

WASHINGTON JOURNAL OF LAW, TECHNOLOGY & ARTS  
VOLUME 12, ISSUE 4 SPRING 2017

TAKING CARE OF ARTICLE 6BISNESS: HOW BELMORA LLC V.  
BAYER CONSUMER CARE AG MADE THE WELL-KNOWN MARK  
DOCTRINE INEVITABLE IN THE U.S.

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CITE AS: 12 WASH. J.L. TECH. & ARTS 501 (2017)  
<http://digital.law.washington.edu/dspace-law/handle/1773.1/1793>

ABSTRACT

*In Belmora LLC v. Bayer Consumer Care AG, the Fourth Circuit held that a foreign company with no U.S. federal trademark registration for "FLANAX" could nevertheless demand cancellation of its competitor's U.S. trademark for "FLANAX". This holding circumvented Article 6bis of the Paris Convention, a provision which protects trademark owners in signatory countries by way of the well-known mark doctrine. Following Belmora's precedent would allow foreign trademark owners to bypass the U.S.'s existing trademark registration system and so undermine U.S. trademark law's central principle of territoriality. This Article argues that Article 6bis is critical to asserting substantive rights on behalf of foreign trademark owners in the U.S. Part I of this Article reviews the history and common criticisms behind the well-known mark doctrine. Part II balances the doctrine against trademark territoriality and applies its resulting theory to the Belmora decision. Part III reviews theories for reform and argues that where unfair competition law conflicts with a foundational trademark principle such as territoriality, trademark principles should triumph.*

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## INTRODUCTION

In 2016, the Fourth Circuit held that a plaintiff may have standing under § 43(a) of the Lanham Act even if it had not used its trademark in commerce within the United States.<sup>1</sup> *Belmora LLC v. Bayer Consumer Care AG* thus opened an opportunity for foreign trademark owners to bypass the U.S.'s existing trademark system and its current registrants. Such decisions are not unprecedented.<sup>2</sup> However, *Belmora* did something unique: the court's reasoning circumvented Article 6bis of the Paris Convention, a provision which protects trademark owners in signatory countries. By creating case law for the 'famous' or 'well-known mark' doctrine that does not attach to Article 6bis, the decision came into tension with the territoriality principle at the heart of U.S. trademark law.

## I. THE WELL-KNOWN MARK DOCTRINE

Under Article 6bis of the Paris Convention, a foreign trademark's owner can petition the trademark offices in countries which have signed the treaty to refuse or to cancel the registration, and to prohibit the use of virtually any trademark which could be confused with the foreign trademark owner's well-known mark where that mark is being used for the sale of identical or similar goods.<sup>3</sup> This is known colloquially as the 'famous' or 'well-known mark' doctrine.<sup>4</sup> The U.S. signed onto the treaty in 1887 and has been a significant party to its revisions in subsequent years.<sup>5</sup> In theory, Article 6bis thus grants exclusive protection within the U.S. to any trademark owned by a foreign national. This protection

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<sup>1</sup> *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 701 (4th Cir. 2016).

<sup>2</sup> See *infra* Part I.B.

<sup>3</sup> Paris Convention for the Protection of Industrial Property, Art. 6bis, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter "Paris Convention"].

<sup>4</sup> Courts and commentators have used the terms interchangeably; however, because the well-known mark doctrine differs from the 'famous mark' necessary to prove cause for trademark dilution in the U.S., this Article confines its discussion to the term 'well-known mark'.

<sup>5</sup> See generally Laurence R. Helfer, *Regime Shifting: The Trips Agreement and New Dynamics of International Intellectual Property Lawmaking*, 29 YALE J. INT'L L. 1, 19 (2004).

applies even if the owner has not registered that mark with the U.S. Patent and Trademark Office or used it in the U.S., so long as its home country is a signatory to the Paris Convention.<sup>6</sup>

### A. History

#### 1. Considerations During and After the Paris Convention

Created in 1883, the Paris Convention aimed to create a baseline for international dealings in trademark and unfair competition.<sup>7</sup> Drafters at the convention focused on ensuring reciprocal treatment with regard to intellectual property rights for intellectual property owners in signatory countries, regardless of whether those owners had sought formal rights outside of their home countries.<sup>8</sup> This priority grew into Article 6*bis*, which elides the user requirement within a given country for well-known marks and emphasizes instead factors such as source indication, the basis of the defendant's use, and the defendant's co-opting of goodwill.<sup>9</sup> Although the U.S. has been a longstanding signatory, the extent to which the Paris Convention has had any substantive effect on U.S. trademark law is still an open question.<sup>10</sup>

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<sup>6</sup>Certain reviewers have argued that Article 10*bis* of the Paris Convention—which prohibits any act which serves to create trademark confusion, or otherwise mislead consumers regarding identical or similar goods—deliberately reinforces Article 6*bis*'s effect. Treating unfair competition claims and trademark infringement claims as interchangeable, however, has confused the law over time. In an effort to distinguish the topic, examining the interoperability of Article 10*bis* within the well-known marks doctrine falls outside the scope of this Article. For discussion on the blur between unfair competition and trademark infringement, *see infra* Part II.C.

<sup>7</sup>3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:74 (4th ed. 2005).

<sup>8</sup>Geri L. Haight & Philip Catanzano, *The Effects of Global Priority of Trademark Rights*, 91 MASS. L. REV. 18, 21 (2007).

<sup>9</sup>Paris Convention, *supra* note 2.

<sup>10</sup> *See* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 29:4, at 29–30 (4th ed. 2005) (claiming that Article 6*bis* has been incorporated into U.S. trademark canon via §§ 43(a), 43(b), and 44(h) of the Lanham Act); *see also infra* Part I.C.2.

The question endures in large part because of the Paris Convention's unclear status in the U.S. Since the Paris Convention is not a self-executing treaty, trademark owners can claim rights under the treaty only to the extent that its signatory countries espouse those rights in substantive legislation.<sup>11</sup> Like many countries, however, U.S. trademark law has historically emphasized territoriality in both its common law decisions and in its statutes.<sup>12</sup> This principle holds that intellectual property rights are inherently national in character and any protections granted on the basis of such rights have limited extraterritorial reach.<sup>13</sup> Faithful to the territoriality principle, courts have rarely extended U.S. trademark laws into foreign countries.<sup>14</sup> Due to this lingering tension, the Paris Convention has had scattered and sporadic influence in the U.S.<sup>15</sup>

## 2. The TRIPS Agreement and Influences on the Doctrine's Development

Concerned that the Paris Convention provided insufficient protections for intellectual property owners, the U.S. negotiated and lobbied for the inclusion of the Agreement on Trade-Related Aspects of Intellectual Property Rights into the Uruguay Round of

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<sup>11</sup> See 7 PATRY ON COPYRIGHT § 24:1 (reviewing the origins and limitations of the General Agreement on Tariffs and Trade, including the Paris Convention).

<sup>12</sup> See, e.g., 15 U.S.C. § 1126(b) (2000).

<sup>13</sup> See, e.g., *Pers.'s Co. v. Christman*, 900 F.2d 1565, 1568–69 (Fed. Cir. 1990) ("The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme.").

<sup>14</sup> See *Circuit Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952) (holding that Lanham Act claims extend into foreign countries only when the alleged infringer's conduct affects U.S. commerce and applicable foreign law does not explicitly preclude the application of U.S. law). Subsequent cases include *Sterling Drug, Inc. v. Bayer AG*, 14 F.3d 733, 743–44, 747 (2d Cir. 1994) (holding that not every activity of a foreign corporation with any tendency to create some confusion among American consumers could be prohibited by the extraterritorial reach of a U.S. injunction); *First Niagara Ins. Brokers, Inc. v. First Niagara Fin. Group, Inc.*, 476 F.3d 867 (Fed. Cir. 2007); *Hilton Intern. Co., Inc. v. Hilton Hotels Corp.*, 888 F. Supp. 520 (S.D.N.Y. 1995).

<sup>15</sup> See *infra* Part II.B.1.

the General Agreement on Tariffs and Trade in 1994.<sup>16</sup> The TRIPS Agreement supplemented the protections granted to foreign trademarks in signatory countries under the Paris Convention by protecting service marks.<sup>17</sup> It also extended a well-known trademark owner's rights to preventing uses of identical or similar trademarks for dissimilar goods or services, "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 interest of the owner of the registered trademark are likely to be damaged by such use."<sup>18</sup>

Seeking to address concerns on varying applications of the terms 'reputation' and 'well-known' for well-known trademarks in signatory countries, the World Intellectual Property Organization ("WIPO") bolstered the agreement in 1998 by way of a 'Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks'.<sup>19</sup> This served as an advisory document for countries seeking guidelines on implementing the well-known marks doctrine.

In application, however, the TRIPS Agreement has also had a limited impact on U.S. trademark canon. Language within the agreement itself indicates that members must "give effect to the provisions of this Agreement" for the treaty to hold sway, and are "free to determine the appropriate method of implementing the provisions of this Agreement within their own legal system and practice."<sup>20</sup> Federal law further provides that U.S. statutes must triumph where any such laws prove inconsistent with the TRIPS

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<sup>16</sup> JOHN BRAITHWAITE & PETER DRAHOS, *GLOBAL BUSINESS REGULATION* 175–6 (New York: Cambridge University Press, 2000).

<sup>17</sup> TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197, Art. 16(2) (1994) [hereinafter TRIPS or TRIPS Agreement] ("Article 6bis of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services.").

<sup>18</sup> TRIPS, Art. 16(3).

<sup>19</sup> World Intellectual Property Organization, *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* (Sept. 1999), available at

<http://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf/>.

<sup>20</sup> TRIPS, Art. 1(1).

agreement.<sup>21</sup> Thus, courts have uniformly held that the agreement is not, in itself, a self-executing treaty with the force of law.<sup>22</sup>

*B. Current Doctrinal Application in the U.S.*

As a result, the U.S.'s application of the well-known marks doctrine has proven unwieldy and controversial. Courts generally agree on the doctrine's definition—namely that owners of well-known trademarks in foreign countries may theoretically prohibit the use of identical or similar-looking marks in the U.S. by way of a trademark infringement claim under the Lanham Act, even where the foreign mark's owner has not registered the mark or used the mark in U.S. commerce.<sup>23</sup> However, the bases by which a foreign trademark owner may claim such rights vary wildly between jurisdictions.<sup>24</sup> Before *Belmora*, two perspectives reigned.<sup>25</sup> The first view held that Article 6bis of the Paris Convention had been effectively integrated into existing trademark legislation through § 44(b) of the Lanham Act, which provides that a foreign national whose country of origin is a party "to any convention relating to trademarks... or the repression of unfair competition, to which the United States is also a party"<sup>26</sup> is entitled to all benefits arising from

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<sup>21</sup> 19 U.S.C. § 3512(a)(1) ("No provision of any of the Uruguay Round Agreements [including the TRIPS Agreement], nor the application of any such provision to any person or circumstance, that is inconsistent with any law of the United States shall have effect.").

<sup>22</sup> See, e.g., *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 161 (2d Cir. 2007) ("TRIPS is plainly not a self-executing treaty. . ."); *In re Rath*, 402 F.3d 1207, 1209 (Fed. Cir. 2005) (" . . . we find that the Paris Convention is not a self-executing treaty. ").

<sup>23</sup> See generally *American Circuit Breaker Corp. v. Oregon Breakers, Inc.*, 406 F.3d 577, 581–83 (9th Cir. 2005); *Kos Pharms., Inc. v. Andrx Corp.*, 369 F.3d 700, 714 (3d Cir. 2004); *Buti v. Perosa, S.R.L.*, 139 F.3d 98, 105 (2d Cir. 1998).

<sup>24</sup> See, e.g., *Grupo Gigante II*, 391 F.3d 1088, 1094 (9th Cir. 2004); *Almacenes Exito S.A. v. El Gallo Meat Mkt., Inc.*, 381 F. Supp. 2d 324, 326–28 (S.D.N.Y. 2005).

<sup>25</sup> 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 TRADEMARK REP. 1379, 1396 (2008).

<sup>26</sup> 15 U.S.C. § 1126.

the Lanham Act.<sup>27</sup> The second view held that, because no U.S. federal trademark legislation existed to codify the Paris Convention or the TRIPS Agreement, neither agreement had been formally executed and could not be construed as law.<sup>28</sup> Over time, these views consolidated into the primary rallying points for proponents and opponents of the argument that the well-known mark doctrine was an exception to the territoriality principle underlying U.S. trademark law.

### 1. Ninth Circuit Requirements

In *Grupo Gigante S.A. de C.V. v. Dallo & Co.*,<sup>29</sup> the Ninth Circuit explicitly exempted the well-known marks doctrine from the territoriality principle underlying U.S. trademark law. In 2004, a Mexican grocery chain sued a grocery store in California, claiming trademark infringement of its trademark 'Gigante'. While it had not registered the 'Gigante' mark in the U.S., the plaintiff argued that its mark was well-known and so entitled to protection under the Lanham Act by way of Article 6*bis* of the Paris Convention.<sup>30</sup> The *Grupo* court held that Article 6*bis* provided a substantive right for foreign trademark owners enforceable through § 44 of the Lanham Act.<sup>31</sup> Affirming the district court in its exemption, the Ninth Circuit justified the doctrine as merely "recognizing the realities of modern society and business by acknowledging the fact that a trademark can be carried to areas far from the actual point of sale due to advertising and the ambulatory nature of consumers."<sup>32</sup>

Recognizing the doctrine's potential conflicts with territoriality, however, the *Grupo* court imposed specific limits on well-known trademark claims. In particular, the Ninth Circuit determined that significant factors included

[whether] a substantial percentage of consumers in the relevant American market is familiar with the

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<sup>27</sup> See *infra* Part I.B.1.

<sup>28</sup> See *infra* Part I.B.2.

<sup>29</sup> *Grupo Gigante SA De CV v. Dallo & Co.*, 391 F.3d 1088 (9th Cir. 2004).

<sup>30</sup> *Id.* at 1098.

<sup>31</sup> *Id.*

<sup>32</sup> *Id.* at 1090.



foreign mark[,] . . . the geographic area where the defendant uses the alleged infringing mark[,] . . . the intentional copying of the mark by the defendant, and whether customers of the American firm are likely to think they are patronizing the same firm that uses the mark in another country.<sup>33</sup>

Finding such factors need not be considered dispositive, the court held. Rather, the relevant inquiry should be directed towards factors which "bear heavily on the risks of consumer confusion and fraud," and which must be proven by a preponderance of the evidence.<sup>34</sup>

Commentators have noted the decision's lack of precedent and the test's openness to judicial manipulation.<sup>35</sup> By failing to establish grounds in which to root *Grupo's* precedent, and by refusing to establish concrete standards by which to define a well-known mark, critics have argued that the well-known mark doctrine provides an opening to weaken the territoriality principle significantly.

## 2. Rejection of the Doctrine in the Second Circuit

Not three years after *Grupo*, the opposite pole to the well-known marks doctrine grew from the Second Circuit. In *ITC Ltd. v. Punchgini, Inc.*,<sup>36</sup> the court determined that no legislative basis existed to insert the well-known marks doctrine into the Lanham Act. In *ITC Ltd.*, restaurant owners operating in Southeastern Asia under the trademark BUKHARA sued former employees who had opened two restaurants in New York City under the trademark BUKHARA GRILL. Arguing that the defendants had deliberately mimicked the plaintiffs' allegedly internationally renowned

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<sup>33</sup> *Id.* at 1098.

<sup>34</sup> *Id.*

<sup>35</sup> See generally Kristin Zobel, *The Famous Marks Doctrine: Can and Should Well-Known Foreign Marks Receive Trademark Protection Within the United States?*, 19 DEPAUL J. ART, TECH. & INTELL. PROP. L. 145 (2008); James Faris, *The Famous Marks Exception to the Territoriality Principle in American Trademark Law*, 59 CASE W. RES. L. REV. 451 (2009); Rachel Brook, *The United States' Adoption of the Well-Known Foreign Mark Exception*, 36 FORDHAM URB. L.J. 889 (2009).

<sup>36</sup> *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135 (2d Cir. 2007).

marks<sup>37</sup>—which included logos, decor, staff uniforms, wood-slab menus, and red-checkered customer bibs<sup>38</sup>—the plaintiffs sued for trademark infringement, unfair competition, and false advertising in violation of the Lanham Act.<sup>39</sup>

The Second Circuit, however, held that it could not discern in the relevant portions of the Lanham Act "a clear congressional intent to incorporate a famous marks exception into federal unfair competition law."<sup>40</sup> To carve out an exception for marks of international renown in U.S. law was Congressional territory. Arguments based on policy, the court asserted, "must be submitted to Congress for it to determine whether and under what circumstances to accord federal recognition to such an exception to the basic principle of territoriality."<sup>41</sup> But the foreign plaintiffs were not left entirely without recourse: in a later opinion, the court held that the plaintiffs were eligible to file a misappropriation claim under New York state law, provided that they could prove secondary meaning.<sup>42</sup> Ultimately, the Second Circuit demurred from incorporating the Paris Convention into existing federal trademark canon.

In the seven years following, the *ITC* and *Grupo* decisions effectively dichotomized the tensions underlying the U.S. approach to the well-known mark doctrine: courts could either seek to incorporate Article 6*bis* into trademark canon or stand by the Paris Convention's non-self-executing nature.<sup>43</sup>

### C. Contemporary Criticisms

Due in large part to the doctrine's bipolarity, items key to the well-known marks doctrine have often been left to judicial

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<sup>37</sup> *Id.* at 143.

<sup>38</sup> *Id.* at 144.

<sup>39</sup> *Id.* at 142.

<sup>40</sup> *Id.* at 163.

<sup>41</sup> *Id.* at 165.

<sup>42</sup> *ITC Ltd. v. Punchgini, Inc.*, 518 F.3d 159 (2d Cir. 2007).

<sup>43</sup> *See, e.g.*, *Paleteria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. De C.V.*, 69 F. Supp. 3d 175 (D.D.C. 2014); *Kerzner Int'l Ltd. v. Monarch Casino & Resort, Inc.*, 675 F. Supp. 2d 1029 (D. Nev. 2009); *Aktieselskabet AF 21. Nov. 2001 v. Fame Jeans, Inc.*, 511 F. Supp. 2d 1 (D.D.C. 2007 [hereinafter *Well-Known Mark Doctrine Cases*]).

discretion. Courts have ranged in their definitions of terms, from what may constitute a "well-known mark" to the factors necessary for a finding of trademark infringement, much to the doctrine's detriment.

### 1. Judicial Vagueness in Defining and Evaluating a "Well-Known" Mark

In the decades since the well-known marks doctrine reached the U.S., standards for key terms such as 'well-known' have remained unclear.<sup>44</sup> This confusion originated in part from a failure to uniformly confirm or condemn the TRIPS Agreement and the Paris Convention as treaties which have, or lack, the force of law in the U.S.<sup>45</sup> The Paris Convention provided few requirements, holding only that Article 6*bis* was expected

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.<sup>46</sup>

As a result, circuits vary not only in their definitions of the term, but in whether judges even reference the factors provided by way of WIPO's joint recommendations.<sup>47</sup>

Part of this confusion also appears etymological. Though the two doctrines apply to distinct forms of trademark harm, courts have not yet settled on how much, if at all, the 'well-known mark' overlaps with the 'famous mark' whose owner may sue for trademark dilution. *Grupo* imposes only two requirements, both of which suggest a use requirement typical for a trademark infringement claim.<sup>48</sup> Compare

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<sup>44</sup> See generally 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 29:4 (4th ed.).

<sup>45</sup> *Id.*

<sup>46</sup> Paris Convention, Art. 6*bis*.

<sup>47</sup> See, e.g., ITC Ltd. v. Punchgini, Inc., 518 F.3d 159 (2d Cir. 2007).

<sup>48</sup> Grupo Gigante SA De CV v. Dallo & Co., 391 F.3d 1088, 1090 (9th Cir.

these requirements with earlier cases, which were often brought under a cloud of unfair competition claims. In *Maison Prunier v. Prunier's Restaurant & Café*,<sup>49</sup> the court held that protections for the senior user's mark reached the territory where it had established a reputation, regardless of whether it had actually used or failed to use the mark in that territory. The court focused primarily on the American defendant's bad faith intent to take advantage of the senior user's reputation in France.<sup>50</sup> The mere assertion that the plaintiff had "a well-known reputation and good will built up as the result of decades of honest business effort" was sufficient to entitle it to consideration as a well-known mark owner.<sup>51</sup> Instead, the court's focus steered towards the broader precepts of unfair competition.<sup>52</sup> This contrasts, not only the non-exhaustive list of factors presented in *Grupo*, but also the many well-known mark factors that WIPO has put forward for consideration.<sup>53</sup>

Subsequent courts have prioritized public policy over established factors in evaluating the well-known marks doctrine, depending on whether the substance of the claims seems to emerge from unfair competition or trademark infringement law.<sup>54</sup> Problematically, courts do not always distinguish between well-known mark precedents drawn from unfair competition claims and those drawn from trademark infringement. Courts have thus varied in their willingness to prioritize specific factors in finding a well-known mark, let alone whether the doctrine has any bearing in their circuit, based on a jumble of considerations between bodies of law.<sup>55</sup>

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2004).

<sup>49</sup> *Maison Prunier v. Prunier's Restaurant & Café*, 288 N.Y.S. 529 (N.Y. Sup. Ct. 1936).

<sup>50</sup> *Id.* at 537.

<sup>51</sup> *Id.* at 531.

<sup>52</sup> *Id.* at 532.

<sup>53</sup> World Intellectual Property Organization, *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* (Sept. 1999), available at <http://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf/>.

<sup>54</sup> See *Well-Known Mark Doctrine Cases*, *supra* note 43; for general discussion of the interplay between the Paris Convention and unfair competition law, see Patricia V. Norton, *The Effect of Article 10bis of the Paris Convention on American Unfair Competition Law*, 68 FORDHAM L. REV. 225 (1999).

<sup>55</sup> See *Well-Known Mark Doctrine Cases*, *supra* note 43.

The uncertainty of the doctrine's definition has thus crippled its growth and applicability.

## 2. Lack of Use Requirement

In a striking departure from general trademark tenets, U.S. courts have failed to require any showing of use from the well-known mark doctrine.<sup>56</sup> Subsequent courts have typically looked to *Grupo* as the primary implementation of the well-known mark doctrine in the U.S.<sup>57</sup> *Grupo*, however, set out only two requirements: (1) that a preponderance of the evidence must show that a substantial percentage of relevant American consumers were aware of the mark, and (2) that these consumers must be in the disputed area.<sup>58</sup> Thus, *Grupo's* language elides the presumed notice critical to establishing the rights of unregistered marks.

Efforts to bridge the discrepancy between the well-known mark doctrine and standard U.S. trademark canon have varied. Some academics have read the doctrine to expand on trademark dilution and to evaluate the suit based on whether the defendant's use of the mark impacts the reputation of the plaintiff's goods or services.<sup>59</sup> Under the Dilution Act, the plaintiff need not prove a likelihood of confusion or that the defendant sought to compete with the plaintiff's goods or services.<sup>60</sup> Instead, the plaintiff must only demonstrate that the defendant's use of a mark weakened the connection between the plaintiff's mark and the plaintiff's goods or services in the relevant

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<sup>56</sup> 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 TRADEMARK REP. 1379 (2008).

<sup>57</sup> See *Well-Known Mark Doctrine supra* note 43.

<sup>58</sup> *Grupo Gigante SA De CV v. Dallo & Co.*, 391 F.3d 1088, 1095 (9th Cir. 2004).

<sup>59</sup> Xuan-Thao Nguyen, *The Other Famous Marks Doctrine*, 17 TRANSNAT'L L. & CONTEMP. PROBS. 757 (2008).

<sup>60</sup> See Restatement (Third) of Unfair Competition § 25 cmt. b. (1995) ("[T]he state of mind required for confusion and dilution are distinct and inconsistent. Confused consumers believe that the actor's use of the mark indicates a connection with the trademark owner, and thus for those consumers the actor's use does not dilute the distinctiveness of the mark.").

geographic market,<sup>61</sup> or that the defendant's use of the mark causes an unsavory or inferior reflection upon the plaintiff's products.<sup>62</sup> Such a reading, however, strays from the doctrine's intended effects under Article 6*bis*. A dilution suit in the U.S. requires that the mark at issue must be "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner."<sup>63</sup> Notably, recognition seems unlikely within the U.S. without either use or actual registration.<sup>64</sup>

### 3. New Zone-of-Interests Requirement

Over time, even standing has become an issue in applying the doctrine. In 2014, the Supreme Court adopted a 'zone-of-interests' test in determining who may bring a claim for false advertising.<sup>65</sup> Distilled, *Lexmark v. Static Control Components, Inc.* requires that courts evaluate whether a claimant falls within the zone-of-interests—better known as the class of plaintiffs authorized to sue under § 1125(a)—based on two considerations: (i) whether the plaintiff is seeking to protect interests that the statute was designed to redress, and (ii) whether a plaintiff can successfully plead, and subsequently prove, an injury to a commercial interest in sales or business reputation proximately caused by the defendant's misrepresentations.<sup>66</sup> The *Lexmark* court intended these as factors for determining 'statutory' standing rather than 'prudential' standing,<sup>67</sup> and the test was meant to be "not especially demanding."<sup>68</sup> *Lexmark* thus departed significantly from previous standing rules for false advertising claims, which had developed a

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<sup>61</sup> 15 U.S.C. § 1125(a)(1)(A).

<sup>62</sup> 15 U.S.C. § 1125(c)(2)(C).

<sup>63</sup> 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 TRADEMARK REP. 1379, 1396 (2008).

<sup>64</sup> *Id.*

<sup>65</sup> *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 134 S. Ct. 1377 (2014).

<sup>66</sup> *Id.* at 1391–2.

<sup>67</sup> *Id.* at 1386.

<sup>68</sup> *Id.* at 1389.

reputation for stringency.<sup>69</sup>

However, by expanding standing for trademark infringement suits to incorporate protection from unfair competition, specifically "injuries to business reputation and present and future sales," the *Lexmark* Court created a target all too easy for foreign marks to reach.<sup>70</sup> Under American trademark canon, almost any case where a defendant's foreign conduct confuses American consumers will likely have a substantial effect on U.S. commerce.<sup>71</sup> Indeed, courts have traditionally weighed American consumer confusion more significantly than other factors in findings of foreign trademark infringement.<sup>72</sup> Although relaxing the standard for false advertising claims expands the class of permissible plaintiffs, *Lexmark* acted too generously in granting standing to a doctrine which has yet to establish the boundaries of its key terms and requirements. Traditional statutory standing under the Lanham Act has been expected to further the Act's specific purpose: preventing consumer confusion and preserving producer goodwill.<sup>73</sup> While *Lexmark* benefited consumers by shifting the focus onto the harm suffered by plaintiffs, the decision offers no barrier to foreign trademark owners seeking to take advantage of the well-known trademark doctrine.

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<sup>69</sup> Deborah R. Gerhardt, *Lexmark and the Death of Initial Interest Confusion*, 7 LANDSLIDE 22, 25 (2014) ("Standing rules for false advertising claims had been viewed as notoriously stringent.").

<sup>70</sup> *Id.* (discussing the *Lexmark* court's recognition of the false advertising statute's purpose as protection from unfair competition and lack of basis for applying the test any differently to trademark infringement litigation).

<sup>71</sup> *See, e.g., United Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952); *see also Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1006 (2d Cir. 1997) (importing infringing products "clearly has substantial impact on United States commerce").

<sup>72</sup> *See, e.g., Rodgers v. Wright*, 544 F. Supp. 2d 302, 315 (S.D.N.Y. 2008) (holding that the Lanham Act applies to an American defendant's foreign infringement where that infringement resulted in a likelihood of a confusion to American consumers); *see also Piccoli A/S v. Calvin Klein Jeanswear Co.*, 19 F. Supp. 2d 157, 170 (S.D.N.Y. 1998) (emphasizing a substantial effect on U.S. commerce where a defendant's conduct results in consumer confusion).

<sup>73</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:1 (4th ed.).

*D. A comparison in doctrinal expectations*

The U.S.'s failure to sustain a coherent body of case law for the well-known mark is not unique;<sup>74</sup> nevertheless, it provides a striking contrast to the doctrine's development elsewhere. Through the European Court of Justice ("ECJ"), Paris Convention signatories in Europe have established both the grounds by which a claimant may raise the doctrine as well as the factors which define a 'well-known mark'.<sup>75</sup> While the well-known mark doctrine in Europe took root for different reasons than it did in the U.S.,<sup>76</sup> the two nevertheless yield instructive parallels. Citizens of Europe, for example, are more likely to travel from country to country than their American counterparts.<sup>77</sup> Packaging of a single product often varies significantly from country to country, even those which border one another.<sup>78</sup> As such, consumers accustomed to receiving products from a variety of countries must rely less on the packaging of a given product and more on the source-identifying function of a trademark. Filing for a trademark in every country of the European Union, however, is far more expensive than filing for a federal trademark to cover a similar expanse of territory in the U.S.<sup>79</sup> The well-known mark doctrine thus enables European companies to exclude others from using their marks for a given good or service where such companies can prove that the mark has a strong likelihood of

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<sup>74</sup> See Stephanie M. Greene, *Protecting Well-Known Marks in China: Challenges for Foreign Mark Holders*, 45 AM. BUS. L.J. 371 (2008).

<sup>75</sup> See *infra* Part I.D.1.

<sup>76</sup> See *infra* Part III.A.1.

<sup>77</sup> HostelWorld, *Introducing the Hostelworld Meet The World Report...* (last visited May 23, 2017), available at <http://www.hostelworld.com/blog/introducing-hostelworld-meet-world-report/>.

<sup>78</sup> Mary LaFrance, *A Material World: Using Trademark Law to Override Copyright's First Sale Rule for Imported Copies*, 21 MICH. TELECOMM. & TECH. L. REV. 43, 72–3 (2014) ("Goods manufactured or packaged specifically for foreign markets might have different ingredients, might be labeled or packaged differently, might be accompanied by different documentation (perhaps in a language other than English), might have been subjected to different levels of quality control during manufacturing, packaging, handling, or shipping, and might be covered by different warranties.").

<sup>79</sup> See 1 TRADEMARKS THROUGHOUT THE WORLD § 54:2.



confusing consumers in a specific geographic region, even without registration. Such a right recalls the common law use doctrine in the U.S. However, the E.U. showcases a tendency to mix unfair competition precedents into trademark-based claims, based on specific directives and tenets unfeasible under U.S. trademark canon.

#### 1. Defining Case Law in the E.U.

Cases such as *General Motors Corp v. Yplon SA* established the boundaries and factors to consider in evaluating a trademark's reputation, particularly the market share held by the earlier mark. In *General Motors Corp. v. Yplon SA*, both General Motors and Yplon had registered the word mark CHEVY at the Benelux Trademark Office: General Motors for motor vehicles in 1971 and Yplon for cleaning products. General Motors sought an injunction against Yplon's use of the mark under the Trademark Directive, which protected well-known trademarks from dilution.<sup>80</sup> In determining General Motors' rights, the European Court of Justice specifically addressed two questions: "1) How is the concept of a trademark with a reputation within the meaning of Article 5(2) of the Directive to be interpreted?; 2) Must the reputation of the trademark extend throughout the three Benelux countries or is it sufficient that its reputation is established in one of those countries or part thereof?"<sup>81</sup> The court subsequently compared the defining characteristics of a mark with a reputation to those of a well-known trademark, and ultimately held that "a mark with a reputation need not be as well-known as a well-known mark."<sup>82</sup> Instead, the ECJ held that a mark with a reputation must satisfy two conditions: "it must be known to a large part of the public concerned by the two products in question ... [and] the earlier mark must have a reputation such that the consumer, on seeing the contested mark, associates the latter with the earlier mark and makes a connection between the

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<sup>80</sup> Case C-375/97, *General Motors Corp. v. Yplon, S.A.*, [1999] E.C.R. I-5421, [1999] E.T.M.R. 122.

<sup>81</sup> *Id.* at ¶ 17.

<sup>82</sup> *Id.* at ¶ 37.

two."<sup>83</sup>

Significantly, the ECJ's ruling refers back to Article 5 of the Trademark Directive, which allows suit based on use of a trademark which "takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."<sup>84</sup> Later courts have only expanded upon this right, holding that member states may allow trademark owners to prevent third parties from using the sign for dissimilar goods, even though no likelihood of confusion exists.<sup>85</sup> As such, the Directive currently provides for three different levels of protection in member states: (1) protections afforded to trademark owners for marks related to goods or services which are identical to those for which the mark is registered; (2) protections for trademark users against marks which are identical or similar to registered marks and likely to cause confusion on the part of the public; and (3) protections for trademark users against marks identical or similar to well-known marks, registered or otherwise.

The E.U.'s blend of unfair competition and trademark law, however, has taken trademark law's ability to police unfair competition to an extreme. In *L'Oréal v. Bellure*,<sup>86</sup> L'Oréal took legal action for trademark infringement against Bellure after Bellure manufactured and marketed a line of 'smell-alike' perfumes modeled on the more famous L'Oréal products with explicit, continuous comparisons to the L'Oréal brand perfumes. Although Bellure never sought to pass off its products as those of L'Oréal, L'Oréal nevertheless filed suit with both trademark infringement and unfair competition claims, arguing that that Bellure had infringed their registered word-marks and that Bellure had used their marks to attain an unfair advantage in the market.<sup>87</sup> Upon referral to the ECJ, the court held that the Trademark Directive did not require likelihood of confusion or detriment to the trademark owner's

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<sup>83</sup> *Id.* at ¶ 38.

<sup>84</sup> Case C-408/01, *Adidas-Salomon AG v. Fitnessworld Training LTD*, 2003 E.C.R. 0000, 2003 WL 101343.

<sup>85</sup> *See, e.g.*, Case C-418/02, *Praktiker Bau v. Heimwerkermarkte AG*, 2005 E.C.R. I-05873; Case C-421/04, *Matratzen Concord AG v. Hukla Germany SA*, 2006 E.C.R. I-02303; *Mastercard International Incorporated v. Hitachi Credit (Uk) Plc ChD (Bailii, [2004] EWHC 1623 (Ch))*.

<sup>86</sup> Case C-487/07, *L'Oréal v. Bellure*, 2009 E.C.R. I-05185.

<sup>87</sup> *Id.* ¶ 12.

business. Rather, the 'unfair advantage' derives from the third-party user's "riding on the coat-tails" of the senior mark in order to benefit from the senior mark's reputation and existing goodwill "without paying any financial compensation."<sup>88</sup> Provided that use of the junior mark either affected, or was liable to affect, one of the other major functions of the senior mark, a court could find an unfair advantage and could subsequently bar use of the junior mark.

The decision troubled U.S. commentators in large part because the case turned on "vague and undefined notions of unfair competition and free riding."<sup>89</sup> Where U.S. law focuses on the harm suffered by the senior mark user,<sup>90</sup> the concept of "taking unfair advantage"<sup>91</sup> shifts the court's attention instead to the benefits received by the junior mark user. This hostility to free-riding, critics have argued, goes against the economic purpose of U.S. trademark law: its vagueness significantly impairs comparative advertising and chills the possibility of smaller competitors entering a market already dominated by a trademark user with an established reputation.<sup>92</sup>

Taken together, *General Motors* and its successors provide three vital distinctions between E.U. trademark law and U.S. canon. First, the Trademark Directive codifies references to unfair competition claims, which enables trademark owners to bring dilution suits based on misappropriation of goodwill.<sup>93</sup> Second, the Directive does not require likelihood of confusion requirement from suits brought on behalf of a well-known mark. In such cases, the question becomes whether the relevant section of the public has heard of the mark rather than whether the junior mark would confuse them. Third, the qualifications to become a well-known mark in the E.U.

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<sup>88</sup> *Id.* ¶ 49.

<sup>89</sup> See, e.g., J. Thomas McCarthy, *Dilution of a Trademark: European and United States Law*, 94 TRADEMARK REP. 1163, 1165 (2004).

<sup>90</sup> See 15 U.S.C. § 1125.

<sup>91</sup> *L'Oréal*, ¶¶ 41, 49.

<sup>92</sup> See generally Tim W. Dornis & Thomas Wein, *Trademarks, Comparative Advertising, and Product Imitations: An Untold Story of Law and Economics*, 121 PENN ST. L. REV. 421 (2016).

<sup>93</sup> See Marcus H. H. Luepke, *Taking Unfair Advantage or Diluting A Famous Mark - A 20/20 Perspective on the Blurred Differences Between U.S. and E.U. Dilution Law*, 98 TRADEMARK REP. 789 (2008).

are not nearly as stringent as those of the U.S. The Lanham Act mandates that only nationally famous marks can raise anti-dilution claims—specifically, those marks that are "widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner."<sup>94</sup> By contrast, marks seeking protection under the E.U.'s anti-dilution laws may still receive all the benefits of a famous mark, provided that it carries some reputation in a substantial portion of the relevant market sector. This, however, may have a significant chilling effect on its competition, at odds with the U.S. pro-competition spirit.

## II. BELMORA LLC v. BAYER CONSUMER CARE AG

In *Belmora LLC v. Bayer Consumer Care AG*, the Fourth Circuit held that a foreign company, which had neither used nor registered "FLANAX" in the U.S., could nevertheless demand cancellation of its competitor's "FLANAX" U.S. trademark registration. In *Belmora*, the plaintiff sold pain relievers under the "FLANAX" mark in Mexico and other parts of Latin America since the 1970s, but never in the U.S.<sup>95</sup> In 2004, the defendant, which owned the FLANAX trademark in the U.S., used it to sell its own pain relievers. The plaintiff subsequently filed suit against the defendant, contending that Belmora had deliberately "used the FLANAX mark to... deceive Mexican–American consumers into thinking they were purchasing [the plaintiff's] product,"<sup>96</sup> and alleged that the plaintiff had been injured by this "false association with its FLANAX product in violation of Lanham Act § 43(a)(1)(A)."<sup>97</sup>

On appeal, the Fourth Circuit held that foreign marks which had been neither registered nor used in U.S. commerce could nevertheless find protection under the Lanham Act. Because the plaintiff had abandoned its Article 6*bis* claims on appeal, the court fell back instead to the premise that § 43(a) of the Lanham Act had become a shelter for unfair competition as well as trademark

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<sup>94</sup> 15 U.S.C. § 1125(c)(2)(A) (2012).

<sup>95</sup> *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 701 (4th Cir. 2016).

<sup>96</sup> *Id.* at 701–2.

<sup>97</sup> *Id.*

infringement claims.<sup>98</sup> As a result, the court's reasoning necessarily deviated from precedent raised in either the Second or the Ninth Circuits. Specifically, the court emphasized that "this is an unfair competition case, not a trademark infringement case."<sup>99</sup> Holding that Congress had deliberately omitted any requirement that a plaintiff use its own mark in U.S. commerce in order to have standing to sue under § 43(a) of the Lanham Act,<sup>100</sup> the *Belmora* court determined that the plaintiff's case could be read as a series of unfair competition claims, and could accordingly be judged only on the merits of those claims. Most significant among the *Belmora* Court's rulings are its determinations that use in U.S. commerce had never been an express prerequisite to bringing a § 43(a) action,<sup>101</sup> and that the well-known mark doctrine entrenches the very core of American trademark law: preventing consumer confusion and preserving the goodwill of the manufacturer.<sup>102</sup>

#### A. *Territoriality in U.S. Trademark Law*

Under the territoriality principle, trademark registration represents the government's recognition of an individual's right to a specific brand within the country.<sup>103</sup> By definition, trademarks act as source-indicators and as tools to compile goodwill towards the owner's specific goods or services.<sup>104</sup> Thus, a trademark is useful only so long as the owner can exclude others from use of that mark for purposes of marketing particular goods or services.<sup>105</sup> Exclusivity serves both the mark-owner and the consuming public:

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<sup>98</sup> *Id.* at 710.

<sup>99</sup> *Id.* at 708.

<sup>100</sup> *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 708 (4th Cir. 2016).

<sup>101</sup> *Id.* at 706.

<sup>102</sup> *Id.* at 714.

<sup>103</sup> *See Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 599 (5th Cir. 1985) (citing *Ingenohl v. Walter E. Olsen & Co.*, 273 U.S. 541, 544 (1927) ("... the territoriality principle is one that is "basic to trademark law," in which trademark rights "exist in each country solely according to that country's statutory scheme.")).

<sup>104</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:1 (4th ed.).

<sup>105</sup> *See A. Bourjois & Co. v. Katzel*, 260 U.S. 689 (1923) (first case in the U.S. to reject the "universality" theory of trademarks in favor of territoriality).

by registering a trademark, the owner has incentive to perpetuate the mark's reputation by streamlining product quality. Further, the public knows to rely on the mark for products of established quality. Because a national government can only exercise control within its country borders, academics and courts alike have generally held that trademarks rely on territoriality as a matter of common sense.

Nevertheless, the territoriality principle serves a narrower purpose than the unfair competition principles which formed the trademark system. As a result, parts of trademark law seem to oppose one another where territoriality conflicts with the larger precepts of unfair competition law. Comparing the treatment of the common law trademark doctrine with that of the well-known mark doctrine makes this particularly clear. Both operate under the presumption that marks deserve certain rights based on the likelihood of consumer confusion. Territoriality, however, emphasizes the geographic scope of use as well as the likelihood of confusion; thus common law marks have established rights without registration, while the rights of registered foreign marks are conditional.

Other jurisdictions have avoided this question entirely by protecting unregistered marks exclusively under unfair competition law: the E.U., for example, holds that a passing-off plaintiff must show misrepresentation, damages, and loss of goodwill in order to succeed in a passing-off suit.<sup>106</sup> By extending protection to unregistered marks, the government imposes a double-qualification: trademarks may receive protection based not only on government acknowledgement, but on any use which may result in consumer confusion. Thus, while courts have claimed that "foreign use is ineffectual to create trademark rights in the United States,"<sup>107</sup> foreign use is not irreconcilable with ongoing U.S. trademark canon. Owners of foreign trademarks have largely used two legal theories. First, they may claim priority rights based on use of the mark in the U.S. in compliance with the territoriality principle.<sup>108</sup> Second, they

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<sup>106</sup> See *Erven Warnink B.V. v. J. Townsend & Sons (Hull) Ltd.*, [1979] A.C. 731 (H.L.).

<sup>107</sup> *La Societe Anonyme des Parfums le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1271 (2d Cir. 1974).

<sup>108</sup> See, e.g., *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135 (2d Cir. 2007).

may seek exemption from the territoriality principle and claim a similar priority right based on likelihood of confusion based on the broader principles of false advertising and unfair competition law.<sup>109</sup>

Arguments against exempting foreign use from the territoriality principle have traditionally been directed towards two items: first, a refusal to overextend the Lanham Act;<sup>110</sup> second, concerns regarding foreign retribution, which could weaken the trademarks of American companies abroad.<sup>111</sup> Where a U.S. national acts abroad, for instance, courts have had fewer qualms in extending the Lanham Act's reach.<sup>112</sup>

### *B. How the Territoriality Principle Weakens the Belmora Decision*

Faced with judicial vagueness on doctrinal definitions and requirements, *Belmora* inevitably drew controversy when it tried to circumvent the Paris Convention's lingering open question. The Fourth Circuit essentially rooted its acknowledgement of the well-known mark doctrine in the premise that § 43(a) has become understood as a shelter for unfair competition claims as well as trademark infringement claims.<sup>113</sup> As a result, the court dismissed previous holdings which treated use of the mark at issue within the U.S. as a prerequisite, determining that this had been imposed as an extraneous condition upon the statute.<sup>114</sup> This reading comports with unfair competition law. Unlike trademark infringement, unfair

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<sup>109</sup> See, e.g., *De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate, Inc.*, 440 F. Supp. 2d 249 (S.D.N.Y. 2006).

<sup>110</sup> See *supra* Part I.B.2.

<sup>111</sup> See Robert C. Bird & Elizabeth Brown, *The Protection of Well-Known Foreign Marks in the United States: Potential Global Responses to Domestic Ambivalence*, 38 N.C. J. INT'L L. & COM. REG. 1 (2012).

<sup>112</sup> See *United Steele v. Bulova Watch Co.*, 344 U.S. 280 (1952) (American company had a right to enjoin Mexican businesses from using its trademark in Mexico); see also *Int'l Café, S.A.L. v. Hard Rock Café Int'l (U.S.A.), Inc.*, 252 F.3d 1274 (11th Cir. 2001); *Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633 (2d Cir. 1956).

<sup>113</sup> *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 710 (4th Cir. 2016).

<sup>114</sup> *Id.* at 706 ("... the plain language of § 43(a) does not require that a plaintiff possess or have used a trademark in U.S. commerce as an element of the cause of action.").

competition claims typically need only show that the work at issue originated with the plaintiff, that the defendant falsely designated the work's origin, that the false designation was likely to cause consumer confusion, and that the plaintiff was harmed by the defendant's false designation.<sup>115</sup> In theory, unfair competition precepts thus demand an exception to the territoriality principle in U.S. trademark canon for foreign trademark owners.

However, *Belmora* misses the counterpoint between unfair competition and trademark infringement claims: namely, while the two have historically been intertwined, unfair competition has historically reflected broader priorities. Where its priorities aligned with those of trademark law, this caused no discrepancy. Territoriality's nation-specific focus, however, lies directly at odds with unfair competition's potentially global application, and subsequently with the well-known marks doctrine.

Wholly avoiding the territoriality principle in the *Belmora* tradition is impractical. Territoriality traditionally exists to protect domestic goodwill. Commentators have made arguments regarding the impact of reputational feedback, market allocation, and free-riding,<sup>116</sup> but these de-emphasize if not disregard consumer confusion as the heart of trademark infringement. As the Ninth Circuit noted in *Grupo*, an absolute territoriality rule without a well-known mark carve-out could well "promote consumer confusion and fraud" by enabling businesses within the company to ride on the coattails of successful foreign businesses.<sup>117</sup> Taking *Belmora* to its logical end thus suggests that any trademark applicant could register a mark in a foreign trademark office and subsequently prevent the registration of similar marks in the U.S. without ever resorting to the Trademark Office.

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<sup>115</sup> 28 U.S.C. § 1441(a).

<sup>116</sup> See Mark P. McKenna, *Testing Modern Trademark Law's Theory of Harm*, 95 IOWA L. REV. 63, 117 (2009) ("At a more conceptual level, this literature suggests that if producer interests are to continue to influence the scope of trademark protection, courts must confront squarely market preemption and free-riding arguments, since those arguments have much more empirical support than the reputational feedback arguments.").

<sup>117</sup> *Grupo Gigante SA De CV v. Dallo & Co.*, 391 F.3d 1088, 1094 (9th Cir. 2004).



### C. Pre-Belmora Use of Unfair Competition Precedents

Courts have long applied elements of both trademark and unfair competition law in establishing the well-known mark doctrine.<sup>118</sup> This unstable compromise is becoming increasingly untenable as the U.S. trademark regime interacts with the demands of an international market. Unfair competition law has only come to encompass additional claims over time; it is impractical, if not impossible, to interpret a doctrine which depends on a specific national regime according to the international precepts of its ancestral field of law. Where unfair competition law conflicts with a foundational trademark principle such as territoriality, trademark principles should triumph.

Reconciling the disparate parts of the well-known mark doctrine has become particularly urgent after *Belmora*. Past courts looked to the precedents put forward by the Second and Ninth Circuits, and made their selections based at least in part on whether they acknowledged Article 6bis as having been incorporated by way of § 44(b) of the Lanham Act, or whether they foresaw a need for congressional intervention.<sup>119</sup> By introducing a new alternative, the *Belmora* court showcased an increasing judicial consciousness of the global environment. But this consciousness must be reined in with a uniform application of the doctrine.

#### 1. The Complexities of Overlapping Unfair Competition Claims with Trademark Infringement Claims

The fields of unfair competition and trademark infringement have historically shared driving precepts, and so methods of application. Like trademark infringement, unfair competition law turned on the principle of passing off,<sup>120</sup> which "afford[ed] relief wherever, by reason of an unjustifiable act, the goods of one party to the suit [would] probably be accepted by the purchasing public as

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<sup>118</sup> See *supra* Part I.C.

<sup>119</sup> See *Well-Known Mark Doctrine*, *supra* note 43

<sup>120</sup> 1 L. ALTMAN, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES (4th ed.) § 2.2.

the goods of another."<sup>121</sup> As trade took on an international perspective, courts came to cite unfair competition as "the umbrella for all statutory and non-statutory causes of action arising out of business conduct that is contrary to honest practice in industrial and commercial matters."<sup>122</sup> Such an umbrella includes cases such as "misappropriation of the right of publicity and other business values, false advertising and other false representations, and misappropriation of trade secrets."<sup>123</sup> Since inception, these suits have historically sought to prevent the wrongful diversion of a plaintiff's business.<sup>124</sup>

Thus, unfair competition law does more than yield a background to trademark infringement law. The field continues to absorb many of trademark infringement's tenets.<sup>125</sup> Both trademark and unfair competition law exist to protect the reputation and goodwill of a mark as much as it does consumers from deception and confusion over the source of goods and services.<sup>126</sup> Both trademark

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<sup>121</sup> *Wm. A. Rogers, Limited, v. Majestic Products Corporation*, 23 F.2d 219, 220 (D. Del. 1927); *but see also* 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (2d ed.) § 25:1 ("... "palming off" and "passing off" are synonymous, and are used in judicial opinions to mean three different things: (1) substitution of one brand of goods when another brand is ordered; (2) . . . the infringer intentionally meant to defraud and confuse buyers; and (3) . . . there is no proof of fraudulent intent, but there is a likelihood of confusion of buyers.")

<sup>122</sup> *See, e.g., American Heritage Life Ins. Co. v. Heritage Life Ins. Co.*, 494 F.2d 3, 14, (5th Cir. 1974).

<sup>123</sup> CALLMANN, *supra* note 120.

<sup>124</sup> *See Delaware & Hudson Canal Co. v. Clark*, 80 U.S. 311, 322 (1871) ("... in all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and that it is only when this false representation is directly or indirectly made that the party who appeals to the court of equity can have relief.").

<sup>125</sup> RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 4 (1995) ("The "passing off" held actionable at common law was frequently accomplished through the use of confusingly similar trade symbols, and during the 19th century this general principle of liability served as the genesis of the technical rules governing the validity and infringement of trademarks and the recognition of secondary meaning.").

<sup>126</sup> *See* 1 WILLIAM C. HOLMES, INTELLECTUAL PROPERTY AND ANTITRUST LAW § 3:12.

infringement and unfair competition claims thus often depend on proving likelihood of confusion between marks.<sup>127</sup> Even the current judicial approach to false advertising cases bears striking similarities to the one taken to cases of trademark infringement.<sup>128</sup> As commentators have noted, "[t]he principles involved in trademark cases and tradename cases are substantially identical."<sup>129</sup>

Currently the main distinctions between unfair competition and trademark infringement lie in the standard of proof.<sup>130</sup> Presuming that courts continue to cross trademark precedents with unfair competition precedents, however, the Supreme Court's decision in *Lexmark* will lower the threshold requirements for proof of standing substantially in both fields.

#### *D. Consequences and Questions Left Open in Belmora*

Even beyond matters of territoriality and broadened unfair competition precedent, several unresolved questions stand in the way of owners seeking to claim trademark protection for foreign marks unused in the U.S. Taken on its face, *Belmora* tries to deliver the results of Article 6bis without encroaching on congressional territory; however, the decision overextends unfair competition law and so undercuts any precedential use.

*Belmora's* reliance on unfair competition precedents to decide a trademark matter pled under the Lanham Act treads on thin ice. Nine circuits have addressed whether § 44 of the Lanham Act creates a

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<sup>127</sup> See generally *Int'l News Serv. v. Associated Press*, 248 U.S. 215, 39 S. Ct. 68, 63 L. Ed. 211 (1918).

<sup>128</sup> See Rebecca Tushnet, *Running the Gamut from A to B: Federal Trademark and False Advertising Law*, 159 U. PA. L. REV. 1305, 1312 (2011) ("The advertising plaintiff need not show that the defendant promulgated the false ad deliberately. Similarly, like the trademark plaintiff, the advertising plaintiff need not show any actual harm flowing from the advertisement, unless seeking money damages. To obtain an injunction, the plaintiff must demonstrate only that the defendant's ad is false and that the plaintiff is "likely" to be injured by the defendant's conduct.").

<sup>129</sup> Mark P. McKenna, *Testing Modern Trademark Law's Theory of Harm*, 95 IOWA L. REV. 63, 72 (2009).

<sup>130</sup> See generally David L. Belt, *The Standard for Determining "Unfair Acts or Practices" Under State Unfair Trade Practices Acts*, 80 CONN. B.J. 247 (2006); see also CORPORATE COUNSEL'S GUIDE TO TRADEMARK LAW § 17:11.

new federal right against unfair competition for foreign competitors. Of these, only the Ninth Circuit has held that the section grants broad national protection.<sup>131</sup> The remaining courts have, for the most part, elected to follow the Second Circuit's holding that §§ 44(b), (h), and (i) only extend to citizens and residents the same benefits that any convention or treaty recognizes for aliens.<sup>132</sup> To date, the Paris Convention remains the only treaty signed by the U.S. which has addressed the matter. Unfair competition law, in essence, provides no answers that trademark law does not: both must go through the Paris Convention or not at all.

Critics have also flagged concerns on the matter of standing under the well-known mark doctrine going forward.<sup>133</sup> *Belmora* aside, only one case has reached a circuit court after *Lexmark*. In *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*,<sup>134</sup> the Federal Circuit held that Cuban cigar company Cubatabaco had a right to seek the cancellation of a trademark registered in the U.S. even though Cubatabaco remained barred from selling products within the country. Looking to statutes which authorized transactions for registering and renewing trademarks,<sup>135</sup> the court determined that Cubatabaco had a "real interest in cancelling the Registrations and a reasonable belief that the Registrations blocking its application [were] causing it damage."<sup>136</sup> The decision's restraint struck a sharp contrast to *Belmora*, which relied on a lack of explicit statutory restrictions in order to expand *Lexmark*'s application to cancellation and other Lanham Act remedies.<sup>137</sup> Even presuming that courts can safely generalize unfair competition tenets into trademark cases, such decisions must be narrowly read in light of the narrow

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<sup>131</sup> See *Stauffer v. Exley*, 184 F.2d 962 (9th Cir. 1950).

<sup>132</sup> See 1 L. ALTMAN, *CALLMANN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES* § 2:6 (4th ed.).

<sup>133</sup> See generally Charles Lee Thomason, *After Lexmark Rejects Multifactor Measures for Standing, Which Challengers Stand in the Zone of Interests for Lanham Act Remedies?*, 25 *FED. CIR. BAR. J.* 699 (2016).

<sup>134</sup> *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270 (Fed. Cir. 2014).

<sup>135</sup> 31 C.F.R. § 515.527.

<sup>136</sup> *Id.* at 1274.

<sup>137</sup> See *supra* Part II.

conditions under which those protections originated.<sup>138</sup> Commentators have noted the dangers of taking the well-known mark doctrine too far.<sup>139</sup> By expanding standing to the wide range of remedies available under unfair competition law and the Lanham Act, and lowering the necessary burden of proof, *Belmora* and *Lexmark* in combination threaten to impact trademark registration in the U.S. and chill healthy competition significantly.

### III. RECOMMENDATIONS FOR HOW TO APPLY THE WELL-KNOWN DOCTRINE IN A POST-BELMORA WORLD

As trade globalizes, so must trade-related lawsuits. Decades of commentary have criticized the overlap between unfair competition and trademark law,<sup>140</sup> the conflicts of the well-known mark doctrine with essential U.S. trademark principles,<sup>141</sup> and the complexities of broadened standing for trademark cases.<sup>142</sup> By introducing a new loophole into the U.S.'s recognition of the Paris Convention, *Belmora LLC v. Bayer Consumer Care AG* brings all of these concerns to a crisis. In a post-*Belmora* world, courts can no longer ignore the tensions between the U.S.'s expanding application of unfair competition precedent and existing trademark canon.

Two answers to this dilemma exist: first, whether a majority of circuits eventually elect to follow or to reject *Belmora*'s treatment of foreign trademark owners, courts must rein in the capacity to file

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<sup>138</sup> See 1 L. ALTMAN, CALLMANN ON UNFAIR COMPETITION, TRADEMARKS & MONOPOLIES § 2:6 (4th Ed.) ("...if a liberal interpretation of § 44 were adopted, Section 1338(b) of the Judicial Code would then appear superfluous, except . . . in cases of pending claims arising from transactions not affecting interstate commerce.").

<sup>139</sup> See Lee Ann Lockridge, *Honoring International Obligations in U.S. Trademark Law: How the Lanham Act Protects Well-Known Foreign Marks (and Why the Second Circuit Was Wrong)*, 84 ST. JOHN'S L. REV. 1347 (2010).

<sup>140</sup> Jamey Minnihan, *Having Your Cake and Eating It Too: U.S. Treatment of Well-Known Foreign Trademarks and Its Global Market Implications*, 50 GONZ. L. REV. 219 (2015).

<sup>141</sup> Katherine-Anne Pantazis Schroeder, *A Trademark Gamble: Should Use of Services Abroad by U.S. Citizens Meet the Lanham Act "Use in Commerce" Requirement?*, 90 IOWA L. REV. 1615 (2005).

<sup>142</sup> Kristin Zobel, *The Famous Marks Doctrine: Can and Should Well-Known Foreign Marks Receive Trademark Protection Within the United States?*, 19 DEPAUL J. ART, TECH. & INTELL. PROP. L. 145 (2008).

claims and cancellation proceedings against U.S.-registered trademarks based on the priority dates of foreign registrations. Because the U.S. lacks the binding directives of the E.U. to restrict the remedies available to unfair competition and trademark claimants, U.S. courts may look to the Trademark Directive and the ECJ's decisions for extreme s to avoid in mixing trademark and unfair competition precedents. Second, legislators should reference the extensive writings on the well-known mark doctrine in explicitly delineating the intersection between the Paris Convention and the Lanham Act. In light of *Lexmark*, however, any such legislation should address and prioritize matters of standing for trademark suits. Only by distinguishing trademark claims can U.S. trademark owners maintain confidence in their properties.

#### A. *Balancing the Well-Known Mark Doctrine in Court*

What problems the judiciary giveth, the judiciary may take away. Because *Belmora's* issues arose largely as a matter of statutory interpretation and judicial implementation, the case has potential for a quicker solution than awaiting statutory amendments from Congress. Courts which choose to ignore *Belmora's* grant of partial rights to foreign trademark owners will likely follow the Second Circuit's wholesale rejection of Article 6*bis*, which provides the same effects as *Belmora* and shares its lack of explicit judicial grounding. While ignoring the systemic faults brought to the fore in *Belmora* hardly solves them, avoidance would minimize the decision's key issue: undermining the territoriality principle by entrenching precedent where foreign trademarks could supplant U.S. trademark registrations without some showing of harm within the country.

In the same vein, courts which accept *Belmora* must narrow its scope. Commentators have offered myriad potential implementations for balancing the well-known mark doctrine against trademark territoriality in the U.S.<sup>143</sup> In a post-*Belmora*

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<sup>143</sup> See generally James E. Darnton, *The Coming of Age of the Global Trademark: The Effect of Trips on the Well-Known Marks Exception to the Principle of Territoriality*, 20 MICH. ST. INT'L. L. REV. 11 (2011); Geri L. Haight & Philip Catanzano, *The Effects of Global Priority of Trademark Rights*, 91 MASS. L. REV. 18 (2007); Maxim Grinberg, *The WIPO Joint*

world, courts seeking to address these matters should pay particular attention to clarifying the boundaries of what may constitute a 'well-known mark' and by pleading that its mark enjoys some reputation in a substantial portion of the relevant market sector, which is likely to be damaged by the registered mark's uninterrupted use. This would conform with both common law trademark enforcement and trademark dilution suits under the Lanham Act, which grants standing to any person who believes that he or she is or is likely to be damaged by such act. To this end, courts could look to the 'Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks',<sup>144</sup> as the E.U. has done, in entrenching a uniform definition of the 'well-known mark' distinct from trademark dilution's 'famous mark' in the U.S. Regardless, courts should distinguish trademark infringement claims from unfair competition by restricting unfair competition claims to § 43 of the Lanham Act and requiring showings of actual territorial harm under trademark infringement. By restricting remedies to their separate fields, courts would avoid chilling corporate competition.

#### 1. Learning from how Other Jurisdictions have Applied Article 6bis

The E.U. has avoided quagmires like *Belmora* by establishing both resources for defining a 'well-known mark'<sup>145</sup> and maintaining rigorous standards for proving trademark infringement of a foreign mark.<sup>146</sup> Unregistered marks generally receive only the damages and injunctions necessary to make the plaintiff whole again.<sup>147</sup> Under

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*Recommendation Protecting Well-Known Marks and the Forgotten Goodwill*, 5 CHI.-KENT J. INTELL. PROP. 1 (2005).

<sup>144</sup> World Intellectual Property Organization, *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* (Sept. 1999), available at <http://www.wipo.int/edocs/pubdocs/en/marks/833/pub833.pdf>.

<sup>145</sup> While no general legislative definition exists for the 'well-known trademark', trademark offices in signatory countries generally look to the WIPO recommendation, which has stabilized trademark protection across countries. See also E.U. Directive 2015/2436/EC, Art. 5(2)(d).

<sup>146</sup> E.U. Community Trademark Regulation (207/2009), Art. 8(2)(c).

<sup>147</sup> Jane C. Ginsburg, *Euro-Yearnings? Moving Toward A "Substantive" Registration-Based Trademark Regime*, 130 HARV. L. REV. F. 95, 103 (2017).

the E.U.'s trademark regime, an inherently distinctive mark need not show use prior to registration; if a mark lacks that inherent distinction, the applicant must show that the mark has acquired distinctiveness through actual use for five years prior to registration.<sup>148</sup> In effect, the E.U. substitutes the remedies available for intent-to-use applications in the U.S. with a combination of tort law and broad protections restricted to strong and successful marks. Its success derives from its presumption that any qualifying mark deserves broad protection.

By contrast, U.S. trademark law qualifies protection based on mark use as well as registration. The Trademark Office grants bases for registration with a show of intent-to-use,<sup>149</sup> and courts have recognized that common law trademark users deserve partial rights like those obtainable by registration.<sup>150</sup> Commentators have criticized the disparity between types of enforceable rights, noting that it "undermines the utility of registration even as it honors the role of consumer perception in giving rise to trademark rights."<sup>151</sup> This disparity has another consequence: the U.S. notably lacks the ECJ's confinement to tort remedies, and standing in trademark cases does not depend on a showing that the mark has reached a 'substantial portion of the relevant market sector'. Commentators have noted the U.S.'s increasing trend towards ECJ precedents in its battle against trademark dilution.<sup>152</sup> Intended or not, attempts to

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<sup>148</sup> European Union Intellectual Prop. Office, Guidelines for Examination of European Union Trademarks, Part B § 4, § 2.6.5 (2016) (Applicant must prove "a link between the sign and the goods and services for which the sign is applied for, establishing that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark.").

<sup>149</sup> The United States Patent and Trademark Office, *Intent-to-Use (ITU) Applications* (last visited on May 23, 2017), available at <https://www.uspto.gov/trademarks-application-process/filing-online/intent-use-itu-applications/>.

<sup>150</sup> See *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918); *New England Duplicating Co. v. Mendes*, 190 F.2d 415 (1st Cir. 1951); *Electro Source, LLC v. Brandess-Kalt-Aetna Grp., Inc.*, 458 F.3d 931 (9th Cir. 2006).

<sup>151</sup> Jane C. Ginsburg, *Euro-Yearnings? Moving Toward a "Substantive" Registration-Based Trademark Regime*, 130 HARV. L. REV. F. 95, 98 (2017).

<sup>152</sup> See Marcus Luepke, *Taking Unfair Advantage or Diluting A Famous Mark - A 20/20 Perspective on the Blurred Differences Between U.S. and E.U.*



follow the E.U.'s mix of unfair competition and trademark law in implementing the well-known mark doctrine could extend trademark cancellation rights to marks whose owners have no valid interests within the U.S.

*B. Reforming the Lanham Act: Issues and Strategies*

For decades, academics have suggested a number of strategies for adapting the U.S.'s existing trademark law to the well-known mark doctrine. In large part, these suggestions remain current: Congress could amend § 43(a) of the Lanham Act,<sup>153</sup> tie trademark rights into three separate categories of territoriality,<sup>154</sup> or structure the doctrine as a safety valve—as opposed to primary protection—for foreign trademarks well-known in foreign jurisdictions which lack registration and use in the U.S.<sup>155</sup> Few commentators, however, address the dangers posed by the growing blur between unfair competition and trademark precedent, and the threat posed by allowing owners outside the U.S. market to petition for trademark cancellations based on unfair competition claims.

In light of the U.S.'s increasing globalization, any reform should bear in mind two considerations. First, a foreign mark owner claiming trademark infringement under the well-known mark doctrine should be required to plead that a substantial percentage of the relevant market sector is familiar with their mark, and must provide proof during trial in order to prevail. Second, where the U.S. recognizes and protects well-known trademarks based on reputation alone, Congress should confine those protections only to the relevant market sector and to the geographic areas in which the mark was provably used. This is in keeping with both common law trademark principles and with previous academic suggestions to

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*Dilution Law*, 98 TRADEMARK REP. 789 (2008) and Daniel R. Bereskin, *Anti-Dilution/anti-Free-Riding Laws in the United States, Canada, and the E.U.: Bridges Too Far?*, 101 TRADEMARK REP. 1710 (2011).

<sup>153</sup> 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 TRADEMARK REP. 1379, 1423 (2008).

<sup>154</sup> Graeme B. Dinwoodie, *Trademarks and Territory: Detaching Trademark Law from the Nation-State*, 41 HOUS. L. REV. 885 (2004).

<sup>155</sup> Leah Chan Grinvald, *A Tale of Two Theories of Well-Known Marks*, 13 VAND. J. ENT. & TECH. L. 1 (2010).

maintain the doctrine as a safety valve. Unlike the E.U., the U.S. does not have an onerous trademark registration regime; registration is a small cost to pay for half a continent's worth of protection. Most significantly, stringent limits would protect the territoriality principle which defines trademark law.

#### CONCLUSION

*Belmora LLC v. Bayer Consumer Care AG* created a significant loophole for foreign trademark owners to bypass the U.S.'s existing trademark system and its current registrants. Both the decision, and its underlying reliance on overextended precedents, undermined the territoriality principle at the heart of U.S. trademark law. Future courts have every reason to restrain the decision's consequences by confining unfair competition to § 43 of the Lanham Act. Until Congress issues some definitive statement on the Paris Convention's effect, courts and agencies alike should defer to territoriality. In particular, owners of well-known trademarks seeking to enforce a registered trademark owner's traditional rights based on reputation alone must show both damages and a higher standard of proof with regard to market share and mark recognition.

International business is increasing, and with it the need for stronger trademark protections. As the Trademark Office moves towards a registration regime less protective of marks not in use,<sup>156</sup> *Belmora* serves as a useful bellwether by which to avoid larger conflicts with the fundamentals of U.S. trademark canon.

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<sup>156</sup> See, e.g., 82 F.R. 22517.

## PRACTICE POINTERS

- Until the courts reach a consensus, foreign trademark owners with significant business interests in the U.S. should not rely on the well-known mark doctrine, but should instead file for a U.S. trademark.
- Trademark owners seeking to enforce a registration based outside the U.S. should distinguish between the well-known mark and the famous mark doctrines in pleadings.
- Attorneys should minimize the integration of unfair competition case law into trademark infringement suits, and vice versa, except where strictly relevant to the case at hand.