Q234: Relevant Public for Determining Degree of Recognition

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Q234. Relevant public for determining the degree of recognition of famous marks, well-known marks and marks with reputation
In the United States, the relevant public for "famous marks" is defined by statute for trademark dilution purposes: "a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner."
The term "well-known marks" is used in several treaties and international agreements to which the U.S. is a party, and in the WIPO recommendations which the U.S. supports, but there is limited case law using that term. Where the term is used, the relevant public is a limited set of the general public, typically, those who purchase the goods or services in question.
The term "marks with a reputation" is not normally used, and does not have a generally accepted definition in the United States. However, a mark's reputation – in the sense of how widely it is recognized, or whether a descriptive term has acquired trademark distinctiveness through use and promotion – would be measured by considering a limited set of the general public, such as, those who purchase the goods or services in question.
1. How is the relevant public for purposes of determining the degree of recognition of famous, well-known and reputed marks defined in your jurisdiction? Is it the general public at large or a relevant sector of the public that is considered to be the relevant public in determining the knowledge, recognition or fame of a mark?
2. Please clarify whether your jurisdiction uses several of the terms discussed in sections 22-26. If so, is the “relevant public” construed differently when determining the recognition of famous marks, well-known marks and marks with reputation respectively (and, if applicable, marks subject to another term)? Is the assessment made based on the same criteria?
3. If the relevant public can be a limited sector of the public please respond (if applicable with reference to statutory provisions and/or case law) to the following questions.

(a) Please briefly describe the criteria for determining the relevant public. Is consideration taken e.g. to age, gender, geography, culture, groups with special interests, sophistication/skill of the consumer? Is consideration taken to the way the goods or services with the trademark in question are marketed?
(b) Would the relevant public be populated by actual/potential consumers/buyers of the products/services in question only or a larger public? Please explain how the delimitation is made.

(c) Could the relevant public be composed of business/professional end consumers?

(d) Could the relevant public be composed of people in the trade of the goods or services in question, such as distributors, licensees and retailers?
(e) Could the relevant public be “mixed” in a sense that it is composed of persons involved in trade, professional/business end customers and private end customer?

(f) How limited in terms of quantification can the relevant sector of the public be to constitute the relevant public? Is there a clear established “lowest level”?

(g) Is it possible to see any differences for different products/industry sectors in respect of the delimitation of the relevant public?
Analysis of Current Law and Case Law

4. Are there any differences between the “relevant public” concept when assessing the recognition of trademarks in respect of e.g. dilution, free riding, or when determining likelihood of confusion in infringement proceedings?

5. When does the assessment of the relevant public come into play e.g. in registration matters, proceedings in respect of wrongful use such as free riding, dilution, infringement proceedings, and opposition proceedings?
6. Is the relevant public determined by a test, a specific procedure or in some similar manner, or rather on a case-by-case basis? Please give a brief description of how the test or analysis is made.
Is harmonization desired? If yes, please respond to the following questions.

1. Is it the general public at large or a particular sector of the public that should be considered as the relevant public in determining the knowledge, recognition or fame of a mark?

2. Please briefly set out the criteria to be used when establishing the relevant public for determining the degree of recognition of famous marks, well-known marks and marks with reputation.
Proposals for Harmonization

3. Should the relevant public be construed differently for famous marks, well-known marks or marks with a reputation? If so, please define the terms used and describe what criteria is to be used for the different types of mark.

4. Would it be possible or desired to establish a test or a specific method of establishing the relevant public or should this be done on a case-by-case assessment? How should the test or analysis be made?
In the United States, the relevant public for "famous marks" is defined by statute for trademark dilution purposes: "a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." The term "well-known marks" is used in several treaties and international agreements to which the U.S. is a party, and in the WIPO recommendations which the U.S. supports, but there is limited case law using that term. Where the term is used, the relevant public is a limited set of the general public, typically, those who purchase the goods or services in question. The term "marks with a reputation" is not normally used, and does not have a generally accepted definition in the United States. However, a mark's reputation – in the sense of how widely it is recognized, or whether a descriptive term has acquired trademark distinctiveness through use and promotion – would be measured by considering a limited set of the general public, such as, those who purchase the goods or services in question.
Thank you!

Questions?
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Griff Price
Griff Price has been involved in commercial litigation, focusing on intellectual property trials and appeals, for more than 35 years. He has an extensive background in the procedural and substantive aspects of IP litigation in the federal courts, as well as federal and state appellate courts. Griff has served as lead counsel and/or otherwise participated in trials of dozens of patent, trademark, trade secret, unfair competition, antitrust, and related cases. His current practice focuses on patent, trade secret, and trademark, trade dress, and false advertising infringement litigation for clients in a variety of industries and technical fields. He also counsels clients on prosecuting trademarks and trademark and trade secret protection and enforcement. He has extensive experience in the field of damages analysis and damages litigation in IP cases.

Griff has taught trademark law at George Washington Law School and has written and lectured extensively on a wide variety of IP law topics, is a former member of the Boards of Directors of both AIPLA and INTA (formerly USTA), is a member of the Board of Editors of the *AIPLA Quarterly Journal* and a former member of the Board of Editors of *The Trademark Reporter*, and is an AIPLA Fellow.