

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.

to have a reputation within the public concerned. Whether the relevant part of the public consists of the public at large or a specific part thereof depends on the type of marked goods/services. In the light of the criteria mentioned in the preceding paragraph, assessment on a case-by-case basis is necessary while the law does not require certain percentage levels.<sup>796</sup> However, as a practical rule of thumb, one can say that a degree of awareness within the relevant audiences of approximately 40-50% and higher should suffice.<sup>797</sup>

As to the abovementioned requirements of unfair advantage or detriment to the distinctive character or the repute of the earlier mark, Advocate General *Jacobs* observed in *Adidas-Salomon v Fitnessworld Trading*<sup>798</sup> that the taking of unfair advantage concerns free-riding where the defendant is using its mark to trade on the reputation of another. Detriment to the distinctive character of a trade mark – this reflects what is generally referred to as dilution – is existent where the use of the defendant’s mark is likely to blur the distinctiveness of the older mark so that it is “no longer capable of arousing immediate association with the goods for which it is registered and used”.<sup>799</sup> Detriment to the reputation of a mark, also referred to as tarnishment, occurs where the association between the infringing sign and the registered mark can damage the reputation of the latter in such way that its power of attraction is reduced.

The detriment Art. 8(5) CTMR seeks to protect the reputable mark of results from a certain degree of similarity between the signs in question causing the audience to establish a connection between them without confusing them. Hence, absent the prerequisite of likelihood of confusion, there exists the unwritten requirement of a link to the reputable mark in the minds of the relevant audience, created by the use of the junior mark.<sup>800</sup> Whether or not

796 Cf. e.g. CFI, judgment of 6 February 2007, Case T-477/04, [2007] ECR II-399, *Aktieselskabet af 21. November 2001 v. Office of Harmonization for the Internal Market (Trade Marks and Designs) (OHIM) – TDK*, at para. 49.

797 *Hasselblatt/Hasselblatt*, § 38 at no. 123.

798 Opinion of Mr Advocate General *Jacobs* delivered on 10 July 2003, Case C-408/01, [2003] ECR I-12537, *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd*.

799 *Ibid.* at para. 37.

800 Cf. e.g. ECJ, judgment of 23 October 2003, Case C-408/01, [2003] ECR I-12537, *Adidas-Salomon AG and Adidas Benelux BV v. Fitnessworld Trading Ltd – Adidas-Salomon v Fitnessworld Trading* and CFI, judgment of 25 May 2005, Case T-67/04, [2005] ECR II-1825 *Spa Monopole, compagnie fermière de Spa SA/NV v. Office of Harmonization for the Internal Market (Trade Marks and Designs) (OHIM) – SPA-FINDERS*. This requirement is roughly equivalent to the requirement of Art. 16(3)