

## THE GLOBAL TRADE MARK

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## 1. INTRODUCTION

The Apple iPad was the world's leading tablet device in 2012. It commanded over 57 percent of the market worldwide.<sup>1</sup> However, despite the iPad's popularity, Apple faced a major problem. In China, Apple's fastest growing market, Apple did not own the trademark to "iPad."<sup>2</sup> Another company did.<sup>3</sup> That company, Proview Shenzhen, sued Apple for \$1.6 billion (10 billion yuan) in China – and both the trial court and appeals court agreed the case against Apple should proceed forward.<sup>4</sup> Apple faced the daunting prospect of being unable to market the iPad in China under the trademark by which the rest of the world knew the device. Even worse, Apple could have even faced a ban on all exports of the iPad to other parts of the world from China, where the iPad was manufactured. To resolve this predicament, Apple eventually settled the case and paid Proview \$60 million for the trademark rights to "iPad" in China.<sup>5</sup>

Apple's predicament is a company's worst nightmare: developing a successful new product that runs up against someone else's assertion of intellectual property (IP) in another part of the world, especially an important market. This worst-case scenario is not uncommon in today's global market.<sup>6</sup> And it

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<sup>1</sup> See Josh Wolford, *Android Tablets Grab 10% Market Share from Apple's iPad*, WEBPRONNEWS (Jan. 27, 2012), <http://www.webpronews.com/android-tablets-grab-10-market-share-from-apples-ipad-2012-01> ("They [lost] about 10% of market share to Android OS . . . falling to 57.6% worldwide.").

<sup>2</sup> See Wendy Li, *Apple iPad Will Say Goodbye to Chinese Market Over Trademark Infringement?*, INT'L BUS. TIMES (Feb. 8, 2012, 8:10 AM), <http://www.ibtimes.com/articles/295075/20120208/apple-facing-huge-challenge-chinese-company-demanded.htm> (examining the allegations of trademark infringement against Apple in China).

<sup>3</sup> *Id.*

<sup>4</sup> See Kunal Dua, *10 Facts About Apple's 'iPad' Battle in China*, NDTV GADGETS (Feb. 8, 2012), <http://gadgets.ndtv.com/tablets/news/10-facts-about-apples-ipad-battle-in-china-224555> (discussing legal challenges for the iPad in China).

<sup>5</sup> Keith Bradsher, *Apple Settles an iPad Dispute in China*, N.Y. TIMES (July 2, 2012), [available at http://www.nytimes.com/2012/07/02/business/global/apple-settles-an-ipad-trademark-dispute-in-china.html?smid=pl-share](http://www.nytimes.com/2012/07/02/business/global/apple-settles-an-ipad-trademark-dispute-in-china.html?smid=pl-share) (discussing the resolution of the iPad trademark dispute in China).

<sup>6</sup> See, e.g., Andrew E. Kramer, *After Long Dispute, a Russian Starbucks*, N.Y. TIMES (Sept. 7, 2007), [available at http://www.nytimes.com/2007/09/07/business/worldbusiness/07sbux.html](http://www.nytimes.com/2007/09/07/business/worldbusiness/07sbux.html) (explaining how a third party registered "Starbucks" in Russia, forcing Starbucks to litigate to obtain rights to the mark);

happens not just in trademark law, but also in patents. For example, the global “smartphone wars” involving litigation over patents asserted around the world by the market leaders (including Apple, Google, and Samsung) against each other reflects the growing disconnect between markets and IP laws.<sup>7</sup> Put simply, markets are global, but IP laws are not.

Existing IP laws are legacies of a decision countries made over a century ago when they began formulating the first international intellectual property treaties in the late 1800s.<sup>8</sup> In thinking how best to regulate IP internationally, countries naturally thought of the possibility of coming up with one universal system for the world, given the growth in international trade. Eventually, countries nixed the idea, primarily because of the difficulty of reaching agreement on what the universal standard should be (each country favored its own approach).<sup>9</sup> As a compromise, countries decided to keep a national territorial approach to IP laws under which rights are limited to each country’s borders and are decided by national laws that were subject to minimum standards of protection set by international treaties. That fateful decision from the nineteenth century left a legacy of a territorial-based system of IP laws that has carried over to this day.

This legacy has tradeoffs. While the national territorial approach helps to preserve each country’s sovereignty and power to shape its own IP laws, potentially in ways different from other countries, territoriality also creates greater challenges and expenses for IP owners to secure protection internationally. For example, IP owners must seek patents and trademarks for the same underlying invention or trademark in every country where

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Kitsuron Sangsuvan, *Trademark Squatting*, 31 WIS. INT’L L.J. 252 (2013) (explaining how a Chinese company owns the trademark to “Weige,” the Chinese transliteration of “Viagra”). The ongoing dispute over “Budweiser” beer between Anheuser-Busch and the Czech Budejovicky Budvar Company—a dispute that dates back over a century—provided an early glimpse of how territorial laws may be ineffective in handling global rights. See Jitka Smith, *Budweiser or Budweiser?*, 32 J. MARSHALL L. REV. 1251, 1252–56 (1999).

<sup>7</sup> Hon. Jimmie V. Reyna, *The Tariff and the Patent: A New Intersection*, 62 AM. U. L. REV. 779, 780 (2013).

<sup>8</sup> See SAM RICKETSON & JANE GINSBURG, 1 INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND ¶ 2.24 (2005) (discussing the Berne Convention and other intellectual property treaties).

<sup>9</sup> See GRAEME B. DINWOODIE & ROCHELLE COOPER DREYFUSS, A NEOFEDERALIST VISION OF TRIPS: THE RESILIENCE OF THE INTERNATIONAL INTELLECTUAL PROPERTY REGIME 22–24 (2012) (evaluating the TRIPS agreement and its application).

protection is sought.<sup>10</sup> Sometimes, this process presents serious obstacles, as the Apple iPad case shows. Moreover, even if successful in obtaining rights around the world, IP owners must enforce those rights on a country-by-country basis, even if a lawsuit involves the same parties and the same course of conduct in multiple countries. Given the legacy of the territorial approach now embedded in the TRIPS Agreement for 159 World Trade Organization (WTO) countries,<sup>11</sup> the idea of switching to a universal IP system seems remote, if not deleterious. Yet, retaining the territorial approach for all IP laws in a global market seems questionable, not to mention inefficient. As markets have become increasingly global in the twenty-first century, it is time to reconsider the idea of a universal system of IP, at least in some limited respects.

This Article begins that undertaking.<sup>12</sup> It offers a proposal for WTO countries to adopt global IP rights for a special class of trademarks: famous or well-known marks.<sup>13</sup> Well-known marks

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<sup>10</sup> By contrast, copyright law typically does not require any administrative formalities for authors to obtain copyrights for their works. The Berne Convention prohibits countries from imposing such formalities on works of foreign origin. See Berne Convention for the Protection of Literary and Artistic Works art. 5(2), Sept. 9, 1886, as revised July 24, 1971 and as amended Sept. 28, 1979, 1161 U.N.T.S. 30 [hereinafter Berne Convention] (providing copyright protection on an international stage).

<sup>11</sup> Although territoriality is not expressly recognized in TRIPS, the Agreement is based on minimum standards that countries must implement through their own territorial laws. See Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments - Results of the Uruguay Round, 33 I.L.M. 1125 (1994) [hereinafter TRIPS Agreement]. As of March 2013, the WTO had 159 members. See *Understanding the WTO: Members and Observers*, available at [http://www.wto.org/english/thewto\\_e/whatis\\_e/tif\\_e/org6\\_e.htm](http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm) (last visited March 1, 2014) (listing the 159 WTO members).

<sup>12</sup> It is worth noting that some ideas for a global patent system have been floated as not too fanciful. See *Three Heads, One Mind*, THE IPKAT (Apr. 5, 2011), <http://ipkitten.blogspot.com/2011/04/three-heads-one-mind.html> (discussing view of then-U.S. Patent Office Director David Kappos).

<sup>13</sup> "Well-known" marks are trademarks that have a sufficient level of fame or recognition among the relevant public in a country, although the exact way or test to determine fame in what sector(s) is still a source of disagreement among countries. See WIPO, PROTECTION OF WELL-KNOWN MARKS: RESULTS OF THE STUDY BY THE INTERNATIONAL BUREAU AND PROSPECTS FOR IMPROVEMENT OF THE EXISTING SITUATION 6 (Nov. 13-16, 1995) [hereinafter WIPO WELL-KNOWN MARKS STUDY] ("[S]ince the Paris Convention itself does not define the conditions under which a trademark is to be considered well-known, considerable uncertainty exists as regards the circumstances under which a trademark owner can rely on Article

are well-suited for international protection, given the transnational protections for well-known marks that already exist under the Paris Convention and TRIPS Agreement.<sup>14</sup> This Article proposes creating a Global Trade Mark (GTM) for well-known marks, to be governed by a uniform international law. The GTM will span all countries in the WTO. The GTM is inspired, in part, by the Community Trade Mark (CTM) in the European Union, the first truly transnational IP form.<sup>15</sup> While the CTM is regional in scope (applying to all EU countries), the GTM will be international (applying to all WTO countries).

This Article proceeds in four Parts. Part 2 discusses the theory behind the Global Trade Mark and why it is worth adopting today. Part 3 sketches the outlines of the proposed Global Trade Mark Treaty, whose signal feature will be to establish a uniform body of international law to govern the GTM and an International Court of the GTM to resolve conflicts over its interpretation. Part 4 discusses the two ways by which a trademark can be registered as a GTM: (1) an international registration of an existing famous mark that is famous in a certain threshold number of countries or (2) an “intent-to-develop” registration of a mark an owner intends to make famous in the threshold number of countries within a prescribed time of 10 years. Part 5 discusses enforcement of GTMs in national courts and post-registration issues, including exhaustion and exceptions to rights. Of course, further details and amendments to the proposal will be required. The proposal is meant as a starting point for WTO countries to study and debate a

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6bis of the Paris Convention.”). As explained below, well-known or famous marks receive special trademark protections, both in international and national trademark law. See *infra* notes 37–42 and accompanying text. In some countries, a “famous” mark is not the same thing as a “well-known” mark. See WIPO WELL-KNOWN MARKS STUDY, *supra* note 13, at 10. However, it is common in international IP discussions to use the two interchangeably, and I will do so here unless differentiation is required.

<sup>14</sup> See Paris Convention for the Protection of Industrial Property art. 6bis, Mar. 20, 1883, 24 U.S.T. 2140 (1967) [hereinafter Paris Convention] (protecting against the use of well-known marks found in other countries); TRIPS Agreement, *supra* note 11, at art. 16(2), (3).

<sup>15</sup> See Council Regulation (EC) No. 40/94 of Dec. 20, 1993 on the Community Trade Mark, 1994 O.J. (L 11) 1, now replaced by Council Regulation (EC) No. 207/2009 of Feb. 26, 2009 on the Community Trade Mark, 2009 O.J. (L 78) 1 [hereinafter Community Trade Mark Regulation] (providing for protection of Community trademark). For an assessment of the CTM system, see MAX PLANCK INST. FOR INTELL. PROP. & COMPETITION LAW, STUDY ON THE OVERALL FUNCTIONING OF THE EUROPEAN TRADE MARK SYSTEM (Feb. 15, 2011).

global alternative to the current territorial approach to IP laws. More fundamentally, the proposal is intended as an example of how a global IP right might be crafted within the prevailing international IP system.

## 2. THEORY: TREATY DNA AND GLOBAL RIGHTS

Part 2 develops the theory underlying the Global Trade Mark. In our global market, the GTM is an idea that is long overdue. As explained below, the current approach to international IP replicates a patchwork design (territorial IP laws, subject to minimum standards) that may not be desirable in the long run for all international IP treaties. The proposed system for a global trademark presents a good opportunity for countries to innovate, incrementally, the way in which intellectual property is protected internationally.

### 2.1. *The Typology of Treaties: Analyzing "Treaty DNA"*

International treaties can be viewed along two planes: (i) a vertical plane (or y-axis) represents the number of international rules that countries must follow in a particular area of law, and (ii) a horizontal plane (or x-axis) represents the flexibility and areas of discretion including minimum standards that countries may exercise in that area of law.<sup>16</sup> Figure 1 below depicts the relationship.

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<sup>16</sup> Some of my ideas are inspired by the framework or terminology used by Dinwoodie and Dreyfuss, although their use of the terms "vertical" and "horizontal" is not exactly the same as I use here. See DINWOODIE & DREYFUSS, *supra* note 9, at 15 (evaluating the TRIPS agreement and its application). I borrow their use of "vertical" to describe international-to-national relationships. However, their use of "horizontal" applies to different international bodies and treaties that govern the same field. I use the term "horizontal" to describe the level of flexibility countries are afforded by an international treaty.

FIGURE 1. BASIC MATRIX FOR INTERNATIONAL TREATIES



The higher one moves vertically on the y-axis, the more (substantial) requirements the treaty in question imposes. Conversely, a treaty with few requirements falls lower down on the y-axis. The y-axis measures not just the number of requirements in the treaty, but also, more importantly, the *breadth* of those requirements in trying to regulate an entire field. Broader international requirements are higher up, while narrower ones are lower down. In addition, as depicted horizontally by the x-axis, the international requirements may allow greater or lesser discretion to countries. The more discretion afforded to countries, the further to the right the treaty is located along the x-axis.

Thus, an international treaty that attempted to establish an elaborate code of requirements for an entire field of regulation, with little discretion for countries, would be a “top down” body of law—more is done at the international level. By contrast, an international treaty that had fewer requirements, with more discretion to countries, would be a “bottom up” body of law—more is done at the national level.

Consider two examples. First, as depicted by the “Uniform”



circle in Figure 1, a treaty that imposed many requirements to regulate in great detail a particular area of law, while allowing countries little discretion, would be situated higher along the y-axis (symbolizing many requirements), and to the far left on the x-axis (symbolizing little discretion). In other words, the Uniform circle represents a “top down” approach, attempting to impose many specific requirements on countries.

By contrast, as depicted by the “Flexible” circle, a treaty that imposed few requirements in a particular area of law and that allowed countries much discretion would be situated lower along the y-axis (few requirements) and to the far right of the x-axis (much discretion). The Flexible circle represents a “bottom up” approach that achieves only modest harmonization among countries and imposes few specific requirements on them.

Although this matrix is simplistic, it provides a way to conceptualize and visualize different types of international treaties and how they are framed—not just in IP, but also in other areas of law. The primary benefit in using this matrix is that it allows systemic comparisons of different treaties in terms of their overall structure—analyzing the extent to which a treaty attempts to regulate a particular area of law and how much discretion it affords to countries.

International treaties can thus be viewed as systems or archetypes—with a particular structure or internal makeup. Analyzing or mapping these structures or “treaty DNA,” so to speak, is helpful not only to commentators who study international treaties, but also to the international bodies that draft the treaties. Just as scientists map the human DNA to develop gene therapy for diseases,<sup>17</sup> legal commentators can map treaty DNA to develop better solutions for the regulation of global problems.

## 2.2. TRIPS and the Legacy of Territorial IP Laws

The structure of international intellectual property today is largely a legacy of the first international IP treaties dating back to the nineteenth century. This legacy has resulted in relatively the same approach to international IP agreements: territorial IP laws subject to some international minimum standards that leave a

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<sup>17</sup> See Jeremy A. Colby, Note, *An Analysis of Genetic Discrimination Legislation Proposed by the 105<sup>th</sup> Congress*, 24 AM. J.L. & MED. 443, 449 (1998) (discussing proposed legislation designed to prevent abuses of genetic information).

good deal of discretion among countries to decide (i) how the minimum standards should be interpreted and implemented, and (ii) how to address other areas not covered by the treaty. The existing international IP agreements share, in other words, the same basic treaty DNA.

Graphically, the substantive IP law treaties cluster in the middle of the matrix, as depicted below in Figure 2. This is a crude representation, but nonetheless sufficient for our general purposes. Except for the Paris Convention, (i) most of the substantive IP treaties have a fair number of international requirements for particular areas of law, but, at the same time, (ii) most allow a fair amount of discretion to countries to implement the minimum standards—not only above the standard, but also at the minimum and also where no minimum standard is required. The TRIPS Agreement, Berne Convention,<sup>18</sup> Rome Convention,<sup>19</sup> and WIPO Treaties<sup>20</sup> are all constructed in this fashion.

Thus, I have placed TRIPS, Berne, Rome, and the WIPO

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<sup>18</sup> See Berne Convention, *supra* note 10. The Berne Convention has 47 articles total, plus an Appendix. (Throughout, I have counted separately articles that are enumerated in the same sequence, such as bis, ter, quarter.) Berne broadly regulates copyright subject matter, exclusive rights, term, moral rights, exceptions to the reproduction right, other exceptions, seizures, retroactivity, accession, and the Berne Union.

<sup>19</sup> See International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations, Oct. 26, 1961, 496 U.N.T.S. 43 [hereinafter Rome Convention]. The Rome Convention has 34 articles. It regulates the so-called “neighboring rights” for protection of performers, producers of phonograms or sound recordings, and broadcasting organizations. The Rome Convention, which applies only to performances, phonograms, and broadcasts, is narrower in coverage than the Berne Convention, so it is placed lower down along the y-axis in Figure 2.

<sup>20</sup> See WIPO Performances and Phonograms Treaty, Dec. 20, 1996, WIPO Doc. CRNR/DC/96, available at [http://www.wipo.int/export/sites/www/treaties/en/ip/wppt/pdf/trtdocs\\_wo034.pdf](http://www.wipo.int/export/sites/www/treaties/en/ip/wppt/pdf/trtdocs_wo034.pdf) [hereinafter WPPT]; WIPO Copyright Treaty, Dec. 20, 1996, 36 I.L.M. 65 (1997), WIPO Doc. CRNR/DC/96, available at [http://www.wipo.int/export/sites/www/treaties/en/ip/wct/pdf/trtdocs\\_wo033.pdf](http://www.wipo.int/export/sites/www/treaties/en/ip/wct/pdf/trtdocs_wo033.pdf) [hereinafter WCT]. The WCT has only 25 articles; it supplements the requirements of the Berne Convention. One of the key provisions requires the adoption of anti-circumvention law. See WCT at art. 12. In 2014, the WCT had 91 members. See *Contracting Parties*, WIPO, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=16](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=16) (last visited Jan. 20, 2014). The WPPT has 33 articles that deal with protections for performers and producers of phonograms. In 2014, the WCT had 92 members. See *Contracting Parties*, WIPO, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=) (last visited Jan. 20, 2014).

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THE GLOBAL TRADE MARK

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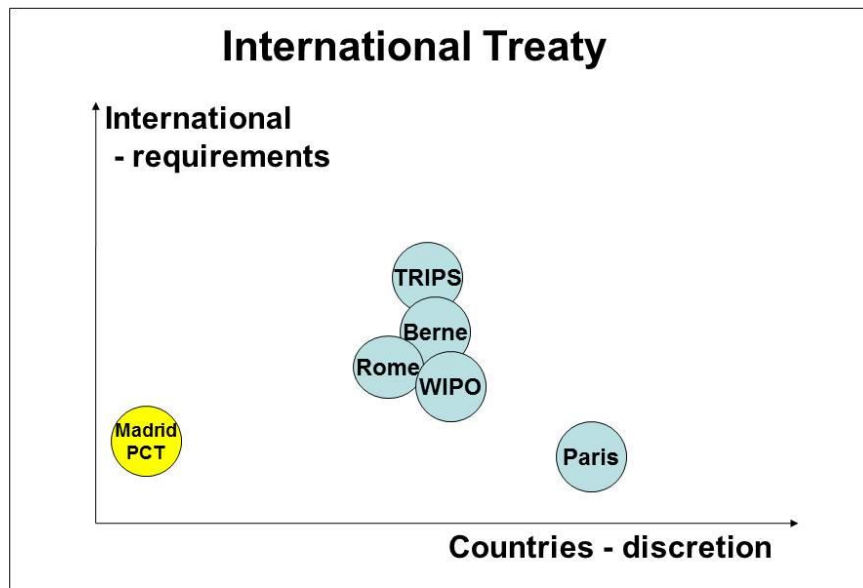
Treaties as a cluster together near the center of the matrix. Although I have tried to position them accurately *vis-à-vis* each other, I am less concerned on getting correct their respective positions *vis-à-vis* each other. The important lesson to draw from the matrix is that all of the agreements tend to share some of the same common features (or treaty DNA), as depicted by the clustering. Each has a number of international minimum standards to regulate countries' IP laws, but in a way that affords a fair amount of discretion to countries to implement the minimum standards. TRIPS is, by far, the most comprehensive agreement covering, in 73 articles, 7 different areas of intellectual property – copyright and related rights, trademarks, geographical indications, industrial designs, patents, layout-designs of integrated circuits, and protection of undisclosed information.<sup>21</sup> In addition, TRIPS also incorporates major sections of the Berne and Paris Conventions, and, to a lesser extent, the Rome Convention.<sup>22</sup> Accordingly, because TRIPS is the most detailed and comprehensive of all the IP treaties, it is the highest in the matrix.

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<sup>21</sup> See TRIPS Agreement, *supra* note 11, at art. 1(2) (discussing the scope of “intellectual property”).

<sup>22</sup> See *id.* at arts. 2, 9(1), 14(6), 16 (establishing minimum standards for intellectual property regulation).

FIGURE 2. MATRIX FOR INTERNATIONAL IP TREATIES



By contrast, the Paris Convention has relatively few minimum standards,<sup>23</sup> so it is placed lower on the y-axis. Under Paris, countries have a good deal of discretion in how they address the subject matter (primarily, trademarks and patents) under their own laws. As depicted by the Paris circle above, a big variable that affects positioning vertically in the matrix is the number of requirements in the treaty. One can break free of the cluster by having only a very few minimum standards, leaving most of the area of law unregulated by the treaty. Indeed, the considerable discretion countries had especially in patent law under Paris led, in part, to the U.S. patent lobby's successful efforts to obtain international standards for patents in the TRIPS Agreement.<sup>24</sup> In

<sup>23</sup> The Paris Convention has 46 articles total—8 of which specifically address patent issues (albeit in a narrow manner)—and 16 of which deal with trademarks. See generally Paris Convention, *supra* note 14 (creating protections for industrial property).

<sup>24</sup> See Brook K. Baker, *Ending Drug Registration Apartheid: Taming Data Exclusivity and Patent/Registration Linkage*, 34 AM. J.L. & MED. 303, 313-14 (2008) (describing efforts of a coalition including pharmaceutical, software,

other words, the TRIPS Agreement effectively reined in the discretion for patent law afforded to countries by Paris and pulled international patent regulation back to the model set by the Berne and Rome Conventions. The DNA for international IP treaties thus became even more homogeneous.

The clustering effect depicted above should not be surprising. If all the IP treaties are using the same approach—international minimum standards implemented by territorial law—one would expect the level of discretion to be in the same general ballpark. Minimum standards afford some discretion to countries, as does the reliance on territorial laws. Of course, discretion among countries is often considered to be beneficial to allow for some tailoring of IP laws to their particular socio-economic needs, culture, and circumstances.

As depicted by the Madrid/PCT circle in Figure 2, the real outliers to the cluster are the administrative treaties governing trademark and patent applications—the Madrid System<sup>25</sup> for trademarks and the Patent Cooperation Treaty (PCT) for patents.<sup>26</sup> These procedural treaties establish a uniform, international application process that all member countries follow. Madrid and

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entertainment, and publishing companies in the U.S. to secure a global system of intellectual property protections).

<sup>25</sup> The Madrid System is composed of two alternative agreements: the Madrid Agreement and the Madrid Protocol. The Madrid Agreement is the older of the two, but the less popular today. *See generally* Madrid Agreement Concerning the International Registration of Marks, Apr. 14, 1891, as amended Sept. 28, 1979, 828 U.N.T.S. 389 [hereinafter Madrid Agreement] (providing a system for obtaining trademark registrations in different jurisdictions). The Madrid Agreement has 27 articles and 46 rules. *See generally id.*; Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement, available at [http://www.wipo.int/madrid/en/legal\\_texts/common\\_regulations.htm](http://www.wipo.int/madrid/en/legal_texts/common_regulations.htm) [hereinafter Madrid Regulations] (providing rules governing Madrid Agreement). The Madrid Protocol was adopted in 1989, but already has 83 members. *See generally* Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks [hereinafter Madrid Protocol]; *Contracting Parties*, WIPO, [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=8](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=8) (last visited Mar. 20, 2014). The Madrid Protocol has 26 articles, plus the 46 rules that the Agreement shares in common. Madrid Protocol, *supra* note 25; Madrid Regulations, *supra* note 25.

<sup>26</sup> The Patent Cooperation Treaty, originated in 1970, has 69 articles and 96 rules. *See generally* Patent Cooperation Treaty, June 19, 1970, 28 U.S.T. 7645, 1160 U.N.T.S. 231, reprinted in 9 I.L.M. 978 (1970) (providing a unified procedure for filing patent applications in contracting states); *Regulations Under the Patent Cooperation Treaty*, WIPO, available at <http://www.wipo.int/pct/en/texts/rules/>.

the PCT establish uniform formalities requirements, with little country-to-country discretion. Given the lack of discretion (countries must accept the Madrid and PCT applications), the Madrid/PCT circle is placed to the far left on the x-axis. However, since the requirements, though decent in number, regulate only the narrow area of formalities for a specialized international application process, the Madrid/PCT circle falls lower along the y-axis. By establishing a uniform international application process, both Madrid and the PCT are widely praised for the efficiencies they afford applicants in securing international protections (albeit still in the territorial or national approach to IP rights).<sup>27</sup> Given the success of both the Madrid and PCT systems in producing an efficient, uniform application process, it is somewhat surprising that countries have not achieved any comparable consensus or uniform approach to any substantive IP law. As depicted in Figure 2, Madrid and PCT are noticeable outliers.

### *2.3. Why Lack of Diversity in IP Treaties Is a Problem*

The homogeneity in approach to substantive international IP treaties for over 130 years raises a problem. The lack of diversity in the ways in which substantive international IP treaties are framed may hinder international progress in lawmaking, create and entrench inefficiencies in how IP is regulated and protected, and exacerbate errors (such as in over- or under-regulation) over time.

#### *2.3.1. Perpetuation of Old Legacy System*

Using only one approach for international IP law could be desirable if we can be confident that single approach works, and works well over time, for the welter of issues subject to IP laws. Unfortunately, that is not the case.

First, the basic structure of today's international IP treaties was developed 130 years ago—before mass communication, mass transportation, and the Internet. What worked in 1880 may not

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<sup>27</sup> See David Lindsay Barch, *Navigating the Madrid Protocol: A New Global Regime for the International Registration of Trademarks*, 8 INTELL. PROP. L. BULL. 16, 16 (2003) ("The Madrid Protocol is the latest in a succession of international efforts to create an efficient one-stop shop for the international registration of trademarks."); Amir H. Khoury, *The End of the National Patent Office*, 52 IDEA 197, 210 (2012) ("In essence, the PCT simplifies the application process relating to the international registration of patents and makes it cheaper and more efficient.").

necessarily be as effective for the twenty-first century. The global economy and growth of international trade have put significant pressures on territorially-based IP protections (as discussed in greater depth below), as have the growth of international counterfeiting and commercial infringement. IP owners must adapt to the cost of obtaining and enforcing piecemeal protections by collecting national IP rights from different countries, subject potentially to varying standards in 150 plus countries. Although the territorial approach to IP treaties has afforded countries a fair amount of national discretion, the price is that IP protection is harder to achieve internationally in today's global market. Perhaps that tradeoff is one that all countries would continue to embrace, but the tension between global IP trade and territorially-based IP laws raises a serious question about the overall performance of the current structure in international IP treaties.

Second, we will never know whether some change might work better than the status quo, unless we have some *alternative* for comparison. For example, the Framers of the U.S. Constitution had the lessons from the ineffective Articles of Confederation to draw upon in drafting the Constitution.<sup>28</sup> Likewise, the United Nations had the failed League of Nations to build upon.<sup>29</sup> And, in the context of trademarks, the EU first agreed to a Trademark Directive to harmonize national trademark laws in the EU (using the territorial approach), but, five years later, agreed to the Community Trade Mark, the first unitary regional IP form.<sup>30</sup> In other words, we cannot know if a global IP system will work if it is never tried.

The proposal in this Article is intended as a small, first foray

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<sup>28</sup> See Michael J. Teter, *Recusal Legislating: Congress's Answer to Institutional Stalemate*, 48 HARV. J. ON LEGIS. 1, 2 (2011) (explaining how the Framers of the Constitution sought to address the flaws of Congress under the Articles of Confederation).

<sup>29</sup> See Mark Angehr, *The International Court of Justice's Advisory Jurisdiction and the Review of Security Council and General Assembly Resolutions*, 103 NW. U. L. REV. 1007, 1011 (2009) (stating that the failure of the League of Nations influenced the shaping and structure of the UN system).

<sup>30</sup> See First Council Directive 89/104/EEC, 1989 O.J. (L 40/1) (EC) ("Whereas the trade mark laws at present applicable in the Member States contain disparities which may impede the free movement of goods and freedom to provide services and may distort competition within the common market . . . it is therefore necessary . . . to approximate the laws of Member States"); Community Trade Mark Regulation, *supra* note 15 ("[T]rade marks should be created which are governed by a uniform Community law directly applicable to all Member States.").

into unitary IP law in a limited area that is well-suited to a global approach. The goal is *not* to displace the current territorial approach in favor of a unitary approach generally. Indeed, given how extensively the TRIPS Agreement embeds the territorial approach in all corners of IP, the idea of switching to a universal approach seems far-fetched. The current international IP regime can be likened to a legacy system that would cost too much to redesign or replace from scratch. My proposal attempts to improve upon the current approach with a more diverse set of international structures or frameworks—a new kind of treaty DNA, so to speak, but in a very limited area. Just as genetic diversity helps organisms avoid replication of deleterious traits and even outright extinction, so too does having diversity in legal approaches to regulate conduct in a fast-changing world.<sup>31</sup>

### 2.3.2. Inefficiencies of Territorial IP in Global Market

A major downside to the territorial approach to IP protection is that, while preserving a country's flexibility and sovereignty, it may make more difficult and less efficient the protection of IP internationally. The difficulties are exacerbated especially when the underlying infringing activity spans several countries—and would be considered infringing by all affected countries. For example, imagine if twenty countries around the world all would deem the same defendant to have violated anti-counterfeiting laws by producing and selling fake Tag Heuer watches. Under the current approach, Tag Heuer, the trademark holder, would still have to bring twenty separate lawsuits in twenty different countries. Although there is no conflict of law (the result of liability is the same under any national law), the trademark holder must nevertheless still bring multiple suits around the world and seek separate enforcement. The high cost of duplicative lawsuits is an inefficient allocation of resources for both the IP owners and the various national courts.<sup>32</sup>

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<sup>31</sup> Cf. Marjorie D. Matocq & Francis X. Villablanca, *Low Genetic Diversity in an Endangered Species: Recent or Historic Pattern?*, 98 *BIOLOGICAL CONSERVATION* 61, 61 (2001) (discussing the detrimental effects of a reduction in a population's genetic diversity).

<sup>32</sup> See Graeme B. Dinwoodie, *A New Copyright Order: Why National Courts Should Create Global Norms*, 149 *U. PA. L. REV.* 469, 541 n.223 (2000) (“[S]trict adherence to territoriality would cause inefficient serial national litigation of almost identical issues”); Graeme B. Dinwoodie et al., *The Law Applicable to Secondary Liability in Intellectual Property Cases*, 42 *N.Y.U. J. INT’L L. & POL.* 201, 212



Likewise, territoriality may cause distortions in investments and create incentives for inefficient allocation of resources. For example, in the bankruptcy context, Lucian Bebchuk and Andrew Guzman have shown how a system following a territorial approach to bankruptcies of a business with transnational bankruptcies—allowing the bankruptcy to be decided in multiple jurisdictions—produces distortions and inefficient allocation of capital *ex ante*.<sup>33</sup> Specifically, some “[f]irms will . . . choose not to invest in the country offering the greatest return on investment, accepting instead a lower return in exchange for a lower interest rate on loans.”<sup>34</sup>

Although more study is needed in the IP context, perhaps a similar kind of distortion occurs here. Some IP owners may under-invest in IP creation or the optimal level of IP protection for their creations in certain markets, given the expensive, piecemeal territorial approach to IP or difficulties of enforcing IP rights. Conversely, other IP owners may over-invest in order to compensate for the piecemeal, territorial approach to IP, such as by devoting massive and at times redundant resources to fight infringement and IP disputes in countries around the world.

### 2.3.3. *Errors Are Repeated at Global Level*

A final reason to question the current approach to international

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(2009) (“This approach recognizes that, despite historical commitments to territoriality, the application of numerous national laws to conduct that bears no overriding connection to a single state is not only inefficient but arguably also relatively weak in prescriptive legitimacy.”). A similar concern arises in other contexts. See Paul B. Stephan, *Global Governance, Antitrust, and the Limits of International Cooperation*, 38 CORNELL INT’L L.J. 173, 208 (2005) (“[A] universal commitment to territoriality would prevent a state from regulating offshore producers intending to limit competition in the state’s market, thus creating inefficiencies. Barring all such desirable regulation can be justified only if one can demonstrate that on balance extraterritorial regulation would decrease welfare.”).

<sup>33</sup> See Lucian Arye Bebchuk & Andrew T. Guzman, *An Economic Analysis of Transnational Bankruptcies*, 42 J.L. & ECON. 775, 775 (1999) (“Territoriality is shown to generate a distortion in investment patterns that might lead to an inefficient allocation of capital across countries.”). But see Lynn M. LoPucki, *The Case for Cooperative Territoriality in International Bankruptcy*, 98 MICH. L. REV. 2216, 2226 (2000) (describing the difficulty in identifying the home country of debtors for bankruptcy purposes); Robert K. Rasmussen, *A New Approach to Transnational Insolvencies*, 19 MICH. J. INT’L L. 1, 5 (1997) (arguing that to promote efficiency, firms should be allowed to choose a set of bankruptcy rules to use in case of financial distress at the time of their incorporation).

<sup>34</sup> Bebchuk & Guzman, *supra* note 33, at 779.

IP agreements is that such redundancy in approach will likely reproduce any shortcomings or errors in the approach itself. As discussed in the previous section, the territorial approach to IP increases enforcement and judicial costs for transnational suits involving the same course of conduct. If all IP treaties have the same territorial approach, the inefficiencies produced by piecemeal IP protection are compounded and repeated—in copyright law, patent law, trade secret law, trademark law, and other IP laws. To the extent international IP agreements all instantiate the same territorial approach, the inefficiencies become universalized. Would-be infringers are able to exploit these longstanding deficiencies, much in the same way bacteria become resistant to the same antibiotics if used over and over again. For example, counterfeiters can locate their illegal operations offshore in countries with lax trademark enforcement and thereby escape the territorial reach of other countries.

In the face of imperfect information about the best international system of IP,<sup>35</sup> relying on a single approach in international IP agreements increases the potential magnitude of any systemic error. Instead of a systemic error localized to one treaty (such as for copyright law), the error becomes replicated in all signatory countries in all IP treaties with the same DNA or approach (such as for patent law, trade secret law, and trademark law). Of course, this fear of reproducing errors occurs with global laws as well—“[a] single bad rule that applies worldwide carries much greater potential harm than a single bad rule that applies to just one country.”<sup>36</sup> My proposal for a universal approach is not immune from this concern. Ameliorating the inefficiencies of the territorial approach by a universal system may produce other side effects that require addressing. However, one way to deal with this danger is to limit the global approach to a narrow area, in order to test its effectiveness, as proposed by this Article. My

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<sup>35</sup> See generally Edward Lee, *The New Canon: Using or Misusing Foreign Law to Decide Domestic Intellectual Property Claims*, 46 HARV. INT'L L.J. 1, 21–22 (2005) (discussing when and how U.S. courts might rely on foreign authorities in deciding IP cases).

<sup>36</sup> *Id.* at 21. Although in my prior scholarship I have emphasized the importance of having diversity in IP approaches at the *national* level, my position here does not negate that goal. Instead, my proposal for a narrow class of global trademark is meant to be integrated within the current system of international IP treaties, nearly all of which are predicated on minimum standards that afford countries a fair amount of discretion in their national laws.

proposal is incremental and is meant to be incorporated alongside existing international IP treaties that take a territorial approach. If so adopted, the proposal will provide greater diversity to the ways in which countries protect IP rights internationally.

#### *2.4. Why Well-Known Marks Are Suited for Global Rights*

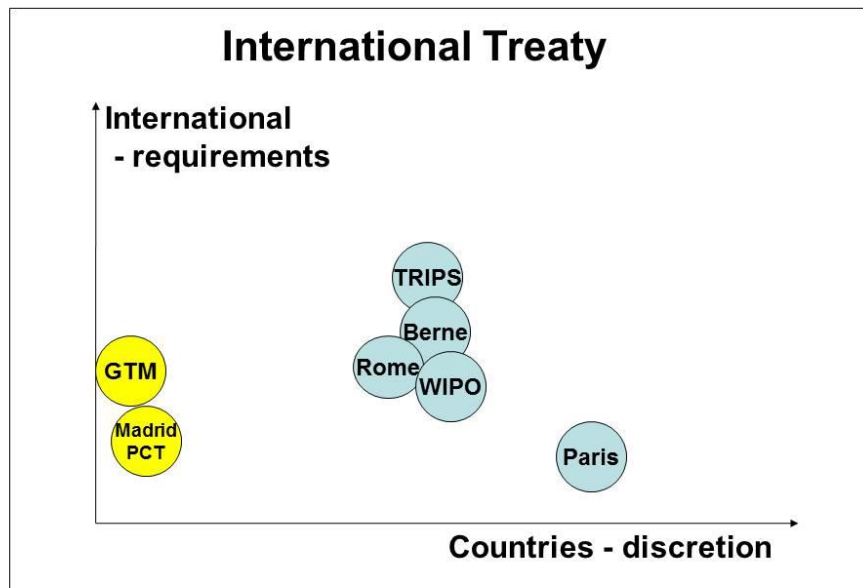
Proposals for developing a unitary, global law should be treated with caution, if not skepticism. Well-known marks, however, present a narrow area that may be better suited for developing a global law.

##### *2.4.1. Limited Class of "Super" Well-Known Marks*

One reason why the proposed Global Trade Mark offers a good opportunity to attempt a unitary international IP approach is that it would govern a very narrow class of marks that are well-known in a threshold number of countries around the world, at least in three continents (as discussed in Parts 3 and 4). The narrow class of marks eligible for the GTM would be "super" well-known marks that are famous in a sizeable portion of the world. Thus, relatively few trademarks in the world would qualify for the GTM. As a first foray into global IP rights, it is attractive to begin with a relatively small class of subject matter. In other words, the GTM would deal with global marks—which are a good fit for global lawmaking.

If we situate the GTM on our treaty matrix, it would fall to the far left of the x-axis (allowing little discretion to countries), but only modestly up the y-axis (although above the Madrid/PCT circle), indicating that the GTM imposes uniform substantive law requirements only for a limited field of trademarks. From an international perspective, the benefit of the GTM is that it would be the first real attempt in the left side of the matrix—establishing a uniform substantive IP law, but only in a narrow area.

FIGURE 3. THE GLOBAL TRADE MARK ON THE TREATY MATRIX



#### 2.4.2. Existing Special International Protections for Well-Known Marks

Another reason the proposed Global Trade Mark presents a good area for developing a global system of IP law is that well-known marks already receive special international protections under the Paris Convention and TRIPS. These special protections help well-known marks attain international reach, even without use or registration in a country.

Article 6bis of the Paris Convention effectively requires countries to recognize and to give priority to trademarks that are well-known in their borders, irrespective of registration and use.<sup>37</sup> A well-known trademark has priority over third-party uses of the mark on identical or similar goods.<sup>38</sup> While countries normally

<sup>37</sup> See Paris Convention, *supra* note 14, at art. 6bis (protecting against the use, in any country party to the Convention, of a trademark which constitutes a "reproduction, an imitation, or a translation" of a well-known mark found in that country).

<sup>38</sup> *Id.*

require either registration or use as a prerequisite to obtaining trademark rights, neither can be required if the mark is already famous in the country.<sup>39</sup> The fame of the mark acts effectively as a surrogate for registration or use.

Article 16(2) of TRIPS extends the protections of Article 6bis of Paris to service marks, in addition to providing some guidelines on what factors should be considered in determining whether a mark is well-known.<sup>40</sup> Article 16(3) of TRIPS extends Paris Article 6bis protection to registered well-known marks; the protection extends “to goods or services which are *not similar* to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.”<sup>41</sup> The precise meaning of Article 16(3) has been the source of contention among countries—some countries like the U.S. argue that it requires protection against dilution of well-known marks, while other countries like Australia argue that it requires protection only against likelihood of confusion with well-known marks.<sup>42</sup> Regardless of the controversy over TRIPS Article 16(3), TRIPS and Paris offer heightened protections for well-known marks. These special protections allow well-known marks to qualify for trademarks around the world, simply based on the fame of the mark within respective countries.

Thus, the more famous the mark around the world, such as Coca-Cola, the more likely it will have trademark protection in all countries in the WTO simply by being famous. In this respect, the

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<sup>39</sup> See WIPO WELL-KNOWN MARKS STUDY, *supra* note 13, at 4–5 (stating that Article 6bis can be invoked where a “trademark is registered but not—or not sufficiently—used in the country, and there is no justification for the failure to use” in order to “ensure protection for the trademark, provided it is well known in the country”).

<sup>40</sup> See TRIPS Agreement, *supra* note 11, at art. 16(2) (“In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge of the Member concerned which has been obtained as a result of the promotion of the trademark.”).

<sup>41</sup> *Id.* at art. 16(3) (emphasis added).

<sup>42</sup> See Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 YALE J. INT’L L. 405, 432 (2010) (explaining that some WTO members, including Australia, advocated for more narrow obligations under Article 16(3)).

current Paris and TRIPS protections for well-known marks can be viewed as precursors to the proposed Global Trade Mark. As Frederick Mostert suggests, we are already down the path of a global trademark based on “a common set of principles, in effect a *ius gentium* [that] has developed around famous and well-known marks, which can serve as a basis for a harmonized global approach in conformity with the needs of contemporary commerce.”<sup>43</sup> Given these existing protections for well-known marks, the proposed treaty would not be too radical of a change for countries to adopt.

### 3. PROPOSAL: THE GLOBAL TRADE MARK TREATY

This Part outlines the institutional design of the proposed Global Trade Mark Treaty as an agreement within the WTO. The Treaty is intended to create an international registration system to be administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) and a uniform body of law for Global Trade Marks.

#### 3.1. WTO and WIPO Joint Oversight

As the preferred route, the Global Trade Mark Treaty will be proposed as a WTO agreement. The advantage of operating under the auspices of the WTO is twofold: first, the WTO has 159 members (thereby ensuring a near global scope to protection); and, second, the WTO has an established Dispute Settlement Body to handle disputes among countries related to enforcement and implementation of the treaty.<sup>44</sup> Empirical studies show that the DSB has been fairly successful in resolving IP disputes among countries and in encouraging countries to fix violations of their international obligations.<sup>45</sup>

A goal of the GTM Treaty would be to combine institutional

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<sup>43</sup> FREDERICK W. MOSTERT, *FAMOUS AND WELL-KNOWN MARKS: AN INTERNATIONAL ANALYSIS*, at xxxi (2d ed. 2004).

<sup>44</sup> See Geraldo Vidigal, *From Bilateral to Multilateral Law-Making: Legislation, Practice, Evolution and the Future of Inter Se Agreements in the WTO*, 24 EUR. J. INT'L L. 1027, 1029 (2013) (highlighting how the involvement of the WTO transforms “bilateral logic,” which normally underlies state relations, into a more fluid type of “multilateral logic”).

<sup>45</sup> See Edward Lee, *Measuring TRIPS Compliance and Defiance: The WTO Compliance Scorecard*, 18 J. INTELL. PROP. L. 401, 411-12 (2011) (proposing the use of a TRIPS Compliance Scorecard to rate a country’s attempts to correct its alleged treaty violations).

features of both the WTO and the International Bureau of WIPO to administer the GTM. The WTO would handle primarily dispute resolution among countries (as it does for the TRIPS Agreement and other WTO agreements), while the IB of WIPO would handle registration of GTMs by trademark holders, given the IB's expertise in administering international registrations under the Madrid System.<sup>46</sup> WIPO already has a searchable online database of international registrations under Madrid (an application system that is still predicated on territorial, national rights).<sup>47</sup> The idea would be to expand that Madrid database to include new GTM registrations—establishing, for the first time, an international database of global marks.

Of course, WIPO is a separate entity (a specialized agency of the United Nations) from the WTO,<sup>48</sup> so the proposed joint effort between the WTO and WIPO would take coordination. But, as other scholars have recognized, greater collaboration between WTO and WIPO would be fruitful and desirable in developing international IP.<sup>49</sup>

The GTM Treaty would not displace the current Madrid System. Instead, the GTM would operate alongside the Madrid System, adding an extra level of registration and protection for a special class of global marks. Trademark holders would still be able to utilize the Madrid System. Indeed, given the high threshold for trademarks to qualify for GTM status (discussed in Part 4), one would expect that most trademark holders would opt to use the Madrid System in order to attain international registrations of their marks in various countries.

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<sup>46</sup> See *The International Application*, WIPO, <http://www.wipo.int/madrid/en/general/#intapp> (last visited Jan. 20, 2014) (summarizing requirements for rendering international applications under the Madrid System).

<sup>47</sup> See *Madrid: The International Trademark System*, WIPO, <http://www.wipo.int/romarin> (last visited Jan. 20, 2014) (providing searchable database of international registrations).

<sup>48</sup> *What is WIPO?*, WIPO, <http://www.wipo.int/about-wipo/en/> (last visited Jan. 20, 2014).

<sup>49</sup> See generally Graeme B. Dinwoodie & Rochelle C. Dreyfuss, *Designing a Global Intellectual Property System Responsive to Change: The WTO, WIPO, and Beyond*, 46 HOUS. L. REV. 1187, 1192–96 (2009) (forwarding suggestions regarding the design of a more comprehensive and responsive intellectual property system).

### 3.2. *Global Rights and Unitary International Law*

#### 3.2.1. *Recognizing a Global Trade Mark*

The defining feature of the Global Trade Mark is that it would establish one “global” trademark that would be effective in all 159 countries of the World Trade Organization. Although the GTM would be limited to a very narrow class of “super” well-known marks (as determined by a formula discussed in Part 4), once a mark qualified for GTM registration, it would automatically receive protection in all member countries around the world. In short, a single GTM registration would preserve the GTM owner’s rights in all countries as a unitary global right.<sup>50</sup>

The GTM will recognize three basic causes of actions: (1) trademark infringement, (2) dilution in countries where fame of the mark is established, and (3) counterfeiting. Actions against counterfeiting and trademark infringement (based on likelihood of confusion) are required already by TRIPS, so their inclusion in the GTM Treaty should not raise controversy.<sup>51</sup> But countries disagree whether TRIPS requires actions against dilution of registered well-known marks under Article 16(3),<sup>52</sup> and the expansion of dilution claims has generated criticism among some trademark scholars.<sup>53</sup> However, at least some of these criticisms would be vitiated by setting a very high standard to qualify for a “super” well-known mark under the GTM Treaty.<sup>54</sup> The GTM Treaty could also include special protections for GTMs as used in domain names. For example, with coordination with ICANN, the Uniform

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<sup>50</sup> Should a GTM owner choose to give up all of its prior national registrations, the GTM would still operate to protect and preserve the rights to the mark in all of those countries.

<sup>51</sup> See TRIPS Agreement, *supra* note 11, at arts. 16(1), 61 (providing that the owner of a registered trademark may prevent third parties from using identical or similar signs to those in respect of which the trademark is registered).

<sup>52</sup> See *supra* note 42 and accompanying text (noting that some states do not confer a broad anti-dilution right on the holders of well-known marks).

<sup>53</sup> See, e.g., Robert N. Klieger, *Trademark Dilution: The Whittling Away of the Rational Basis for Trademark Protection*, 58 U. PITT. L. REV. 789 (1997) (examining the importance and simultaneous fragility of trademarks).

<sup>54</sup> Cf. Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1704 (1999) (dilution should be limited to truly famous marks because “preventing dilution in appropriate cases will lessen aggregate consumer confusion and thus encourage investment in the quality of the underlying product”).



Domain-Name Dispute Resolution policy<sup>55</sup> could be amended to include a specific provision prohibiting registration of a domain name by third parties consisting solely of a GTM in any second-level or top-level domain (including new top-level domains approved by ICANN).

Another major benefit of the GTM is enforcement: GTM owners can bring enforcement actions against international infringement in one jurisdiction and obtain international remedies. To return to the counterfeit Tag Heuer watch example, if Tag Heuer qualified for a GTM, it could sue the counterfeiter in one country and receive an injunction that covered the 20 countries where the defendant had been selling counterfeit Tag Heuer watches. Thus, in terms of both registration and enforcement, the GTM would be more efficient than the current piecemeal approach under TRIPS. All that is needed is one court to enforce a registered GTM internationally.

### 3.2.2. *Establishing a Uniform International Law*

Another defining feature of the GTM Treaty is that it would establish—for the first time in history—a unitary body of international IP law that would, at least in theory, be uniform across all jurisdictions. Of course, establishing a uniform body of international law is easier said than done. But, as explained below, the institutional design of the GTM will be set up to maximize the possibility of achieving a uniform approach.

One way to minimize the prospect of conflict among countries is to draft the GTM Treaty with greater specificity, particularly on key issues, such as what constitutes a well-known mark. The goal would not be to draft minimum standards that allow countries the chance for divergent views—the territorial approach of TRIPS, the Paris Convention, and the Berne Convention. Instead, the goal would be to draft specific rules for how the GTM will operate for uniform application. The Treaty will enumerate the standards for proving trademark infringement, dilution, and counterfeiting, as well as fair use, generic marks, and other defenses. And, as discussed below, the new International Court of the GTM will provide authoritative interpretations of the Treaty.<sup>56</sup>

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<sup>55</sup> See *Uniform Domain Name Dispute Resolution Policy*, ICANN, <http://www.icann.org/en/udrp/udrp.htm> (offering a synopsis of the Dispute Resolution Policy).

<sup>56</sup> For a helpful discussion on what the test might consider, see *infra* note 72;

### 3.2.3. *The International Court of the Global Trade Mark (ICGTM)*

The limits of language make it difficult, if not impossible, to avoid some uncertainty and disagreement over the application of treaty provisions to future circumstances. Thus, critical to the success of establishing a uniform international law would be to have an institution that would resolve any conflicts in interpretation of the treaty among countries and that would be the final authority on the meaning of the treaty.

The GTM Treaty will establish the International Court of the Global Trade Mark (ICGTM), to be seated in Geneva, Switzerland. WTO Members would nominate qualified judges and lawyers from their countries to serve on the ICGTM; each country can nominate only one person. Based on a vote of the WTO, five ICGTM judges would be selected to serve for four years. All five judges would hear cases involving interpretation of the Treaty. Decisions would be made by majority vote and would be precedential within the ICGTM—meaning past interpretations by the ICGTM would be binding in future cases unless the Court voted to overrule its earlier decision.

The ICGTM would have jurisdiction over interpretation of the GTM Treaty based on a national referral system. In this regard, the ICGTM would operate similarly to the Court of Justice of the European Union (CJEU), which provides uniform interpretations of EU law based on referrals from national courts in EU countries.<sup>57</sup> The ICGTM would decide questions of interpretation of the Treaty referred by national courts in WTO countries. A WTO member itself could refer a question related to a final decision of a national court involving interpretation of the GTM Treaty. The ICGTM would be required to review any referral by a national court or a country. In either type of referral, the ICGTM would decide or resolve only legal issues (but not factual issues). The Court's interpretation of the Treaty would be authoritative.

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WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, Sept. 20–29, 1999, WIPO Publication 833(E), available at [http://www.wipo.int/about-ip/en/development\\_iplaw/pub833-01.htm#P59\\_2888](http://www.wipo.int/about-ip/en/development_iplaw/pub833-01.htm#P59_2888); see also Leah Chan Grinvald, *A Tale of Two Theories of Well-Known Marks*, 13 VAND. J. ENT. & TECH. L. 1, 22 (2010) (discussing establishment of fame through consumer “passive perception” versus consumer “interaction”).

<sup>57</sup> See Juscelino F. Colares, *The Reality of EU-Conformity Review in France*, 18 COLUM. J. EUR. L. 369, 371 (2012) (explaining how EU-conformity review emerged and analyzing whether EU supremacy theories spawn different conformity adjudication results).

The ICGTM would also have discretionary jurisdiction to review appeals filed by parties from decided cases involving GTM claims in national courts. The discretionary authority to review appeals in actual disputes would be similar to the U.S. Supreme Court's discretionary authority to grant petitions for writ of certiorari.<sup>58</sup> Thus, if a designated national court made an egregious legal error or misapplication of GTM law, the International Court would have the discretionary power to review and reverse the error.

#### 3.2.4. Dispute Resolution: WTO DSB to Resolve Challenges

Finally, the WTO Dispute Settlement Body (DSB) will resolve disputes brought by countries as to the enforcement and implementation of the GTM Treaty in countries. If a member fails to implement the Treaty, or repeatedly rejects or misapplies an interpretation of the Treaty by the ICGTM, other members would be able to bring a challenge before the WTO Dispute Settlement Body. A violation of the ICGTM would be handled in the same way as any other violation of other WTO agreements—with the possibility of trade sanctions being authorized against non-compliant countries as a last resort.<sup>59</sup> The institutions involved in interpreting and enforcing the GTM Treaty would help to ensure, as best as reasonably possible, that it is applied in a uniform manner among countries.

#### 4. GTM REGISTRATION: THE TWO PATHWAYS TO OBTAINING A GLOBAL TRADE MARK

Part 4 outlines two pathways of registration by which trademark holders can register a GTM. Pathway 1 is for trademarks that are already well-known in several countries. Pathway 2 is for new trademarks or trademarks that are not yet well-known. Each pathway is discussed in turn.

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<sup>58</sup> See Ryan Stephenson, *Federal Circuit Case Selection at the Supreme Court: An Empirical Analysis*, 102 GEO. L.J. 271, 273 (2013) (describing how, in the absence of a circuit split, the Supreme Court decides which Federal Circuit cases merit review).

<sup>59</sup> See Lee, *supra* note 45, at 405–08 (explaining how the Dispute Settlement Body (DSB) operates to enforce compliance with international obligations).

#### 4.1. ELIGIBLE MARKS: WORD MARKS, LOGOS, AND COMPOSITES

Before discussing how entities can obtain a Global Trade Mark, one important limitation should be noted. At the inception of the GTM Treaty, only word marks (including stylized word marks), logos or devices, and composites of word marks and logos would be eligible for registration as a GTM. However, trade dress and so-called non-traditional marks<sup>60</sup> (sound, smell, color alone, three-dimensional items, touch, motion, etc.) would *not* be eligible for GTM registration. The reason for excluding trade dress and non-traditional marks is to minimize disagreement among countries on whether the mark should be protectable or not. All WTO countries recognize word marks and logos as trademarks.<sup>61</sup> But countries diverge on how, if at all, trade dress and non-traditional marks should be protected.<sup>62</sup>

Another reason to limit the field of eligible marks is administrative: in implementing the new GTM system, the International Bureau and national trademark offices designated to review GTM applications should be given an easier task at the start. Search capabilities for nontraditional marks—such as smell, taste, and motion—are not as effective as they are for text or words. In the future, the WTO might consider opening up the GTM to trade dress or non-traditional marks, but only after seeing how well or poorly the GTM system worked with basic word marks and logos.

#### 4.2. Pathway 1: Graduation of Existing Well-Known or Famous Marks

The Global Trade Mark will be limited to a class of marks that are well-known in numerous countries—the idea being that GTMs should be reserved for marks that are global in recognition among

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<sup>60</sup> See Anne Gilson LaLonde & Jerome Gilson, *Getting Real with Nontraditional Trademarks: What's Next After Red Oven Knobs, the Sound of Burning Methamphetamine, and Goats on a Grass Roof?*, 101 TRADEMARK REP. 186 (2011) (discussing U.S. approach to nontraditional marks).

<sup>61</sup> See TRIPS Agreement, *supra* note 11, at art. 15 (setting forth trademark subject matter).

<sup>62</sup> See THOMAS P. ARDEN, PROTECTION OF NONTRADITIONAL MARKS: TRADEMARK RIGHTS IN SOUNDS, SCENTS, COLORS, MOTIONS AND PRODUCT DESIGN IN THE U.S. (2000); Melissa E. Roth, *Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations*, 27 CARDOZO L. REV. 457, 464-95 (2005) (discussing EU and U.S. approach to nontraditional marks).

the public. The following section explains a threshold requirement of fame that trademark owners must meet in order to register a GTM.

*4.2.1. Threshold Requirement: The Rule of 7*

Under Pathway 1, well-known marks can “graduate” to Global Trade Mark status upon proof that the mark is well-known in a certain threshold number of countries. The Global Trade Mark is reserved for those trademarks that can be considered in some sense “global” in reach. The exact threshold can be set after debate and deliberation by the WTO. For illustrative purposes, this Article offers the following formula, called “the Rule of 7.” Under the Rule of 7, the trademark holder must establish a well-known mark in 7 of the Top 30 nations in GDP at the time of filing as determined by the International Monetary Fund (the list from two years previous would be used for all filings within the calendar year). The 7 countries must be from the following 2 sets of countries:

- (a) **Category A:** The trademark holder must establish a well-known mark in at least 2 of the Top 4 countries or entities in terms of GDP (the EU, U.S., China, and Japan in 2012), and
- (b) **Category B:** The trademark holder must establish a well-known mark in at least 5 of the Top 5 through 30 GDP countries (a country in the Top 4 countries can also be used here if not used to satisfy Category A).<sup>63</sup>

In addition, to satisfy the requirements of Categories A and B, the Rule of 7 requires that the 7 countries chosen must span at least 3 continents—a number that probably would be expected in any event, given the current break down of Top 30 GDP countries. In order to avoid double counting, if one of the Top 4 countries

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<sup>63</sup> In 2012, the Top 31 GDP countries or trading areas were: (1) EU, (2) U.S., (3) China, (4) Japan, (5) Germany, (6) France, (7) UK, (8) Brazil, (9) Russia, (10) Italy, (11) India, (12) Canada, (13) Australia, (14) Spain, (15) Mexico, (16) South Korea, (17) Indonesia, (18) Turkey, (19) Netherlands, (20) Saudi Arabia, (21) Switzerland, (22) Sweden, (23) Norway, (24) Poland, (25) Belgium, (26) Argentina, (27) Taiwan, (28) Austria, (29) South Africa, (30) United Arab Emirates, and (31) Venezuela. See *List of Countries by GDP (Nominal)*, WIKIPEDIA, [http://en.wikipedia.org/wiki/List\\_of\\_countries\\_by\\_GDP\\_\(nominal\)](http://en.wikipedia.org/wiki/List_of_countries_by_GDP_(nominal)) [hereinafter 2012 GDP list] (collecting data from IMF and other institutions) (last visited Jan. 20, 2014).

relied on by the trademark owner is the EU, EU countries could not also be used to meet the threshold in Category B.<sup>64</sup> Because some of the countries in Category B are from the EU, an additional country from the GDP list (Venezuela) will be added in order to increase the options available to GTM applicants.

<b>Rule of 7 - Top 30 GDP Countries (2012)</b>	
<b>Category A</b>	<b>Category B</b>
EU	Germany
United States	France
China	United Kingdom
Japan	Brazil
	Russia
	Italy
	India
	Canada
	Australia
	Spain
	Mexico
	South Korea
	Indonesia
	Turkey
	Netherlands
	Saudi Arabia
	Switzerland
	Sweden
	Norway
	Poland
	Belgium
	Argentina
	Taiwan
	Austria
	South Africa
	United Arab Emirates
	Venezuela

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<sup>64</sup> If a country listed in the Top 30 GDP countries is not a member of the WTO (such as Iran), that country is excluded from the list of qualifying countries and the next country on the list of Top 30 GDP countries is included.

Consider the following example of how a trademark owner could satisfy the Rule of 7. Coca-Cola can satisfy the Rule of 7 by having a well-known mark in the U.S. and EU (2 from Category A), plus in Canada, Brazil, Mexico, Australia, and South Korea (5 from Category B). The trademark "Coca-Cola" is already well-known in many countries around the world, but the trademark owner would only need to prove its mark is well-known in 7 countries.<sup>65</sup>

Likewise, Samsung might satisfy the Rule of 7 by establishing that it has a well-known mark in China and Japan (2 from Category A), plus the U.S., South Korea, India, Indonesia, and UK (5 from Category B).<sup>66</sup> Louis Vuitton might prove that it has a well-known mark in the U.S. and Japan (2 from Category A), plus Germany, France, UK, Italy, and Spain (5 from Category B).<sup>67</sup> In each of these examples, the well-known trademark can "graduate" to Global Trade Mark status and obtain GTM registration upon submission of evidence of fame to satisfy the Rule of 7.

Using a formula like the Rule of 7 has several advantages. First, the formula can help to identify marks that are famous in several large GDP countries around the world. The trademark holder would have to prove well-known status in 3 different continents, if not more. Thus, under the Rule of 7, a trademark holder would be required to show well-known status in parts of at least 50% of the continents of the world (excluding Antarctica). This requirement would help to screen out those marks whose fame was only regional.

Second, the Rule of 7 targets fame in the Top 30 GDP countries, meaning those countries that produce the greatest market value in goods and services. Establishing well-known trademarks in 2 of the Top 4 GDP countries and 5 of the other Top 30 countries serves as a reasonable proxy for the strength of the consumer recognition that the trademark in question has around the world. The Top 30 GDP countries (excluding the EU and including Venezuela instead of Iran) represent over 86 percent of the world's total GDP.<sup>68</sup> Thus,

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<sup>65</sup> In 2013, "Coca-Cola" was ranked as the third most valuable brand in the world. See Stephen Shankland, *Apple Bumps Coca-Cola to Become World's Top Brand*, CNET (Sept. 30, 2013), [http://news.cnet.com/8301-13579\\_3-57605207-37/apple-bumps-coca-cola-to-become-worlds-top-brand/](http://news.cnet.com/8301-13579_3-57605207-37/apple-bumps-coca-cola-to-become-worlds-top-brand/) (assessing the value of brands).

<sup>66</sup> Samsung was ranked No. 8 in the world in terms of brand value. *Id.*

<sup>67</sup> Louis Vuitton was ranked No. 17 in the world in terms of brand value. *Id.*

<sup>68</sup> The numbers are based on calculations from the IMF GDP figures for 2012

the Rule of 7 would require the trademark holder to establish well-known status of its mark in markets representing, at a minimum, 22 percent of the world's total GDP.<sup>69</sup> And if the U.S. is one of the countries used to satisfy the Rule of 7, the trademark holder would have to establish well-known status in markets representing at least 33 percent of world GDP.<sup>70</sup>

Third, the Rule of 7 is a pragmatic formula. It is meant to alleviate some of the applicant's cost and burden of having to prove the existence of a well-known mark in every country in the WTO. Such a country-by-country requirement for all 159 WTO countries would likely be cost-prohibitive and would deter trademark holders from even applying for a GTM. Instead of 159 countries, the trademark holder seeking a GTM would have to prove well-known status in only 7 countries (2 from Category A and 5 from Category B).

Of course, the ultimate formula adopted by the WTO might be different from the Rule of 7. The important point is not the exact formula, but what it represents. The requirements of proving the fame of a mark could be made easier or harder—depending on what countries viewed as the better approach. The Rule of 7 is an example of an approach that attempts to balance (i) the interest of reserving the GTM for truly global marks and (ii) the costs and practicalities of proving the fame of a mark in many countries around the world. The threshold for establishing the global fame of a mark should not be set so low that even marks with only regional fame can qualify. On the other hand, the threshold should not be set too high—such as proving fame in all 159 countries—that it would be cost-prohibitive for applicants. The Rule of 7 strikes a balance.

#### 4.2.2. GTM Application Process

As depicted in Figure 4 below, the first step in the application

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(by adding the GDP figures from the Top 30 countries and dividing them by the total world GDP figure). See 2012 GDP list, *supra* note 63.

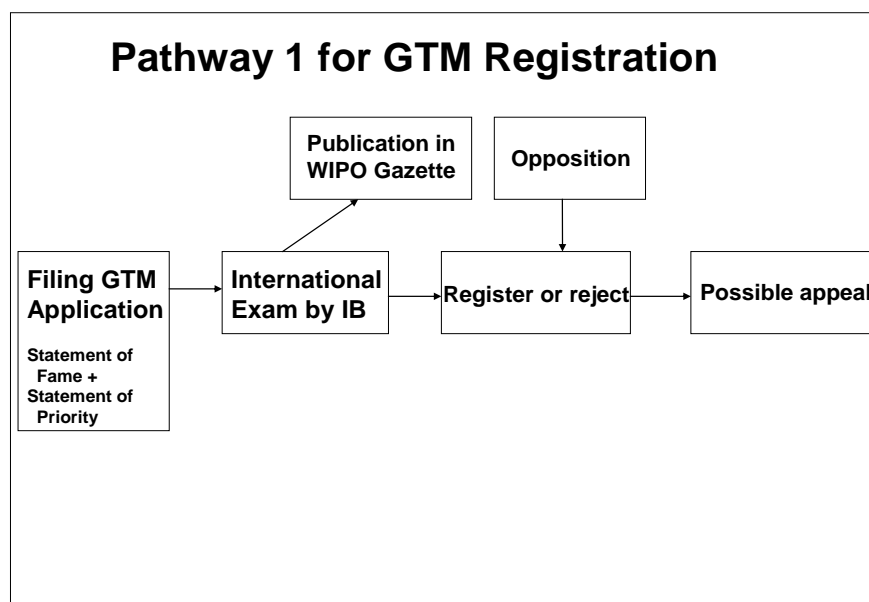
<sup>69</sup> The figure is calculated by adding the GDP from the two countries with the lowest GDP in Category A (China and Japan) and the five countries with the lowest GDP in Category B (Taiwan, Austria, South Africa, United Arab Emirates, and Venezuela), then dividing that number by the world GDP figure. See *id.*

<sup>70</sup> The figure is calculated by adding the GDP from the U.S. and the country with the lowest GDP in Category A (Japan) and the five countries with the lowest GDP in Category B (Taiwan, Austria, South Africa, United Arab Emirates, and Venezuela), then dividing that number by the world GDP figure. See *id.*



process is that a trademark holder files a GTM application electronically in the IB of WIPO or in a designated national office. The electronic databases of the IB and the designated national offices will be coordinated. The GTM application can be the first application filed for a new mark, or it can be a subsequent filing for an existing mark (including with Paris priority for applications filed within a six-month period after the first filing).<sup>71</sup>

FIGURE 4. PATHWAY 1 FOR GTM REGISTRATION



In the application, the trademark holder is required to aver, with supporting documentation, that (i) its trademark is well-known in seven countries to satisfy the Rule of 7 (“Statement of Fame”) and (ii) it has conducted an international search of its trademark and believes it has priority over the trademark as of a specified date (“Statement of Priority”).<sup>72</sup> As to the Statement of

<sup>71</sup> For more on the Paris priority, see *infra* note 86 and accompanying text.

<sup>72</sup> The GTM Treaty or regulations would set forth acceptable evidence of fame, such as evidence showing: (i) high volume of or revenues from sales of goods or services offered under the trademark during the relevant times in

Priority, the trademark holder would have a duty to conduct an international search of its mark and to disclose the entity that performed the search (which could be itself), the extent of the search, and any known prior users of the mark or other marks likely to cause confusion. If the trademark holder has national registrations of the mark, those registrations can be used as evidence of priority in those countries where the mark was already registered.

As depicted in Figure 4, the next step in the process is that the IB or the trademark office in which the application is filed would begin to conduct the international examination of the mark. The IB would focus on two main criteria: (i) the priority of the trademark holder to the mark internationally and (ii) the fame of the mark under the Rule of 7. Other aspects of trademark eligibility, such as lack of distinctiveness of a descriptive mark, will also be considered. The trademark examiner would review the application, particularly the Statement of Fame and Statement of Priority, along with the supporting documentation submitted by the applicant. The trademark examiner would be able to seek information, further evidence, and disclaimers from the applicant during the examination process.

Thus, the International Bureau of WIPO will assume a much greater examination role for the GTM than it currently has for international applications under the Madrid System. Under Madrid, the IB undertakes primarily an administrative role in registering international applications and coordinating requests for extension of protection with national offices.<sup>73</sup> Under the GTM Treaty, however, the IB, along with designated national offices, will make legal determinations as to priority and fame of the mark.<sup>74</sup>

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countries used to satisfy the Rule of 7, (ii) expenditures on advertising and publicity of the trademark during the relevant times in those countries, (iii) actual recognition of the trademark in those countries, such as by surveys and national media, (iv) the number of consumers of the product or service in those countries, and (v) the regions where the product or service is marketed and sold in those countries.

<sup>73</sup> See Int'l Trademark Ass'n (INTA), *The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice*, 92 TRADEMARK REP. 1430, 1460-61 (2002) [hereinafter INTA] (describing the International Bureau's role in reviewing Madrid applications).

<sup>74</sup> The IB and designated national offices will assume responsibilities akin to International Search Authority patent offices under the Patent Cooperation Treaty. See Markus Nolf, *The Expanded International Search Procedure: What Will*

Third, the trademarks in GTM applications will be published in the *WIPO Gazette* at a designated point in time, so that third parties with an interest in the same or similar trademark—such as senior mark holders—could file oppositions to the registration (e.g., to challenge the asserted fame of the mark or the applicant's priority).<sup>75</sup> Entities filing oppositions would have access to the application and supporting documents for challenge. Oppositions would be adjudicated by the revamped IB of WIPO or by designated national trademark offices.

Fourth, upon the completion of the international examination (and any opposition), the trademark office would render a decision on the (i) priority and (ii) the fame of the mark under the Rule of 7. Applications that satisfied the GTM criteria would be registered on the GTM registry administered by the IB. Applications that failed to satisfy the GTM criteria would be denied. Rejected applications could be appealed to a specialized GTM appellate court established by the WTO. In addition, as discussed below, the applicant would have the opportunity to convert a denied GTM application into a national application, while still maintaining the priority date of the GTM application.

#### 4.2.3. Example of Pathway 1 Application: Coca-Cola

The following example shows how Pathway 1 operates. Coca-Cola, owner of the world's third most valuable brand, has numerous trademark registrations around the world and is no doubt famous in many countries.<sup>76</sup> After the GTM Treaty becomes effective, Coca-Cola applies for a GTM on its mark "Coca-Cola" for beverages, in part to get the ability to bring international trademark claims in one forum. Its Statement of Fame asserts well-known status in a variety of countries including the United States, European Union, China, Japan, Brazil, Canada, Australia, and Mexico—a number more than enough to satisfy the Rule of 7. Coca-Cola submits documentary evidence of massive sales and

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*Be the Next Step in View of TRIPS?*, 86 J. PAT. & TRADEMARK OFF. SOC'Y 717, 719 (2004) (explaining the role of national patent offices in PCT procedure).

<sup>75</sup> A similar process occurs in the Madrid system. See INTA, *supra* note 73, at 1460.

<sup>76</sup> See Robert P. Merges, *One Hundred Years of Solicitude: Intellectual Property Law, 1900–2000*, 88 CAL. L. REV. 2187, 2209 n.101 (2000) (illustrating the extent of the Coca-Cola brand's notoriety around the country and world); Shankland, *supra* note 65 (ranking Coca-Cola as the third most valuable brand name in the world).

advertising in all of these countries sufficient to show fame of its mark. Coca-Cola also submits a Statement of Priority showing its international searches of the term "Coca-Cola" and all of its prior registrations around the world.

Based on the submissions, and after publication of Coca-Cola's mark in the *WIPO Gazette* without opposition, the IB registers Coca-Cola's mark on the Global Registry. The GTM registration provides prima facie evidence that the marks are famous in each of the countries for which Coca-Cola submitted evidence to the IB during the application process. It also ensures that Coca-Cola's mark is registered in all 159 countries in the WTO. Thus, even if Coca-Cola had not registered its mark in some WTO countries before, the GTM registration would ensure that all WTO countries protect the mark as a *registered* mark.

#### 4.2.4. GTM Registration and Scope of Rights in Countries

If a GTM application is approved, the trademark is registered on the international registry as a Global Trade Mark and is entitled to protection in all member countries. Under the Treaty, countries must treat the GTM registration as establishing trademark rights (subject to any defenses). The level of protection required under the Treaty will differ depending on whether the registrant had submitted evidence of fame of the mark in that country. As explained below, the GTM is to be treated as presumptively famous in all countries that the applicant used to satisfy the Rule of 7. However, other countries (for which no direct evidence of fame was presented) will have the discretion under the GTM Treaty whether to treat the GTM as famous within the country's borders. If the GTM is not treated as famous in a country, it still must be treated as a registered trademark, with all the benefits and protections a registered mark receives.

##### 4.2.4.1. Prima Facie Evidence of Fame in Rule of 7 Countries

In those countries used by the GTM registrant to satisfy the Rule of 7, the registration of the GTM is treated as prima facie evidence of the well-known status of the mark. If the defendant does not produce evidence or reason to discredit the GTM holder's submission to satisfy the Rule of 7, the GTM registration should be deemed sufficient proof of the well-known status of the mark in all those countries relied on by the GTM registrant. For example, in the above example, Coca-Cola established fame in the United

States, European Union, China, Japan, Brazil, Canada, Australia, and Mexico. The primary benefit of having a well-known mark is the ability to bring claims against dilution.

4.2.4.2. *Discretion to Consider GTM Registration as Evidence of Worldwide or Transborder Reputation*

The more difficult issue is whether the GTM Treaty should create any evidentiary presumption in other countries for which the GTM registrant did not provide any direct evidence of the fame of the mark during the registration process. In other words, beyond the seven countries used to satisfy the Rule of 7, should other countries treat the GTM as presumptively famous based on the GTM registration?

At least initially, this Article proposes that countries be given the discretion whether to treat the GTM registration as prima facie evidence of well-known status in other jurisdictions outside those countries used to satisfy the Rule of 7. Some countries might do so, based on the notion that a showing of fame of a mark in three continents and markets totaling over twenty percent of world GDP—some of which markets may be nearby to the country in question—provides circumstantial evidence the mark is also well-known within their borders. Indeed, some countries have already adopted such a principle under the concept of “transborder reputation” of a mark in foreign jurisdictions.<sup>77</sup>

Other countries, however, may decide to require individualized showings of well-known status in each case in which the GTM is litigated, without giving any evidentiary weight to the GTM registration. In these countries, the GTM registration would establish prima facie evidence of the validity of the registered mark, but the countries could decide to treat the marks as ordinary marks, absent a more particularized showing of fame.

Granted, the suggested approach means that the same registered GTM might be famous in some countries of the WTO,

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<sup>77</sup> India, for example, recognizes transborder reputation. See Sanjeev Davé, *TRIPS: International Trademark Law that Promotes Global Trade*, 12 J. CONTEMP. LEGAL ISSUES 458, 460 (2001) (describing a court case where the Delhi High Court’s decision was consistent with TRIPS art. 16.2, finding that the U.S. corporation plaintiff “was entitled to the benefit of the marks’ transborder reputation . . .”); Robert J. Gutowski, *The Marriage of Intellectual Property and International Trade in the TRIPS Agreement: Strange Bedfellows or a Match Made in Heaven?*, 47 BUFF. L. REV. 713, 728–29 (1999).

but not others.<sup>78</sup> In this respect, the proposed GTM might not achieve uniformity of treatment as to the fame of the underlying mark in all jurisdictions. Yet this varied treatment of fame strikes me as fairer and more consistent with principles of trademark. The fact that a mark is famous in, for example, sixty percent of WTO countries does not necessarily mean that it is famous in the remaining forty percent. The GTM mark holder would still be able to prove the fame of the mark in the remaining forty percent, but it would not be entitled to a presumption of fame based merely on the GTM registration. In all events, however, the GTM registration would qualify the underlying mark to protection as a trademark in all WTO countries. Whether the GTM received heightened protections accorded to famous marks would depend on a case-by-case examination of fame.

#### 4.3. Pathway 2: "Intent to Develop" a Global Trade Mark

Pathway 2 allows an alternative way of registering a GTM by declaring an "intent to develop a Global Trade Mark." This route would be attractive to start-up companies intending to become international in reach, and current international businesses whose marks were not yet well-known enough to satisfy the Rule of 7 under Pathway 1. The route is similar to the popular "intent-to-use" application under § 1(b) of the U.S. Lanham Act.<sup>79</sup>

Figure 5 below summarizes Pathway 2. First, an entity would file a GTM application to establish priority over a new mark, along

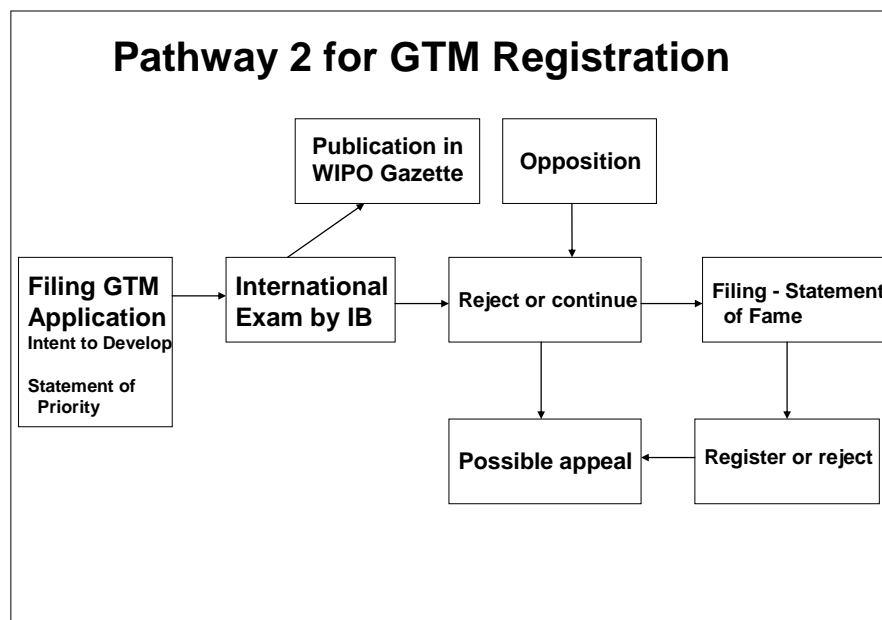
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<sup>78</sup> A similar issue arises in the context of the Community Trade Mark in the EU. The Court of Justice of the European Union has held that the fame of a CTM need only be established in one country of the EU. See Case C-301/07, PAGO Int'l GmbH v. Tirolmilch Registrierte Genossenschaft mbH, 2009 E.C.R. I-9429, 29 ("As the present case concerns a Community trade mark with a reputation throughout the territory of a Member State, namely Austria, the view may be taken, regard being had to the circumstances of the main proceedings, that the territorial requirement imposed by Article 9(1)(c) of the regulation is satisfied."). Yet such a showing of fame in one EU country does not necessarily mean that the CTM holder could assert a dilution claim in every EU country: the CTM holder would unlikely be able to show dilution of its mark in a country where it was not famous (meaning the defendant's activity would not be detrimental to the distinctive character of the mark). Thus, the CTM would have varying levels of enforceability and rights depending on how much fame the CTM holder had established in a particular EU member. The proposed GTM adopts a similar approach but focuses on the threshold showing of fame (instead of the question of dilution or infringement of rights).

<sup>79</sup> See 15 U.S.C. § 1051(b) (1946) (providing for the "Application for bona fide intention to use trademark.").

with a Statement of Priority. The key difference from Pathway 1 is that the applicant can delay the filing of a Statement of Fame for a period of 10 years from the filing date. Within the ten-year period, the applicant would have to file, with supporting documentation, a Statement of Fame averring that it owns a trademark that is well-known in 7 countries to satisfy the Rule of 7. Once that is established, the GTM would be registered. During the ten-year period while the mark holder is establishing the fame of its mark, the trademark holder would maintain priority over the mark.

FIGURE 5. PATHWAY 2 FOR GTM REGISTRATION



#### 4.3.1. Threshold Requirement: The Rule of 7 Delayed

The threshold requirement under the Rule of 7 is the same under Pathway 2. As depicted in Figure 5, the only major difference is that, under Pathway 2, the applicant does not have to satisfy the Rule of 7, or have a famous mark in 7 designated

countries, at the time of filing. Instead, the applicant has a 10-year period in which to file a Statement of Fame. The other requirements, such as the Statement of Priority, would still apply at the time of filing the application under Pathway 2. Once the Statement of Fame is filed, the IB will decide whether to accept or reject the application.

Alternatively, if WTO countries felt that ten years would be too long to lock up a potential GTM before proof of fame is required, the time periods can be staggered. For example, the GTM Treaty could require: (1) proof of fame in at least two countries by Year 5; (2) proof of fame in at least four countries by Year 8; and then (3) proof of fame in at least seven countries by Year 10. If the applicant failed any of these benchmarks, the registration would be denied.

#### *4.3.2. Example of Intent-to-Develop Application: Twitter*

The following example demonstrates how Pathway 2 operates. Imagine that even before launching its service, Twitter filed for an “intent to develop” a GTM in the mark “Twitter,” thus preserving its priority to the mark as of the filing date. In addition to paying the \$15,000 application fee, Twitter included its Statement of Priority with the application, but did not need to attach any Statement of Fame at the time. The mark is published in the *WIPO Gazette*. As a precaution, Twitter also filed a U.S. registration for the mark within the six-month Paris priority period. After just a few years, Twitter became a worldwide sensation and one of the most visited social networking sites in the world. Within the ten-year grace period allowed under the GTM Treaty, Twitter filed its Statement of Fame showing millions of registered users and “tweets,” along with popular media references to “Twitter,” in the U.S., Canada, EU, Japan, Australia, Indonesia, Brazil, and Venezuela. After reviewing Twitter’s evidence of fame, the IB of WIPO determines the mark satisfies the Rule of 7 and registers it as a GTM on the Global Registry. Upon GTM registration, Twitter has a registered mark in all WTO countries—even though it only filed two applications (U.S. national and GTM international applications) under this scenario.



#### 4.4. Other Registration Issues

##### 4.4.1. Registration Fees: \$15,000 Per Application

The GTM application will require a fee. The fee should be set at a relatively high amount—say, at \$15,000 per application. That figure is 150 times the fee amount for an international application under Madrid (\$100).<sup>80</sup> So why the high fee? One reason in setting the fee high is to weed out non-meritorious applications or potential “name-squatters” desiring to warehouse marks. The fee should not be set so low that it would invite frivolous or bad faith applicants, as was the case with domain name registrations. While \$15,000 probably would deter frivolous filers, legitimate businesses, including start-ups and individuals, should be able to afford \$15,000 if they have a business with global potential. Another reason to set the fee high is to help offset the administrative costs of running the GTM system, including the ICGTM and registry. For example, two hundred applications for the GTM would earn \$3 million. Of course, the filing fee could be set even higher if the administrative costs of running the GTM system are too costly.

##### 4.4.2. Term and Renewal of Registration

The basic GTM registration would last for ten years. Every ten years, the GTM registration must be renewed with the payment of maintenance fees.

##### 4.4.3. Languages and Foreign Equivalents

Under the Treaty, a GTM registration would provide the registrant the rights to the underlying mark not only in the language of origin, but also in foreign languages. Thus, a third party in a foreign country could not commercially use for the same type of goods or services a famous mark—let’s say Starbucks—simply by translating or transliterating the English words “star” and “bucks” into a foreign language, such as “Xingbake” in Chinese.<sup>81</sup> The mark registered under a GTM would be protected

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<sup>80</sup> Madrid FAQs, USPTO, <http://www.uspto.gov/trademarks/law/madrid/madridfaqs.jsp#q7> (last visited Jan. 20, 2014).

<sup>81</sup> See Stephanie M. Greene, *Protecting Well-Known Marks in China: Challenges for Foreign Mark Holders*, 45 AM. BUS. L.J. 371, 384–85 (2008) (describing a 1999 case in which Starbucks sued the owner of a café in Qingdao, China); see also Daniel

in its foreign equivalents, including phonetically (i.e., its sounds) and semantically (i.e., its meaning). By the same token, the GTM Treaty will recognize the doctrine of foreign equivalents, which bars giving trademark status to foreign words that are generic in their country of origin.<sup>82</sup> Thus, an applicant could not pick a generic term in Japanese (such as *otokoyama* for a type of sake) and try to register it as a GTM for that type of product or service simply by transliterating the symbol for the term into English.

#### 4.4.4. *Nice Classification of Goods and Services*

The GTM Treaty will adopt the classification system for goods and services recognized by the Nice Agreement.<sup>83</sup> Currently, eighty-four countries are members of the Nice Agreement.<sup>84</sup> And many more trademark offices follow the Nice classification system. As WIPO explains, "the trademark offices of at least 147 States, as well as the International Bureau of WIPO, the African Intellectual Property Organization (OAPI), the African Regional Intellectual Property Organization (ARIPO), the Benelux Organisation for Intellectual Property (BOIP) and the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) of the European Communities, actually use the Classification."<sup>85</sup>

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C.K. Chow, *Trademark Squatting and the Limits of the Famous Marks Doctrine in China*, GEO. WASH. INT'L L. REV. (forthcoming 2014) (manuscript at 16-27) (describing how popular Western trademarks are often transliterated into Chinese language equivalents by third parties), available at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2443923##](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2443923##).

<sup>82</sup> See *Otokoyama Co. v. Wine of Japan Import, Inc.*, 175 F.3d 266, 271 (2d Cir. 1999) (holding that the Japanese word for a type of sake is generic in Japan and therefore should be considered generic in the United States). *But see* Serge Krimnus, *The Doctrine of Foreign Equivalents at Death's Door*, 12 N.C. J.L. & TECH. 159 (2010) (criticizing doctrine of foreign equivalents).

<sup>83</sup> See generally *Nice Agreement Concerning the International Classification of Goods and Services of the Purposes of the Registration of Marks*, June 15, 1957, 23 U.S.T. 1336, 550 U.N.T.S. 46, available at [http://www.wipo.int/treaties/en/classification/nice/trtdocs\\_wo019.html](http://www.wipo.int/treaties/en/classification/nice/trtdocs_wo019.html) [hereinafter *Nice Agreement*].

<sup>84</sup> *Nice Agreement Contracting Parties*, WIPO, available at [http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty\\_id=12](http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=12) (last visited Jan. 25, 2014).

<sup>85</sup> *Summary of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957)*, WIPO, available at [http://www.wipo.int/treaties/en/classification/nice/summary\\_nice.html](http://www.wipo.int/treaties/en/classification/nice/summary_nice.html).

#### 4.4.5. Relationship with Paris Convention and Madrid System

The GTM system will be integrated with both the Paris Convention and the Madrid System.

##### 4.4.5.1. Paris Priority

Under the GTM Treaty, a new trademark holder can file a domestic application first and then seek a GTM registration (under Pathway 2) within six months, while preserving the Paris priority date (the date of the first filing) for the GTM registration.<sup>86</sup> Thus, the date of the first domestic filing will apply also to the application of the GTM for the purposes of establishing priority to the mark. Conversely, one can file a GTM application first and then file national applications within the Paris priority period. By contrast, for famous marks already in existence (Pathway 1), the need for using Paris priority may be no longer necessary or applicable. Presumably, the famous marks already have multiple national registrations in various countries of the world. Moreover, the Paris Convention establishes priority for a well-known mark in countries as of the date the mark became famous in respective countries.<sup>87</sup> A GTM applicant can rely on the dates of priority established by its prior national registrations and fame.

##### 4.4.5.2. Madrid System and Conversion of Failed GTM Applications

The GTM system will be integrated with the Madrid System. One of the options on the Madrid application form will be the GTM. In addition, the registry for the GTM would be included in the same searchable database as international registrations under Madrid. The GTM system will also permit applicants to convert to the Madrid system, should the GTM application fail for some

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<sup>86</sup> See Paris Convention, *supra* note 14, at art. 4 (“Any person who has duly filed an application . . . for the registration of . . . a trademark, in one of the countries of the Union, . . . shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed. . . . The periods of priority referred to above shall be . . . six months for . . . trademarks.”).

<sup>87</sup> See *id.* at art. 6bis (“The countries of the Union undertake . . . 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.”).

reason. This process of conversion will be similar to the process of transformation under the Madrid Protocol that allows applicants to transform into national applications an international registration that was successfully challenged under a “central attack” during the first five years of registration.<sup>88</sup> For new trademarks that fail to receive GTM status, the applicant could elect, within three months of a final rejection, to convert the GTM application into an application under the Madrid system—all while preserving the priority date established by the GTM application. For existing trademarks (many of which are already registered in multiple countries), the conversion of a failed GTM application probably will not be needed.

## 5. GLOBAL ENFORCEMENT AND POST-REGISTRATION ISSUES

The GTM will be global in scope and enforceable in all of the approved national courts of WTO countries. A major benefit of the GTM system is that it enables national courts to hear transnational trademark disputes and authorize transborder remedies, including injunctions spanning multiple countries in the WTO. The efficiencies in adjudicating transnational disputes involving GTMs are potentially substantial.

### 5.1. *Litigation in Member Countries*

#### 5.1.1. *International Lawsuits in National Courts*

A GTM can be enforced just as any other registered trademark in national courts. The WTO will approve the countries that can hear GTM disputes based on each country’s maintenance of an adequate court system. The threshold for approval will be set low, but it will nevertheless require satisfaction of basic requirements of an independent judiciary, fidelity to the rule of law, and evidence of sufficient judicial resources to handle trademark lawsuits.<sup>89</sup>

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<sup>88</sup> See Madrid Protocol, *supra* note 25, at arts. 6(3), 9quinquies (“Where, in the event that the international registration is cancelled at the request of the Office of origin . . . in respect of all or some of the goods and services listed in the said registration, the person who was the holder of the international registration files an application for the registration of the same mark with the Office of any of the Contracting Parties in the territory of which the international registration had effect, that application shall be treated as if it had been filed on the date of the international registration.”).

<sup>89</sup> WTO countries are already subject to several basic requirements of civil procedure to handle IP cases. See TRIPS Agreement, *supra* note 11, at arts. 42–48

National courts will have jurisdiction over a GTM dispute if some infringing activity—e.g., manufacture, transport, distribution, sales—occurs within the country's borders. In addition, countries will have jurisdiction over a claim if the underlying infringing activity produces "substantial effects" in that country.<sup>90</sup> Under the current system, transnational trademark disputes must be litigated in several different countries, given the reluctance of countries to entertain jurisdiction over foreign trademarks.<sup>91</sup> The GTM avoids piecemeal litigation (i.e., lawsuits in several countries over related conduct involving the same trademark) and achieves greater efficiency in resolving transnational disputes.

### 5.1.2. Transborder Remedies and Injunctions

Another advantage of the GTM system is that it will authorize national courts to issue transborder remedies for infringing activity that spans several countries. Damages calculations can include losses from infringing activity in all member countries in which the GTM in question was infringed. In addition, the court will have the power to issue a transborder injunction against the infringer for all infringements of the GTM in WTO countries.<sup>92</sup>

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(stating the various civil procedures that WTO members must recognize).

<sup>90</sup> See generally AM. LAW INST., RESTATEMENT OF THE LAW (THIRD): THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 402 (1986) ("Subject to § 403, a state has jurisdiction to prescribe law with respect to (1) . . . (c) conduct outside its territory that has or is intended to have substantial effect within its territory."). For example, the United States allows jurisdiction in cases where foreign trademark infringement results in substantial effects in the United States. See *Steele v. Bulova Watch Co.*, 344 U.S. 280, 283-87 (1952) (holding that a United States district court has jurisdiction to award relief to an American corporation against acts of trademark infringement in a foreign country by a United States citizen).

<sup>91</sup> See DANIEL C.K. CHOW & EDWARD LEE, INTERNATIONAL INTELLECTUAL PROPERTY: PROBLEMS, CASES, AND MATERIALS 819-21 (2006); Kerry J. Begley, *Multinational Patent Enforcement: What the "Parochial" United States Can Learn from Past and Present European Initiatives*, 40 CORNELL INT'L L.J. 521 (2007) (discussing U.S. and EU approaches to jurisdiction over foreign patent claims); David R. Toraya, Note, *Federal Jurisdiction over Foreign Copyright Infringement Actions – An Unsolicited Reply to Professor Nimmer*, 70 CORNELL L. REV. 1165, 1178-80 (1985) (discussing bases to deny jurisdiction over claims related to foreign patents and foreign trademarks).

<sup>92</sup> The EU recognizes EU-wide injunctions for infringement of the Community Trade Mark. See Case C-235/09, *DHL Express France SAS v. Chronopost SA*, 2011 E.C.R. I-2825, ¶ 44 (holding that a court should usually grant an EU-wide injunction for infringements of the Community Trade Mark).

### 5.1.3. Example of GTM Litigation: Adidas

The following hypothetical example illustrates the potential advantages of how the GTM can be enforced. Imagine that Adidas, the German manufacturer of sports merchandise, has determined that its Adidas goods are being counterfeited by Copycat Defendant in several countries in Asia. Counterfeit Adidas goods have been shipped to the European Union, the United States, and other parts of the world. Adidas owns a registered GTM for its mark and logo. Under the GTM Treaty, Adidas can bring a trademark suit against Copycat Defendant in the European Union—or any of the other countries where the infringing goods were made or distributed. Adidas sues Copycat Defendant in a designated court in the European Union and is successful in obtaining a verdict against Defendant for counterfeiting. The court in the European Union authorizes damages for all of the infringing activity, plus a transborder injunction against Copycat Defendant in all WTO countries. With the injunction, Adidas is able to enlist the local authorities in the various Asian countries to shut down the known counterfeiting operations of Copycat Defendant. With this “one-stop-shopping” in a GTM court, Adidas can file one lawsuit to address all of the Copycat Defendant’s infringing activity around the world. By contrast, the current system offers no such streamlined process. Instead, Adidas must file trademark lawsuits in the European Union *and* every single country where infringing activity takes place.

### 5.2. International Exhaustion and Trademark Exceptions

The GTM will be governed by a principle of international exhaustion, meaning that the lawful first sale of a trademarked good anywhere in the WTO will exhaust the GTM owner’s distribution and importation rights to the good in question.<sup>93</sup> For example, if Adidas had a GTM and sold gym bags with the Adidas mark on it in Australia, Adidas’s distribution rights to the sold gym bags would be exhausted internationally. After the lawful first sale in any WTO country, the gym bags can be resold by their purchasers anywhere in the world, even at cheaper prices in

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<sup>93</sup> For a discussion of international versus national exhaustion, see Irene Calboli, *Market Integration and (the Limits of) the First Sale Rule in North American and European Trademark Law*, 51 SANTA CLARA L. REV. 1241, 1246 (2011).

competition with Adidas's goods. International exhaustion allows parallel imports or so-called gray market goods. Some may question the adoption of the expansive approach of international exhaustion for the GTM. However, international exhaustion is the most consistent with the overall philosophy of the Global Trade Mark—i.e., that it is one global trademark in a global market. In addition, some of the major trading countries, like the United States and European Union, already adopt exhaustion principles for trademark law that are more expansive than national exhaustion.<sup>94</sup>

The GTM Treaty will also recognize exceptions to trademark rights, including for fair use, parody, and noncommercial uses of marks, as well as for free speech concerns. The precise exceptions for inclusion will require further study and debate. The exceptions to dilution of famous marks under U.S. law provide a good start.<sup>95</sup>

### 5.3. *Loss of GTM Rights*

The GTM Treaty will establish standards governing the loss of GTM rights. Given the well-known status of the GTM in a significant number of markets, and the heightened protection that such status merits under Paris and TRIPS, the GTM Treaty will set a high bar before a registrant may lose GTM rights to its well-known mark. (Of course, loss of GTM rights does not necessarily mean that the registrant loses its national trademark rights to the mark.)

#### 5.3.1. *Loss of Fame Below the Rule of 7 Threshold*

One way in which a registered GTM can be invalidated is if the registration is not supported by fame to meet the threshold under the Rule of 7. Once a GTM is registered, the burden will lie with a

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<sup>94</sup> See *id.* at 1262–71 (describing the United States approach of international exhaustion in trademark law).

<sup>95</sup> See 15 U.S.C. § 1125(c)(3) (“The following shall not be actionable . . . (A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person’s own goods or services, including use in connection with— (i) advertising or promotion that permits consumers to compare goods or services; or (ii) Identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner. (B) All forms of news reporting and news commentary. (C) Any noncommercial use of a mark.”); Graeme B. Dinwoodie, *Developing Defenses in Trademark Law*, 13 LEWIS & CLARK L. REV. 99, 112–24 (2009).

challenger—either in a trademark lawsuit or in an opposition before the IB—to provide some evidence to discredit or disprove the registrant’s showing of fame. The challenger could attempt to do so by, for example, submitting more recent evidence showing the registrant’s lack of sales, minimal advertising expenditures, or lack of general recognition of the mark in the country in question. Once such a showing by a challenger is made, the registrant would have the opportunity to rebut the challenge.

If the challenger is successful in establishing the lack of fame of the mark in one of the countries used to satisfy the Rule of 7, such that fame is established in only six or fewer countries, the GTM registration would be in jeopardy of cancellation. However, the registrant would be given the opportunity of complying with the Rule of 7 by establishing the fame of its mark in another country of the Top 30 GDP countries not yet used by the registrant.

In the end, if the Rule of 7 is not satisfied for the GTM in question, the registration for the mark will be canceled. If the challenge is successful in a national court or the IB, the registrant would have the opportunity for appeal through the national court system. If cancellation of the GTM registration is upheld on appeal, the registrant may elect to convert the invalidated GTM registration into an application for registration in national trademark offices, with the same priority date as the GTM application.<sup>96</sup>

### 5.3.2. GTM Genericide

Just as with any trademark, the GTM will be susceptible to genericide, meaning that the primary significance of the mark in the minds of consumers denotes the type of product or service, rather than its source.<sup>97</sup> An alternative standard is that the term has become “customary in common language as the common name for such goods or services in the territory.”<sup>98</sup> Famous examples of genericide include thermos, yo-yo, nylon, zipper,

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<sup>96</sup> The Madrid Protocol recognizes a similar process of conversion. See Madrid Protocol, *supra* note 25, at art. 9quinquies (describing how to convert an international to a national trademark application).

<sup>97</sup> See 15 U.S.C. § 1064(3) (“At any time if the registered mark becomes the generic name for the goods or services”); *Murphy Door Bed Co. v. Interior Sleep Sys., Inc.*, 874 F.2d 95, 101 (2d Cir. 1989) (being generic to a “substantial majority of the public”).

<sup>98</sup> TRIPS Agreement, *supra* note 11, at art. 24(6).



escalator, and aspirin. A generic mark cannot be protected as a trademark.

The standard for establishing genericide of a registered GTM will be higher than required for an ordinary mark. The challenger must prove that the GTM is generic not just in one country, but in a threshold number of countries (e.g., four of the seven countries used in the Rule 7 by the registrant). A GTM will not be considered generic and invalid unless the threshold of countries for genericide is met. If sufficient proof establishes that the GTM is generic in a country, but not in the threshold of countries, the GTM will be considered non-enforceable just in that country where the mark is generic. In all other WTO countries, the mark will be enforceable. Moreover, within a five-year period after any determination of genericide of a GTM within a country, the GTM registrant may attempt to “revive” the secondary meaning of the mark by advertising, sales, and promotion. In such case, the registrant must submit, to the IB, evidence that the mark is no longer generic in that country, as well as evidence of fame sufficient to satisfy the Rule of 7. A GTM will be canceled as a generic mark only if it has been shown to be generic in the threshold number of countries.

### 5.3.3. *Abandonment*

A registered GTM will be subject to a higher standard of abandonment as well. Abandonment is a doctrine that deems a trademark to be effectively relinquished by its owner, such as if the owner fails to use the mark for three consecutive years without intention of resuming its use.<sup>99</sup> Abandonment of a GTM will not arise simply based on a showing of abandonment within one country. Instead, a challenger must prove that the GTM in question has not been used in a threshold number of countries for an uninterrupted period of three years or more.<sup>100</sup> Once such a showing is made, a presumption of abandonment is raised. The GTM owner will have the opportunity to rebut the presumption, such as by showing that it intended to use the GTM in the

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<sup>99</sup> See TRIPS Agreement, *supra* note 11, at art. 19 (“[U]se is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use”); *Electro Source, LLC v. Brandess-Kalt-Aetna Group, Inc.*, 458 F.3d 931, 935 (9th Cir. 2006).

<sup>100</sup> Cf. TRIPS Agreement, *supra* note 11, at art. 19 (stating the minimum standard of “an uninterrupted period of at least three years of non-use”).

challenged countries (as evidenced in business preparations, planning, or the like) or that it had legitimate reason for non-use.

The GTM Treaty will not recognize abandonment by so-called “naked licensing.” The doctrine, originated in the United States, holds that the trademark holder’s lack of quality control over licensees of the mark may constitute abandonment of the mark.<sup>101</sup> A number of scholars have argued for jettisoning the naked licensing doctrine as *ad hoc*, ineffective, and unnecessary, although some still believe in its usefulness.<sup>102</sup> Only a few U.S. cases have ever found naked licensing.<sup>103</sup> Given its debatable value, the GTM Treaty will not recognize the bar against naked licensing.

## 6. CONCLUSION

Businesses commonly seek intellectual property protection around the world, yet there is no global form of IP protection. This Article offers a model for how WTO countries can establish a Global Trade Mark system for a narrow class of “super famous” marks. The proposal is meant as a way for countries to experiment with developing transnational forms of IP rights, in order to develop a more efficient and sensible approach for today’s

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<sup>101</sup> See *Barcamerica Int’l USA Trust v. Tyfield Importers, Inc.*, 289 F.3d 589, 596 (9th Cir. 2002) (stating that if there is a failure to exercise adequate quality control, “a court may find that the trademark owner has abandoned the trademark, in which case the owner would be estopped from asserting rights to the trademark.”); *Dawn Donut Company, Inc. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 366 (2d Cir. 1959); *Franchised Stores of N.Y., Inc. v. Winter*, 394 F.2d 664, 668–69 (2d Cir. 1968).

<sup>102</sup> See, e.g., JAY DRATLER, JR. & STEPHEN M MCJOHN, LICENSING OF INTELLECTUAL PROPERTY § 11.03 (2008); Katya Assaf, *Brand Fetishism*, 43 CONN. L. REV. 83, 112–13 (2010); Irene Calboli, *The Sunset of “Quality Control” in Modern Trademark Licensing*, 57 AM. U. L. REV. 341, 395–400 (2007); Noel Gillespie, *Licensing and the “Related Companies” Doctrine*, 12 J. CONTEMP. LEGAL ISSUES 209, 210–12 (2001); W.J. Keating, *Promotional Trademark Licensing: A Concept Whose Time Has Come*, 89 DICK. L. REV. 363, 365 (1985); Rudolph J. Kuss, Comment, *The Naked Licensing Doctrine Exposed: How Courts Interpret the Lanham Act to Require Licensors to Police Their Licensees & Why this Requirement Conflicts with Modern Licensing Realities & the Goals of Trademark Law*, 9 MARQ. INTELL. PROP. L. REV. 361, 381–82 (2005); Kevin Parks, *“Naked” Is Not a Four-Letter Word: Debunking the Myth of the “Quality Control Requirement” in Trademark Licensing*, 82 TRADEMARK REP. 531, 557 (1992). But see, e.g., J. THOMAS MCCARTHY, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 18.61 (4th ed. 2013) (espousing strict enforcement of quality control requirement).

<sup>103</sup> See DRATLER, *supra* note 102, § 11.03 (describing how courts have enforced the control requirement in very few litigated cases).

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global market than the current piecemeal, territorial system of intellectual property. The proposal is not intended for adoption in all IP treaties, but, instead, is meant as a way for IP policymakers and countries to experiment with an alternative global approach to IP protection in a narrow area of law. Success or failure of such a global system will provide valuable information for countries to evaluate future efforts to deal with globalization.