the Congress of London in 1960 (Q29) on marks that are well-known within the meaning of Article 6bis Paris Convention, including the weakening of such marks in their distinctive character or their power of attraction;
 - b. The resolution of the Congress of Berlin in 1963 (Q29) that marks enjoying high reputation should be protected against use or registration by third parties, even in respect of different goods or services and even if they are not used in the country where protection is sought, when such registration or use is liable to be harmful to the proprietor of the mark;
 - c. The resolution of the Executive Committee of Barcelona in 1990 (Q100) that (i) the protection of well-known marks should conform to certain minimum standards, (ii) marks having a reputation should be protected against detriment to the distinctive character or reputation of the mark and (iii) marks having a high reputation should be protected against use or registration without the need to prove any detriment to the distinctive character or reputation of the mark;
 - d. The resolution of the Executive Committee of Lisbon in 2002 (Q168) concerning *inter alia* certain defences to alleged trademark infringement by fan clubs and in parody;
 - e. The resolution of the Executive Committee of Berlin in 2005 (Q188) concerning conflicts between trademark protection and freedom of expression; and
 - f. The resolution of the Executive Committee of Singapore in 2007 (Q195) that trademark right limitations should be allowed only to the extent that the use of another’s trademark by a third party does not cause dilution of the mark.
- 2) The present Resolution sets forth general principles for protecting certain marks from dilution.

Considering that:

- 1) There is broad agreement on the basic policy that certain marks should be protected against dilution in appropriate cases by unauthorized use or registration by third parties;
- 2) That trademark dilution is a departure from the traditional trademark law principle of specialty, i.e., that marks are protected only with respect to the particular (or similar) goods or services for which they are used and/or registered, and therefore it is important to strike the correct balance between limited and unlimited trademark protection;
- 3) Uniform rules would be desirable concerning:
 - a. What trademarks should be eligible for protection against dilution, and a definition of terms, recognizing that confusion should be avoided with other terms that already exist for marks in different legal contexts;
 - b. Whether both varieties of dilution should be recognized, i.e., dilution by blurring and dilution by tarnishment;
 - c. Whether eligibility for dilution protection should require that the mark has recognition or fame among the general public, or whether recognition or fame within a limited product market (“niche”) is sufficient;
 - d. Whether eligibility for dilution protection should also require that the mark be distinctive, and if so, whether it is equally acceptable that the mark be inherently distinctive or that the mark has acquired distinctiveness through use and promotion;
 - e. If proof of recognition or fame and distinctiveness are required, as of what point in time must they be proved, with reference to the other mark or other sign in dispute?
 - f. Whether eligibility for dilution protection should require registration or a pending application for registration in the country in question;
 - g. Whether eligibility for dilution protection should require use of the mark in the country in question;
 - h. Whether there should be a registry of marks that are eligible for dilution protection;
 - i. Whether a dilution action should require a “mental association” or “link”;
 - j. Whether a dilution action should require a change in the economic behavior of the relevant public;
 - k. Whether the existence and extent of third party use of the same or similar marks or other signs should be a factor to consider; and
 - l. What remedies should be available for dilution of a mark?

Resolves that:

- 1) Certain trademarks should be eligible for protection against dilution irrespective of the identity, similarity or dissimilarity of goods and services, subject to the following conditions,
 - a. Such trademarks being defined as having recognition or fame among a significant part of the relevant public. In determining such recognition or fame, all relevant factors will be taken into account, e.g. the intensity, geographical extent and duration

of the use of the trademark, the amount of sales under the trademark, the size of the investment made by the undertaking in advertising and/or promoting the trademark and the market share held by the trademark;

- b. The relevant public in determining the recognition or fame of a mark being dependent on the goods and services in question, i.e. the public concerned by the products or services covered by the trademark, which can be a limited product market (“niche”);
 - c. Distinctiveness also being a requirement, to be determined according to normal principles of trademark law, recognizing distinctiveness acquired through extensive use and promotion as well as inherent distinctiveness;
- 2) Dilution by blurring and dilution by tarnishment should both be recognized,
 - a. Dilution by blurring arising from the impairment or reduction of the distinctiveness of the mark;
 - b. Dilution by tarnishment arising from harm to a mark’s reputation;
 - 3) The owner of a mark asserting dilution must prove its mark is recognized or famous, and is distinctive, from prior to the challenged mark’s or other sign’s first use or application date in the country in question;
 - 4) Eligibility for dilution protection should not require use of the mark in the country in question;
 - 5) Eligibility for dilution protection should not require registration or a pending application for registration of the mark in the country in question;
 - 6) There should not be a registry of marks that are eligible for dilution protection, as such a procedure creates more issues than solutions;
 - 7) A “mental association” or “link” between the mark and the challenged mark or other sign should be a necessary requirement;
 - 8) An actual or potential change in the economic behavior of the relevant public may be among the factors to consider, but should not be a separate requirement;
 - 9) The existence and extent of third party use of the same or similar marks or other signs as of the time of instituting the action may be a factor to consider;
 - 10) Dilution of a mark
 - a. should be a ground for opposition, cancellation, nullification or revocation of registration, to the extent such procedures are available in a country; and
 - b. should, in actions before courts or other competent authorities, be subject to remedies, including but not limited to injunction and damages.