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**LEGAL REGULATION OF WELL-KNOWN TRADE MARKS  
(IN EXAMPLE LEGISLATION OF UZBEKISTAN AND FOREIGN  
COUNTRIES)**

**Annotation:** In this article, we study some features of the legal regulation of well-known trademarks with the legislation of Uzbekistan, legislation of foreign countries and with the international conventions.

**Key words:** well-known trademark, famous mark, highly renowned, highly reputed, Paris Convention, TRIPs Agreement, Benelux Trademark, Trademark Act of Germany, Trademark Directive, European law, European Union.

**Introduction** The brand is becoming an integral piece of developing economic relations. Especially there is great difference between economic income of certain brand position and simple trademarks. For these reason

popular trademarks at the level of some countries is regarded as a national symbol even. For example, Mercedes-Benz, BMW (Germany), Samsung (South Korea), Toyota, Honda (Japan), Coca-Cola (USA) etc.

The issues of regulation of legal protection of popular brand has produced the adoption and implementation of it not only the national legislation norms, but also the norms of international law.

The Uzbekistan's legal system for the protection of intellectual property rights and well-known trademarks has made significant achievements. It has established a trend towards harmonization with international norms and the laws of other countries. It has not only effectively protected trademark owners' rights and benefits, but has also contributed to improving Uzbekistan's economy. This has been achieved through the implementation of the system by Uzbekistan's authorities.

Uzbekistan's economy has changed greatly and for the better in recent years. This renewal and renovation has brought remarkable progress to the Uzbekistan's economy in general and specifically to the field of trade. From the beginning of this process, the Uzbekistan's market has actively engaged international markets. Since then, an increasing number of foreign investors have entered the domestic market, making large capital investments. This capital includes intellectual property, a significant part of which is comprised of well-known trademarks.

From a theoretical perspective, well-known trademarks and the protection of well-known trademarks have increasingly become important topics engaging the thoughts of scholars all over the world. There have been many books and research works dealing with issues concerning well-known trademark protection in theory and legislation. However, in Uzbekistan, as in

other developing countries legal issues concerning well-known trademark protection have still not received proper attention even though some scholars and lawyers have examined the issue to some extent in academic works and articles.

Well-known trademarks have been recognized as one of the most important types of trademark in the trademark system as reflected in both national law and in international treaties. The legal regime of well-known trademark protection has been continuously enhanced and developed over time due to the increasing importance of well-known trademarks becoming known to a worldwide public as well as development of their role in the international trade system. However, these legal issues are novel concepts for many countries, especially in developing and least developed countries, including Uzbekistan.

In Uzbekistan legal regulation of well-known acquires the legal status in national legislation system. Before it was not existed the concept of “well known trademark” in the Law of the Republic of Uzbekistan which hold in August 30, 2001 about “Trademarks, service marks and the origin of trade names”. The improvement of trademarks associated with the membership of Uzbekistan in Paris convention for the protection of industrial property on December 25, 1991 and legal protection of the brand associated with the character of all known rules and then proceeding, 19 September 2007 the law on amendments and additions to some legislative acts of the republic of Uzbekistan “the well known brand” concept comes into national legislation.

According to the Law of the Republic of Uzbekistan on August 30, 2001, about “Trademarks, service marks and origin of trade names” in the article 32 was registered “on the basis of a protected trademark registered in the

territory of the republic of Uzbekistan, in accordance with international agreements of the republic of Uzbekistan registered a trademark protected in the territory of the republic of Uzbekistan also despite as well as the brand used, but to have legal protection in the territory of the Republic of Uzbekistan according to the application of legal or the physical person, such a brand is a sign as a result of they are used according to the condition of the person specified in the application on the date the relevant goods in the Republic of Uzbekistan is stuck wide known among consumers, the brand can be recognized as well known in the Republic of Uzbekistan” fixed stained.

All well-known trades of international legal regulation are carried out also in accordance with the law.

Countries have made an international effort to create an important exception to the territoriality principle, which is set forth in the Paris Convention<sup>1</sup> and the TRIPs Agreement<sup>2</sup>. Accordingly, a trademark that is well known in a country or countries can also be recognized and protected in other countries even though the trademark owner has not registered or used that trademark in those countries<sup>3</sup>. Thus, the concept of protecting well-known marks is rooted in Article 6*bis* of the Paris Convention for the Protection of Intellectual Property, which states, in part, that member countries agree refusing or cancelling the registration, and to prohibit the use,

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<sup>1</sup> The Paris Convention for the Protection of Industrial Property was enacted on 20 March 1883, signed by more than 100 countries, come into effect on 7 March 1884, has been amended several times at Brussels on 14 December 1900, at Washington on 2 June 1911, at the Hague on 6 November 1925, at London on 2 June 1934, at Lisbon on 31 October 1958, and at Stockholm on 14 July 1967; and as amended on 28 September 1979. It is amended

<sup>2</sup> See Article 16(2) of TRIPs Agreement

<sup>3</sup> Xuan-Thao Nguyen, The other Famous Marks Doctrine, the Article was solicited as part of the “International and Comparative Aspects of Trade mark Dilution” Symposium, Transnational Law & Contemporary Problems, Vol. 17, pp. 757-773, Fall 2008.

of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered to be well-known in a country as being already the mark of a person entitled to the benefits of the Convention<sup>4</sup>.

Brand is the American version of English word “brand-name”<sup>5</sup>. The notion of brand or well known trade mark (is used as brand) was widely used as precedent in the middle of the XIX century in some European countries, legal basis of the concept was identified as a result of revision of Paris convention on protection of industrial property, which was held in 1925, November 6.

In addition, in the legislation of other countries the legal regulation of well known brands associated with the set of rules is passed.

Provisions for the protection of well-known trademarks have also been featured under national laws: for example The Trademarks Act 1938 (replaced by the Trademarks Act 1994), of the United Kingdom<sup>6</sup>, the Lanham Act of 1946 of the United States of America (amended by the Federal

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<sup>4</sup> Lile Deinard and Amy Stasik, The Famous Marks Doctrine under the Paris Convention – Is the remedy available to foreign entities in the Second Circuit?, New York Law Journal, October 16, 2006.

<sup>5</sup> Мюллер В.К. 70 000 слов и выражений. Изд. 14-е, стереотип. – М.: «Советская Энциклопедия», 1969. – С.912.

<sup>6</sup> See the Section 56(1) – Trade mark Act 1994.

Trademark Dilution Act in 1995 and the 2006 Revisions)<sup>7</sup>, and the Trademark Act of 31 December 1964 and the Intellectual Property Code of France<sup>8</sup>.

The French Intellectual Property Code distinguishes between a “well-known mark” and a “famous mark.” The French well-known trademark is a mark recognized by a large proportion of the circles concerned with the production, sale or use of the goods in question and is clearly perceived as indicating a particular origin of these products while the famous (“*renomme*”) trademark is a trademark known internationally and worldwide<sup>9</sup>.

Under China’s current Trademark Law and the Trademark Law Implementing Regulations, China, for the first time formally recognized well-known marks. The Recognition Rules<sup>10</sup> define a “well-known trademark” as a trademark that is “widely known to the pertinent general public and enjoys a relatively high reputation.” The rule further defines “pertinent general public” to mean consumers, manufacturing operations, and persons involved in the sales of the goods or services bearing such trademarks. The Recognition Rules eliminated the requirement of China’s prior 1996 Rule that a well-known trademark be a registered trademark and changed “widely known to the market” to “widely known to pertinent general public” in defining the term “well-known trademark”. However, the “relevant public”

<sup>7</sup> In March 1995, the Federal Trade mark Dilution Act of 1995 (H.R 1295) was introduced by Representative Carlos J. Moorhead, the chairman of the House Judiciary Subcommittee on Courts and Intellectual Property. The bill created a new Section 43 (c) of the Lanham Act (1995, 15 U.S.C. section 1125 (c)) to provide the owner of a famous, federally registered mark with relief against another person’s “commercial use in commerce” of a mark if such use causes dilution of the distinctive quality of the registrant’s mark. This provision has been amended continuously under the Trade mark Dilution Revision Act (TDRA) which became effective on October 6, 2006.

<sup>8</sup> Law dated January 4, 1991, codified into Chapter VII of the French Intellectual Property Code, last amended by the Act No. 2003-706 dated August 1, 2003.

<sup>9</sup> WIPO national seminar on Intellectual Property, The protection of well-known trade marks, Cairo, February 17 to 19, 2003.

<sup>10</sup> Regulations on the Recognition and Protection of Well-known trade marks in China (“Well-known Trade marks Regulations” or “Recognition Rules”) came into force in 2003.

is only within the territory of China not internationally. This means that, a trademark that might be well-known in other countries but not yet registered or recognized in China does not qualify as a well-known trademark in China<sup>11</sup>. This provision seems to be a high hurdle, which well-known trademarks coming from foreign countries must overcome. The foreign well-known status may assist to some degree in showing that a trademark is well-known in China<sup>12</sup>.

In some literature, the popularity of trademark is divided into “known” or “well known”. However, the representatives international association of trademark protection”, which was founded in 1897 are suggested in 1990 to differentiate “known” and “well known”. European countries suggested various classification of trademark.

However, some countries, especially Great Britain reject the classification of trademark in this way. The reason was the classification of trademarks in its narrow sense during the law sitting (passing off) leads to difficulties in using delikt. This classification of brand leads some difficulties in law enforcement practice in legislation and in determining the protection rules. This is primarily to define the popularity of the brand and determine the level of protection associated with the set of appropriate legal terms and conditions. For example, in which case the brand is “well known” and in what cases is “known”. Neither this condition was mentioned in Paris convention on protecting industrial property, nor at the international and national legislation associated with the regulation.

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<sup>11</sup> Yvonne Chua, Howard Tsang, “Legislative changes boost status of well-known marks”, Magazine: MANAGING INTELLECTUAL PROPERTY, London: Dec. 2002/Jan. 2003, page 75.

<sup>12</sup> Loke-Khoon Tan, Pirates in the Middle Kingdom - The ensuing Trade mark Battle, second edition, (Sweet and Maxwell Asia 2007), para. 3.7, page 43.

Under United States law there is a difference between the concepts of “famous mark” and “well-known mark”. Famous mark seems to be the official notion. Actually, there has been no exact definition of well-known trademark or famous trademark in the United States. This is similar to the actual situation of many other countries. However, the United States has indirectly accepted the term of “famous trademark” but not “well-known trademark” through its statutory language. Indeed, according to the provisions of the section 3 of the Federal Trade marks Dilution Act in 1995<sup>13</sup>, the owner of a *famous mark* shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person’s commercial use of a mark or trade name, if such use begins after the mark has become *famous* and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. Thus, under the US law the definition of well-known trademark has not been stated.

In Japan, famous trademark and well-known trademark should be classified more clearly. There, a well-known trademark is considered as less famous than a famous one. Indeed, in the Japanese legal system, trademarks are divided into four groups including (1) regular trademarks, (2) reputed trademarks, (3) well-known trademarks and (4) famous trademarks. This

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<sup>13</sup> In March 1995, the Federal Trade mark Dilution Act of 1995 (H.R 1295) was introduced by Representative Carlos J. Moorhead, the chair man of the House Judiciary Subcommittee on Courts and Intellectual Property. The bill created a new Section 43 (c) of the Lanham Act (1995, 15 U.S.C. section 1125 (c)) to provide the owner of a famous, federally registered mark with relief against another person’s “commercial use in commerce” of a mark if such use causes dilution of the distinctive quality of the registrant’s mark. Because of concerns voiced by the Administration at the Committee Hearing, the requirement that the famous mark be registered to be entitled to protection against dilution was deleted so as not to undercut the United States’ position that famous marks should be protected regardless of whether they are registered in the country where protection is sought.



differs from many other countries which have assimilated the concept of “well-known” and “famous” trademarks. Japan bases this mainly on the ground that it is not necessary to make a distinction between the two because of their similarities not only in their natural characteristics but also in the scope of their legal protection. The main issue is how to define and distinguish a normal trademark from a well-known or famous one, but not between a well-known trademark and a famous one.

Accordingly, in a comparative view there are many different ways to understand the concept of “well-known trademark” and other terms, including “notorious”, “reputation”, “famous”, “highly renowned”, “highly reputed”, and “exceptionally well-known”<sup>14</sup>. Because of the lack of a common definition for the well-known trademark in the relevant international conventions and treaties, each country has its own viewpoint on the question of what constitutes a well-known trademark. “Well-known” or “famous” means to be widely and fully known by many people within a certain area. To some extent, the words “well-known,” “famous” and “popular” are synonymous. Therefore, the community should popularly use a well-known or famous trademark. It has to be easily recognized and identified by consumers.

Nowadays it is very important the legal protection of the brand and legal regulation of the relationship. Because of the fact that trade relations between countries are growing in number, as well as all of the brand names that are known needs legal protection not only a state, but in two or more states are realized.

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<sup>14</sup> Frederick Mostert, “Famous and Well-known Marks - An international Analysis”, (Butterworth’s 1997), page 18.

As noted above, protection of the brand originally was set in 1883, March 20, in the Paris convention for the protection of industrial property.

The Paris Convention addresses basic issues such as the scope of industrial property protection, the principles of protection, priority of applications, and the enforcement and implementation of the Convention in member states. The Convention's provisions have become an important source of law in the field. They continue to be referred to in other international agreements as well as in domestic legislation.

Article 6bis of the Paris Convention deals with three legal issues:

- The obligations of members to protect a well-known trademark by refusing or cancelling the registration of any mark which infringes the well-known mark,

- That determinations of well-known trademarks will be based upon (a) a decision of the competent authority of the registered country, or (b) a decision of the competent authority of the country where the mark is used; and

- Defining infringements of well-known trademarks to include the reproduction of the whole or the essential part of the mark, or an imitation, or a translation of such mark which can create confusion with the well-known mark.

Thus, the Paris Convention has provided general provisions, which have become important fundamental sources of law on well-known trademarks and their protection. However, in addition to its achievements the Convention also contains some shortcomings:

- The Convention only refers to the protection of well-known trademarks for goods but not in connection with services;

– The Convention does not provide a definition for “well-known trademark” leaving it to member state law with the result that the factors used to define a trademark as being well-known have little in common and it is difficult to apply them in practice; and

– The protections of the Convention are only applied to identical or similar goods but not to goods which are not identical or similar.

In the area of trademark law, two possibilities for additional protection under unfair competition law exist. However, these possibilities will not regularly arise, primarily because of the wide scope of protection of the Benelux Trademark Act. Firstly, the protection of signs that do not fall within the meaning of section 1 of the Benelux Trademark Act. Examples of such signs are (certain) words<sup>15</sup>, slogans<sup>16</sup>, advertisements<sup>17</sup>, a title of a book or periodical<sup>18</sup>, (certain) logos<sup>19</sup>, and shop fixtures and fittings<sup>20</sup>. The imitation of

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<sup>15</sup> See e.g. HR 28 June 1929, NJ 1929, 1750 (EMM); President District Court The Hague 10 September 1971, BIE 1972, no. 33, p. 79 where the sign REDDY for *inter alia* vegetable oils and fats was diluted, but protection against confusion was still possible under unfair competition law; President District Court Zwolle 4 June 1982, BIE 1982, no. 33, p. 82.

<sup>16</sup> See e.g. President District Court Haarlem 29 May 1990, IER 1990, no. 52, p. 106 upheld by Court of Appeal Amsterdam 18 October 1990, BIE 1992, no. 34, p. 122. Slogans can, alternatively, in some cases be protected under copyright law, see Spoor/Verkade, *Auteursrecht en naburige rechten*, Deventer: Kluwer 1993, no. 77 (recently a new 3d edition has been published in 2005).

<sup>17</sup> See e.g. HR 26 June 1953, NJ 1954, no. 90 (Ph.A.N.H.); President District Court Haarlem 17 May 1971, BIE 1972, no. 30, p. 69; President District Court Breda 4 January 1974, BIE 1976, no. 8, p. 41; President District Court Amsterdam 20 December 1979, BIE 1982, no. 4, p. 19; President District Court The Hague 28 June 1996, BIE 1997, no. 34, p. 215. Advertisements, other than slogans, can be protected under copyright law as well, see Spoor/Verkade (1993), no. 77.

<sup>18</sup> See e.g. President District Court The Hague 26 February 1982, BIE 1982, no. 71, p. 218; President District Court Utrecht 6 January 1983, BIE 1983, no. 63, p. 176; President District Court Haarlem 13 October 1989, BIE 1991, no. 6, p. 20; President District Court Zutphen 26 July 1990, see Court of Appeal Arnhem 18 June 1991, BIE 1992, no. 83, p. 328. A title of a book or periodical will, however, in many cases fall within the scope of protection of the Benelux Trademark Act or Trade Names Act

<sup>19</sup> See e.g. Court of Appeal Arnhem 1 April 1970, NJ 1970, no. 392; Court of Appeal Den Bosch 7 February 1979, NJ 1980, no. 178. Logos will, however, in many cases fall within the scope of protection of the Benelux Trademark Act or Trade Names Act.

<sup>20</sup> See e.g. Court of Appeal Leeuwarden 15 February 1995, BIE 1996, no. 98, p. 360 and President District Court Groningen 3 July 1987, BIE 1988, no. 67, p. 230. See for more case law Van Nispen, **Social sciences and humanities** **Babakulov Z.**

these signs can be held to be unlawful under unfair competition law. Secondly, the protection of owners of trademarks within the meaning of the Benelux Trademark Act against behaviour that is not actionable under the Benelux Trademark Act<sup>21</sup>.

As noted above, the Benelux Trademark Act protects against a wide range of actions, including the dilution<sup>22</sup> of a well-known trademark that has a reputation in the Benelux, i.e. the use without due cause of an identical or similar mark for goods or services which are similar<sup>23</sup> or not similar to those for which the earlier trademark is registered, that takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier trademark<sup>24</sup>. In addition, a trademark owner is protected under the Benelux Trademark Act against dilution by someone who uses his trademark other than for the purposes of distinguishing goods or services<sup>25</sup>.

The new Trademark Act of Germany, provides for three types of trademark protection: (i) through trademark registration, (2) without registration, if the mark is used in commerce and has acquired recognition in the marketplace as a trademark in the relevant market sector, and (3) if it is a well-known trademark within the terms of Article 6*bis* of the Paris

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Ongeoorloofde mededinging (looseleaf), IV.6, no. 314. The protection of shop fixtures and fittings or the 'trade dress' of a business is of particular importance to businesses that use franchising as a business model. See Slagter (1963), p. 97-98; Molenaar, Handel in goede naam (Openbare les), Tilburg, 1970; Kneppers-Heynert, Een economische en juridische analyse van franchising tegen de achtergrond van een property rights- en transactiekostenbenadering, diss.

<sup>21</sup> This category of exceptions includes the case of a defendant who uses a (similar) trademark, but *not* in the course of trade. See e.g. District court of The Hague (interlocutory proceedings) 5 October 2004 (Lijst Pim Fortuin). In this case some members of the Dutch political party LPF (Lijst Pim Fortuin) had broken away from the party but were still using the name LPF. This use of the trademark LPF was considered to be unlawful under 6:162 BW

<sup>22</sup> The rules on comparative advertising, as codified in Article 194a-196 BW, may be applicable in these cases as well.

<sup>23</sup> ECJ 9 January 2003 (Davidoff/Gofkid).

<sup>24</sup> Section 13A,1,C Benelux Trademark Act, cf. Section 5(2) of the Trade Marks Directive.

<sup>25</sup> Section 13A,1,D Benelux Trademark Act, cf. Section 5(5) of the Trade Marks Directive.

Convention<sup>26</sup>. The framework for protection of famous and well-known trademarks in relation to dissimilar goods or services had previously been based upon the law of unfair competition and the law of torts under the general civil law. Under that system protection could be granted without considering whether the mark had been used as a trademark, or whether there was a likelihood of confusion. The provisions of the New Trademark Act are applied to prevent unauthorized registration of well-known trademarks pursuant to Article 4(4) (a) and upon the provision of rights surrounding well-known trademarks under to Article 5(2) of the Trademark Directive.

In practice, well-known status is of significance in four situations and the requirements placed on the mark's recognition level are different in each case. These situations are divided into the following cases:

- Marks with market recognition: high distinctiveness; lower percentage levels of recognition (from around 20% to over 70%)<sup>27</sup>.
- Well-known marks: higher distinctiveness; higher percentage levels of recognition (around 60%)<sup>28</sup>.
- Marks known in Germany: high distinctiveness; known in Germany minimum percentage of recognition 30%<sup>29</sup>.
- Famous marks: the highest level of distinctiveness and recognition; more factors considered; minimum percentage of recognition excess of 80%<sup>30</sup>.

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<sup>26</sup> Frederick Mostert, "Famous and Well-known Marks - An international Analysis", (Butterworths 1997), page 283.

<sup>27</sup> Idem, page 288. See more: BGH GRUR 1960, page 130 - Sunpearl case; GRUR 1963, page 622 - Sunkist case; BGH GRUR 1974, page 337 - Stonsdorfer case.

<sup>28</sup> Frederick Mostert, "Famous and Well-known Marks - An international Analysis", (Butterworths 1997), page 289. See also: Sack, GRUR 1995, pages 81, 91 with further references.

<sup>29</sup> Idem, page 290. See also: BGH GRUR 1991, page 465, 466 - Salomon case; BGH GRUR 1985, page 550, 551 - Dimple case.

In Spain well-known trademarks regulates by the legislation Law 17/2001 of December 7, 2001, on Trademarks. In Chapter III Trademark law of Spain that prescribed unregistered trademarks which, on the application or priority date of the trademark being examined, are “well known” in Spain within the meaning of Article 6*bis* of the Paris Convention and so The provisions of this Article shall apply to an unregistered trademark “well known” in Spain within the meaning of Article 6*bis* of the Paris Convention, except as provided in paragraph 2(c)

Well-known trademarks have been regulated by the Directive (First Counsel Directive 89/104 EEC of 21st December 1988 to approximate the laws of the member states relating to Trademarks) providing that any member may stipulate the protection of a well-known national trademarks under the same conditions. The provision also foresees the concept and definition of a well-known trademark and the cases in which it is stated that a trademark infringement exists. The referred provision was harmonized in the national Trademark Act 17/2001 of 7 December 2001. Following the Trademark Law Revision of 2001, well-known trademarks in Spain have been more clearly defined and granted broader protection in the concept of being “well-known” and “reputed” trademarks.

A special mention should be made of the strengthening of the protection for known and famous trademarks. For these purposes, a legal definition of the concept of a known and well-known trademark is established for the first time in our legal system, whereby the scope of its protection is fixed. A known trademark is that known in the relevant public sector for which its goods or services are intended and, if it is registered, it

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<sup>30</sup> Idem, page 291. See also: BGH GRUR 1991, page 863-866 – Avon case.

enjoys protection above and beyond the principle of specialization, depending on the extent to which it is known, while if it is not protected its owner is entitled not only to take the corresponding action for invalidation, as hitherto, but also to oppose the registration using administrative means. Where a trademark is known to the public in general, it is considered to be famous and the scope of its protection extends to any type of goods or services. The same protection is granted to a known as to a famous registered trademark.

In Great Britain well known trademarks regulates by the legislation Trade Marks Act which adopted in 1994. Section 56 of the *Trade Marks Act 1994* expressly makes Article 6bis of the *Paris Convention* and Article 16 of TRIPS protecting “well-known marks” part of UK domestic legislation. References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who –

a) is a national of a Convention country, or

b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom.

The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

Section 56 of the Trade Marks Act 1994 confers upon the owner of the well-known mark the right to an injunction to restrain use of an identical or similar mark in the UK which is used for identical or similar goods or services where there is a likelihood of confusion. These rights are lost if the owner acquiesces for five years or more or the third party commenced use prior to the 31st October 1994. Well-known marks may form the basis of opposition or invalidation proceedings.

Thus, under currently applicable Uzbekistan's law, the concept of well-known trademark is generally accorded the meaning of the term in Article 6*bis* of the Paris Convention. This is similar to EU law since both Uzbekistan and all EU Member States are members of the Paris Convention. This may explain the similarities between the two systems in approaching the general concept of well known trademark. However, there seems to be a significant difference between EU law and Uzbekistan law on how the concept is to be interpreted and understood in practice. While in Uzbekistan the notion of well-known trademark is defined in the statute, the EU legal system has no statutory definition of the notion but indirectly interprets it through case law. The EU legislation also seems to prefer to use a definition of a mark with a reputation rather than the well-known trademark.

In Uzbekistan, the term "well known trade mark" has not been statutorily defined. However, by the legislation of Uzbekistan states that signs may not be considered and protected as trademarks if they are "identical with or confusingly similar to another person's mark which has been widely used and recognized for similar or identical goods or services before the filing date or the priority date". Thus even though the Law does not refer directly to the term "well known trade mark", it states an equivalent



concept, the so-called “widely used and recognized trademark” a concept that has been frequently utilized to evaluate the distinctiveness of signs treated as trademarks. There is no further definition which clarifies this concept in the Law or its explanatory documents.

Trademark lawyers and practitioners in Uzbekistan unofficially recognize a similar term known as “widely used and recognized marks” to define trademarks which rank in between ordinary and well-known trademarks. In the Uzbekistan’s perspective a trademark which is widely used and recognized is considered to be at a lower ranking in comparison with a well-known trademark and is therefore not treated as a separate subject protection.

In Uzbekistan, even though the subject matter of protection for well-known trademarks was defined in Trade mark Act of Uzbekistan which adopted in 2001 31 of august, the factors to be considered in determining well-known trademarks were not defined either in legislation or in practice until enactment of the 2001 Trade mark Act and its guidance documents. Under Uzbekistan law a trademark’s reputation is an important factor to be considered when making determinations regarding well known trademarks.

The 2001 Trade mark Act was the first to recite the requirement that the reputation of a trademark shall be considered as well-known if a “number of relevant consumers” have been aware of it and it has a “wide reputation of goods or services bearing the mark.” There seems to be some confusion between the terms “reputation of trademark” and “reputation of goods and services bearing the mark” in Uzbekistan legislation. While they are two different terms with different meanings, a close relationship between the two is not so easily discerned. The reputation of a trademark is created and

ensured through the reputation of goods or services and similarly, the reputation of goods or services bearing the mark is enhanced and ensured by the reputation of the trademark. Thus, this provision of Uzbekistan Law can be seen as an affirmation of the requirement of the existence of a trademark's reputation for determining whether that trademark is well-known or not.

There is an important European legal principle relating to trademark protection which holds that the scope of protection is not limited to similar goods and services. The scope of protection is expanded for marks with reputation to cover the use of similar marks on dissimilar goods or services when such use damages, or takes unfair advantage of, the reputation of earlier mark<sup>31</sup>. This can be seen as an echo of the doctrine of trademark dilution.

In Europe, however, the term "trademark dilution" is not expressly stated in the legislation or in the case-law. Some commentators refer to Articles 4(4) (a) and 5(2) of the Trademark Directive as anti-dilution laws<sup>32</sup>, loosely modeled on those in place for many years in the Benelux and other European countries<sup>33</sup>. Before the Trademark Directive, these anti-dilution laws were in force in several European countries. These include national trademark laws, such as Benelux trademark law, or segments of unfair

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<sup>31</sup> See *Marca Mode v. Adidas* [2000] E.T.M.R. 561 for the Opinion of the Advocate General, and [2000] E.T.M.R 723 for the decision of the ECJ. See also: Spyros M. Maniatis (Senior Lecturer in IP, Queen Mary University of London) Article "Trademark Law and Domain Names: Back to Basics?", *European Intellectual Property Review*, 2002, page 398.

<sup>32</sup> Cornish & Llewelyn, "Intellectual Property", §17-99, third edition (2003). See also: Thomas McCarthy, "Dilution of a Trademark: European and United States law compared", the *Trademark Reporter* Vol. 94 TMR, page 1163.

<sup>33</sup> T. Martino, "Trademark Dilution", (1996) page 100. See also: *Case C-375/97, General Motors Corporation v. Yplon SA*, [1999] 3 C.M.L.R. 427, paragraph 28.

competition law, such as in Germany. However, the word “dilution” is absent from the Directive<sup>34</sup>.

Following the purpose of the thesis this chapter seeks to analyze well-known trademark protection under European and Uzbekistan law through a comparative analysis. This comparison has been made concerning both the theoretical background and practices in well-known trademark protection in the two systems. Within the scope of the thesis as well as in this chapter, the author has no intention of comparing all legal matters embraced in well-known trademark protection but only to emphasize important and common issues. On that basis, and consistent with the given targets, we have reached the following conclusions:

First, as regards the definition of a well-known trademark, even though both European and Uzbekistan law are derived from the legal regime of the protection of well-known trademark of Article *6bis* of the Paris Convention, there still remain some differences between the two systems in defining what a well-known trademark actually is. While European law seems to avoid using the term “well-known trademark” and focuses more on the concept of mark with a reputation, Uzbekistan law is more faithful to the original concept of the Paris Convention. Uzbekistan’s law unofficially recognizes the special term “widely used and recognized mark” to indicate trademarks which rank in between ordinary trademarks and well-known trademarks. This is different from the concept of mark with a reputation under European law.

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<sup>34</sup> Thomas McCarthy, “Dilution of a Trademark: European and United States law compared”, the Trademark Reporter Vol. 94 TMR, page 1163.

Second, concerning the criteria for determining well-known trademarks, while Uzbekistan law attempts to build up a set of criteria for determining well known trademarks, European legislation has made no specific references to such criteria. However, in the case law, European courts have applied similar criteria suitable to the circumstances of particular cases. Furthermore, because of the differences between these specific circumstances, there remain some gaps between the two systems in the application of criteria for determining well known trademark.

Third, regarding the basic legal grounds for the protection of well-known trademarks, despite the differences in interpretation and application, both European and Uzbekistan law have established the requirement of likelihood of confusion as a very important element of well-known trademark protection. However, concerning the doctrine of trademark dilution, there remains a substantial difference between the two systems. Although there has been no official recognition in the statutes, the doctrine of trademark dilution has been applied quite frequently by European courts. Meanwhile, the doctrine of trademark dilution continues to be foreign to Uzbekistan lawmakers and practitioners.

Fourth, on the scope of protection for well-known trademarks, European and the Uzbekistan law have a similar approach to expanding protection for well-known trademark to unregistered trademarks, dissimilar goods and services, noncompeting goods and services within an unlimited period. However, the specific reasoning and foundations for such expansions of the scope of protection are not identical.

This comparative investigation has presented a detailed picture of the European Union and Uzbekistan legal systems regarding well-known

trademark protection. However, it should be noted that another purpose for making such comparisons is to review the Uzbekistan's legal systems' status in order to make suggestions for future improvements.

In sum, over time, especially with the appearance of the new law for protecting well-known trademarks, the Uzbekistan's legal system for well-known trademark protection has had a significant success. *First*, the law has stated clearly cases where the authorities must refuse the application of registration for a sign as trademark. Accordingly, any trademark may not be used for any goods/services when regarded as identical or confusingly similar to a well-known trademark, and the use of such mark prejudices the distinctiveness of the well-known trademark or its registration, or if it aims to take advantage of the prestige and goodwill of the well-known trademark will be excluded from registration. *Second*, the law explicitly stipulates that the use of signs, which are identical, or confusingly similar to a well-known trademark, constitute acts of infringement if such use could lead to the likelihood of confusion as to the origin of goods, or imply the wrong perception about the business relationship between the person using the sign and the well-known trademark owner. *Finally*, there are the definitions of the jurisdiction and the specific measures applied to the enforcement of intellectual property rights and trademark protection in particular. Therefore, it is not an exaggeration to conclude that the Uzbekistan's legal system for well-known trademark protection is quite complete and conforms to international legal standards.

## References

1. The Paris Convention for the Protection of Industrial Property was enacted on 20 March 1883, signed by more than 100 countries, come into effect on 7 March 1884, has been amended several times at Brussels on 14 December 1900, at Washington on 2 June 1911, at the Hague on 6 November 1925, at London on 2 June 1934, at Lisbon on 31 October 1958, and at Stockholm on 14 July 1967; and as amended on 28 September 1979. It is amended

2. See Article 16(2) of TRIPs Agreement

3. Xuan-Thao Nguyen, The other Famous Marks Doctrine, the Article was solicited as part of the "International and Comparative Aspects of Trade mark Dilution" Symposium, Transnational Law & Contemporary Problems, Vol. 17, pp. 757-773, Fall 2008.

4. Lile Deinard and Amy Stasik, The Famous Marks Doctrine under the Paris Convention - Is the remedy available to foreign entities in the Second Circuit?, New York Law Journal, October 16, 2006.

5. Мюллер В.К. 70 000 слов и выражений. Изд. 14-е, стереотип. - М.: «Советская Энциклопедия», 1969. - С.912.

6. Junqin Z. Protection of well-known in China // China Patents and Trademarks. - 2001. - V. 66. - №3. - P. 40-44.

7. See the Section 56(1) - Trade mark Act 1994.

8. In March 1995, the Federal Trade mark Dilution Act of 1995 (H.R 1295) was introduced by Representative Carlos J. Moorhead, the chairman of the House Judiciary Subcommittee on Courts and Intellectual Property. The bill created a new Section 43 (c) of the Lanham Act (1995, 15 U.S.C. section 1125 (c)) to provide the owner of a famous, federally registered mark with relief against another person's "commercial use in commerce" of a mark if

such use causes dilution of the distinctive quality of the registrant's mark. This provision has been amended continuously under the Trade mark Dilution Revision Act (TDRA) which became effective on October 6, 2006.

9. Law dated January 4, 1991, codified into Chapter VII of the French Intellectual Property Code, last amended by the Act No. 2003-706 dated August 1, 2003.

10. WIPO national seminar on Intellectual Property, The protection of well-known trade marks, Cairo, February 17 to 19, 2003.

11. Regulations on the Recognition and Protection of Well-known trade marks in China ("Well-known Trade marks Regulations" or "Recognition Rules") came into force in 2003.

12. Yvonne Chua, Howard Tsang, "Legislative changes boost status of well-known marks", Magazine: MANAGING INTELLECTUAL PROPERTY, London: Dec. 2002/Jan. 2003, page 75.

13. Loke-Khoon Tan, Pirates in the Middle Kingdom - The ensuing Trade mark Battle, second edition, (Sweet and Maxwell Asia 2007), para. 3.7, page 43.

14. В.Пирогова. Европейский опыт охраны общеизвестный знаков. ИС. Промышленная собственность. № 3, 2006. С 22.

15. In March 1995, the Federal Trade mark Dilution Act of 1995 (H.R 1295) was introduced by Representative Carlos J. Moorhead, the chair man of the House Judiciary Subcommittee on Courts and Intellectual Property. The bill created a new Section 43 (c) of the Lanham Act (1995, 15 U.S.C. section 1125 (c)) to provide the owner of a famous, federally registered mark with relief against another person's "commercial use in commerce" of a mark if such use causes dilution of the distinctive quality of the registrant's mark. As

a result of concerns voiced by the Administration at the Committee Hearing, the requirement that the famous mark be registered to be entitled to protection against dilution was deleted so as not to undercut the United States' position that famous marks should be protected regardless of whether they are registered in the country where protection is sought.

16. Frederick Mostert, "Famous and Well-known Marks - An international Analysis", (Butter worths 1997), page 18.

17. See e.g. HR 28 June 1929, NJ 1929, 1750 (EMM); President District Court The Hague 10 September 1971, BIE 1972, no. 33, p. 79 where the sign REDDY for *inter alia* vegetable oils and fats was diluted, but protection against confusion was still possible under unfair competition law; President District Court Zwolle 4 June 1982, BIE 1982, no. 33, p. 82.

18. See e.g. President District Court Haarlem 29 May 1990, IER 1990, no. 52, p. 106 upheld by Court of Appeal Amsterdam 18 October 1990, BIE 1992, no. 34, p. 122. Slogans can, alternatively, in some cases be protected under copyright law, see Spoor/Verkade, Auteursrecht en naburige rechten, Deventer: Kluwer 1993, no. 77 (recently a new 3d edition has been published in 2005).

19. See e.g. HR 26 June 1953, NJ 1954, no. 90 (Ph.A.N.H.); President District Court Haarlem 17 May 1971, BIE 1972, no. 30, p. 69; President District Court Breda 4 January 1974, BIE 1976, no. 8, p. 41; President District Court Amsterdam 20 December 1979, BIE 1982, no. 4, p. 19; President District Court The Hague 28 June 1996, BIE 1997, no. 34, p. 215. Advertisements, other than slogans, can be protected under copyright law as well, see Spoor/Verkade (1993), no. 77.



20. See e.g. President District Court The Hague 26 February 1982, BIE 1982, no. 71, p. 218; President District Court Utrecht 6 January 1983, BIE 1983, no. 63, p. 176; President District Court Haarlem 13 October 1989, BIE 1991, no. 6, p. 20; President District Court Zutphen 26 July 1990, see Court of Appeal Arnhem 18 June 1991, BIE 1992, no. 83, p. 328. A title of a book or periodical will, however, in many cases fall within the scope of protection of the Benelux

21. Trademark Act or Trade Names Act

22. See e.g. Court of Appeal Arnhem 1 April 1970, NJ 1970, no. 392; Court of Appeal Den Bosch 7 February 1979, NJ 1980, no. 178. Logos will, however, in many cases fall within the scope of protection of the Benelux Trademark Act or Trade Names Act.

23. See e.g. Court of Appeal Leeuwarden 15 February 1995, BIE 1996, no. 98, p. 360 and President District Court Groningen 3 July 1987, BIE 1988, no. 67, p. 230. See for more case law Van Nispen, *Ongeoorloofde mededinging* (looseleaf), IV.6, no. 314. The protection of shop fixtures and fittings or the 'trade dress' of a business is of particular importance to businesses that use franchising as a business model. See Slagter (1963), p. 97-98; Molenaar, *Handel in goede naam* (Openbare les), Tilburg, 1970; Kneppers-Heynert, *Een economische en juridische analyse van*

24. *Franchising tegen de achtergrond van een property rights- en transactiekostenbenadering*, diss.

25. This category of exceptions includes the case of a defendant who uses a (similar) trademark, but *not* in the course of trade. See e.g. District court of The Hague (interlocutory proceedings) 5 October 2004 (Lijst Pim Fortuin). In this case, some members of the Dutch political party LPF (Lijst

Pim Fortuin) had broken away from the party but were still using the name LPF. This use of the trademark LPF was considered to be unlawful under 6:162 BW

26. The rules on comparative advertising, as codified in Article 194a-196 BW, may be applicable in these cases as well.

27. ECJ 9 January 2003 (Davidoff/Gofkid).

28. Section 13A, 1, C Benelux Trademark Act, cf. Section 5(2) of the Trade Marks Directive.

29. Section 13A, 1, D Benelux Trademark Act, cf. Section 5(5) of the Trade Marks Directive.

30. Frederick Mostert, "Famous and Well-known Marks - An international Analysis", (Butterworth's 1997), page 283.

31. Idem, page 288. See more: BGH GRUR 1960, page 130 - Sunpearl case; GRUR 1963, page 622 - Sunkist case; BGH GRUR 1974, page 337 - Stonsdorfer case.

32. Frederick Mostert, "Famous and Well-known Marks - An international Analysis", (Butter worths 1997), page 289. See also: Sack, GRUR 1995, pages 81, 91 with further references.

33. Idem, page 290. See also: BGH GRUR 1991, page 465, 466 - Salomon case; BGH GRUR 1985, page 550, 551 - Dimple case.

34. Idem, page 291. See also: BGH GRUR 1991, page 863-866 - Avon case.

35. See *Marca Mode v. Adidas* [2000] E.T.M.R. 561 for the Opinion of the Advocate General, and [2000] E.T.M.R 723 for the decision of the ECJ. See also: Spyros M. Maniatis (Senior Lecturer in IP, Queen Mary University of

London) Article “Trademark Law and Domain Names: Back to Basics?”, European Intellectual Property Review, 2002, page 398.

36. Cornish & Llewelyn, “Intellectual Property”, §17-99, third edition (2003). See also: Thomas McCarthy, “Dilution of a Trademark: European and United States law compared”, the Trademark Reporter Vol. 94 TMR, page 1163.

37. T. Martino, “Trademark Dilution”, (1996) page 100. See also: Case C-375/97, General Motors Corporation v. Yplon SA, [1999] 3 C.M.L.R. 427, paragraph 28.

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