

## The extension and nobility of a well-known trademark.

The notion of a Well-Known Trademark is one of the most polemic concepts regarding Intellectual Property but also the most noble as well. The juridical and commercial consequences generated from its application or any misapplication would lead to preservation or a devastation of a trademark. The well-known concept involved the solution to the sensible situation of the legitimate ownership over registration rights of the prestige trademarks.

In Venezuela before our adhesion and signature of The Paris Convention for the Protection of Industrial Property (which already contains the well-known concept since the beginning of the last XX century) and other related International Regulations that ratified such concept (N.B. The Decision N° 486 of Andean Community of Nations), a complex irregular situation took place in the commercial field as a result of a fraudulent misappropriation of international famous trademarks and the absence of proper regulations of intellectual property duly applied by the Venezuelan PTO in order to reject any intent for misappropriation and illegitimate use of original trademarks.

In this sense, the legal adoption of the well-known character of a trademark supposed a remarkably advance in the process of establishing a legal frame for those licensees of famous trademarks that found benefit from the legitimate circulation of original goods and related foreign investment.

Certainly the substitution of the local regulations for the innovated International Legislation changes the old view of inobservance of the well-known concept. The rigorous application of such concept leaves behind the background of bad faith by disloyal third parties. The chase and hunting of prestigious trademarks has been stopped by the depurated labor of the National Register Office through an updated criteria supported by the respect of commercial aspects including the *good will* of the sign as a result of many years of efforts for investments.

The well-known character of a trademark contains the exclusive and legitimate right to own the sign beyond borders, requesting the application of international principles of loyalty in the commerce assuring at the same time the good faith of consumers. This concept of notoriety is a category not limited only to a certain territory or location since such well-known character deserve to be considered by the time the trademark has gained this quality in the country of origin. That is why it is possible that one trademark can be very famous in Europe but is unfamiliar in America or Asia.

Nowadays with the advance of the technology regarding the aspects of globalization would be hard rigid to limit any recognized trademark to a group of consumers in certain territory without observing the potential presence in unproven markets, taking into account the commercial efforts of the company and the quality of the products or services identified with the Well-known Sign.. The matter is to extent the protection of the well-known in prospective markets where the public acknowledgment of consumers allows to lead the trademark to a well position in market.

It is also important to explain the concept the Well-known trademark as an exception of the principle of classified the trademarks according to the good or service identified. This means that the well-known trademark must be recognized as so no matter the class of product, good or service to which is applied.

Against this rule, the Supreme Court of Canada has recently dismissed appeals by the owners of famous trade-marks (*Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* and *Mattel v. 3894207 Canada Inc.*) regarding the petition of rejection for similar trademark applications protecting services for small businesses non directly associated with the famous trade-marks.

In this way, the Supreme Court of Canada has declared the coexistence of trademarks VEUVE CLIQUOT (champagne) and BOUTIQUE CLIQUOT (retail store for clothing and accessories) in one hand, and in another the trademark BARBIE (toys) and BARBIE'S (restaurant services), both decisions in contradiction with the described principles for the recognition of well-known trademarks in all classes of goods and services.

From our point of view, such decisions have been set with a weak interpretation of Intellectual Property concepts avoiding not only the aspect trademark dilution but also the enforcement of the well-known trademark recognition that includes the corporative effort of the commercial operations through out the world.

In case that the Decisions from the Supreme Court of Canada were right, it will be lack of sense the fact that the legitimate owners explore different nature of products and services identified with the same original trademark. For sure, the quality and confidence of a costumer that looks for excellent champagne as Viuve Cliquot is the same when acquiring a piece of clothing identified with Viuve Cliquot.

It is in this situation where the principle of protection by class of product is covered by the pristine principle of the Famous Character of a Trademark which notoriety includes the exclusive ownership over the rights and values of the original trademark.

There are many examples of this diversification of products and rights such as Ferrari for clothing, dishes, fragrances, notebooks, pens and different accessories far from the concept of a vehicle exclusively, or Mont Blanc for as much different accessories different from the famous fountain pen.

As a result of the inobservance or merely confusion regarding the correct understanding of the well-known quality of a sign, it is possible to open other misinterpretations that could lead to the loss of confident for investments and international commerce. It is important to remind that this kind of trademarks involved other related aspects such as the know-how regarding production methods, management, quality and efficiency of products or services.

In conclusion, the concept of a well-known trademark has to be evaluated under the extension of its acknowledgement among consumers which recognized the trademark as a symbol of quality no matter the products or services protected by its figure and design.

Finally it is important to add some comment in regard to the burden of proof activity since we considered that any evidence for well-known should not be circumscribed only to the suggested instruments of proof such as: market surveys, advertising, capacity of sales or certifications of trademark antiquity. In view of globalization, it is important the application of maximum experience criteria, discretionary estimation (technical and cultural) and wide cognitive evaluation by the National Trademark Offices in order to set the recognition of a well-known sign. Any inconsistency in applying such principles of estimation shall deny the extension and nobility of the well-known character of a trademark.

Orlando Viera-Blanco

---

**VIERA BLANCO LOPEZ & ASOCIADOS**

Av. Don Bosco, Qta. Mercedes

Urb. La Florida - Caracas, Venezuela

Tlf.: (58 212) 730.3603

Fax.: (58 212) 730.7746

---