

process between seller and target audience as a result of which the mark is perceived as a sign of origin of the respective goods or services.

The later TRIPs Agreement extends the application of the Paris Convention to all WTO Member States pursuant to its Art. 2(1) which specifies that WTO Members “shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967)”. Hence, the TRIPs Agreement incorporates, through its Art. 2, all substantive provisions of the Paris Convention, making them binding on all WTO Members, whether or not they are signatories of the Paris Convention.<sup>756</sup>

Furthermore, Art. 16(2) TRIPs extends the scope of Art. 6<sup>bis</sup> Paris Convention in a number of ways. For instance, it extends Art. 6<sup>bis</sup> Paris Convention to protect service marks. Unlike Art. 6<sup>bis</sup> Paris Convention, Art. 16(2) TRIPs provides some guidance as to under which circumstances a mark is well-known. According to this provision, one shall take into account “the knowledge of the trade mark in the relevant sector of the public, including knowledge in the Member [*i.e. Member State to the WTO, A/N*] concerned which has been obtained as a result of the promotion of the trade mark.”. The mere mention of promotion means that the respective mark need not actually be used to the extent that there are sales of marked goods or services in the respective country.<sup>757</sup>

The priority of well-known marks is more difficult to detect than the one of registered trade marks. Whereas the priority of registered marks depends on the date of application, the point in time at which a mark becomes well-known is decisive for its protection under Art. 6<sup>bis</sup> Paris Convention (in countries where this provision is held to be self-executing) and the related domestic laws respectively.<sup>758</sup> Evidence of a trade mark application can be

756 This is named the “Paris Plus Approach”, cf. *Kur*, GRUR Int. 1994, 987, 989.

757 In addition, Art. 16(3) TRIPs extends the application of Art. 6<sup>bis</sup> Paris Convention to the protection of registered well-known trade marks from unauthorised use of the mark on non-competing, unrelated goods or services provided that this “would indicate a connection between those goods or services and the owner of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use.”. Herewith, the protection of well-known marks is extended beyond similarity, the traditional realm of protection of registered trade marks. Hence, a registered well-known mark is protected from its use on dissimilar goods or services in a manner which blurs or tarnishes its unique drawing power – a central component of the value of the well-known mark in question. This section 5.7 deals with the protection of unregistered marks only. For more on protection of registered trade marks beyond cases of double identity and likelihood of confusion cf. below at 5.12.

easily provided, yet proprietors of well-known marks often encounter factual difficulties to prove the priority of the mark in question, as they are forced to rely upon not merely sales and advertising figures but also, for instance, market surveys with past-related questions or reverse projection of current empirical data.<sup>759</sup>

### 5.7.3 Trade Marks Acquired Through Use

According to § 4 Nr. 2 MarkenG, a sign can attain protection as a trade mark in case it is used in trade or commerce and this use has led to a recognition by the relevant public that the sign is a mark of the claimant (*Verkehrsgeltung*).<sup>760</sup> As this definition suggests, a trade mark acquired through use<sup>761</sup> does not accrue by merely initialising use of a sign in trade or commerce. Rather, trade mark protection must be ‘acquired’, i.e. such use must lead to connection of the respective signage with a certain meaning by the target audience, enabled by continued usage of the sign in trade or commerce. Hence, use marks are, like well-known marks, the result of a communication process between proprietor (or licensee/franchisee) and target audience in which the audience has learned to perceive the respective signage as an indication of origin of the marked goods and/or services.<sup>762</sup>

Whereas the object of protection in case of a registered trade mark is the sign as shown in the register, the use mark is protected as it is in fact being used in trade or commerce. Also, it needs to be precisely determined for which goods and/or services the sign at issue can claim protection as a use mark. Contrary to a trade mark registered with the German Patent and Trade Mark Office, a use mark’s protection does not automatically accrue for the whole German territory. Rather, one must identify the region in which the respective sign is used – this can be Germany at large or merely a certain region, for instance one or several *Bundesländer* (federal states).<sup>763</sup>

758 For instance, § 4 Nr. 3 MarkenG refers to Art. 6<sup>bis</sup> Paris Convention as laying down one of three possibilities for trade mark protection to accrue (next to registration and secondary meaning).

759 *Marx, Deutsches, europäisches und internationales Markenrecht*, at no. 384.

760 This possibility of origination of trade mark protection is equally listed next to the two other possibilities, registration (§ 4 Nr. 1 MarkenG) and notoriety/well-known marks (§ 4 Nr. 3 MarkenG).

761 In German: *Benutzungsmarke*.

762 *Marx, Deutsches, europäisches und internationales Markenrecht*, at no. 584.

763 *Hasselblatt/Raab*, § 36 no. 71.