

mark is registered, in case the earlier mark has a reputation<sup>790</sup> and “the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.<sup>791</sup> This provision protects registered trade marks with a reputation, in certain circumstances, against abuse of their unique drawing power, even if the goods and/or service classes the conflicting signs relate to are neither identical nor similar and there exists no likelihood of confusion. It transfers the abovementioned<sup>792</sup> principle laid down in Art. 16(3) TRIPs to the European level.<sup>793</sup>

Next to the requirement of identity or similarity of the marks in question, Art. 8(5) CTMR provides that the older mark must have a reputation, either in the European Community in the case of a Community trade mark or in a Member State in case of a national mark. The CTMR does neither stipulate what ‘reputation’ in this sense means nor whether ‘reputation’ differs from the term ‘well-known’ as laid down in Art. 6<sup>bis</sup> Paris Convention. The European Courts have developed a case law definition for ‘reputation’ yet it remains unclear whether there is a difference between the two terms. For instance, the ECJ held in *General Motors v Yplon*<sup>794</sup> that a trade mark must be known by a significant part of the public concerned in a substantial part of the relevant territory in order to have a reputation. Furthermore, in the course of assessing the issue of reputation, it was held that one should take into account the intensity, geographical extent and duration of the mark’s use, its market share and the size of the investment made in promoting it. It was argued in this case that a mark did not have to be well-known in the sense of the above-mentioned Paris Convention provisions in order to have a reputation.<sup>795</sup> However, the ECJ did not comment on this issue.

Hence, quantitatively, a certain level of publicity is necessary for a trade mark

790 A reputation in the Community in case of a CTM and a reputation in a Member State in case of a national trade mark.

791 Similarly, § 9(1) Nr. 3 MarkenG stipulates the same with respect to German trade marks or trade mark applications respectively.

792 Cf. above at fn. 757.

793 In contrast, the issue of enforceability of unregistered well-known trade marks is left for the Member States as EU legislation does not address the requirement of Art. 6<sup>bis</sup> Paris Convention to allow a well-known unregistered mark to be asserted against the use of a younger mark.

794 Judgment of 14 September 1999, Case C-375/97, [1999] ECR I-5421, *General Motors Corporation v. Yplon SA*.

795 *Ibid.* at para. 13.