THE CAMBRIDGE HANDBOOK OF INTERNATIONAL AND COMPARATIVE TRADEMARK LAW

Trade in goods and service has historically resisted territorial confinement, but trademark protection remains territorial, albeit within an increasingly important framework of multilateral treaties. Trademark law therefore demands that practitioners, policy makers, and academics understand principles of international and comparative law. This handbook assists in that endeavor, with chapters describing and critically analyzing international and regional frameworks, and providing comparative perspectives on the substantive issues in trademark law and related fields, such as geographic indications, advertising law, and domain names. Chapters contrast common law and civil law approaches while focusing on the US and EU trademark systems in light of the role these systems have played in the development of trademark laws. Additionally, this handbook covers other jurisdictions, both common law and civil law, on the Asia-Pacific, African, and South American continents. This work should be read by anyone seeking a better understanding of trademark law around the world.

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The Cambridge Handbook of International and Comparative Trademark Law

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Foreword

Trade mark law is a paradoxical subject. When it is first encountered, one is likely to think that it seems reasonably straightforward. Most people have some notion of what a trade mark is, and the idea that the proprietor of a trade mark should be able to stop the use of signs which are likely to cause confusion has an intuitive appeal. Equally, it is not difficult to see why, for example, registration of signs as trade marks should only be permitted if they are either inherently distinctive for the relevant goods and/or services or have acquired distinctiveness through use. The more one learns about trade mark law, however, the more one comes to understand how difficult it really is. This is partly due to the ever-increasing sophistication of branding practices, the effects of changes in technology and business models and the broader rights which modern legislation tends to confer upon trade mark proprietors. More fundamentally, however, it is because even the most basic concepts turn out to be remarkably slippery. What is (and is not) a trade mark? What amounts to acquired distinctiveness, and is it sufficient that consumers recognise the sign and associate with the applicant’s products? What do we mean when we speak of confusion, and does it include such things as initial-interest confusion, post-sale confusion and downstream confusion? Furthermore, experience has taught us that trade marks raise issues concerning such matters as economics (for example, when it comes to exhaustion of rights) and freedom of expression (for example, in regulating what marks may be registered). Trade marks also pose challenges when it comes to questions such as choice of law and accessory liability. For these and other reasons, trade mark law needs to be viewed holistically. For example, in considering the requirement in European law that the use of an identical sign in relation to identical goods or services must affect, or be liable to affect, one of the functions of the trade mark if the use is to infringe that trade mark, it is necessary to consider (among other things) the circumstances in which use of the sign in relation to the proprietor’s own goods may infringe, the defence of honest concurrent use, the territorial scope of injunctions, the law with respect to keyword advertising and who bears the burden of proof on this issue.¹

In this volume Irene Calboli and Jane Ginsburg have assembled a distinguished team of scholars whose contributions explore contemporary trade mark law by first placing it in its public international context and then applying the comparative law method. In the first part, we find eight chapters considering the international dimension. In the second part, we find fifteen pairs of chapters, each of which considers an aspect of trade mark law from both a common law and a

¹ Richard Arnold, Infringement under Article 10(2)(a) Trade Marks Directive (Recast)/Article 9(2)(a) European Union Trade Mark Regulation and Effect on the Functions of the Trade Mark. GRUR Int. 884 (2016).
civil law perspective. These perspectives are revealing because common law systems place more emphasis on the rights acquired by the use of a trade mark, while civil law systems place more emphasis on the rights acquired by registration. Moreover, the global spread of the contributors provides insights from a diversity of laws which resemble each other, but differ in subtle yet significant ways. Between them, these chapters consider almost every aspect of trade mark law, including its important boundaries with areas such as advertising law, the right of publicity, unfair competition law and designs. The authors all have something fresh to say about the topics they address, as well as recapping the known law. The volume thus represents a valuable contribution to the scholarly literature, and is more than the sum of its very considerable parts.

Richard Arnold
Royal Courts of Justice, London
Preface

INTERNATIONAL AND COMPARATIVE TRADEMARK LAW:
A COMPREHENSIVE APPROACH

Trade in trademark-bearing goods and services resists territorial confinement; sales of goods and performance of services have long traversed borders, and internet commerce has vastly augmented trademarks’ yearning for ubiquity. Today, trademarks amount to one of the most economically valuable intangible assets for multinationals and corporate portfolios. The recent rise of Louis Vuitton Moët Hennessy’s chairman Bernard Arnault to the second position in the rank of the world’s richest persons exemplifies the power of trademarks as best-sellers of products. Yet trademark protection remains territorial; national laws define its subject matter and scope, albeit within an increasingly important framework of multilateral treaties. A few examples (though we could cite many more) illustrate the interplay of multinational commerce and national norms. Nestlé, the Swiss producer of the four-fingers-shaped Kit Kat chocolate bar, has in recent years undertaken multiple legal proceedings to register its trade dress as a shape mark, with different results, in the United Kingdom (with respect to a national trademark), the European Union (with respect to an EU-wide trademark), Singapore, and South Africa. The trademark infringement actions by Christian Louboutin, the French designer of the famed red-sole shoes, encountered a similar fate. In some countries, national offices and courts have found the red sole to be protectable as a mark, while others rejected the claim or canceled Louboutin’s registration. The American chain McDonald’s has also been the protagonist of multiple legal proceedings across the world to protect its marks against similar names, or names using its famous “Mc” prefix or variations such as “Mac,” for products related and unrelated to hamburgers and fast food. Here again, the outcomes of these proceedings have alternated in favor of and against McDonald’s. And of course, worldwide litigation involving many of the trademarks that have so enriched Mr. Arnault has resulted in very variable outcomes, including regarding the use of the Louis Vuitton marks in parodies and artistic works.

Trademark law today therefore demands that its practitioners, exponents, and policy makers master (or at least remain alert to) principles of international and comparative law. This book aims to assist that endeavor. Its chapters describe and critically analyze the international and regional frameworks, and then provide comparative law perspectives on the principal substantive issues in trademark law and related fields, such as geographic indications, advertising law, domain names, and licensing. It is the first of its kind to address these topics systematically and comparatively in one comprehensive collection. The book contrasts common law and civil
law approaches, and focuses on the US and EU trademark systems. The book accords these systems particular prominence in light of the role they have had, historically, in the development of trademark laws internationally and, in turn, the impact that the principles, rules, and doctrines originating from these two systems have had on the national laws of a large number of jurisdictions worldwide. But it also takes into account other jurisdictions, both common law and civil law, on the Asia-Pacific, African, and South American continents.

**METHODOLOGY AND STRUCTURE OF THE BOOK**

The book is structured in two main parts. Part One focuses on the trademark law developments at the international level, while Part Two comparatively analyzes the theoretical and practical evolution of trademark law in national and regional systems in the United States and the European Union and across common law and civil law jurisdictions. In addition to their individual content, the two parts and the chapters within each part remain closely interlinked; the critical reflections that bear on one topic often illuminate the analysis of other subjects.

In particular, Part One addresses the trademark provisions in the international agreements under both the framework of the World Intellectual Property Organization (WIPO) and of the World Trade Organization (WTO). This part includes chapters focusing, specifically, on: the Paris Convention for the Protection of Industrial Property; the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS); the international registration system administered by WIPO through the Madrid Agreement and Protocol, and the more recent Trademark Law Treaty and Singapore Agreement on trademarks. It also includes a chapter addressing the protection of well-known marks under international trademark law, with particular focus on the WIPO Guidelines in this area. Part One also addresses the developments in international trademark law outside the fora of WIPO and the WTO; it includes a chapter focusing on the analysis of the trademark provisions in the post-TRIPS bilateral and plurilateral trade agreements. Similarly, Part One features a chapter comparing the systems of trademark harmonization in several regional organizations: the European Union, the Organisation Africaine de la Propriété Intellectuelle (OAPI), the African Regional Intellectual Property Organization (ARIPO), the Association of South East Asian Nations (ASEAN), and the Mercado Común del Sur (MERCOSUR). Part One concludes with two chapters focusing, respectively, on conflicts of law related to adjudications of transnational trademark disputes and on the application of alternative dispute resolution mechanisms to trademark disputes across jurisdictions.

Building upon the analysis in Part One, Part Two of the book addresses legislation and judicial doctrines in trademark law from a comparative perspective. This part primarily, but not exclusively, features the EU and US approaches in this area. It highlights the still-existing differences, but also the convergences, between common law and civil law countries. This part is subdivided into fifteen specific areas of inquiry; each topic pairs authors (or joint authors) offering an EU or US perspective, or a common law or civil law perspective. The topics are: the nature and function of trademarks; the types of signs that can be protected as trademarks; the public policy limitations of protectable trademark subject matter; the relationship between trademarks and geographical indications of origin; the concept and treatment of certification and collective marks; the relationship between trademark law and advertising law; the relationship between trademark law and the right of publicity; the relationship between trademarks and domain names and relevant dispute resolution systems; overlapping rights between trademark protection and other intellectual property rights; theories underlying the standards for trademark infringement; trademark protection beyond confusion-based theories, notably
trademark dilution; the doctrines related to secondary trademark liability; trademark defenses; the principle of exhaustion of trademark rights; and trademark transactions.

Together, Parts One and Two of the book provide a comprehensive survey of the existing trademark rules and general doctrines that have evolved over the course of the past century at the international level and how these rules (that originated from a variety of national systems subsequently molded into international agreements through international diplomacy) have later been implemented at the national level. These multilateral efforts have produced a largely harmonized trademark system worldwide. Still, the book highlights that, despite this process of harmonization and convergence of national and regional laws, some differences in national trademark laws persist. Moreover, the national application of harmonized principles has led, at times, to different results in adjudication of similar cases across different countries, and the book provides a useful resource also in this respect.

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As with all collective works, this book is the result of the joint efforts of many people. We have been fortunate to count on a stellar list of colleagues who have collaborated with us from many regions in the world and have contributed the various chapters in the book. We want to express our gratitude to these distinguished scholars and practitioners. We have no doubt that the readers will enjoy the wealth of information and appreciate the depth of analysis presented in every chapter of the book. This collection also offers an important example of international collaboration of authors from across different jurisdictions and legal traditions. The result is a book that reflects both differences and similarities in national and regional laws, as well as in the views of the contributors.

Our research assistants have been working closely with us throughout the editing process, before the manuscript was delivered to the publisher. We are very grateful to Lee Chedister, Victoria Gonzalez, Megan Pharis, and Elizabeth Ramey for their excellent work, dedication, and patience for many months, and for their reviews of the many drafts of the chapters of the book. We also would like to thank Cambridge University Press, in particular Matt Gallaway for his support during the development of this project from the book proposal to final publication, and Cameron Daddis for editorial assistance. We are grateful as well to our universities, Columbia Law School and Texas A&M University School of Law, for providing us with research support in order to complete the book.

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