

Секция «Английский язык и право (на английском языке) только студенты
магистратуры и аспирантуры»

**Famous, well-known and reputed marks in the United States: legislation and
court practice**

Научный руководитель – Ерпылева Наталия Юрьевна

Даулетшина Эльза Викторовна

Аспирант

Национальный исследовательский университет «Высшая школа экономики», Факультет
права, Москва, Россия

E-mail: elza.dauletshina@gmail.com

The three categories of trademarks commonly used in the United States - famous, well-known and reputed - may seem synonymous, or even identical, to a person unfamiliar with the concept. However, placing the mark in one of these groups can be crucial for determining the trademark protection strategy.

Out of the three the most familiar are well-known trademarks protected internationally in countries signatories to the Paris Convention [1] and the TRIPS Agreement [2]. Although both these conventions along with several other international agreements, of which the United States is a member nation [3], as well as the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks [4], require protection for well-known foreign marks, the question of whether well-known local marks can be protected under the same agreements is still controversial [5]. This question has been numerously raised in the United States courts leading to such landmark decisions, as in Grupo Gigante SA de CV v. Dallo & Co. [6], Empresa Cubana del Tabaco v. Culbro Corp. [7] and ITC Ltd. v. Punchgini, Inc. [8].

At the same time, the famous mark doctrine has purely domestic roots and a "famous" mark is defined in the Lanham Act as one that is "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of trade mark's owner" [9]. However, the level of protection granted to well-known and famous marks is considered by some legal scholars to be different [10]. To identify the degree of protection granted to trademarks recognized as either well-known or famous one must compare the criteria for such recognition crystalized in the United States legislation and court practice.

As for the terms "reputed marks" and "marks with a reputation", they do not find proper reflection or have any accepted fixed meaning in the United States trademark law. It is argued by some legal scholars, that these terms could be analogized to descriptive marks held to have acquired distinctiveness, or secondary meaning, through use and promotion [11].

Taking into consideration the different scope of protection granted to trademark owners, depending on whether their mark is recognized as "well-known" or "famous", it is crucial to identify and analyze such differences. To make a clear distinction in terminology, the following analysis has to be conducted in English language to convey the specifics of each term used in United States legislation and court practice while avoiding the difficulties of synonymous translation and confusion with similar concepts under the Russian law.

Источники и литература

- 1) Paris Convention for the Protection of Industrial Property, Mar. 20, 1888, 13 U.S.T. 2, 828 U.N.T.S. 107, as revised at Stockholm on July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305
- 2) Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, annex 1C, art. 22.1, 108 Stat. 4809, 869 U.N.T.S. 299 (1994)
- 3) North American Free Trade Agreement, U.S.-Can.-Mex., art. 1708(6), Dec. 17, 1992, 32 I.L.M. 605 (1993); Inter-American Convention for Trademark and Commercial Protection, art. 7, Feb. 20, 1929, 46 Stat. 2907, 2918
- 4) Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, URL: http://www.wipo.int/about-ip/en/development_iplaw/pub833.htm
- 5) Graeme B. Dinwoodie, Trademarks and Territory: Detaching Trademark Law from the Nation-State (2004) Houston Law Review, Vol. 41, No. 3 at 924
- 6) Grupo Gigante SA de CV v. Dallo & Co., 391 F.3d 1088, 1094 (9th Cir. 2004)
- 7) Empresa Cubana del Tabaco v. Culbro Corp., 399 F.3d 462, 480–81 (2d Cir. 2005)
- 8) ITC Ltd. v. Punchgini, Inc., 373 F. Supp. 2d 275 (S.D.N.Y. 2005), aff'd, 518 F.3d 159 (2d Cir. 2008)
- 9) Lanham Act 15 U.S.C., §1125(a) (2006)
- 10) Lee Ann W. Lockridge, Honoring International Obligations in U.S. Trademark Law: How the Lanham Act Protects Well-Known Foreign Marks (And Why the Second Circuit Was Wrong), St. John's Law Review, Issue 4 Volume 84, Fall 2010 at 1354
- 11) Maria A. SCUNGIO, Robert SACOFF, Relevant public for determining the degree of recognition of famous marks, well-known marks and marks with reputation, Study Report of the United States Working Group (2013)