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Well-Known, or Not Well-Known? That is the Question. The Paris Convention for the Protection of Industrial Property's Article 6*bis* in the Context of American Trademark Law

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*With an interconnected world, products and services can be exchanged instantaneously, and what people may have considered as foreign can now be within their grasp. This brings a multitude of legal questions, including how to protect the trademark rights of companies that may not yet have an extensive place in the American economy, but may soon. Article 6*bis* of the Paris Convention on the Protection of Industrial Property emphasizes that countries may refuse to register a trademark within their own borders if that trademark is one that is well-known in another country. The United States has agreed to that principle by adopting the Paris Convention and reaffirming the so-called “well-known marks” doctrine in subsequent treaties. But as of now, courts are split as to how to implement this idea into domestic law.*

*This split can be resolved. Read together under the lens of a canon of construction that emphasizes the United States' role in adhering to international law, three sections of the Lanham Act—the statutory scheme that provides for federal recognition of trademarks—imply that Article 6*bis* and the well-known marks doctrine do in fact have a role in domestic law. This Note presents this argument by first providing a short discussion of the relevant law and history, then arguing that despite certain shortcomings in the ability to implement the Paris Convention in*

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domestic law, there is still a way to read the well-known marks doctrine as being protected through the Lanham Act.

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INTRODUCTION

Despite the recent political debates regarding the issue of globalization, the world is clearly becoming more and more interconnected on a daily basis. People can travel more easily, access information within seconds, and even purchase goods and services across borders. Thus, the economies of each country on the globe can be dependent on the citizens of different states. This brings up a multitude of questions on a variety of issues, but one of the most important questions is the role trademarks play in this global economy. If one goes even deeper, there are thousands of questions that come up with this issue.

In this Note, I will focus on one aspect of trademark law: the well-known marks doctrine, as first explained in Article *6bis* of the Paris Convention for the Protection of Industrial Property (“Paris Convention”).¹ This doctrine states that “[i]f a mark used only on products or services sold abroad is so famous that its reputation is known in the United States, then that mark should be legally recognized in the United States.”²

This doctrine has been well-established in treaty law and has been reiterated in subsequent intellectual property treaties following the original draft of the Paris Convention.³ But there is a debate as to whether it is also established in the domestic law of the United States. The Ninth Circuit said it is, acknowledging the growing importance of products crossing borders. However, the Second Circuit refused to abide by this understanding, holding that established American trademark law did not invoke the doctrine in the plain meaning of its terms.⁴

This issue has raised an eclectic range of questions. What is a well-known trademark? If a foreign company wants to sell its products or services in the United States, how can it protect its trademark within U.S. borders? Similarly, what happens when a foreign company infringes the well-known trade name or service mark of an American-based company in commerce within American borders or abroad? In that vein, how do the traditional methods of testing the strength of a trademark hold up in the new global economy? Can a foreign business enforce its trademark rights derived in a foreign country against a user in the United States? In either situation, would a court examining this question apply U.S. law, an international treaty, or both? American courts and legal scholars have debated these issues, but no pertinent, specific answers have come up.⁵ Simply, there is a lot of uncertainty about what to do to answer these questions. This was most evident when the Ninth Circuit and Second Circuit courts adopted completely opposite viewpoints on whether the well-known marks doctrine has a domestic effect, creating a circuit split that has yet to be resolved.⁶

1. Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as revised at Stockholm, July 14, 1967, 21 U.S.T. 1583, 1648, 828 U.N.T.S. 305, 337 [hereinafter Paris Convention].

2. 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 29:4 (5th ed.).

3. See, e.g., North American Free Trade Agreement Canada-Mexico-United States, art. 1708, Dec. 8, 1993, 32 I.L.M. 605, 673; TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, The Legal Texts: The Results of the Uruguay Round of Multilateral Trade Negotiations 320 (1999), 33 I.L.M. 1197, 1869 U.N.T.S. 299 (1994) [hereinafter GATT TRIPS].

4. *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 164 (2d Cir. 2007), *certified question accepted*, 8 N.Y.3d 994 (2007), *and certified question answered*, 9 N.Y.3d 467 (2007) (holding that despite treaty obligations, the United States has not invoked the “well-known marks” doctrine in federal law); *Grupo Gigante SA De CV v. Dallo & Co.*, 391 F.3d 1088, 1094 (9th Cir. 2004) (holding that the doctrine does exist in federal law as an “exception to the territoriality principle”).

5. See cases cited *supra* note 4; see also sources cited *infra* notes 15, 19.

6. See cases cited *supra* note 4.

Because the global marketplace is ever-changing, parties litigating trademark issues in federal courts are increasingly advocating for the recognition and application of exceptions to the traditional principle of U.S. trademark law.⁷ Under this traditional principle, a party acquires rights only through actual use of a trademark in the United States.⁸ But international law—generally and as applied to trademark rights—has long recognized a principle of territoriality localizing such property rights, which may not exactly require “use” as a prerequisite for trademark protection.⁹

In recognizing the greater role trademarks and other forms of intellectual property play in the global economy, many nations of the world adopted the Paris Convention in 1883.¹⁰ It has since been revised numerous times, with the most recent version coming as the Stockholm Act, adopted in 1967.¹¹ Today, there are 195 States Parties to the Stockholm Act.¹²

The purpose of the Article *6bis*, and subsequently, the well-known marks doctrine, is to avoid the registration and use of a trademark, liable to create *confusion* with *another* mark already *well-known in the country of such registration or use*, although the latter well-known mark is not, or not yet, protected in that country by a registration which would normally prevent the registration or use of the conflicting mark.¹³ In today’s interconnected globe and economy, foreign marks can accrue a well-known distinction much more easily. For instance, many scholars have evaluated the role the Internet plays in the global economy¹⁴ and how trademark law may be affected by it. Additionally, easier global travel lets people more easily find marks from other countries, and foreign companies can now try and make their

7. See cases cited *supra* note 4.

8. See 3 MCCARTHY, *supra* note 2, § 19:1 (citing Grand Canyon West Ranch, L.L.C. v. Hualapai Tribe, 78 U.S.P.Q.2d 1696 (TTAB 2006) (“It is clear that an applicant cannot obtain a registration under Section 1 of the Trademark Act for goods or services upon which it has not used the mark.”)).

9. 5 MCCARTHY, *supra* note 2, § 29:1.

10. *WIPO-Administered Treaties*, WORLD INTELL. PROP. ORG., http://www.wipo.int/treaties/en/ActResults.jsp?act_id=31 [<https://perma.cc/2RLE-NBWQ>] (last visited Jan. 25, 2019).

11. 5 MCCARTHY, *supra* note 2, § 29:22.

12. *WIPO-Administered Treaties*, *supra* note 10.

13. G.H.C. BODENHUASEN, GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY 90 (1968), http://www.wipo.int/edocs/pubdocs/en/intproperty/611/wipo_pub_611.pdf [<https://perma.cc/W4G9-RN3S>].

14. Joshua Clowers, *On International Trademark and the Internet: The Lanham Act’s Long Arms*, 13 RICH. J.L. & TECH. 1 (2006) (stating that “[t]he Internet’s influence has brought the necessity for comprehensive international standards for trademark protection to a critical point, and regardless of which direction we go from here, the result must reflect the reality of our globalized commercial society. Any proposed solution that neglects to adequately address this reality is a failure on its face and will only serve to further complicate the issue.”); see also Sheldon W. Halpern, *A High Likelihood of Confusion: Wal-Mart, TrafFix, Moseley, and Dastar—The Supreme Court’s New Jurisprudence*, 61 N.Y.U. ANN. SURV. AM. L. 237, 239 (2005) (arguing that “the growing international and transnational nature of commerce, the spread of digital technology, and the ubiquity of the Internet, which together have provided a fertile ground for new trademark battles, have accompanied a broad legislative and judicial expansion of fundamental trademark concepts.”); Dan L. Burk, *Trademark Doctrines for Global Electronic Commerce*, 49 S.C. L. REV. 695 (1998).

marks well-known through online advertising. But there must be more discussion as to the role Article 6bis plays in the domestic context and how to resolve the circuit split.

Historically, there has been an inconsistent application of the well-known marks doctrine by the United States as between domestic and foreign companies. U.S. companies, quite frankly, are not shy about using the doctrine to protect their well-known trademarks. Indeed, there have been numerous instances where American companies used the well-known marks doctrine to protect their respective famous trademarks across the globe. One example is that of the ubiquitous American coffee powerhouse Starbucks. Before 2005, the well-known STARBUCKS trademark had not been used on coffee shops in Russia. That year, a Russian entrepreneur registered the STARBUCKS coffee trademark and logo. He then offered to sell the Russian rights to the U.S. owner of the mark for \$600,000. But Russian authorities ruled that the Russian registration was “pirated” and cancelled it at the behest of the U.S. owner.¹⁵ Similarly, in 2014, the U.S. maker of Tesla electric vehicles was about to introduce its products to China. However, before it could do so, the company found that a Chinese person had in 2006 registered, without use, the TESLA mark for automobiles in China. This was three years after Tesla’s first use in 2003 in the United States. Using the well-known marks doctrine, the U.S. company was successful in having the Chinese authorities invalidate the registration.¹⁶

These are some of the numerous instances in which American companies have been able to cancel the registration of their well-known marks by a non-affiliated foreign party. However, the United States does not always afford the same protection to foreign companies. Simply put, “the United States cannot expect other nations to protect famous American trademarks if United States courts decline to afford reciprocal protection to famous foreign marks.”¹⁷ The U.S. is a signatory to numerous intellectual property treaties that provide protection to well-known

15. 5 MCCARTHY, *supra* note 2, § 29:61 (citing *Starbucks Wins Trademark Battle in Russia*, MOSNEWS (Nov. 17, 2005), <http://www.mosnews.com/money/2005/11/17/starbucks.shtml> [<https://web.archive.org/web/20060324025107/http://www.mosnews.com/money/2005/11/17/starbucks.shtml>]); Susan J. Keri, *Starbucks Trademark Victory in Russia*, INT’L TRADEMARK ASSOC. (Mar. 15, 2006), <https://www.inta.org/INTABulletin/Pages/StarbucksTrademarkVictoryinRussia.aspx> [<https://perma.cc/P3VB-X4DE>].

16. Even though Tesla ended up invalidating the Chinese registration, it was sued for infringement by the Chinese registrant while proceedings were pending. To clear up the matter, Tesla had to enter into a settlement with the (at the time) Chinese trademark holder. Samuel Shen & Norihiko Shirouzu, *Tesla Resolves Trademark Dispute in China*, REUTERS (Aug. 5, 2014, 8:31 PM), <http://www.reuters.com/article/us-tesla-motors-china-idUSKBN0G606420140806> [<https://perma.cc/RM4P-NQ9C>]; see also Sophie Brown, *Brand Wars: Battling China’s Trademark Squatters*, CNN, <http://www.cnn.com/2014/07/17/world/asia/china-trademark-squatters-penfolds> [<https://perma.cc/CX87-ZJVP>] (last updated July 17, 2014) (describing Tesla case and providing other examples of trademark trolls using famous American marks).

17. *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 164 (2d Cir. 2007).

marks.¹⁸ The application of this principle has thus been relatively hypocritical, and the United States must get beyond this legal two-facedness.

This inconsistent application must be resolved. Under the Lanham Act, the well-known marks doctrine should be applied for the protection of foreign marks as an exception to the “use” principles of territoriality. Therefore, well-known foreign marks should be registerable in the United States upon a good faith showing of actual famousness and use in a particular region. Courts should thus incorporate Article 6*bis*’ well-known marks doctrine in disputes involving foreign companies seeking trademark rights in the United States. Simply put, the well-known marks doctrine should be applicable in domestic trademark registration and litigation.

Numerous scholars have analyzed and debated the well-known marks doctrine and the resulting circuit split over the past few years. However, only a few have evaluated Article 6*bis* and considered whether it directly binds the United States.¹⁹ Some pieces have conducted a self-execution analysis (as I do in Section II(A) below), but these happen in the context of other Articles in the Paris Convention.²⁰ Further, this Note is different because it incorporates analysis of the Second Circuit’s decision, which other scholarship has not done.

To provide further support to the research and work already devoted to this arena of trademark law analysis, I will present my findings in a different fashion. This Note will examine whether the treaty has immediate effect on American law, analyze where the two circuits have split, and attempt to remedy that split. I will address the remedy in two ways. First, I will argue that the Lanham Act, through a trinity of sections, has the well-known marks doctrine impliedly tied into its language. This will come from a reading of the statute that differs from the interpretation the Second Circuit took in *ITC*. Additionally, I will reflect on the opinions of Professor J. Thomas McCarthy and reiterate his recommendation that the Lanham Act should be amended to incorporate the doctrine into its text directly.

18. See treaties cited *supra* note 3.

19. See, e.g., Jamey Minnihan, *Having Your Cake and Eating It Too: U.S. Treatment of Well-Known Foreign Trademarks and Its Global Market Implications*, 50 GONZ. L. REV. 219, 220 (2015); Robert C. Bird & Elizabeth Brown, *The Protection of Well-Known Foreign Marks in the United States: Potential Global Responses to Domestic Ambivalence*, 38 N.C. J. INT’L L. & COM. REG. 1 (2012); Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 YALE J. INT’L L. 405, 406 (2010); Lee Ann W. Lockridge, *Honoring International Obligations in U.S. Trademark Law: How the Lanham Act Protects Well-Known Foreign Marks (and Why the Second Circuit Was Wrong)*, 84 ST. JOHN’S L. REV. 1347, 1348 (2010); James Faris, *The Famous Marks Exception to the Territoriality Principle in American Trademark Law*, 59 CASE W. RES. L. REV. 451 (2009); Xuan-Thao Nguyen, *The Other Famous Marks Doctrine*, 17 TRANSNAT’L L. & CONTEMP. PROBS. 757 (2008); Geri L. Haight & Philip Catanzano, *The Effects of Global Priority of Trademark Rights*, 91 MASS. L. REV. 18 (2007). But cf. Brandon Barker, *The Power of the Well-Known Trademark: Courts Should Consider Article 6*bis* of the Paris Convention an Integrated Part of Section 44 of the Lanham Act*, 81 WASH. L. REV. 363 (2006) (arguing that Article 6*bis* is not self-executing, but providing arguments that a plain reading analysis of Lanham Act sections 44(b), 44(h), and 44(i) “reveals that the Paris Convention’s well-known marks doctrine is a part of federal trademark law”). Note that the Barker article was published before the Second Circuit’s decision in *ITC* and the resulting circuit split.

20. See sources cited *supra* note 19.

In this Note, I will discuss how best to resolve the circuit split. To do so, I divide my analysis into four main parts. In Part I, I will first provide a background of two important areas of American federal law—trademark protection and treaty interpretation in the domestic context. From there, I will transition into a short description of the Paris Convention and the well-known marks doctrine. Subsequently, I will discuss the issues presented with the doctrine, from controversies over territoriality to the split of authority between the Ninth and Second Circuit Courts of Appeal. The background may seem lengthy, but it is necessary to provide the appropriate context for the issues. Once I establish the necessary background for this Note, Part II will analyze Article *6bis* in two different contexts. First, I will examine whether Article *6bis* is self-executing. This means that I will evaluate whether domestic courts can use this provision and read it as applying directly into American law from the treaty itself, rather than through actual legislation. Following that discussion, Part III will demonstrate that despite whatever result comes from the self-execution analysis, Article *6bis* and its protection of well-known marks is in fact applicable under United States law through a trinity of sections of the Lanham Act. Therefore, this Note will argue against the Second Circuit’s interpretation of the Act’s plain meaning and assert that the well-known marks doctrine does in fact have a place in domestic law. Finally, Part IV will discuss the next steps that must be taken regarding the implementation of the well-known marks doctrine. Thus, foreign parties should be able to bring actions for trademark infringement of their well-known marks in United States courts, request cancellation of the registered infringing marks, and seek damages and injunctive relief for any infringement of their well-known trademarks.

I. BACKGROUND

A. The Lanham Act and Its Role in Protecting Trademarks in the United States

A trademark is a designation specifically used to “identify the goods of a person.”²¹ To become recognized as a trademark, the designation must identify the source of one seller’s goods and distinguish that source from other sources.²²

The first federal trademark statute was enacted in 1870, but it was held unconstitutional because it was not limited to interstate commerce. The Supreme Court thus found that this statute was beyond Congress’s powers under the copyright and patent clause.²³ Congress then enacted a statute in 1881 applicable only to marks used in commerce with foreign nations and Indian tribes.²⁴ Thereafter, Congress utilized its commerce clause powers to enact the “first modern

21. Lanham Act § 45, 15 U.S.C. § 1127 (2016).

22. 1 MCCARTHY, *supra* note 2, § 3:1.

23. *In re Trade-mark Cases*, 100 U.S. 82 (1879).

24. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt e. (AM. LAW INST. 1995).

federal trademark registration statute” in 1905.²⁵ The 1905 statute was then replaced by the current federal trademark statute, the Lanham Trade-Mark Act, in 1946.²⁶

There are two primary purposes behind trademark law. First, it serves to protect consumers from deception and confusion over trade symbols.²⁷ Second, trademark law serves to protect a potential plaintiff’s infringed trademark as property.²⁸ Indeed, “[t]he law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting consumers from confusion as to source.”²⁹ Simply, “the keystone of that portion of unfair competition law which relates to trademarks is the avoidance of a likelihood of confusion in the minds of the buying public.”³⁰

Moreover, trademarks play a role in the global marketplace and in each individual market society. “Trademarks are a universal phenomenon in that the legal system of almost every nation in the world recognizes some form of identification of the source and quality of goods.”³¹ Further, “in free market economies, trademarks are legally recognized and protected as an inherent feature of the marketplace and of consumer protection.”³²

It is important to understand what exactly can constitute a trademark and how the Lanham Act serves to protect the two interests discussed above. “A trademark is a word, name, symbol, device, or other designation, or a combination of such

25. *Id.*

26. *See* Lanham Act, 15 U.S.C. §§ 1051–1157 (2012).

27. *See* 1 MCCARTHY, *supra* note 2, § 2:2 (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 766 n.4 (1992) (Stevens, J., concurring) (“The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.”).

28. *Id.*

29. *See* 1 MCCARTHY, *supra* note 2, § 2:8 (referencing as example *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 382 (5th Cir. 1977)) (“Unfair competition is a common law tort that occurs when one business entity ‘palms off’ its products as those of another The determinative question is whether the tortfeasor’s practices are likely to mislead customers into believing that the product emanates from or has been endorsed by the claimant.”); *see also* *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28 (2003) (“The Lanham Act was intended to make ‘actionable the deceptive and misleading use of marks,’ and ‘to protect persons engaged in . . . commerce against unfair competition.’”); *Two Pesos*, 505 U.S. at 773 n.15 (“[T]he protection of trademarks and trade dress under § 43(a) serves the same statutory purpose of preventing deception and unfair competition.”); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (“The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting consumers from confusion as to source.”).

30. *See* MCCARTHY, *supra* note 29.

31. 1 MCCARTHY, *supra* note 2, § 2:6 (4th ed.) (citing PINNER’S ENCYCLOPEDIA OF WORLD UNFAIR COMPETITION LAW (2d ed. 1979); TRADEMARKS THROUGHOUT THE WORLD (West Group); DIGEST OF COMMERCIAL LAWS OF THE WORLD: PATENTS AND TRADEMARKS (L. Nelson 1982); LADAS, PATENTS, TRADEMARKS AND RELATED RIGHTS: NATIONAL AND INTERNATIONAL PROTECTION (1975)).

32. *Id.*

designations, that is distinctive of a person's goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others."³³ Similarly, "[a] service mark is a trademark that is used in connection with services."³⁴

By establishing a uniform federal trademark law in the 1940s, "Congress determined that a sound public policy requires that trademarks should receive nationally the greatest protection that can be given them."³⁵ The Lanham Act was designed to "unify the common law of unfair competition and trademark protection."³⁶ Additionally, to provide a large scope of relief, Congress adopted the Lanham Act in broad rather than constricting language.³⁷

Congress had authority to enact the Lanham Act because it regulates conduct which is deemed to occur in interstate or foreign commerce. Unlike its power over regulating patents and copyrights, Congress does not garner its ability to regulate this arm of intellectual property law from Article One, Section Eight, Clause Eight of the Constitution.³⁸ Instead, it is derived from Congress's power to legislate in matters of interstate and foreign commerce under Article One, Section Eight, Clause Three.³⁹ Additionally, trademark law can be applied to extraterritorial matters.⁴⁰

The Lanham Act provides that no mark used in interstate commerce can be refused registration, unless it meets a statutory bar. Subject to some exceptions, a mark may be refused registration if it "consists or comprises of" either: (1) "immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute";⁴¹ (2) "the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of

33. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (AM. LAW INST. 1995); *see also id.*, cmt. g (expanding on this definition. "The subject matter of trademark law was initially limited to fanciful or arbitrary words and symbols. This limitation excluded not only descriptive words and symbols, but also other devices that could identify the source of goods, such as the physical appearance of the goods or the appearance of labels, wrappers, containers, or advertising materials that accompany the goods in the marketplace. When such features in fact served to distinguish the goods of a particular producer, they were protected, together with descriptive marks, in an action for unfair competition. As the distinctions between the actions for trademark infringement and unfair competition diminished, the law of trademarks eventually subsumed descriptive designations that had acquired significance as indications of source.").

34. *Id.*

35. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985) (quoting S. REP. NO. 1333, 79th Cong., 2d Sess. 6 (1946)).

36. *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 846 n.2 (1982).

37. *See* Joseph P. Bauer, *A Federal Law of Unfair Competition: What Should Be the Reach of Section 43(a) of the Lanham Act?*, 31 UCLA L. REV. 671, 679–81 (1984) (describing Congress's intent in drafting the Lanham Act).

38. Clowers, *supra* note 14, at 5.

39. *Id.*

40. *Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952).

41. Lanham Act § 2(a), 15 U.S.C. § 1052(a) (2012).

any foreign nation”;⁴² (3) “[a] name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President”;⁴³ or if it is (4) so close to another mark as to cause confusion or mistake.⁴⁴ Moreover, if the mark is either: (1) merely descriptive or misdescriptive; (2) “primarily geographically descriptive”; (3) “primarily geographically deceptively misdescriptive”; (4) primarily a surname; or (5) functional, then the mark may be refused registration.⁴⁵ However, if the mark is either: (1) descriptive or misdescriptive, (2) primarily geographically descriptive, or (3) primarily a surname, then it may be granted registration if it has acquired secondary meaning.⁴⁶

And what is secondary meaning? Secondary meaning is a term of art “used generally to indicate that a mark . . . has come through use to be uniquely associated with a specific source.”⁴⁷ The Supreme Court has explained that “[t]o establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term *is to identify the source of the product rather than the product itself*.”⁴⁸ As noted, a key feature of trademark law is to protect consumers. Simply, if a consumer recognizes a mark and associates it with a supplier of goods or services rather than associating the mark with the goods or services themselves, the mark has acquired secondary meaning.

Finally, the key vehicle for bringing claims for infringement of unregistered marks comes under Lanham Act section 43(a)(1)(A). This section is “the only provision in the Lanham Act that protects an unregistered mark.”⁴⁹ Moreover, “[i]ts purpose is to prevent customer confusion regarding a product’s source . . . and to enable those that fashion a product to differentiate it from others on the market.”⁵⁰ Under this section,

[a]ny person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which is *likely to cause confusion*, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a

42. *Id.* § 1052(b).

43. *Id.* § 1052(c).

44. *Id.* § 1052(d).

45. *Id.* § 1052(e).

46. *Id.* § 1052(f).

47. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 766 n.4 (1992) (Stevens, J., concurring) (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13, cmt. e (Tentative Draft No. 2, 1990)).

48. *Id.* (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982)) (emphasis added).

49. *Centaur Commc’ns, Ltd. v. A/S/M Commc’ns, Inc.*, 830 F.2d 1217, 1220 (2d Cir. 1987).

50. *Id.* (citation omitted).

civil action by any person who believes that he or she is likely to be damaged by such act.⁵¹

It is necessary to note the role of this section because plaintiffs invoking the well-known marks doctrine in federal court will most likely be advocating for an unregistered mark—one that was instead taken by someone within the United States. Further, as I will discuss later, section 43(a), coupled with 44(b) and 44(h), impliedly provides a legal recognition of the doctrine.

B. The Paris Convention and Its Role in Protecting Trademarks Across the Globe

In 1970, the United States Senate ratified Articles 13–30 of the Paris Convention for the Protection of Industrial Property (“Paris Convention”).⁵² Three years later, President Richard Nixon—through the advice of the Senate—ratified the first twelve Articles.⁵³

The Paris Convention is the foundation of international trademark law,⁵⁴ as reflected in Article 6(3). Under this Article, “[a] mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.”⁵⁵ The Paris Convention goes on to contain a “national treatment” tenet supporting this approach to trademark law jurisdiction, emphasizing that

[n]ationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereinafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.⁵⁶

Professor McCarthy summarizes the history of and intent behind the Paris Convention as follows:

The Paris Convention is essentially a compact between the various member nations to accord in their own countries to citizens of the other member nations trademark and other rights comparable to those accorded their own citizens by their domestic law. The underlying principle is that foreign nationals should be given the same treatment in each of the member countries as that country makes available to its own citizens. The Convention is not premised upon the idea that the trademark laws of each member nation shall be given extraterritorial application, but on exactly the

51. Lanham Act § 43(a), 15 U.S.C. § 1125 (2012).

52. Paris Convention, *supra* note 1, at art. 6.

53. *Id.* at art. 2.

54. See generally Curtis A. Bradley, *Territorial Intellectual Property Rights in an Age of Globalism*, 37 VA. J. INT'L L. 505 (1997).

55. Paris Convention, *supra* note 1, at art. 6(3).

56. *Id.* at art. 2(1).

converse principle that each nation's law shall have only territorial application. Thus, the Paris Convention creates nothing that even remotely resembles a "world mark" or an "international registration." Rather, it recognizes the principle of the territoriality of trademarks: a mark exists only under the laws of each sovereign nation.⁵⁷

C. *The Well-Known Marks Doctrine*

Among the various Articles within the Paris Convention is the subject of this Note—Article 6*bis*, entitled "Marks: *Well-Known Marks*."⁵⁸ Under this Article, States Party agree to refuse registration of a reproduction, imitation, or translation of a mark that is considered "well known" if it is likely to cause confusion.⁵⁹

Article 6*bis* was introduced into the Paris Convention by the Revision Conference of The Hague in 1925. It was later modified by the Revision Conferences of London in 1934 and of Lisbon in 1958. At the latter Conference, the Article was very thoroughly discussed. Its application, which formerly concerned only the refusal or cancellation of the registration of a mark conflicting with a mark which is well known in the country concerned, was then extended to a prohibition of the use of the mark first mentioned.⁶⁰

The Paris Convention's Article 6*bis* is considered the cornerstone of international protection of well-known marks.⁶¹ Subsequent treaties take this language and expand upon it. For instance, the Trade Related Aspects of Intellectual Property of the General Agreement on Tariffs and Trade ("GATT TRIPS") expressly references and extends the doctrine. GATT TRIPS Article 16(1) extends this idea to service marks and requires that these marks be well-known only to a "relevant sector of the public."⁶²

The three sections of the Paris Convention's Article 6*bis* provide that

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

57. 5 MCCARTHY, *supra* note 2, § 29:25 (referencing *Vanity Fair Mills v. T. Eaton Co.*, 234 F.2d 633 (2d Cir. 1956)).

58. Paris Convention, *supra* note 1, at art. 6*bis*.

59. *Id.*

60. BODENHAUSEN, *supra* note 13, at 89.

61. 5 MCCARTHY, *supra* note 2, § 29:62.

62. GATT TRIPS, *supra* note 3, at art. 16(2).

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.⁶³

Article 6*bis*'s purpose is to avoid the registration and use of a trademark, liable to create *confusion* with *another* mark already *well known in the country of such registration or use*. This comes into play even if the latter well-known mark is not protected in that country by a registration which would normally prevent the registration or use of the conflicting mark.⁶⁴

This doctrine differs depending on which country is evaluating it. But generally, the well-known marks doctrine “is a concept under which a trademark or service mark is protected within a nation if it is well-known in that nation, even though the mark is not actually used or registered in that nation.”⁶⁵ Marks can become known in a nation through various means, even in the absence of sales.⁶⁶ These methods include “advertising in internationally distributed media, such as magazines or television, by returning travelers who saw the mark in other nations, or by discussion in local media by reporters and commentators.”⁶⁷

The United States, however, does not have a specific category of marks defined as “famous” or “well-known.” “This is because U.S. law protects a mark against infringement or registration by another, even in the absence of registration, if it is so well known in the United States that confusion is likely to result.”⁶⁸

“The well-known marks doctrine is especially important in nations that do not recognize (or have very narrow recognition of) common law rights in unregistered marks.”⁶⁹ Further, “[i]n many nations of the world, a mark is not protected from an infringing use or registration by another unless it is registered in that nation for those particular goods.”⁷⁰ Unlike the United States, “[m]any nations do not recognize unregistered, or common law, rights in marks.” Thus, “[t]he well-known marks doctrine is an exception to that rule. Even in those nations, a trademark or service mark is protected if it is well-known in that nation even though the mark is not actually used or registered in that nation.”⁷¹ Further, Article 6*bis* alone will

63. Paris Convention, *supra* note 1, at art. 6*bis*.

64. BODENHAUSEN, *supra* note 13, at 90.

65. 2 MCCARTHY, *supra* note 2, § 11:78.

66. *Id.*

67. *Id.*

68. *Id.*

69. 5 MCCARTHY, *supra* note 2, § 29:61.

70. *Id.*

71. *Id.*

protect a well-known mark for only “identical or similar *goods*.”⁷² Because of this limitation,

Kraft arguably could not enjoin the use of KRAFT on cigarette lighters (assuming most countries would consider food products and cigarette lighters to be unrelated goods). Furthermore, United Air Lines could not enjoin the use of MILEAGE PLUS on frequent flyer programs because the Paris Convention does not protect service marks.⁷³

In many nations, a mark is not protected from an infringing use or registration by another unless it is registered in that nation for a set of particular goods or services; indeed, many nations do not recognize unregistered, or common law, rights in marks.⁷⁴ The well-known marks doctrine is an exception to that rule. Unlike in the United States, a well-known trademark can be protected in another Paris Convention nation even though the mark is not actually used or registered in that nation.⁷⁵ So then, “[o]ne common use of the doctrine is to fight trademark pirates who rush to register a well-known mark on goods on which it has not yet been registered in a nation by the legitimate foreign owner.”⁷⁶

Moreover, a trademark may be *well known* in a country before its registration there and, in view of the possible repercussions of publicity in other countries, even before it is *used* in the state. The question of whether a trademark is well known in a country will be determined by its competent administrative or judicial authorities.⁷⁷

Finally, a Member State is not *obliged* to protect well-known trademarks which have not been used within its territory. However, it will be free to do so depending on its own judicial and legislative applications.⁷⁸ Further, the protection of well-known marks applies only with respect to other marks filed, registered, or used for *identical or similar goods*. Evaluation of whether this condition is fulfilled is done by the administrative or judicial authorities of the country in which protection is claimed.⁷⁹

With the relevant legal background established, I will now provide a brief discussion of the primary issues presented with the “well-known marks” doctrine. I first focus on principles of territoriality. Then, I will provide a short evaluation of the facts and legal analysis the Ninth and Second Circuits took when the circuits made their respective differing decisions on the validity of the doctrine in American jurisprudence.

72. 3 MARY M. SQUYRES & NANETTE NORTON, TRADEMARK PRACTICE THROUGHOUT THE WORLD § 27:3 (2018) (emphasis in original).

73. *Id.*

74. 5 MCCARTHY, *supra* note 2, § 29:61.

75. *Id.*

76. *Id.* § 29:25.

77. BODENHAUSEN, *supra* note 13, at 91.

78. *Id.*

79. *Id.*

*D. The Problem**1. Territoriality Principles*

Because the United States recognizes common law trademark rights, the well-known marks doctrine can strike at odds with established legal theories of territoriality—the idea that “trademark rights exist in each country solely according to that country’s statutory scheme.”⁸⁰ Whether or not the well-known marks doctrine can be invoked in American law as an exception to territoriality principles is the primary question behind the circuit split at issue.

In the international trademark context, there has been a shift as to the scope of geographical protection provided to trademarks based on which mark holder came first. The two most common views in this priority analysis are the universality and territorial understanding of trademark protection.

The universality principle “stands for the proposition that a trademark serves the sole purpose of identifying the source of a product. Under this principle, a trademark is valid if it correctly identifies the origin or source of the product, regardless of where the consumer purchases the product.”⁸¹ This was the American view until 1923.⁸²

In *A. Bourjois & Co. v. Katzel*, the United States Supreme Court moved away from the universality principle and towards a territorial understanding of trademark priority. Here, the plaintiff purchased a French cosmetic firm’s American business and used its goodwill and trademarks on face powder.⁸³ Then, the plaintiff continued to sell the French firm’s face powder, using “substantially the same form of box and label for its predecessors,” but selected only colors “suitable for the American market.”⁸⁴ These boxes and labels had “come to be understood by the public [in the United States] as meaning goods coming from the plaintiff.”⁸⁵ The plaintiff sued a third party manufacturer who purchased the same exact face powder and resold it in the United States using the original French boxes for trademark infringement.⁸⁶ The Court held that the plaintiff’s trademark rights were actually infringed.⁸⁷ Justice Holmes reasoned that the “monopoly of a trade-mark . . . deals with a delicate matter that may be of great value but that easily is destroyed, and therefore should be protected with corresponding care.” So, he explained that “it is the trade-mark of the plaintiff only in the United States and indicates in law, and, it is found, by public understanding, that the goods come from the plaintiff although

80. *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 599 (5th Cir. 1985).

81. *Am. Circuit Breaker Corp. v. Or. Breakers Inc.*, 406 F.3d 577, 581 (9th Cir. 2005) (quoting 1 JEROME GILSON & ANNE GILSON LALONDE, *TRADEMARK PROTECTION AND PRACTICE* § 4.05[5] (2004)).

82. *See A. Bourjois & Co. v. Katzel*, 260 U.S. 689 (1923).

83. *Id.* at 690.

84. *Id.* at 691.

85. *Id.*

86. *Id.*

87. *Id.*

not made by it.”⁸⁸ Further, the plaintiff’s goods were “sold and could only be sold with the good will of the business that the plaintiff bought. It stakes the reputation of the plaintiff upon the character of the goods.”⁸⁹ Simply, the Court explained that defendant’s use of the mark misrepresented the origin of the goods, and the plaintiff was deprived the marketplace advantage it expected from owning the U.S. trademark rights it acquired from the French company. In reaching this decision, the Court dismissed the concept of a universality scope of trademark rights.

Now, the American trademark system comports with what is known as the territoriality principle of trademark law. Under the territoriality principle, a trademark is recognized as having a separate existence in each sovereign territory in which it is registered or legally recognized as a mark.⁹⁰ In the United States, this territoriality of marks doctrine is “basic to American trademark law.”⁹¹ Thus, a mark’s ability to be well-known is confined to its national territory, until it is used in the United States.⁹² Since this shift, the territoriality principle continues to play an extensive role in American trademark jurisprudence.

The Paris Convention also follows the territoriality doctrine. In explaining the territoriality principle under the context of the Paris Convention, Professor McCarthy says, with an example

[T]he Paris Convention recognizes that a U.S. registered trademark for foreign-made goods can have a separate legal existence in the United States and that this separate mark and its good will are assignable. That is, manufacturer Alpha may own the mark in France, but exclusive importer Zeta may own the mark in the United States, if it is validly assigned by Alpha. Similarly, a U.S. company with international operations may split the company territorially and sell off the international part of its business, retaining only the domestic portion.⁹³

88. *Id.* at 692.

89. *Id.* (citation omitted).

90. *Buti v. Perosa, S.R.L.*, 139 F.3d 98 (2d Cir. 1998) (applying the territoriality rule to service marks); 2 *LADAS*, *supra* note 31, § 732; 5 *MCCARTHY*, *supra* note 2, § 29:1 (“The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country’s statutory scheme.” (citing *Person’s Co., Ltd. v. Christman*, 900 F.2d 1565 (Fed. Cir. 1990))).

91. *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 155 (2d Cir. 2007); *accord* *Topps Co. v. Cadbury Stani S.A.I.C.*, 526 F.3d 63, 70 (2d Cir. 2008) (holding that the legal effect of an assignment of a trademark in Argentina is not to be judged by U.S. trademark law, but by Argentinean law); *id.* (“The principle of territoriality is fundamental to trademark law. A trademark has a separate legal existence under each country’s laws, and trademark rights exist in each country solely according to that nation’s laws.”); *see also* *RESTATEMENT (THIRD) OF UNFAIR COMPETITION* § 24, cmt. f (AM. LAW INST. 1995) (“The premise of the universality principle that trademarks necessarily identify the original manufacturer has been rejected in our domestic law.”).

92. *Person’s*, 900 F.2d at 1569–70 (finding the Japanese trademark “Person’s,” though known in Japan, has no reputation in the United States; thus, the known foreign mark had no priority in the United States, and an argument under Article 6*bis* could not be applicable to the instant case); *see also* *Grupo Gigante SA De CV v. Dallo & Co.*, 391 F.3d 1088, 1093 (9th Cir. 2004) (“The territoriality principle . . . says that [p]riority of trademark rights in the United States depends solely upon priority of use in the United States, not on priority of use anywhere in the world.” (internal quotations omitted)).

93. 5 *MCCARTHY*, *supra* note 2, §29:1.

In American domestic law, the territorial scope of an unregistered mark is limited to the territory in which the mark is known and recognized by those in the defined group of potential customers.⁹⁴ Further, the national senior user of an unregistered mark cannot stop the use of a territorially “remote” good faith national junior user who was first to use the mark in that territory.⁹⁵

Again, territoriality principles are important because of the various issues deriving from the circuit split. The Ninth Circuit held that the well-known marks doctrine was an exception to this rule. However, the Second Circuit held it was not. *This* dispute is the reason for the circuit split.

2. *The Circuit Split*

In 2005, the Ninth Circuit held that the well-known marks doctrine does have effect in domestic law, but it described the doctrine as a “famous mark exception.”⁹⁶ In *Grupo Gigante SA De CV v. Dallo & Co., Inc.*, Mexican company Grupo Gigante was able to stop an American company from using its name for a grocery store chain. The court held that the mark “Gigante” for a large chain of grocery stores in Mexico was sufficiently well-known among Mexican-Americans in Southern California. The court found that, prior to Grupo Gigante’s 1999 entry into the United States’ market by opening Gigante stores in Los Angeles, the Mexican company had already created rights superior to the Dallo brothers first use in 1995 of Gigante in San Diego. Thus, the mark had seniority over the Dallo brothers’ Gigante grocery stores. The District Court found that the Mexican mark was well-known in the United States because it had become clear that the mark had developed a secondary meaning in the Southern California territory. But the parties knowingly co-existed on opposite sides of the border for four years before Grupo Gigante filed suit. This led the District Court to find an estoppel by laches, barring any injunction.⁹⁷

The Ninth Circuit found on appeal that the evidence did not support a summary judgment decision that Grupo Gigante’s Mexican Gigante mark was in fact well-known in Southern California prior to the Dallo brothers’ 1995 first use there. However, the appellate court found that U.S. law did recognize such an exception to the normal rule of territoriality: the well-known mark exception.

In ruling that Grupo Gigante had trademark rights over the Dallo brothers, the Ninth Circuit stated the following:

We hold . . . that there is a famous mark exception to the territoriality principle. While the territoriality principle is a long-standing and important doctrine within trademark law, it cannot be absolute. An absolute territoriality rule without a famous-mark exception would promote consumer confusion

94. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 100 (1918); *see also* *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 415–16 (1916); 5 MCCARTHY, *supra* note 2, § 26:2.

95. *United Drug Co.*, 248 U.S. at 100.

96. *Grupo Gigante*, 391 F.3d at 1094.

97. *Id.* at 1092.

and fraud. *Commerce crosses borders*. In this nation of immigrants, so do people. Trademark is, at its core, about protecting against consumer confusion and “palming off.” There can be no justification for using trademark law to fool immigrants into thinking that they are buying from the store they liked back home.⁹⁸

But, in 2007, the Second Circuit completely disagreed. In *ITC Ltd. v. Punchgini, Inc.*, the Second Circuit examined the trademark rights of an Indian corporation. As part of its analysis, the court evaluated the role the well-known marks doctrine plays in American law. It is important to know the facts of the case before discussing the Second Circuit’s conclusion.

ITC Limited and ITC Hotels Limited are Indian corporations, and they held the registered United States trademark “BUKHARA” for restaurant services. Defendants Punchgini, Inc., Bukhara Grill II, Inc., and others were former employees of ITC’s Bukhara restaurant, which closed in 1991. After the closure, the defendants opened their own restaurant using the BUKHARA mark. The plaintiffs sued the defendants in the Southern District of New York, claiming that defendants’ use of a similar mark and related trade dress constituted trademark infringement, unfair competition, and false advertising in violation of federal and state law. Judge Lynch granted summary judgment for the defendants because plaintiffs had abandoned their mark. While plaintiff once had a Bukhara restaurant in New York, it closed in 1991 after five years of operation. However, the plaintiffs continued to operate Bukhara restaurants in four locations in Asia. Thus, on appeal, the plaintiffs asserted that the well-known marks doctrine nevertheless permitted them to sue defendants for unfair competition, because its continued international use of the mark led to a federally protected right.⁹⁹

Unlike the Ninth Circuit, the Second Circuit refused to find that the well-known marks rule was a part of federal law to give plaintiff a ground to assert infringement. In so doing, it concluded that Congress had not yet incorporated that doctrine into federal trademark law.¹⁰⁰ This ruling was contrary to the Ninth Circuit view noted above and created a split of authority among the circuits. Despite treaty obligations, the Second Circuit held that well-known marks doctrine does not provide a cause of action because it has not yet been incorporated into federal law.¹⁰¹ In reaching that holding, the court analyzed the plain meaning of the Lanham Act’s various sections for an express and explicit recognition of the well-known marks doctrine as embodied in the Paris Convention and in the TRIPS Agreement.¹⁰² But because the statute did not explicitly recognize the rule in its words, the court concluded that it was not a part of U.S. federal law.¹⁰³ The court also rejected the

98. *Id.* at 1094 (emphasis added).

99. *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 142 (2d Cir. 2007).

100. *Id.*

101. 5 MCCARTHY, *supra* note 2, §29:4.

102. *See ITC*, 482 F.3d at 142.

103. *See id.*

notion that federal recognition of the well-known marks rule is implicit in the structure of the Lanham Act.¹⁰⁴ Nevertheless, the Second Circuit did recognize that cogent policy arguments existed in favor of recognizing the doctrine in federal law,¹⁰⁵ but the court said that those arguments should be directed to Congress, not the judiciary.¹⁰⁶

In its analysis, the Second Circuit found that “Congress’s specificity in dealing with registered marks cautions against reading a famous marks exception into sections 44(b) and (h).”¹⁰⁷ This is because the sections “nowhere reference the doctrine, much less the circumstances under which it would appropriately apply despite the fact that the foreign mark was not used in this country.”¹⁰⁸ The court was “mindful that Congress has not hesitated to amend the Lanham Act to effect its intent with respect to trademark protection.”¹⁰⁹ In evaluating these various amendments, the court noted an “absence of any statutory provision expressly incorporating the famous marks doctrine or Articles 6*bis* and 16(2).”¹¹⁰ When considered with the fact that the Act was amended over thirty times, this lacking was found to be “all the more significant.”¹¹¹ Thus, the Second Circuit felt that before it could read the Lanham Act to include “such a significant departure from the principle of territoriality, [the court] will wait for Congress to express its intent more clearly.”¹¹²

Most importantly, the Second Circuit held that

[W]e do not ourselves discern in the plain language of sections 44(b) and (h) a clear congressional intent to incorporate a famous marks exception into federal unfair competition law. Section 44(b) guarantees foreign mark holders only “the benefits of this section . . . to the extent necessary to give effect to any . . . convention, treaty or reciprocal law,” as well as the “rights to which any owner of a mark is otherwise entitled by this chapter.”¹¹³

104. *See id.*

105. *Id.* (citing *De Beers LV Trademark Ltd. v. Debeers Diamond Syndicate Inc.*, 2005 U.S. Dist. LEXIS 9307, at *25 (S.D.N.Y. May 18, 2005) (“Recognition of the famous marks doctrine is particularly desirable in a world where international travel is commonplace and where the Internet and other media facilitate the rapid creation of business goodwill that transcends borders.”); Frederick W. Mostert, *Well-Known and Famous Marks: Is Harmony Possible in the Global Village*, 86 TRADEMARK REP. 103, 106 (1996) (“The protection of the global trading system through the prevention of piracy and unfair exploitation of well-known marks has become essential.”). *But see id.* (citing *Badaracco v. Comm’r*, 464 U.S. 386, 398 (1984) (“The relevant question is not whether, as an abstract matter, the rule advocated by petitioners accords with good policy. The question we must consider is whether the policy petitioners favor is that which Congress effectuated by its enactment of [the statute].”)) (“The fact that a doctrine may promote sound policy, however, is not a sufficient ground for its judicial recognition, particularly in an area regulated by statute.”).

106. *ITC*, 482 F.3d at 165.

107. *Id.*

108. *Id.*

109. *Id.*

110. *Id.*

111. *Id.*

112. *Id.*

113. *Id.* at 163 (citing 15 U.S.C. § 1126(b) (2018)).

The Second Circuit found that there was no “famous marks exception” to the territoriality principle written directly into the Lanham Act.¹¹⁴ Because of this, the Second Circuit refused to hold that the well-known marks doctrine has no place in federal law, despite the court approving of the various policy concerns.¹¹⁵ The Second Circuit further emphasized “that any policy arguments in favor of the famous marks doctrine must be submitted to Congress for it to determine whether and under what circumstances to accord federal recognition to such an exception to the basic principle of territoriality.”¹¹⁶

In my view, the Second Circuit viewpoint is wrong. Article *6bis* explicitly requests that trademark registries of states parties refuse to register a mark that may cause confusion to another. The Lanham Act provides the same exact principle. Moreover, while not directly invoked in its language, a reading of Lanham Act sections 43(a), 44(b), and 44(h) ties together to create a cause of action for a foreign holder of a well-known mark.

II. BECAUSE IT IS NOT SELF-EXECUTING, ARTICLE *6BIS* OF THE TREATY OF PARIS ALONE DOES NOT HAVE AUTOMATIC EFFECT AS DOMESTIC LAW WITHIN THE UNITED STATES

With the relevant background and problem defined in Section I, I hope to provide an alternative solution to the well-known marks dilemma. To do this, I will first examine whether the Paris Convention, and whether Article *6bis* itself, is “self-executing” under American law regarding treaty interpretation. This is important because a treaty provision is enforceable in court only if it is, in fact, self-executing, or if it does not require implementing legislation to become effective as domestic law immediately upon entry into force.

The Paris Convention is not self-executing. Thus, legislation must be adopted to establish its terms within American law.

A. What Makes a Self-Executing Treaty?

Section 2 of Article VI of the United States Constitution, otherwise known as the Supremacy Clause, places treaties made under the “Authority of the United States” as part of the “supreme Law of the Land.”¹¹⁷ Indeed, international law is part of American domestic law.¹¹⁸ But, if there is a “controlling executive or legislative act or judicial decision,” the United States may supersede its obligations under international law.¹¹⁹ Moreover, not every treaty provision is enforceable in

114. *Id.* at 165.

115. *Id.*

116. *Id.*

117. U.S. CONST. art. VI.

118. *The Paquete Habana*, 175 U.S. 677, 700 (1900).

119. *Id.*

the courts of the United States.¹²⁰ In evaluating enforceability of treaty provisions, the Supreme Court has instructed courts to undergo a “self-executing” analysis.¹²¹

In a self-executing analysis, the ultimate question is whether the treaty is one that “operates of itself without the aid of any legislative provision,” or rather “addresses itself to the political, not the judicial department.”¹²² Thus, when determining whether a treaty provision is self-executing, courts focus on whether a treaty provision is appropriate for direct judicial application.¹²³ This question is ordinarily resolved by examining the international obligation assumed by the United States—as described by the text and context of the treaty provision, along with other treaty materials—and assessing whether it is consistent with an understanding by the treaty-makers that the provision would be directly enforceable in U.S. courts.¹²⁴

There are two prongs in a self-execution analysis. First, a treaty is self-executing when “the textual provisions indicate that the President and Senate intended for the agreement to have domestic effect.”¹²⁵ Second, courts must evaluate and “decide whether a treaty’s terms reflect a determination by the President who negotiated it and the Senate that confirmed it that the treaty has domestic effect.”¹²⁶ In this vein, a treaty provision will not be enforced by U.S. courts if its obligations are addressed to the political branches of the government rather than to the judiciary.¹²⁷ Therefore, if the treaty provision specifically calls for domestic legislative implementation, then it will not be self-executing. Moreover, when the terms of a treaty provision “import a contract, when either of the parties engages to perform a particular act, the treaty addresses itself to the political, not the judicial department; and the legislature must execute the contract before it can become a rule for the Court.”¹²⁸

When evaluating a specific treaty or provision, courts typically inquire whether it is sufficiently precise or obligatory for judicial application, and whether immediate application of its terms are foreseeable.¹²⁹ This evaluation requires analyzing the particular features of each treaty provision in the context of the treaty as a whole.¹³⁰ Courts have also looked at the United States’ obligations under international law and examined how those obligations would have been understood by the relevant

120. CURTIS A. BRADLEY, *INTERNATIONAL LAW IN THE U.S. LEGAL SYSTEM* 41 (2d ed. 2015).

121. *Id.*

122. *Foster v. Neilson*, 27 U.S. 253, 314 (1829); *accord* *Medellín v. Texas*, 552 U.S. 491, 505, 538 (2008) (Breyer, J., dissenting).

123. RESTATEMENT (FOURTH) OF FOREIGN RELATIONS LAW § 110 (AM. LAW INST., Council Draft No. 1, 2015).

124. *Id.*

125. *Medellín*, 552 U.S. at 519.

126. *Id.* at 521.

127. BRADLEY, *supra* note 120.

128. *Foster v. Neilson*, 27 U.S. 253, 314 (1829).

129. BRADLEY, *supra* note 120.

130. *Id.*

treaty-makers in relation to the self-execution doctrine.¹³¹ Further, “[c]ourts have tended to treat mandatory, present-tense provisions in bilateral treaties as self-executing, especially if the provisions concern the rights of individuals.”¹³² But “[c]ourts have been less likely to treat multilateral treaties as self-executing, especially when the treaties overlap with federal statutes.”¹³³

Some lower courts have adopted multi-factored balancing tests for a self-execution analysis. In general, these courts evaluate the following factors: (1) “the purposes of the treaty and the objectives of its creators;” (2) “the existence of domestic procedures and institutions appropriate for direct implementation;” (3) “the availability and feasibility of alternative enforcement methods;” and (4) “the immediate and long-range consequences of self- or non-self-execution.”¹³⁴

There is no determinative case law that expresses whose specific intent, at the time of drafting, courts should consider when evaluating whether a treaty provision is self-executing. Is it general, including the collective intent of the parties to the treaty, or just the intent of the United States treaty-makers? Scholars and courts have debated this issue, some maintaining that all parties should be included, and others for the idea of considering solely United States intentions. The *Draft Restatement (Fourth) of Foreign Relations Law* follows the contention that the intention of the United States is “dispositive for this issue.”¹³⁵ Indeed, this appears to be the route the Supreme Court took in the most relevant case involving recent trends in self-execution analysis, *Medellín v. Texas*.

Professor Curtis A. Bradley efficiently outlines the U.S. Supreme Court’s analysis of *Medellín* as follows. First, the Court emphasized that “[o]ur cases simply require courts to decide whether a treaty’s terms reflect a determination *by the President who negotiated it and the Senate that confirmed it* that the treaty has domestic effect.”¹³⁶ Indeed, the Court has “held treaties to be self-executing when the textual provisions indicate that *the President and Senate* intended for the agreement to have domestic effect.”¹³⁷ In summarizing its finding of non-self-execution, the Court explained that “[n]othing in the text, background, negotiating and drafting history, or practice among signatory nations suggests that the *President or Senate* intended the improbable result of giving the judgments of an international tribunal a higher status than that enjoyed by ‘many of our most fundamental constitutional

131. *Id.*

132. *Id.* at 42 (citing *Clark v. Allen*, 331 U.S. 503, 507–08 (1947); *Asakura v. City of Seattle*, 265 U.S. 332, 341–43 (1924); *U.S. v. Rauscher*, 119 U.S. 407, 418–19 (1886)).

133. *Id.* at 42–43 (citing *U.S. v. Postal*, 589 F.2d 862, 878–80 (5th Cir. 1979)).

134. *Postal*, 589 F.2d at 877 (quoting *People of Saipan v. U.S. Dep’t of the Interior*, 502 F.2d 90, 97 (9th Cir. 1974)).

135. BRADLEY, *supra* note 120, at 42; *see also* RESTATEMENT (FOURTH) OF FOREIGN RELATIONS LAW, *supra* note 123, § 111, cmt. h.

136. Bradley, *supra* note 120, at 46 (citing *Medellín v. Texas*, 552 U.S. 491, 521 (2008)).

137. *Id.* (citing *Medellín*, 552 U.S. at 519).

protections.”¹³⁸ Further, the Court relied on the U.S. ratification history for the UN Charter rather than on the collective negotiating history.¹³⁹

In discerning this intent, the Court placed significant emphasis on treaty text. As the Court explained, “That is after all what the Senate looks to in deciding whether to approve the treaty.”¹⁴⁰ The Court suggested that future-oriented treaty language directed generically at the states parties—rather than at their courts—is indicative of non-self-execution. An example the Court referenced is the phrase “undertakes to comply” in Article 94 of the UN Charter.¹⁴¹

The Court also rejected a multi-factored approach under which courts would rely on “practical, context-specific criteria” in determining whether a treaty provision was self-executing.¹⁴² According to the Court, this approach would be too vague and would improperly “assign to the courts—not the political branches—the primary role in deciding when and how international agreements will be enforced.”¹⁴³ However, the Court did not rule out more categorical references to contextual factors. Professor Bradley believes “it seems likely that considerations such as the subject matter of a treaty and whether it addresses individual rights will continue to have a bearing on the self-execution analysis.”¹⁴⁴

The *Medellín* decision appears to have implicitly rejected any strong presumption in favor of self-execution.¹⁴⁵ This is because the Court “did not mention such a presumption, and, in concluding that the treaties in question were non-self-executing, it did not require clear evidence of an intent to preclude domestic judicial enforcement.”¹⁴⁶ Instead, the Court examined the text, structure, and ratification history of the treaties to discern whether they were self-executing. Moreover, the Court emphasized that “Congress is up to the task of implementing non-self-executing treaties.”¹⁴⁷

The Court, however, did not appear to adopt a presumption against self-execution. Rather, the Court made clear that self-execution should be considered on a treaty-by-treaty basis. The Court stated that “under our established precedent, some treaties are self-executing and some are not, depending on the treaty.”¹⁴⁸ In addition, the Court observed that prior decisions that have found treaties to be self-

138. *Id.* (citing *Medellín*, 552 U.S. at 523).

139. *Id.*

140. *Id.* (citing *Medellín*, 552 U.S. at 514).

141. *Id.* at 46–67 (citing *Medellín*, 552 U.S. at 508–09.); *see also id.* at 51 n.92 (“In a concurrence, Justice Stevens agreed with the majority on this point, concluding that the phrase ‘undertakes to comply’ in Article 94(1) of the UN Charter, especially when read in context, is best construed as ‘contemplat[ing] future action by the political branches.’” (citing *Medellín*, 552 U.S. at 534 (Stevens, J., concurring))).

142. *Id.* at 47 (citing *Medellín*, 552 U.S. at 549 (Breyer, J., dissenting)).

143. *Id.* (citing *Medellín*, 552 U.S. at 516).

144. *Id.*

145. *Id.*; *see also* RESTATEMENT (FOURTH) OF FOREIGN RELATIONS LAW, *supra* note 123, § 110 para. 3.

146. BRADLEY, *supra* note 120, at 42.

147. *Id.* (citing *Medellín*, 552 U.S. at 521).

148. *Medellín*, 552 U.S. at 520.

executing “stand only for the unremarkable proposition that some international agreements are self-executing and others are not.”¹⁴⁹ Further, courts do not require “talismanic words” for self-execution.¹⁵⁰ Simply, “[t]he Court’s invocation of deference to the executive branch with respect to self-execution was also formulated in treaty-specific terms.”¹⁵¹

With the relevant law established, I move to an evaluation of the Convention’s terms and conduct a self-execution analysis on the Paris Convention as a whole and Article 6*bis*.

B. *Neither the Paris Convention nor Article 6bis Is Self-Executing*

Under this test, neither the Paris Convention as a whole, nor Article 6*bis* alone, is self-executing. The terms of the Paris Convention do not indicate that the President and Senate intended for the agreement to have domestic effect. Moreover, as has been evidenced in judicial decisions throughout history, the Paris Convention requires United States courts to decide whether a treaty’s terms reflect a determination by the President who negotiated it and the Senate that confirmed it, that the treaty has domestic effect.

For starters, Article 25 of the Convention, titled “*Implementation of the Convention on the Domestic Level*” is as follows:

(1) Any country party to this Convention *undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.* (2) It is understood that, at the time a country deposits its instrument of ratification or accession, it will be in a position under its domestic law to give effect to the provisions of this Convention.¹⁵²

Additionally, under Article 6, “[t]he conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.”¹⁵³ The plain language of these two provisions clearly illustrates that legislative action had to be taken in order for the treaty to take effect.

Some courts have ruled the other way, holding that the terms of the Convention are in fact self-executing.¹⁵⁴ But these cases were adjudicated before the

149. *Id.* at 518.

150. BRADLEY, *supra* note 120 (citing *Medellin*, 552 U.S. at 521).

151. *Id.* at 47–48.

152. *See* Paris Convention, *supra* note 1, at art. 25 (emphasis added).

153. *Id.* at art. 6.

154. *See, e.g.*, *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633, 640–41 (2d Cir. 1956) (dictum that Paris Convention is self-executing); *Benard Indus. v. Bayer Aktiengesellschaft*, 38 U.S.P.Q.2d 1422 (S.D. Fla. 1996) (in denying motion to dismiss a claim founded upon the Paris Convention, the court stated, “[t]he court is persuaded by the reasoning in the Davidoff and Roldan decisions which indicate that [non-U.S.] parties have rights under the Paris Convention which can be enforced pursuant to that Convention”); *Laboratorios Roldan, C. por A. v. Tex. Int’l*, 902 F. Supp. 1555, 1568 (S.D. Fla. 1995) (in granting a preliminary injunction based in part on the Paris Convention, the court reasoned that “under § 44(h) of the Lanham Act and Article 10bis of the Paris Convention, [a Dominican Republic corporation] ‘is protected from unfair competition’”); *Davidoff Extension S.A. v. Davidoff Int’l, Inc.*, 612 F. Supp. 4, 8 (S.D. Fla. 1984), *aff’d sub nom. Davidoff Ext. v. Davidoff Int’l*, 774 F.2d 1178

United States adopted Article 6*bis* and the entirety of the Paris Convention in 1973.¹⁵⁵ In fact, there has been a historical trend, one that has recently picked up some steam, among all the judicial, legislative, and even executive branches of the American government to hold that the Paris Convention is not self-executing. Indeed, this is the position a majority of United States circuit courts, including the Federal Circuit, have taken.¹⁵⁶ While there has been some debate, it seems clear that the text of the treaty in and of itself does not comport with self-execution, because it does not “operate[] of itself, without the aid of any legislative provision,” or “address[] itself to the political, not the judicial department.”¹⁵⁷

On the other hand, WIPO itself argues that Article 6*bis* is self-executing. As discussed in WIPO’s Guide to the Implementation of the Paris Convention, “in stipulating that ‘the countries of *the* Union undertake, etc.’ the Article is drafted differently from many other Articles of the Convention, which directly refer to rights or obligations of interested parties, or directly regulate a situation at issue.”¹⁵⁸ Additionally, Article 6*bis* does not “refer only to an undertaking by the countries of the Union to *legislate* on a particular matter”¹⁵⁹ WIPO argues that, “it cannot be deemed *only* to oblige the member States to *legislate* on the subject concerned, but may be considered to contain an undertaking also on behalf of the administrative and judicial authorities of these States.”¹⁶⁰ Thus, if it is compatible with their constitutional systems, Member States “must then give effect to the provisions of the Article at the request of interested parties.”¹⁶¹ Even though the Article leaves certain liberties to national legislations, it does not exclusively refer to them alone.¹⁶²

(11th Cir. 1985) (“The Paris Convention is self-executing and, by virtue of Article VI of the U.S. Constitution, a part of the law to be enforced by the courts”); *Master v. Cribben & Sexton Co.*, 202 F.2d 779 (C.C.P.A. 1953) (holding that the Paris Convention is self-executing); *Ex parte Dorin, Inc.*, 102 U.S.P.Q. 316 (Comm’r Pat. 1954).

155. Convention Done at Stockholm July 14, 1967, T.I.A.S. No. 7727 art. 1–12 (Aug. 25, 1973).

156. *In re Rath*, 402 F.3d 1207, 1211 (Fed. Cir. 2005); *see also* *Int’l Café, S.A.L. v. Hard Rock Café Int’l, Inc.*, 252 F.3d 1274, 1277 n.5 (11th Cir. 2001); *Mannington Mills, Inc. v. Congoleum Corp.*, 595 F.2d 1287, 1298–99 (3d Cir. 1979); *Ortman v. Stanray Corp.*, 371 F.2d 154, 157 (7th Cir. 1967); S. REP. NO. 87–1019 (1961), reprinted in 1961 U.S.C.C.A.N. 3044, 3045 (stating that “[t]he provisions of the Convention of Paris are not self-executing, and legislation is therefore needed to carry into effect any provision not already in our present law”); 19 Op. Att’y Gen. 273, 279 (1889) (“[The Paris Convention] is therefore not self-executing, but requires legislation to render it effective for the modification of existing laws.”); *cf. Vanity Fair Mills*, 234 F.2d at 640–41 (determining that the Paris Convention is self-executing but does not create private rights for acts occurring in foreign countries).

157. BRADLEY, *supra* note 120, at 41; *see also* RESTATEMENT (FOURTH) OF FOREIGN RELATIONS LAW, *supra* note 123, § 110.

158. BODENHAUSEN, *supra* note 13, at 90.

159. *Id.*

160. *Id.*

161. *Id.*

162. *Id.* (bolstering this point by referencing Article 6*bis* paragraph (1) (“if their legislation so permits”) and paragraph (2) (“a period of *at least* five years . . . shall be allowed . . .”; “The countries of the Union *may* provide for a period . . .”).

Despite this, the Article cannot be self-executing under *Medellin*, because it does not clearly “operate[] of itself without the aid of any legislative provision,” or “address[] itself to the political, not the judicial department.”¹⁶³ In order to be effectuated within the United States, the provision of Article 6*bis* must be invoked in the Lanham Act. This is because of the fact that federal trademark law was invoked under the auspices of Congress’s commerce powers. It needs to be implemented in law. And again, Article 25 completely overrides WIPO’s assertions, because the Article requires each Member State to “undertake[] to adopt, in accordance with its constitution, the measures necessary to ensure the application of this Convention.”¹⁶⁴ Even if one article can be *read* to be self-executing, Article 25 completely halts the possibility.

Neither the Paris Convention nor Article 6*bis* itself is self-executing. But, the well-known marks doctrine may still be invoked in American trademark law. This is because existing Lanham Act provisions impliedly work together to present a cause of action arising out of the doctrine.

III. THE WELL-KNOWN MARKS DOCTRINE IS NEVERTHELESS IMPLIEDLY INVOKED IN THE LANHAM ACT AND DOES HAVE EFFECT UNDER THE DOMESTIC LAW OF THE UNITED STATES

Scholars have argued that the well-known marks doctrine actually is incorporated into the Lanham Act, and thus, into domestic law. Through an interpretation of a trinity of statutes in the Act, the well-known marks doctrine does in fact have a place in American law. Professor McCarthy argues that under the collective operation of Lanham Act § 43(a), § 44(b) and § 44(h), the well-known marks doctrine can and does indeed exist in American jurisprudence.¹⁶⁵ I agree. In reading the Lanham Act, the Second Circuit ignored an analytical canon of construction.¹⁶⁶ In cases of ambiguity, courts should interpret a statute—such as sections 43(a), 44(b), and 44(h) of the Lanham Act—as being consistent with international obligations.¹⁶⁷ This is known as the *Charming Betsy* canon of construction. Coupled with an evaluation of legislative history, the Lanham Act can be read in a manner that impliedly includes the well-known marks doctrine.

A. The Charming Betsy Canon and Legislative History

The Supreme Court has held that acts of Congress can supersede international law only when such acts clearly conflict with international obligations, and Congress

163. See sources cited *supra* note 155.

164. Paris Convention, *supra* note 1, at art. 25.

165. MCCARTHY, *supra* note 2, § 29:4.

166. *Id.*

167. RESTATEMENT (FOURTH) OF FOREIGN RELATIONS LAW, *supra* note 123, § 109 (citing *Murray v. Charming Betsy*, 6 U.S. 64 (1804)); see also *Allegheny Ludlum Corp. v. United States*, 367 F.3d 1339, 1348 (Fed. Cir. 2004); *Luigi Bormioli Corp. v. United States*, 304 F.3d 1362, 1368 (Fed. Cir. 2002).

passed the act after the international treaty was ratified.¹⁶⁸ In all other situations, courts continue to follow the *Charming Betsy* canon.

In *Murray v. the Schooner Charming Betsy*, the Supreme Court had to determine whether federal violations of *jus cogens*¹⁶⁹ norms constituted a waiver of immunity.¹⁷⁰ The Court determined that there was a waiver.¹⁷¹ Chief Justice Marshall based his decision on two points. First, international law created such a waiver. Second, Marshall recognized that the U.S. should try its best to avoid legal conflicts with international obligations.¹⁷² Under the *Charming Betsy* canon, unless Congress has indicated otherwise, courts should consider the doctrine of international comity when interpreting statutes. Specifically, this canon of construction recognizes that “an act of Congress ought never to be construed to violate the law of nations if any other possible construction remains,”¹⁷³ even when the international agreement requires enacting legislation. Thus, courts should aim to interpret applicable provisions in a manner consistent with international obligations.

At least one federal court has used the *Charming Betsy* canon when evaluating provisions of the Lanham Act.¹⁷⁴ In analyzing the usage of a surname as a trademark in *In re Rath*, the Federal Circuit used the *Charming Betsy* canon to review Lanham Act section 44(e). This section allows a foreign mark holder to register their mark if it is “eligible.”¹⁷⁵ In this case, the Federal Circuit found that the canon would not have changed its ruling, because the mark at issue simply could not be registered.¹⁷⁶ Despite this ruling, the court found that “[t]here is no question but that Congress generally intended section 44 of the Lanham Act to implement the Paris Convention.”¹⁷⁷

Where statutory language is unclear, courts can evaluate the meaning of a particular provision by looking to its legislative history.¹⁷⁸ This investigation may include the circumstances surrounding the enactment of the statute, the legislative

168. *Breard v. Greene*, 523 U.S. 371, 376 (1998).

169. *Jus cogens* refers to certain fundamental, overriding principles of international law, from which no derogation is ever permitted. They are also known as “peremptory norms.” See IAN BROWNIE, *PRINCIPLES OF PUBLIC INTERNATIONAL LAW* (6th ed. 2003).

170. See *Charming Betsy*, 6 U.S. at 66–67.

171. *Id.*

172. *Id.* at 118–21.

173. *Id.* at 118; see also William S. Dodge, *The Charming Betsy and The Paquete Habana*, in *LANDMARK CASES IN PUBLIC INTERNATIONAL LAW* (Eirik Bjorge & Cameron Miles eds., 2017) (providing a general analysis of the role *Charming Betsy* and *Paquete Habana* play in American jurisprudence).

174. See, e.g., *In re Rath*, 402 F.3d 1207, 1211 (Fed. Cir. 2005) (using the *Charming Betsy* canon to review whether there is any ambiguity in Lanham Act section 44).

175. Lanham Act § 44(e), 15 U.S.C. § 1126(e) (2012).

176. *In re Rath*, 402 F.3d at 1211.

177. *Id.*

178. See *Blum v. Stenson*, 465 U.S. 886, 896 (1984).

policy that the statute was designed to implement, and the statute's relationship to existing principles governing the same general subject matter.¹⁷⁹

Indeed, the Federal Circuit turned to the Lanham Act's legislative history in *In re Rath*. There, the court noted that Congress had in fact intended to invoke the terms of international agreements in the terms of the Lanham Act.¹⁸⁰ Truly, the Lanham Act's legislative history shows that "[t]he intent of this Act is . . . to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations."¹⁸¹ Moreover, Congress instructed that "[the Lanham Act] attempts to accomplish these various things: . . . 2. To carry out by statute our international commitments . . .".¹⁸² So, there is a clear Congressional intent to invoke the Paris Convention in the terms of Lanham Act section 44. However, there is no clear intent that Congress would provide registration or protection for foreign marks that do not satisfy domestic requirements.¹⁸³

The court in *Rath* held that the *Charming Betsy* presumption is inapplicable where the Lanham Act does not provide for registration of a trademark.¹⁸⁴ Indeed, "Congress did not simply adopt language incorporating the requirements of the convention in the Lanham Act. Rather it provided for registration of a foreign mark 'if eligible.'"¹⁸⁵ Under the Lanham Act, "[a] mark is not 'eligible' for registration on the principal register under the statute unless it satisfies the section 2 requirements."¹⁸⁶ So, as noted before, the well-known marks doctrine should only come into play where a mark can be registered. This may include the requirement that the mark has been "used" in interstate commerce.

Thus, in the cases involving a well-known foreign mark, courts should first evaluate whether the mark can be registered under the statutory bars of Lanham Act section 2. While the terms of the Lanham Act may not in and of themselves be ambiguous, there is a question as to whether or not the Act as a whole impliedly invokes the well-known marks doctrine in its language. Because of this uncertainty, the Lanham Act should be read as being consistent with international obligations.

Finally, section 45 of the Lanham Act, read using the *Charming Betsy* canon, provides an unambiguous look at Congress's intent in implementing the Lanham Act. Among other aspects touched upon, this section identifies that

[t]he intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce . . . and to provide rights and remedies stipulated by treaties

179. See *Blue Chip Stamps v. Manor Drug Stores*, 421 U.S. 723, 728–29, 731–32, 734–37 (1975).

180. *In re Rath*, 402 F.3d at 1211.

181. *Id.*

182. H.R. REP. No. 78-603, at 4 (1943).

183. *In re Rath*, 402 F.3d at 1211–12.

184. *Id.* at 1211.

185. TRADEMARK LAW GUIDE ¶ 60,497.

186. *Id.*

and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.¹⁸⁷

The language of this section clearly demonstrates that Congress intended to incorporate treaty provisions within the Lanham Act, and maybe even provide larger rights to foreign mark holders. “It has been held that those treaties, certain phases of them, are not self-executing; so, in the interest of clarity, as well as the integrity of treaty obligations, we have put the treaty provisions into our law, and [the Lanham Act] has that object in mind.”¹⁸⁸ In fact, Judge Bryson’s concurrence in *Rath* seems to indicate as such. “Although the PTO’s interpretation of section 44 in light of the Paris Convention has changed over time, the PTO has explicitly adopted the view that the Paris Convention gives foreign nationals rights under the Lanham Act that may be unavailable to United States citizens.”¹⁸⁹ For example, there does not appear to be a “use in commerce” requirement for foreign marks to achieve registration and protection on the federal level. Because of this clear history and understanding, any arguments about the difference in timing between the treaty and the Lanham Act do not hold water. Further, there is no need to argue about whether “treaty” under Article 25 only refers to those with domestic effect because Congress clearly intended for the Lanham Act to comport with international obligations.

Under Article 6*quinquies*, trademarks registered in a Member State may be denied registration or invalidated in the following circumstances:

1. when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;
2. when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;
3. when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public.¹⁹⁰

As mentioned, “use,” however does not appear to be a requirement. Indeed, the U.S. Senate noted this when introducing several amendments to section 44. The Senate illustrated that “[t]hese amendments will not affect U.S. obligations under the Paris Convention, as presently interpreted, because they do not preclude an applicant under Section 44 of the Act from obtaining a U.S. registration without

187. Lanham Act § 45, 15 U.S.C. § 1127 (2012) (emphasis added).

188. *Crocker Nat’l Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. (BNA) 909, 928 (I.T.A.B. 1984) (referencing in appendix *Hearings on H.R. 9041 Before the Subcomm. on Trademarks of the House Comm. on Patents*, 75th Cong., 3rd Sess. 195 (1938) (statement of Comm’r Coe)).

189. *In re Rath*, 402 F.3d at 1216 (Bryson, J., concurring) (citing John B. Pegram, *Trademark Law Revisions: Section 44*, 78 TRADEMARK REP. 141, 162–70 (1988)).

190. Paris Convention, *supra* note 1, at art. 6*quinquies*.

making use.”¹⁹¹ So, as long as a foreign holder of a mark that is well-known can show their mark is being affected by a mark that is “of such a nature as to infringe rights acquired by third parties in the country where protection is claimed,” then that holder has rights under the Lanham Act.

Legislative history and the Lanham Act’s statutory text show that Congress intended to comport American trademark principles with the United States’ commitment to the Paris Convention. This adherence should include the well-known marks doctrine under Article *6bis*. Even though the doctrine is not explicitly presented in the Lanham Act’s language, the *Charming Betsy* canon counsels for a reading of the Act in a way that comports with international law. Moreover, the Congress of the United States has not indicated that it does not consider international conventions; quite the opposite, in fact. Thus, the Lanham Act’s legislative history and a reading of the Lanham Act under the *Charming Betsy* doctrine help lead to the conclusion that the well-known marks doctrine is impliedly invoked in the Lanham Act.

B. *The Trinity of Lanham Act Sections 43(a), 44(b), and 44(h), and How It Impliedly Invokes the Well-Known Marks Doctrine in American Trademark Law*

Under the *Charming Betsy* canon of construction, courts should read the Lanham Act in a manner that can never “be construed to violate the law of nations, if any other possible construction remains.”¹⁹² If courts read the Lanham Act as a whole in this way, the well-known marks doctrine can be impliedly invoked through some of its provisions. To find that the well-known marks doctrine is impliedly invoked in federal law, courts should evaluate that a trinity of Lanham Act provisions and find that, in conjunction, they provide standing and a cause of action for a foreign national plaintiff to sue in U.S. courts for trademark infringement of their well-known or famous mark.

Lanham Act section 43(a), in conjunction with sections 44(b) and 44(h), gives a foreign national without a federal registration of their mark standing to sue in a federal court. When the foreign national plaintiff files suit against a defendant infringing its trademark, it may invoke the well-known marks doctrine of the Paris Convention Article *6bis*. Simply, section 43(a) allows for the mark holder to file suit for infringement of its unregistered mark. Then, the foreign trademark holder can invoke section 44(h) because it entitles them to “effective protection against unfair competition.” Subsequently, section 44(b) expands that protection “to the extent necessary to give effect to any provision of such convention.” Actionable “unfair competition” therefore includes whatever is barred by “any provision” of an international agreement, including the Paris Convention. So a foreign trademark owner can sue under Section 44 of the Lanham Act for violations of Article *6bis* of

191. S. REP. No. 100-515, at 43 (1988), as reprinted in 1988 U.S.C.C.A.N. 5577, 5606.

192. *Murray v. Charming Betsy*, 6 U.S. 64, 118 (1804).

the Paris Convention. Then, the foreign national plaintiff should prevail if its mark is so well-known in the U.S. that confusion is likely.

As noted above, Lanham Act section 43(a)(1) is the primary statutory vehicle for bringing a claim that an unregistered mark holder's trademark is being infringed. Thus, a foreign national holder of an unregistered well-known mark would be able to bring a cancellation claim in federal court. Indeed, section 43(a)"is the only provision in the Lanham Act that protects an unregistered mark" and "[i]ts purpose is to prevent consumer confusion regarding a product's source, . . . and to enable those that fashion a product to differentiate it from others on the market."¹⁹³ To prevail on a claim under this section, a plaintiff must show that their mark is distinctive and that it has been infringed.¹⁹⁴

Concurrently with section 43(a), Lanham Act section 44 provides a foreign national holder of a well-known mark standing to sue in federal court.

Section 44(b) of the Lanham Act allows persons of nations with a trademark treaty with the United States the right to invoke Lanham Act section 44 to give effect to the provisions of that treaty.¹⁹⁵ This section of the Lanham Act, *Benefits of section to persons whose country of origin is party to convention or treaty*, identifies that

[a]ny person whose country of origin is a party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition, to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of a mark is otherwise entitled by this chapter.¹⁹⁶

Lanham Act section 44(h) embodies the Paris Convention principle of "national treatment" by granting to qualified foreign entities the same protection against unfair competition that is enjoyed by nationals of the U.S.¹⁹⁷ This protection is the same kind of legal protection found either in the federal Lanham Act or in state law. Under Lanham Act section 44(h), "[a]ny person designated in subsection (b) of this section as entitled to the benefits and subject to the provisions of this Act shall be entitled to effective protection against unfair competition."¹⁹⁸ Further, "the remedies provided herein for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition."¹⁹⁹ In addition, this section "provides that if a foreign entity is entitled to the benefits of a treaty such as the Paris Convention, it is entitled to protection against unfair competition

193. Centaur Commc'ns, Ltd., v. A/S/M Commc'ns, Inc., 830 F.2d 1217 (1987).

194. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769 (1992).

195. MCCARTHY, *supra* note 2, § 29:4.

196. *See* Lanham Act § 44(b), 15 U.S.C. § 1126(b) (2012).

197. Mattel, Inc. v. MCA Records, 296 F.3d 894 (9th Cir. 2002).

198. Lanham Act § 44(h), 15 U.S.C. § 1126(h).

199. *Id.*

and the remedies provided by the Lanham Act.”²⁰⁰ In analyzing the intersection of sections 44(b) and 44(h), courts have held that

[t]he grant in [Lanham Act § 44] subsection (h) of effective protection against unfair competition is tailored to the provisions of the unfair competition treaties by subsection (b), which extends the benefits of section 44 only to the extent necessary to give effect to the treaties. The federal right created by subsection 44(h) is coextensive with the substantive provisions of the treaty involved In this way, subsections (b) and (h) work together to provide federal rights and remedies implementing federal unfair competition treaties.²⁰¹

But in *ITC*, the Second Circuit did not follow this analysis. Instead, it argued that “Congress’s specificity in dealing with registered marks cautions against reading a famous marks exception into sections 44(b) and (h), which nowhere reference the doctrine, much less the circumstances under which it would appropriately apply despite the fact that the foreign mark was not used in this country.”²⁰² Again, this view is wrong. Congressional history does show intent to honor the Paris Convention, as discussed above, for even *unregistered* trademarks. Moreover, Congress has shown an intention to provide foreign mark holders rights that even American citizens do not get. Thus, reading the Lanham Act using the *Charming Betsy* canon of construction leads to the conclusion that sections 43(a), 44(b), and 44(h) work together to impliedly invoke the well-known marks doctrine. Even if the doctrine has not been explicitly defined, it is still part of American law. However, to satisfy the Second Circuit’s concerns, I would turn to recommending amending section 44 of the Lanham Act to include a provision specifically referencing the doctrine.

IV. NEXT STEPS: AMENDING THE LANHAM ACT AND DEFINING A TEST FOR WELL-KNOWN TRADEMARKS

A. Proposed Amendment to the Lanham Act

To make the “well-known marks” doctrine clear in American law, the Lanham Act should be amended.²⁰³ Any amendment to the Lanham Act should appear in section 44, because it explicitly relates to international conventions. Amending section 44 would solidify the well-known marks doctrine into American trademark law. Further, any amendment to section 44 would reiterate the United States’

200. MCCARTHY, *supra* note 2, § 29:4.

201. *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788, 792 (9th Cir. 1981); *see also* *Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d 462, 480 (2d Cir. 2005); *Mattel*, 396 F.3d at 907; *Havana Club Holding, S.A. v. Galleon S.A.*, 203 F.3d 116, 134 (2d Cir. 2000).

202. *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 163 (2d Cir. 2007).

203. MCCARTHY, *supra* note 2, § 29:4; *see also* *INTA Board Backs Proposal for U.S. Statute on Well-Known Marks*, 66 INTA BULL. 9 (2011) (The INTA Board of Directors adopted a resolution in support of amending U.S. law to provide an explicit basis for the well-known marks doctrine).

commitment to the treaties and conventions it ratifies and incorporates into the Supreme law of the land.

My recommended amendment is a simple one. Congress should take section 44(h) and add a few words. In my view, the Lanham Act, section 44(h) should be amended in this manner:

Any person designated in subsection (b) of this section as entitled to the benefits and subject to the provisions of this chapter shall be entitled to effective protection against unfair competition, ***including the protection of a mark that is well-known under any treaty or convention relating to trademark protection which the United States is a party to***, and the remedies provided in this chapter for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.

Moreover, if it needs to be made more explicit, then I would recommend creating a new subsection of section 44. This hypothetical section 44(j) would read, simply: Any person designated in subsection (b) of this section holding a well-known trademark shall be entitled to the benefits and remedies of this chapter, so long as the owner of the mark is otherwise entitled to these rights under this chapter. In my view, amending section 44(h) as described above is sufficient, but this potential section 44(j) could play a role in resolving disputes regarding the existence of the well-known marks doctrine in domestic law.

With these hypothetical amendments, Lanham Act section 44(h) alone would then explicitly reference owners of well-known marks, or the Act as a whole would provide rights to holders of well-known marks. This would alleviate the circuit split and any other legal contentions regarding the validity of the doctrine in American trademark law. Congress could also further define what makes a mark well-known, or it could leave it to the courts to decide. Of the available options and definitions of being “well-known,” the “secondary meaning plus” test is the most appropriate.

B. *What Makes a Mark Well-Known?*

Because the well-known marks doctrine is in fact impliedly invoked in domestic law, the next question is how it should be implemented. Simply, when a foreign national plaintiff files suit, how do they prove their mark is well-known? Frankly, it is difficult to pinpoint what exactly makes a mark “well known.” Indeed, “[t]he [Article 6 *bis*] meaning of ‘well-known’ (*notoirement connue*) is rather elusive. Certainly, it means something more than merely ‘known.’ ‘*Notoire*’ in French means something which is of common knowledge or a manifest thing.”²⁰⁴ The main problem is that, under U.S. law, it is unclear just how much fame is required for a mark to be recognized as well-known. “The Paris Convention leaves the definition of what is a well-known mark to the ‘competent authority’ of the nation in which

204. LADAS, *supra* note 31, § 681.

protection is sought.”²⁰⁵ So, “the scope of protection may differ from one country to the other.”²⁰⁶ Because “[t]he scope of protection afforded to well-known marks is different in each country,”²⁰⁷ the United States must establish a concrete definition.

In answering this question, the Second Circuit listed four possibilities for defining the level of renown that might be required. These are: (1) simple secondary meaning; (2) secondary meaning plus; (3) the anti-dilution standard; and (4) use of the six factors listed by the World Intellectual Property Organization (“WIPO”).²⁰⁸

The first possibility is using a strict secondary meaning test. However, both the Second and Ninth Circuits noted that this test could not be utilized appropriately. Mere secondary meaning alone is not an appropriate standard for application of the famous or well-known marks doctrine because it would effectively eliminate the territoriality principle, which “has a long history in the common law.”²⁰⁹

The second option—which is an expansion on the first—is referred to as “secondary meaning plus.” This analytical test was defined by the Ninth Circuit in *Grupo Gigante*. According to the Ninth Circuit, the secondary meaning plus test is that “where the mark has not before been used in the American market, the court must be satisfied, by a preponderance of the evidence, that a substantial percentage of consumers in the relevant American market is familiar with the foreign mark.”²¹⁰ McCarthy suggests that a “substantial percentage” should be at least fifty percent of “consumers in the relevant American market.”²¹¹ Further, the Ninth Circuit defined this standard as an “intermediate” one, where owners of foreign famous marks do not need to “show the level of recognition necessary to receive nationwide protection against trademark dilution.”²¹² But, the owner of a foreign famous mark “who does not use a mark in the United States must show more than the level of recognition that is necessary in a domestic infringement case.”²¹³

Third, the Second Circuit suggested a famousness evaluation through the test expressed in the federal anti-dilution statute. Section 43(c) of the Lanham Act establishes a high standard of recognition and famousness.²¹⁴ Under this section, courts should evaluate four non-exclusive factors when determining whether a mark is sufficiently famous for anti-dilution protection: (1) the duration, extent, and

205. *Id.*

206. *Id.*

207. MCCARTHY, *supra* note 2, § 29:62.

208. *See* ITC Ltd. v. Punchgini, Inc., 482 F.3d 135, 167–70 (2d Cir. 2007) (laying out various tests in request for New York Court of Appeals to answer certified questions).

209. *See id.* at 167 (citing *Grupo Gigante SA De CV v. Dallo & Co.*, 391 F.3d 1088, 1097–98 (9th Cir. 2004)).

210. *Grupo Gigante*, 391 F.3d at 1098.

211. *See* MCCARTHY, *supra* note 2, § 29:4.

212. *Grupo Gigante*, 391 F.3d at 1098.

213. *Id.* at 1106 (Graber, J., concurring).

214. *See* Lanham Act § 43(c), 15 U.S.C. § 1125(c) (2012).

geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties; (2) the amount, volume, and geographic extent of sales of goods or services offered under the mark; (3) the extent of actual recognition of the mark; and (4) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.²¹⁵ If a mark holder has his or her mark deemed famous under this test, they may seek an injunction against another person who, “at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”²¹⁶ But this test may be too specific when compared to claims arising under Article 6*bis*. This Article is merely a protection against a pirate who either uses or registers an owner’s well-known mark before the owner.²¹⁷ It is not a dilution enforcement tool. Moreover, protection against dilution and tarnishment relate to famous marks. Because of the limited scope of Article 6*bis*, it would be best to not confuse whether a mark is famous or well-known. Thus, the American test for dilution should not be the well-known marks test.

Finally, the Second Circuit proposed utilizing the factors that WIPO found relevant in the non-binding “Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks,” adopted in 1999. These factors are: (1) the degree of knowledge or recognition of the mark in the relevant sector of the public; (2) the duration, extent, and geographical area of any use of the mark; (3) the duration, extent, and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, or the goods and/or services to which the mark applies; (4) the duration and geographical area of any registrations, and/or any application for registration, of the mark, to the extent that they reflect use or recognition of the mark; (5) the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities; and (6) the value associated with the mark.²¹⁸

Out of these four tests, none have been exclusively picked to be the standard. In my view, courts should utilize the secondary meaning plus test. Because of its intermediate nature, it ensures that holders of foreign well-known marks may be able to more easily register their marks and pursue infringement claims. Likewise, it more easily allows American companies to ensure their well-known marks are not being infringed on by foreign “trolls.”

215. *Id.* § 1125(c)(2).

216. *Id.* § 1125(c)(1).

217. MCCARTHY, *supra* note 2, § 27:3.

218. *See* WORLD INTELLECTUAL PROP. ORG., JOINT RECOMMENDATION CONCERNING PROVISIONS ON THE PROTECTION OF WELL-KNOWN MARKS (1999), <http://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf> [<https://perma.cc/2P7A-FDYB>]; *see also* FREDERICK MOSTERT, FAMOUS AND WELL-KNOWN MARKS: AN INTERNATIONAL ANALYSIS (2d ed. 2004).

CONCLUSION

In conclusion, I reiterate that the Paris Convention and the “well-known marks” doctrine under Article *6bis* are not self-executing, and do not have immediate effect on American law or enforceability in American courts. But, this may not matter, because a trinity of Lanham Act provisions does indicate that Congress did intend to provide causes of actions for foreign parties. In order to emphasize this, Congress should amend the Lanham Act. If it does so, or if courts do find that the well-known marks doctrine is implicated in American law, this should allow for foreign holders of well-known marks to bring claims in American courts, so long as the mark has been used within American commerce and meets the “secondary meaning plus” test.

There are several implications for the future depending on what happens across the American political system. If the Ninth Circuit—and my—view takes hold, then foreign companies would likely be more willing to invest in the United States. This is because these companies would come into the economy without fear that the goodwill they accumulated with their marks would go to waste. If, however, the Second Circuit view is held to be the dominant view, then the United States will continue to be hypocritical in its application of international law.

To comport with the principles the United States agreed to when it signed the Paris Convention, to implement the intention of Congress when it adopted and amended the Lanham Act, to limit forum shopping, and to further the goals of the Lanham Act, the well-known marks doctrine must be invoked in American law. This goal can be currently reached impliedly, or explicitly through an amendment. Regardless of which understanding takes hold, the well-known marks doctrine should be recognized in U.S. law and provide foreign national well-known mark holders reprieve from pirates that seek to seep from the goodwill they have established across borders.