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Article 6bis of the Paris Convention: How the United States Court of Appeals for the Second Circuit is Violating International Law

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ARTICLE 6BIS OF THE PARIS CONVENTION: HOW THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT IS VIOLATING INTERNATIONAL LAW

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* J.D. Candidate, May 2020, American University Washington College of Law, B.A., Political Science, 2014, The Ohio State University. I am extremely grateful for Professor Christine Farley whose mentorship throughout my law school career and passion for trademarks helped me find an area of law in which I can thrive. I am also thankful for my wonderful colleagues on the American University International Law Review for diligently editing my Comment. I dedicate this Comment to my family, the five individuals whose support carries me through the week.

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I. INTRODUCTION

To the average consumer, a trademark is a label signaling the source of a product: better understood as a “distinguishing characteristic or feature firmly associated with a person or thing.”¹ Trademarks help the average consumer make intelligent and cost-efficient purchases because the mark tells the consumer the quality, cost, function, and overall reputation of the product.² To the company or individual who formed the trademark, it is the source-identifier effortlessly advertising goods and/or services to consumers, increasing profits, and building recognition.³ With the advent of worldwide shipping, trademarks are essential for producers to expand globally.⁴

For a trademark to grow this way, a mark owner must control the use and/or distribution of his mark from infringing uses.⁵ One way is by entering into licensing agreements with any entity or individual

1. *Trademark*, Merriam-Webster Dictionary (2020).

2. See BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK 22–23 (5th ed. 2018) (noting that trademarks help consumers select goods by conveying valuable information such as price, taste, and quality at a lower cost than if the consumer taste-tested every product on the market).

3. See *id.* at 22 (explaining that trademark owners recognize the “merchandising short-cut which induces a purchaser to select what he wants,” and that the trademark owner “exploits this human propensity” by making every effort to make the trademark stronger).

4. See Leah Chan Grinvald, *A Tale of Two Theories of Well-Known Marks*, 13 VAND. J. ENTM'T & TECH. L. 1, 7 (2010) (describing the international community’s goal of free trade across borders).

5. See BEEBE, *supra* note 2, at 22 (citing *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) (“The protection of trade-marks is the law’s recognition of the psychological function of symbols. [. . .] If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.”)).

requesting the use of the mark.⁶ This method of control requires an interested party to put the trademark owner on notice that she is requesting use of the mark;⁷ without that notice, the owner has no control.

The more practical way a trademark owner controls the use of his mark is by suing for trademark infringement or unfair competition, which allows recourse for when the use has already started.⁸ Most countries provide a system for owners to protect the use of their marks and access to remedies for infringing use.⁹ However, each country has its own requirements for bringing trademark infringement or unfair competition claims.¹⁰ To bring trademark infringement suits in the United States, a mark owner must have a protectable mark under Congress's jurisdiction to qualify for relief.¹¹ A protectable mark is a distinctive mark that is "used in commerce,"¹² and therefore a

6. See, e.g., *FreecycleSunnyvale v. Freecycle Network*, 626 F.3d 509, 515 (9th Cir. 2010) ("It is well-established that '[a] trademark owner may grant a license and remain protected provided quality control of the goods and services sold under the trademark by the licensee is maintained.'") (citing *Barcamerica*, 289 F.3d at 595–96 (quoting *Moore Bus. Forms, Inc. v. Ryu*, 960 F.2d 486, 489 (5th Cir.1992))); *Trademark and Licensing Services*, THE OHIO ST. U. <https://trademarklicensing.osu.edu/page/home/> (last visited Feb. 10, 2019) (entering into agreements with interested parties to control the mark's appearance and manner of advertising so that consumers are aware which products are associated with or in connection with the university).

7. See *FreecycleSunnyvale*, 626 F.3d at 515 (implying that it is the trademark owner's duty to control the mark through licensing agreements).

8. See generally 1 Gilson on Trademarks § 3.02 (2018) (discussing the process of protecting trademark rights through infringement and unfair competition claims).

9. See generally Grinvald, *supra* note 4, at 9–14 (discussing many nations' trademark registration systems and different standards for bringing infringement suits).

10. See, e.g., *Trademarks Guide*, GOV'T OF CAN., http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr02360.html#whatYouCanAndCannotRegister (last visited Feb. 9, 2019) (showing that to pursue an action for trademark infringement in Canada, the mark must be registered, which costs \$330 plus additional fees to maintain the registration for subsequent years); John M. Murphy, *Jurisdiction in IP Cases: A Mexican Perspective*, 62 INTA BULL. (2007) (stating that in Mexico, the type of action determines which tribunal must be used, and therefore trademark owners bringing multiple claims may be required to visit multiple tribunals to obtain every type of relief).

11. Lanham Act § 45, 15 U.S.C. § 1127 (2018).

12. Lanham Act § 1(a), 15 U.S.C. § 1051 (2018).

trademark owner must have registered or used his mark in the United States before filing infringement claims.¹³

Since countries can provide different systems to obtain relief, trademark owners seeking global protection are essentially required to register or use their mark in every country before prohibiting unauthorized use. This goal is both costly and near impracticable. Because of this struggle, countries contracted to adopt the well-known marks doctrine in Article 6bis of the Paris Convention.¹⁴

The well-known marks doctrine provides that if a member state's legislation permits or at the request of an interested party, an owner of a well-known mark can bring a claim for infringement or unfair competition for the unauthorized use of his mark.¹⁵ The purpose of this doctrine is to support the effective protection and enforcement of well-known marks worldwide.¹⁶ Most member states of the Paris Convention that are member states of the World Intellectual Property Organization (WIPO) have also enacted the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks to further emphasize the obligation to follow this doctrine.¹⁷ Furthermore, in the 2018 Special 301 Report, the Office of the United States Trade Representative (USTR) noted U.S. concerns for "robust protection" of well-known U.S. producers and traders who have boosted the reputation of their brands.¹⁸ The well-known marks

13. Lanham Act § 32, 15 U.S.C. § 1114 (2018) ("Any person who shall, without the consent of the registrant-(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a *registered* mark [. . .] shall be liable in a civil action by the registrant [. . .]").

14. Paris Convention for the Protection of Industrial Property, art. 6bis, *as last revised* at the Stockholm Revision Conference, Mar. 20, 1883, 21 U.S.T. 1583, 828 U.N.T.S. 305.

15. *Id.*

16. G.H.C. BODENHAUSEN, GUIDE TO THE APPLICATION OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY 90 (1968).

17. World Intellectual Property Organization, *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* (1999), <https://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf>.

18. See Office of the United States Trade Representative, *2018 Special 301 Report* 26-27 (2018) (exclaiming that "[t]he goodwill represented in a company's trademark is often one of a company's most valuable business assets[,] and therefore countries need to provide internationally-recognized trademark protections for U.S. companies that have worked so hard to establish their brand).

doctrine has also been emphasized in the United States-Mexico-Canada Agreement (USMCA), which is specifically citing Article 6bis as authority.¹⁹

However, not all contracting parties of the Paris Convention follow the well-known marks doctrine.²⁰ Some countries treat the Convention as a self-executing treaty and regard Article 6bis as the law of the land.²¹ Other countries claim that the treaty is not self-executing and therefore a country is only obligated to follow the well-known marks doctrine if it is implemented into national law.²² The United States has been inconsistent in following the well-known marks doctrine. The United States Court of Appeals for the Ninth Circuit (the Ninth Circuit) supported the doctrine in *Grupo Gigante S.A. de C.V. v. Dallo & Co.*,²³ whereas the United States Court of Appeals for the Second Circuit (Second Circuit) refused to recognize the doctrine as a part of U.S. law in *ITC Ltd. v. Punchgini, Inc.*²⁴ The Supreme Court of the

19. See Office of the United States Trade Representative, *Chapter 20: Intellectual Property Rights in Agreement between the United States of America, the United Mexican States, and Canada 12/13/19 Text* (signed Nov. 30, 2018), <https://ustr.gov/trade-agreements/free-trade-agreements/united-states-mexico-canada-agreement/agreement-between> (stressing that the signatories to this agreement recognize the importance of the well-known marks doctrine and “shall provide for appropriate measures to refuse the application or cancel the registration and prohibit the use of a trademark that is identical or similar to a well-known trademark”).

20. *Application of Article 6bis of the Paris Convention in Selected Europe and Central Asia Jurisdictions*, INT’L TRADEMARK ASS’N (Dec. 2017), <https://www.inta.org/Advocacy/Documents/2018/Application%20of%20Article%206bis%20of%20the%20Paris%20Convention%20in%20Selected.pdf>.

21. See Gilson, *supra* note 8, § 3.02(1)(iii)(c) (stating that “[t]here is also some evidence suggesting that Article 6bis of the Paris Convention is the law of the United States” though acknowledging that most courts do not deem it automatically binding U.S. law).

22. See *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 162-63 (2d Cir. 2007) (holding that since the treaty is not self-executing, and Congress has not incorporated the text of Article 6bis into the Lanham Act, U.S. courts are not obligated to interpret it into the law).

23. See 391 F.3d 1088, 1098 (9th Cir. 2004) (remanding the case for the District Court to decide whether Grupo Gigante’s grocery store chain trademark meets the standard to receive protection under the well-known marks doctrine).

24. See 482 F.3d at 163 (holding that sections 44(b) and (h) of the Lanham Act show no discernible language or intent to incorporate the text from Article 6bis of the Paris Convention).

United States (the Supreme Court) has not ruled on the doctrine yet. This Comment argues that because the United States has ratified Article 6bis of the Paris Convention and incorporated it into trademark law, the United States is obligated to follow the well-known marks doctrine and thus the Second Circuit is violating international law.

First, this Comment will lay out the background on U.S. implementation of international treaties into federal law and the United States' accession to the Paris Convention.²⁵ Second, it will discuss provisions of the Lanham Act and the Act's interpretation in courts.²⁶ Third, it will analyze how the United States has incorporated Article 6bis into the Lanham Act, thereby making it judicially enforceable law.²⁷ Last, this Comment will provide recommendations for the United States to avoid future ambiguity in international trademark protection.²⁸

II. BACKGROUND

This section will first describe U.S. standards for implementing international treaties and accession to the Paris Convention. Next, it will discuss Sections 14, 32, 43, 44, and 45 of the Lanham Act and relevant case law. Last, it will provide U.S. rulings in cases brought by foreign mark owners.

A. THE UNITED STATES AND INTERNATIONAL TREATIES: A DUALIST APPROACH

Article II, Section 2 of the U.S. Constitution provides that once the President ratifies a treaty and receives Senate approval, that treaty becomes the law of the land.²⁹ However, treaties are not automatically accepted as federal legislation.³⁰ In the United States, international

25. *Infra* Part II.a.

26. *Infra* Part II.b-c.

27. *Infra* Part III.

28. *Infra* Part IV.

29. See U.S. CONST. art. II, § 2 ("He shall have Power, by and with the Advice and Consent of the Senate, to make Treaties, provided two thirds of the Senators present concur.").

30. See generally Frederic L. Kirgis, *International Agreements and U.S. Law*, 2 AM. SOC'Y OF INT'L L. (1997) (outlining the process in which international agreements are accepted in the United States); D.A. Jeremy Telman, *A Monist*

treaties become federal law if they either expressly stipulate obligations (self-executing treaties) or they are ratified by the President and incorporated into federal law (non-self-executing treaties).³¹

The U.S. courts' standard to determine whether Congress has incorporated a ratified treaty is based on whether the ratified provisions of the treaty have been implemented and enforced in U.S. law.³² Courts either look for amendments to existing law that write-in the treaty's text or new federal laws that are consistent with treaty obligations.³³ Essentially, Congress can include the text from the ratified provisions or enact laws that support the provision's purpose.³⁴

Article 6bis of the Paris Convention states:

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods.³⁵

On August 25, 1973, Articles 1-12 entered into force in the United

Supremacy Clause and a Dualistic Supreme Court: The Status of Treaty Law as U.S. Law 1 (Valparaiso University Legal Studies, Research Paper No. 13-6, 2013) (arguing that the United States Constitution does not permit automatic incorporation of international law into the domestic legal order).

31. Kirgis, *supra* note 30.

32. Telman, *supra* note 30, at 1-3 (discussing a variety of methods by which international law can be incorporated into state law).

33. See Anne Gilson LaLonde, *Don't I Know You from Somewhere? Protection in the United States of Foreign Trademarks That Are Well Known but Not Used There*, 98 LAW J. OF THE INT'L TRADEMARK ASS'N 1379, 1392 (2008) ("United States Supreme Court has made clear that a non-self-executing treaty 'does not by itself give rise to domestically enforceable federal law and may only be given effect by implementing legislation passed by Congress.'").

34. See Kirgis, *supra* note 30 (stating that Congress shows an intent for the United States to follow international agreements by writing the agreement's text into federal law or by enacting new provisions into federal law that supports the agreement's purpose and helps enforce the provision in federal law).

35. Paris Convention for the Protection of Industrial Property, *supra* note 14, art. 6bis.

States.³⁶ Furthermore, the United States signed and supported WIPO's Joint Recommendation Concerning the Provision of Well-Known Marks, which stressed an obligation to follow Article 6bis.³⁷ The new USMCA also includes measures to protect well-known marks that specifically reference Article 6bis.³⁸ Last, the United States expressed concern for the protection of well-known marks in the recent issue of USTR's Special 301 Report.³⁹

B. THE LANHAM ACT: SECTIONS PROVIDING RELIEF FOR UNAUTHORIZED USE

Under Sections 14, 32, and 43 of the Lanham Act, a plaintiff can seek cancellation of a registered mark (Section 14) or relief for defendant's unauthorized use (Sections 32 and 43).⁴⁰ Sections 44 and 45, *intent of the chapter*, specifically pertain to international agreements and foreign trademark owners; both of these sections acknowledge U.S. trademark law's adherence to international treaties and obligations.⁴¹

i. Sections 44(b) and (h) and 45 of the Lanham Act: Complying with International Agreements

Section 44(b) and (h) of the Lanham Act states:

(b) Any person whose country of origin is a party to any convention or treaty relating to trademarks, trade, or commercial names, or the repression of unfair competition, to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section under the conditions expressed herein to the

36. United States Department of State, *Treaties in Force: A List of Treaties and Other International Agreements of the United States in Force on January 1, 2018*, <https://www.state.gov/documents/organization/282222.pdf> (last visited Feb. 9, 2019) [hereinafter *Treaties in Force*] (representing the treaties that the United States is obligated to follow: "entered into force").

37. *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, *supra* note 17, at 8.

38. *Agreement between the United States of America, the United Mexican States, and Canada 12/13/19 Text*, *supra* note 19, at 20-11.

39. *2018 Special 301 Report*, *supra* note 18, at 27.

40. Lanham Act § 14, 15 U.S.C. § 1064 (2018); 15 U.S.C. § 1114; Lanham Act § 43, 15 U.S.C. § 1125 (2018).

41. Lanham Act § 44, 15 U.S.C. § 1126 (2018); 15 U.S.C. § 1127.

extent necessary to give effect to any provision of such convention, treaty, or reciprocal law, in addition to the rights to which any owner of a mark is otherwise entitled by this chapter.

(h) Any person designated in subsection (b) of this section as entitled to the benefits and subject to the provisions of this chapter shall be entitled to effective protection against unfair competition, and the remedies provided in this chapter for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.⁴²

Section 45 of the Lanham Act states the following:

The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks, trade names, and unfair competition entered into between the United States and foreign nations.⁴³

Sections 44 and 45 allow foreign trademark owners to bring suits in the United States. Edward Rogers, one of the chief architects of the Lanham Act, was claimed to have drafted provisions with an international focus in mind.⁴⁴ Some courts have interpreted these sections as textual support for foreign trademark owners seeking relief in the United States but not yet as independent unfair competition claims.⁴⁵

42. 15 U.S.C. § 1126.

43. 15 U.S.C. § 1127.

44. See generally Christine Haight Farley, *The Forgotten Pan-American Trademark Convention of 1929: A Bold Vision of Extraterritorial Meets Current Realities* (Digital Commons @ American University Washington College of Law, Working Paper 2-27-2013) [hereinafter Farley, *The Forgotten Pan-American Trademark Convention of 1929*] (discussing Edward Rogers' knowledge of international trademark enforcement); Edward S. Rogers, *The Lanham Act and the Social Function of Trade-Marks*, 14 LAW & CONTEMP. PROBS. 173, 182 (1949) (outlining the purposes of the Lanham Act including the need for a single trademark enforcement measure).

45. See *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 163-64 (2d Cir. 2007) (citing *Empresa Cubana del Tabaco v. Culbro Corporation*, 399 F.3d 462, 484-85 (2d Cir. 2005) (ruling that Section 44 of the Lanham Act gives foreign nationals the same rights and protections provided to United States citizens by the Lanham Act, but

ii. Section 14 of the Lanham Act: Cancellation Proceedings

Section 14 of the Lanham Act states:

A petition to cancel a registration of a mark . . . may . . . be filed as follows by any person who believes that he is or will be damaged, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register . . . :

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.⁴⁶

Section 14 allows trademark owners to request cancellation of a registered mark through the Trademark Trial and Appeal Board (TTAB) of the U.S. Patent and Trademark Office (USPTO).⁴⁷ Pursuant to Section 14, TTAB can hold cancellation proceedings for both parties to present evidence and advocate for or against cancellation of a mark.⁴⁸

The USPTO *has* canceled a U.S. registered mark at a foreign trademark owner's request. In *Bayer Consumer Care AG v. Belmora L.L.C.*,⁴⁹ Belmora, a company operating in the United States that sold

creates no new cause of action for unfair competition)).

46. 15 U.S.C. § 1064.

47. *Trademark Trial and Appeal Board*, USPTO, <https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board> (last visited Feb. 9, 2019) ("TTAB is an administrative board that hears and decides adversary proceedings between two parties, namely, oppositions (party opposes a mark after publication in the Official Gazette) and cancellations (party seeks to cancel an existing registration). The TTAB also handles interference and concurrent use proceedings, as well as appeals of final refusals issued by USPTO Trademark Examining Attorneys within the course of the prosecution of trademark applications.").

48. *Id.*

49. 110 U.S.P.Q.2d (BNA) 1623 (T.T.A.B. 2014).

tablets under the FLANAX brand name since 2002, registered the FLANAX mark with the USPTO in 2004.⁵⁰ Bayer, a Mexican company that sold the same products under the FLANAX brand name since the 1970s, attempted to register FLANAX in the United States in 2004 but was subsequently rejected because of Belmora's registration.⁵¹ Bayer sought cancellation of Belmora's registration and TTAB granted the cancellation.⁵²

Furthermore, in *The All England Lawn Tennis Club (Wimbledon) Limited v. Creations Aromatiques, Inc.*,⁵³ TTAB rejected the U.S. owner's, Creations Aromatiques, application to register "Wimbledon Cologne" at the request of the British corporation, Wimbledon.⁵⁴ TTAB also rejected a U.S. insurance broker's application to register "First Niagara Financial Group, Inc." at the request of the Canadian owner, First Niagara Insurance Brokers.⁵⁵ In these rulings, TTAB acknowledged that the foreign owners had not used their marks in the United States but ruled that these marks had sufficient fame that allowing the marks' registration would cause consumer confusion.⁵⁶

iii. Sections 32 and 43 of the Lanham Act: Relief for Unauthorized Use

Section 32 of the Lanham Act states:

(1) Any person who shall, without the consent of the registrant—(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion or to cause mistake, or to deceive; . . .

[S]hall be liable in a civil action by the registrant for the remedies

50. *Id.* at 1625.

51. *Id.*

52. *Id.* at 1637.

53. 220 U.S.P.Q. (BNA) 1069 (T.T.A.B. 1983).

54. *Id.* at 1072.

55. *First Niagara Ins. Brokers, Inc. v. First Niagara Fin. Group, Inc.*, 77 U.S.P.Q.2d (BNA) 1334 (T.T.A.B. 2005).

56. *See, e.g., Nike, Inc. v. Nikepal Int'l, Inc.*, 84 U.S.P.Q.2d 1820 (N.D. Cal. 2007) (holding that if relief is not granted to Nike under its dilution claim, it will face an escalating erosion of its famous mark and Nike will lose its ability to serve as a source-identifying mark).

hereinafter provided.⁵⁷

Section 43 of the Lanham Act states:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or misleading representation of fact, which-

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . .

[S]hall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(c) Dilution by blurring; dilution by tarnishment

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.⁵⁸

A plaintiff can only bring a claim under Section 32 if his mark is registered with the USPTO⁵⁹ However, courts have not always considered the plaintiff's use of the mark in the United States as a prerequisite to prohibiting the defendant's use under Section 43 claims.⁶⁰ In *Maison Prunier v. Prunier's Rest. & Café*,⁶¹ the Parisian owner of "Maison Prunier" sought to enjoin a New York restaurant's

57. 15 U.S.C. § 1114.

58. 15 U.S.C. § 1125.

59. *See, e.g.*, 15 U.S.C. §§ 1114, 1072 (stipulating that registration is constructive notice of ownership of mark).

60. *See Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003) (holding that plaintiff's use of the mark is not as pertinent in reverse passing off cases because the defendant's use of the mark is the infringement).

61. 288 N.Y.S. 529 (N.Y. Sup. Ct. 1936).

use of its name, slogan, and goodwill; the New York restaurant was advertising itself as, “The Famous French Sea Food Restaurant.”⁶² The New York Supreme Court ruled in favor of the Parisian owner, even though the owner never used his mark in commerce in the United States, because the trademark enjoyed “wide repute” and therefore consumers would confuse the New York restaurant as part of the Parisian franchise.⁶³

The New York trial court again granted a Parisian restaurant, “Maxim’s,” injunctive relief against a New York restaurant that appropriated the Parisian restaurant’s name, décor, and distinctive script.⁶⁴ The court only noted the Parisian restaurant’s (1) uninterrupted use of the mark abroad and (2) fame of the “Maxim’s” mark among “the class of people residing in the cosmopolitan city of New York who dine out” in its ruling in favor of the foreign trademark owner.⁶⁵

C. WELL-KNOWN MARKS DOCTRINE HISTORY IN THE UNITED STATES

U.S. case law shows inconsistency in following the well-known marks doctrine but also the U.S. territoriality principle.⁶⁶ In *Steele v. Bulova Watch Co.*,⁶⁷ respondent, a U.S. watch manufacturer with a registration for the well-known mark, “Bulova,” successfully sued another U.S. company, Steele, for using the mark for business in Mexico.⁶⁸ The Court determined that in exercising its equity powers, a court may command persons properly before it to cease acts outside

62. *Id.* at 531.

63. *Id.* at 537.

64. *Vaudable v. Montmartre, Inc.*, 193 N.Y.S.2d 332, 334 (N.Y. Sup. Ct. 1959).

65. *Id.* at 334–35.

66. BEEBE, *supra* note 2, at 294–98 (explaining that the territorial scope of an unregistered mark is limited to the territory in which the mark is known and recognized by relevant consumers in that territory and that the national senior user of an unregistered mark cannot stop the use of a territorially “remote” good faith national junior user who was first to use the mark in that “remote” territory).

67. 344 U.S. 280 (1952).

68. *Id.* at 280.

its territorial jurisdiction.⁶⁹ In *Vanity Fair Mills, Inc. v. T. Eaton Co.*,⁷⁰ a U.S. manufacturer of women's clothing that used the well-known mark "Vanity Fair" sought relief against a Canadian clothing retailer that used the same mark on its products.⁷¹ Unlike in *Bulova Watch Co.*,⁷² the Second Circuit ruled for the territoriality principle and rejected foreign protection.⁷³

In *Person's Co. v. Christman*,⁷⁴ Christman, a U.S. owner, filed a U.S. application for the Japanese mark, "Person's."⁷⁵ When the Japanese owner, Person's Co., initiated action to cancel Christman's registration under Article 6bis, the Federal Circuit denied relief on the grounds that Person's Co. was not entitled to remedies without having used its mark in the United States.⁷⁶ However, in *Grupo Gigante*,⁷⁷ the Ninth Circuit ruled in favor of the well-known marks doctrine when Grupo Gigante, a Mexican grocery store chain, sued Dallo for opening a Grupo Gigante grocery store in California.⁷⁸ The Ninth Circuit invoked the principles of the well-known marks doctrine stating that regardless of use in the United States, well-known marks are entitled

69. *Id.* at 286-87 ("In the light of the broad jurisdictional grant in the Lanham Act, we deem its scope to encompass petitioner's activities here. His operations and their effects were not confined within the territorial limits of a foreign nation. He bought component parts of his wares in the United States, and spurious 'Bulovas' filtered through the Mexican border into this country; his competing goods could well reflect adversely on Bulova Watch Company's trade reputation in markets cultivated by advertising here as well as abroad. Under similar factual circumstances, courts of the United States have awarded relief to registered trademark owners, even prior to the advent of the broadened commerce provisions of the Lanham Act.").

70. 234 F.2d 633 (2d Cir. 1956).

71. *Id.* at 633.

72. 344 U.S. 280.

73. *Vanity Fair Mills*, 234 F.2d at 642-43 ("We do not think that the Bulova case lends support to plaintiff; to the contrary, we think that the rationale of the Court was so thoroughly based on the power of the United States to govern 'the conduct of its own citizens upon the high seas or even in foreign countries when the rights of other nations or their nationals are not infringed,' that the absence of one of the above factors might well be determinative and that the absence of both is certainly fatal.").

74. 900 F.2d 1565 (Fed. Cir. 1990).

75. *Id.* at 1567.

76. *Id.* at 1571-72.

77. *Grupo Gigante S.A. de C.V. v. Dallo & Co.*, 391 F.3d 1088 (9th Cir. 2004).

78. *Id.* at 1092.

to protection.⁷⁹

In this case before the Second Circuit, ITC brought suit against Punchgini for infringing use of the “Bukhara” mark, a well-known mark in India.⁸⁰ Punchgini employees used to work at a Bukhara restaurant.⁸¹ Then, Punchgini opened its own restaurant with the same name.⁸² The Second Circuit rejected the Indian owner’s claims stating that the well-known marks doctrine is not amended into the Lanham Act,⁸³ and therefore it is not U.S. law.

III. ANALYSIS

The United States has ratified Article 6bis of the Paris Convention and incorporated it into trademark law, and therefore the United States is obligated to follow the well-known marks doctrine. Articles 1-12 of the Paris Convention are still in force in the United States,⁸⁴ and U.S. trademark law has incorporated international agreements that support the well-known marks doctrine into its drafting of the Lanham Act,⁸⁵ which some U.S. courts have interpreted in favor of foreign trademark owners.⁸⁶ Sections 14, 43, 44, and 45 of the Lanham Act and case law demonstrate that the United States has incorporated the treaty provisions into trademark law. This argument as applied to *ITC*⁸⁷ proves that the Second Circuit violated international law by ruling against Article 6bis.

79. *See id.* at 1099 (holding that plaintiff was diligent in enforcing protection of its mark that even became well-known in the United States).

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

81. *Id.* at 144.

82. *Id.*

83. *See id.* at 173 (“[P]laintiff cannot assert a successful federal claim for unfair competition because Congress has not incorporated the substantive protections of the famous mark doctrine set forth in Paris Convention Article 6bis and TRIPS Article 16(2) into the relevant federal law, and this court cannot recognize the doctrine simply as a matter of sound policy[.]”).

84. *Treaties in Force*, *supra* note 36.

85. Rogers, *supra* note 44, at 182.

86. *See, e.g., Grupo Gigante S.A. de C.V. v. Dallo & Co.*, 391 F.3d 1088 (9th Cir. 2004); *Vaudable v. Montmartre, Inc.*, 193 N.Y.S.2d 332, 334 (N.Y. Sup. Ct. 1959).

87. 482 F.3d at 135.

A. U.S. RATIFICATION OF ARTICLE 6BIS OF THE PARIS CONVENTION

The United States is obligated to follow the well-known marks doctrine because it ratified Articles 1-12 of the Paris Convention. Article 6bis of the Paris Convention is required law in the United States since the United States acceded to the Paris Convention in 1973.⁸⁸ The U.S. Department of State compiles a list of treaties and international agreements on record in the Department of State.⁸⁹ In the list published on January 1, 2018, the Paris Convention, specifically Articles 1-12, is still a treaty in force in the United States.⁹⁰

The United States' ratification of Article 6bis of the Paris Convention is important because it shows the United States' compliance with protecting well-known marks.⁹¹ The legislative history of the doctrine shows the intent of all signatories to provide protection for trademark owners who have not yet complied with another country's trademark protection system.⁹² This ratification shows that the United States is authorizing foreign trademark owners to bring suits in the United States against domestic owners even when the foreign owner has not used the mark in the United States yet but the U.S. owner has.⁹³ This means that by signing and ratifying Article 6bis of the Paris Convention, the United States is aware that it allows an exception to the trademark territoriality principle.⁹⁴

A counter to this argument is that because the treaty is not a self-executing treaty, the United States' ratification of Article 6bis does not

88. *Treaties in Force*, *supra* note 36.

89. *Id.* (highlighting that these treaties have not expired by their own terms or been denounced by the parties, replaced, superseded by other agreements, or otherwise definitely terminated).

90. *Id.*

91. *See* Telman, *supra* note 30, at 3 (noting that states have fully embraced international law primacy by incorporating international legal norms into their domestic legal order through established mechanisms).

92. BODENHAUSEN, *supra* note 16, at 90.

93. *See id.*

94. *Contra* BEEBE, *supra* note 2, at 296 (explaining that the territorial scope of an unregistered mark is limited to the territory in which the mark is known and that a national senior user of an unregistered mark cannot stop the use of a "remote" good faith national junior user who was first to use the mark in that "remote" territory, meaning the national junior user's country).

signal anything more than a promise to consider following the well-known marks doctrine.⁹⁵ However, as this Comment will later argue, the United States continues to reference the well-known marks doctrine in subsequent international agreements, which shows its persistence in enforcing Article 6bis's obligations.⁹⁶

B. LANHAM ACT PROVISIONS THAT INCORPORATE THE WELL-KNOWN MARKS DOCTRINE'S PRINCIPLES

The United States is obligated to follow the well-known marks doctrine because Congress has incorporated it into federal trademark law. Congress enacted Section 44(b) to provide protection for foreign nationals in the United States by explicitly referencing an adherence to international treaties and agreements.⁹⁷ This provision of the Lanham Act was intentionally included by one drafter, Edward Rogers, because Rogers believed that the United States had an obligation to protect well-known marks regardless of their use in commerce in the United States.⁹⁸ Implied in the text, this provision aimed to give foreign nationals the same rights and recourse as domestic trademark owners who have used their marks in commerce.

A counter to this argument is that Section 44 provides registration mechanisms for foreign trademark owners so that they have the authority to register their trademark in the United States but not receive the benefits of having a registered trademark without registration.⁹⁹ While this is also true, Congress could have expressly stated the trademark right to registration and not included any

95. See *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 172 (2d Cir. 2007) (reasoning "well known marks" doctrine claims are not justiciable in U.S. courts because Congress has not yet incorporated the doctrine into federal statutory law).

96. *Infra* Part III.d.

97. See 15 U.S.C. § 1126(b) (stating persons whose country of origin is a party to an international treaty or agreement relating to trademark protection is entitled to rights and benefits under U.S. Law necessary to effectuate the provisions of the treaty or agreement so long as the U.S. is also party to the same or U.S. persons have reciprocal rights).

98. See Rogers, *supra* note 44, at 182 (acknowledging an obligation under international law and the need, possibly, for national legislation to ensure that obligation).

99. See LaLonde, *supra* note 33, at 1392-93 (arguing that this section only allowed a foreign applicant to register in the United States without having used its mark in U.S. commerce first).

reference to international treaties or agreements. Instead, Congress stated that foreign nationals “shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such *convention, treaty, or reciprocal law*.”¹⁰⁰ Congress’s actions are intentional and not superfluous, so Congress enacted a provision to assist in the implementation of international law.¹⁰¹ Since the United States is a signatory to the Paris Convention and has ratified it, Section 44(b) thus implies that the Lanham Act must provide benefits to any foreign national also party to the Paris Convention to the extent necessary to give effect to the provisions of Article 6bis.

Furthermore, Sections 44(h) and 45, *the intent of the chapter*,¹⁰² provide language supporting repression of acts of unfair competition. Section 44(h) states that the Lanham Act’s remedies “shall be available so far as they may be appropriate in repressing acts of unfair competition.”¹⁰³ Since infringing a well-known trademark owner’s mark is unfair competition, the Lanham Act is then obligated to make remedies available for foreign mark owners when a user infringes their mark because those remedies would effectively repress acts of unfair competition. In conjunction with Section 44(b), the Lanham Act intends to protect trademark owners, including well-known marks owners, from acts of unfair competition.¹⁰⁴

100. 15 U.S.C. § 1126(b) (emphasis added).

101. See *Statutory Interpretation: General Principles and Recent Trends*, EVERYCRSREPORT.COM (Sept. 24, 2014) <https://www.everycrsreport.com/reports/97-589.html>.

102. See 15 U.S.C. § 1126(h) (stating any person entitled to benefits under and subject to the Lanham Act is “entitled to effective protection against unfair competition”); 15 U.S.C. § 1127 (intending “to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce”).

103. 15 U.S.C. § 1126(h).

104. See, e.g., 15 U.S.C. § 1126(b) (stating persons whose country of origin is party to a treaty for, *inter alia*, the “repression of unfair competition” is entitled to rights and benefits under the Lanham Act necessary to effectuate the provisions of the treaty if the United States is also a party to the treaty, or if international law extends the same rights to U.S. persons); 15 U.S.C. § 1126(h) (entitling appropriate parties under the Lanham Act to rights and benefits necessary to repress unfair competition); 15 U.S.C. § 1127 (intending to regulate commerce by providing rights and remedies to parties bringing claims under international agreements relating to, *inter alia*, unfair competition).

Additionally, Section 43 incorporates the well-known marks doctrine because it contains no express requirement that a plaintiff prove its own actual use in commerce in the United States.¹⁰⁵ This is in sharp contrast to Section 32 of the Act, which states that for a trademark owner to bring a claim of infringement, he must have a registered mark with the USPTO¹⁰⁶ Congress provided a recourse in Section 32 for trademark owners with registered marks, however it also enacted a provision that allowed trademark owners without registered marks to bring claims for false designations of origin, false descriptions, and dilution in Section 43.¹⁰⁷ Again, since acts of Congress are understood to be intentional and not superfluous, the difference in text suggests that Section 32 requires strict adherence to federal trademark requirements whereas Section 43 does not.

Section 43's provisions are similar to the well-known marks doctrine because the trademark owner can suffice with only presenting evidence of the defendant's infringing use of the mark and the likelihood that the infringing use could cause consumer confusion or harm to the trademark owner.¹⁰⁸ Section 43's provision on dilution is almost completely similar to the well-known marks doctrine because it focuses on a mark's wide repute and fame as an indicator of its right to protection.¹⁰⁹ Congress is incorporating protections for well-known marks in these provisions of the Lanham Act.

C. THE USPTO AND THE U.S. COURTS' RULINGS

Congress's failure to prevent the USPTO and U.S. Courts from applying the well-known marks doctrine into U.S. law demonstrates the United States' acceptance of Article 6bis of the Paris Convention. In the U.S. checks and balance system, Congress enacts a law, the Courts interpret the law, and this tells Congress how the language

105. Compare 15 U.S.C. § 1125 (omitting any reference to trademark registration) with 15 U.S.C. § 1114 (referencing trademark registration as a prerequisite).

106. 15 U.S.C. § 1114.

107. 15 U.S.C. § 1125.

108. See generally *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 30 (2003) (demonstrating that defendant's use of the mark in commerce is the crux of the issue of reverse passing off).

109. 15 U.S.C. § 1125.

and/or intent of the law is manifested.¹¹⁰ Congress enacted the Lanham Act and has made sufficient amendments as recent as January 14, 2013.¹¹¹

Since the United States acceded to Articles 1-12 of the Paris Convention in 1973, federal trademark owners have brought, and sometimes won, claims for trademark infringement, false designation of origin, misrepresentation of goods, and cancellation proceedings.¹¹² Mexican owners of the “Grupo Gigante” mark were granted relief in the Ninth Circuit in 2004,¹¹³ which was a landmark case in international trademark law, and TTAB canceled a U.S. owner’s trademark registration for a trademark lawfully used in the United States per the request of a foreign well-known marks owner, Wimbledon, in 1983.¹¹⁴ Essentially, the Ninth Circuit and TTAB allowed foreign trademark owners, who have never used their marks in commerce in the United States, to prohibit registration and use of U.S. trademark owners who have used the mark first and have followed all other requirements necessary for registration with the USPTO¹¹⁵ However, in its most recent amendments to trademark law in 2013, which were after these rulings, Congress did not attempt to close this loophole. This could mean that Congress has accepted these interpretations of the Lanham Act.

110. See *Statutory Interpretation: General Principles and Recent Trends*, *supra* note 101 (explaining that when Congress includes or omits language in a statute it is generally considered intentional).

111. 15 U.S.C. § 1051.

112. See, e.g., *Belmora L.L.C. v. Bayer Consumer Care AG*, 819 F.3d 697 (4th Cir. 2016); *Grupo Gigante S.A. de C.V. v. Dallo & Co.*, 391 F.3d 1088, 1099 (9th Cir. 2004); *The All Eng. Lawn Tennis Club (Wimbledon) Ltd. v. Creations Aromatiques, Inc.*, 220 U.S.P.Q. (BNA) 1069 (T.T.A.B. 1983).

113. *Grupo Gigante*, 391 F.3d at 1099.

114. *All Eng. Lawn Tennis Club (Wimbledon)*, 220 U.S.P.Q. (BNA) 1069.

115. See *Belmora L.L.C.*, 819 F.3d at 705, 710 (holding that the Lanham Act does not require a “plaintiff [to] have used a U.S. trademark in U.S. commerce to bring a Lanham Act unfair competition claim,” so long as the plaintiff believes that it is damaged by the use of its mark); *Grupo Gigante*, 391 F.3d at 1088, 1094 (9th Cir. 2004) (holding that there is a famous mark exception to the territoriality principle in order to prevent trademark law from fooling immigrants into buying what they think is a product from their home country); *All Eng. Lawn Tennis Club (Wimbledon)*, 220 U.S.P.Q. (BNA) 1069 (holding that the opposer acquired U.S. rights to the term “WIMBELDON” through the fame and notoriety associated with the annual tennis championships).

In fact, since the adoption of the Lanham Act, U.S. courts have provided relief to foreign trademark owners even when they have not used the mark in commerce but the U.S. owner has.¹¹⁶ *Maison Prunier*, *Maxim*, *Grupo Gigante*, and *Bayer* are all foreign trademark owners of well-known marks who have not used their marks in the United States, however the New York Supreme Court, the Ninth Circuit, and the Fourth Circuit respectively disregarded the U.S. trademark territoriality principle in favor of protection for well-known marks.¹¹⁷ Interestingly, Congress still has not amended the Lanham Act to prevent further protection for foreign trademark owners who have not used their mark in commerce.

A counter-argument here is that Congress wrote into the Lanham Act that it only regulates trademarks pursuant to the Commerce Clause of the United States Constitution,¹¹⁸ and therefore Congress does not need to amend Sections 14 and 43 to prohibit suits brought by foreign trademark owners.¹¹⁹ However, if courts misconstrue a law, Congress historically has amended the law to correct it.¹²⁰ Here, Congress has not amended the Lanham Act to prevent further cancellations of U.S. registered trademarks or prohibition of U.S. users at the request of

116. See, e.g., *Belmora L.L.C.*, 819 F.3d at 702 (detailing that Bayer sold naproxen sodium pain relievers in the U.S. using the name ALEVE rather than FLANAX); *Grupo Gigante*, 391 F.3d at 1092 (finding in the lower court that Gigante was a well-known mark in Southern California when Gigante Market began using the mark); *Vaudable v. Montmartre, Inc.*, 193 N.Y.S.2d 332, 334 (N.Y. Sup. Ct. 1959) (extending the scope of the doctrine of unfair competition beyond direct territorial competition for a plaintiff whose distinctive Parisian restaurant was overtly copied by the U.S. defendants); *Maison Prunier v. Prunier's Rest. & Café*, 288 N.Y.S. 529, 536 (N.Y. Sup. Ct. 1936) (stating that the protection of trademark rights may extend into markets in which the original mark is well known).

117. See *Belmora L.L.C.*, 819 F.3d at 713 (holding that the Lanham Act allows Bayer to pursue false association and false advertising, despite not having entered the U.S. market with this particular product); *Grupo Gigante*, 391 F.3d at 1098 (finding that the pre-existing foreign mark was well known in the region which Gigante Market used the mark); *Vaudable*, 193 N.Y.S.2d at 358; *Maison Prunier*, 288 N.Y.S. at 537 (affirming the right of the foreign plaintiff to bring an action in U.S. courts, despite not operating in the U.S.).

118. See 15 U.S.C. § 1127 (defining “use in commerce” as it relates to the reach of the Lanham Act).

119. 15 U.S.C. §§ 1064, 1125.

120. See generally Christine Haight Farley, *No Trademark, No Problem*, 23 B.U. J. SCI. & TECH. L. 304, 317 (2017) (postulating that the U.S. courts establish precedent and Congress has the authority to override that precedent).

foreign trademark owners,¹²¹ thereby incorporating Article 6bis's provisions into federal law.

D. SUBSEQUENT INTERNATIONAL AGREEMENTS AND ENFORCEMENT OF THE WELL-KNOWN MARKS DOCTRINE

The United States is obligated to follow Article 6bis of the Paris Convention because it ratified it and continues to promote its enforcement in subsequent international agreements. Since accession to Articles 1-12 of the Paris Convention in 1973, the United States has signed and supported WIPO's Joint Recommendations Concerning Provisions on the Protection of Well-Known Marks¹²² and contracted Article 20.C.5 with Canada and Mexico to include particular measures in the USMCA for the protection of well-known marks.¹²³ It also expressed concern for an international obligation to protect the rights and interests of well-known marks in USTR's Special 301 Report.¹²⁴

The United States consistently entering into these agreements shows intent to promote its obligation to international trademark law. The Special 301 Report specifically intends to promote intellectual property obligations and calls out countries who violate these obligations; the United States argued in its most recent report that some countries infringe the use of U.S. trademark owners' marks and that these countries need to respect U.S. trademark rights pursuant to the well-known marks doctrine.¹²⁵ The United States' promotion of the

121. See generally 15 U.S.C. § 1051.

122. *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks*, *supra* note 17.

123. *Agreement between the United States of America, the United Mexican States, and Canada 12/13/19 Text*, *supra* note 19, at arts. 20.21.1-2 (setting forth guidelines on determining the legitimacy of well-known trademarks in accordance with the Paris Convention).

124. *2018 Special 301 Report*, *supra* note 18, at 26-27 (discussing various trademark protection issues that face certain countries, including inflexible and insufficient systems, administrative lethargy, and prohibitively high trademark fees).

125. See *id.* at 26 ("However, in numerous countries, legal and procedural obstacles exist to securing trademark rights. For example, the UAE reportedly institutes the highest trademark registration fees in the world and brand protection is considered cost-prohibitive, especially for SMEs. Many countries need to establish or improve transparency and consistency in their administrative trademark registration procedures. For example, the trademark system in China suffers from inflexibility in relation to descriptions of goods and services, insufficient legal

well-known marks doctrine validates its intent to follow it and incorporate it into U.S. trademark law.

E. THE SECOND CIRCUIT IS VIOLATING INTERNATIONAL LAW

Since the United States ratified Article 6bis of the Paris Convention, and Congress incorporated the well-known marks doctrine into trademark law, the United States is obligated to follow this doctrine. Therefore, the Second Circuit violated international law by denying relief to Punchgini.¹²⁶

In *ITC*, the Second Circuit ruled that Congress has not incorporated Article 6bis into the Lanham Act.¹²⁷ However, the United States continues to promote enforcement of the well-known marks doctrine in subsequent international publications (specifically a publication that “scorns” countries for not following international obligations they have signed),¹²⁸ and continues to engage in conversations that promote international trademark cooperation. Sections 14, 43, 44, and 45 of the Lanham Act all contain elements of the well-known marks doctrine,¹²⁹ and foreign trademark owners have relied on these sections to seek remedies in the United States. Some U.S. courts have even broken the territoriality principle to rule in favor of the foreign trademark owners.¹³⁰ The legislative history of the Lanham Act shows that drafters of the Lanham Act intended for the act to provide protection

weight ascribed to notarized and legalized witness declarations in China Trademark Office and Trademark Review and Adjudication Board proceedings, unreasonably high standards for establishing well-known mark status, and a lack of transparency in all phases of trademark prosecution. Many other countries, including Brazil, India, Malaysia, and the Philippines, reportedly have slow opposition proceedings while Panama and Russia have no administrative opposition proceedings.”)

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

127. See *id.* at 163 (“[W]e do not ourselves discern in the plain language of sections 44(b) and (h) a clear congressional intent to incorporate a famous marks exception into federal unfair competition law.”).

128. See *2018 Special 301 Report*, *supra* note 18 (notifying certain countries of their intellectual property rights violations and demand recourse).

129. *Supra* Part III.b.

130. See, e.g., *Belmora L.L.C. v. Bayer Consumer Care AG*, 819 F.3d 697 (4th Cir. 2016); *Grupo Gigante S.A. de C.V. v. Dallo & Co.*, 391 F.3d 1088 (9th Cir. 2004); *Vaudable v. Montmartre, Inc.*, 193 N.Y.S.2d 332 (N.Y. Sup. Ct. 1959); *Maison Prunier v. Prunier’s Rest. & Café*, 288 N.Y.S. 529 (N.Y. Sup. Ct. 1936).

in this way to oblige to international agreements.¹³¹

Also, the United States incorporated the well-known marks doctrine through cancellation proceedings in TTAB by cancelling U.S. registrations at the request of a Mexican, Canadian, and English owner.¹³² Even if TTAB cited Section 14 of the Lanham Act, it canceled a U.S. owner's registration at the request of an owner who had never used the mark in the United States.¹³³ What is important to note is that even if the courts did not cite Article 6bis of the Paris Convention specifically, they were breaking the territoriality principle of federal trademark law because they allowed foreign trademark owners who had not used their marks in commerce in the U.S. to gain relief for infringing use of their well-known mark by a domestic trademark owner who may have even received federal trademark registration for the mark with the USPTO

ITC was an interested party that requested the Second Circuit prohibit Punchgini's use of the Bukhara mark.¹³⁴ Bukhara had sufficient fame in India, which had spilled over into New York's cultural hub. Although critics may claim that fame in New York is not sufficient to establish the mark's recognition in the United States, there is no gauge in Article 6bis describing the level of fame or recognition a mark needs to be considered "well-known" enough to win a case of infringement. Moreover, a New York court has ruled in favor of a French trademark owner at the behest of a domestic owner because the French trademark owner's restaurant was famous enough among "the class of people residing in the cosmopolitan city of New York who dine out."¹³⁵ When ITC brought this case to the Second Circuit, the

131. See Rogers, *supra* note 44, at 182 (exploring the purposes of the Lanham Act).

132. See, e.g., Bayer Consumer Care AG v. Belmora L.L.C., 110 U.S.P.Q.2d (BNA) 1623 (T.T.A.B. 2014); First Niagara Ins. Brokers, Inc. v. First Niagara Fin. Group, Inc., 77 U.S.P.Q.2d (BNA) 1334 (T.T.A.B. 2005); The All Eng. Lawn Tennis Club (Wimbledon) Limited v. Creations Aromatiques, Inc., 220 U.S.P.Q. (BNA) 1069 (T.T.A.B. 1983).

133. See, e.g., Bayer Consumer Care, 110 U.S.P.Q.2d (BNA) 1623; First Niagara Ins. Brokers, 77 U.S.P.Q.2d (BNA) 1334; All England Lawn Tennis Club (Wimbledon), 220 U.S.P.Q. (BNA) 1069.

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

135. See *Vaudable*, 193 N.Y.S.2d at 334–35.

well-known marks doctrine should have been invoked.¹³⁶ By not following the doctrine, the Second Circuit violated U.S. obligations to follow Article 6bis of the Paris Convention.

IV. RECOMMENDATIONS

To comply with Article 6bis, this Comment recommends several options for the United States and member states of the Paris Convention. First, Congress needs to amend the Lanham Act to explicitly include the well-known marks doctrine under the infringement¹³⁷ and unfair competition¹³⁸ provisions to avoid any ambiguities in the future or the Supreme Court needs to overrule *ITC Ltd. v. Punchgini, Inc.*¹³⁹ in accordance with Article 6bis. Second, the USPTO needs to expand trademark searches to an international level before granting registration to U.S. trademark owners using a foreign owner's mark.¹⁴⁰ Last, Member States of the World Trade Organization (WTO) should bring disputes against countries that violate Article 6bis.¹⁴¹

First, Congress or the Supreme Court needs to legitimize the well-known marks doctrine to resolve the ambiguity in the U.S. Circuit Courts. So long as Congress does not amend the Lanham Act to include the doctrine or the Supreme Court does not use its power of judicial review to interpret the Lanham Act in line with the principles of Article 6bis, the Second Circuit will reject any argument advocating that the Lanham Act includes an exception for well-known marks.¹⁴²

136. See *Paris Convention for the Protection of Industrial Property*, *supra* note 14, art. 6bis (stating that an interested party may request the protection of his famous trademark).

137. See 15 U.S.C. § 1114.

138. See 15 U.S.C. § 1125.

139. See 482 F.3d at 164-65.

140. See *Using the Trademark Electronic Search System*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks-application-process/searching-trademarks/using-trademark-electronic-search-system> (last visited Feb. 9, 2019) (explaining how to search for trademarks).

141. See *Dispute Settlements*, WORLD TRADE ORG., https://www.wto.org/english/tratop_e/dispu_e/dispu_e.htm (last visited Feb. 6, 2020).

142. See *ITC*, 482 F.3d at 164-65 (rejecting the Ninth Circuit's policy-based argument that the U.S. is obligated to respect foreign well-known marks because it would be unequitable to steal another company's goodwill to trick its emigrants).

This will leave foreign owners of well-known marks without recourse because the Second Circuit refuses to be swayed by policy argument or appeals to equity, unlike the Ninth Circuit.¹⁴³ And while it is noted that foreign owners of well-known marks have the option of litigating in the Ninth Circuit, those owners that only have an option to litigate in the Second Circuit are at a loss. With the increase in globalization, these disputes could be increasing throughout the courts. U.S. Circuit Courts that have not yet ruled on the well-known marks doctrine could follow the Second Circuit's line of reasoning.¹⁴⁴ Unless Congress effectuates the well-known marks doctrine in a statute or the Supreme Court overturns the Second Circuit's ruling, there will continue to be ambiguity in the Circuits.

Second, the USPTO's Trademark Examining Attorneys need to expand their trademark searches before determining a potential mark's eligibility for registration.¹⁴⁵ By including more databases than just the Trademark Electronic Search System (TESS), the USPTO can investigate a wider collection of trademarks before determining that an applicant's registration will not cause a likelihood of confusion with another mark.¹⁴⁶ This approach can be accomplished by using Google searches to research whether the applicant's proposed mark is

143. See *Grupo Gigante S.A. de C.V. v. Dallo & Co.*, 391 F.3d 1088 (9th Cir. 2004) (demonstrating how certain areas of the United States are home to several immigrants from a specific country (Mexico in this case), and companies in those areas of the United States are stealing the marks from these immigrants' home countries to play on the goodwill of another mark owner and trick these immigrants into buying what they think is originally from their home country).

144. See *Federal Court Concepts*, SE. ADA CTR., <http://adacourse.org/courtconcepts/circuits.html> (last visited Mar. 8, 2019) (exploring how Circuit Courts are divided).

145. See Grinvald, *supra* note 4, at 11 ("A robust international registration system lowers the barriers to transactional trade in two ways."); *Trademark Electronic Search System (TESS)*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks-application-process/search-trademark-database> (last visited Feb. 6, 2020).

146. See 15 U.S.C. § 1051 ("No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it [. . .] (d) consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive[.]").

in global use for similar goods and/or services. Due to the fact that TESS only houses trademarks that are attempting registration, not all common-law trademarks are in the database.¹⁴⁷ However, Google can account for these common-law marks by searching the web for any indications of use. The USPTO can also expand their trademark searches by utilizing foreign countries' trademark databases to analyze all their registered and pending marks in the application process.¹⁴⁸ This approach would allow the USPTO to reject domestic applications that are infringing or diluting the goodwill of well-known marks.

Lastly, foreign countries need to utilize the WTO Dispute Settlement Body (DSB)¹⁴⁹ to enforce Article 6bis of the Paris Convention on the United States because, "an international treaty is only as effective as its enforcement."¹⁵⁰ If countries want to ensure global enforcement, there must be consequences for violations.

V. CONCLUSION

The United States is obligated to follow the well-known marks doctrine and based on federal trademark law and practice through U.S. agencies, it is essentially doing so. The Second Circuit argues that Article 6bis is not explicitly written into the Lanham Act, however it

147. See *Trademark Electronic Search System (TESS)*, *supra* note 145 (noting that for a trademark to appear in the USPTO's database, an owner or attorney must have attempted to register it. Therefore, not all marks used in the U.S. appear in the USPTO's database).

148. See *Search: Madrid e-Services*, WIPO, <https://www.wipo.int/madrid/en/search/> (last visited Feb. 9, 2019) (discussing that before a trademark owner files a local or international trademark application, it is important to search existing trademarks in the target markets, and the search will help uncover trademarks that may be similar or identical to the trademark owner's; if the suggested trademark for application infringes on the rights of another person or company, the trademark owner may not be able to register it); *Global Brand Database*, WIPO, <https://www.wipo.int/branddb/en/> (last visited Feb. 9, 2019) (showing how WIPO's Global Brand Database enables trademark owners to search for trademarks registered under the Madrid System, Appellations of Origin registered under the Lisbon System, and Emblems protected under the Paris Convention 6ter; a number of national trademark collections are also included).

149. See *Dispute Settlements*, *supra* note 141.

150. See ALUISIO DE LIMA-CAMPOS & JUAN ANTONIO GAVIRIA, *INTRODUCTION TO TRADE POLICY* 194 (Routledge ed. 2018) (arguing that international agreements have no real effect on domestic law until sanctions and fines for violations of the international agreements hurt the domestic industry).

is incorporated into sections 14, 43, 44, and 45,¹⁵¹ and these sections have provided relief for foreign trademark owners through U.S. courts.¹⁵² The Second Circuit is violating international law by not providing relief when there is an international obligation to do so

The United States should rectify this violation by explicitly implementing the well-known marks doctrine into the Lanham Act or through a Supreme Court ruling. The United States should also implement new policies at the USPTO¹⁵³ to cross-reference international trademark registration or use. If all else fails, signatories to the Paris Convention should bring disputes against the United States in the DSB.¹⁵⁴ Whether the United States implements all of these recommendations or just one, it is important for the United States to comply with the well-known marks doctrine because this violation ultimately hurts consumers and producers.¹⁵⁵

151. *Supra* Part III.b.

152. *Supra* Part III.c.

153. *Supra* Part IV.

154. *Supra* Part IV.

155. *See* BEEBE, *supra* note 2, at 22–23 (“[T]he law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product, thereby encouraging the production of quality products, and simultaneously discourages those who hope to sell inferior products by capitalizing on a consumer’s inability to quickly evaluate the quality of an item offered for sale.”).