



THE LEGAL STATUS OF WELL-KNOWN TRADEMARKS IN ACCORDANCE WITH LEGISLATION OF UZBEKISTAN AND INTERNATIONAL CONVENTIONS AND AGREEMENTS

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ANNOTATION

The article analyses the legal status of known brands on the basis of the legislation of the Republic of Uzbekistan. At the same time, it examines the provisions of international conventions and treaties relating to the international regulation of well-known trademarks. The result of research will provide some proposals to improve the legal status of well-known trademarks.

KEY WORDS: *well-known trademarks, trademarks, famous trademark, brand, Paris Convention, Madrid Agreement, Trips Agreement.*

DISCUSSION

In recent years, the term «brand» has become so firmly embedded in the circle of consumers that this in turn has led to the elimination of the concept of trademark on the market. However, this does not effect on the legal and formal concept of a trademark in the legislation.

The brand is a level of qualitative development of the trademark, the specific feature brand is fame, separate determination of its legal status and legal protection. Brand is an American form of the English word “brand-name”

According to the legislation of the Republic of Uzbekistan, well-known trademarks are not classified differently. Its legal status is recognized as universal, reflecting unique conditions and requirements. Article 321 of the Law of the Republic of Uzbekistan «On Trademarks» of August 30, 2001. The trademark is generally recognized on the following grounds:

Firstly, a trademark protected on the basis of registration in the territory of the Republic of Uzbekistan;

secondly, a trademark protected in accordance with an international agreement of the Republic of Uzbekistan without registration in the territory of the Republic of Uzbekistan;

thirdly, a mark used as a trademark, but without legal protection on the territory of the Republic of Uzbekistan, at the request of a legal

entity or individual, if, as a result of the constant use of such trademarks or marks, they are widely known among the relevant consumers. It can be recognized as a well-known trademark in the Republic of Uzbekistan.

These three grounds for the recognition of a trademark are based on internationally recognized documents.

However, the exact legal nature of the criteria concerning their content and conditions of application in practice is not specified

Presidential decree of the Republic of Uzbekistan № PP-4380 dated July 1, 2019 “On the activities of the Agency for Intellectual Property of the Ministry of Justice of the Republic of Uzbekistan” sets specific tasks for further improvement of the legal status of intellectual property

The decree also establishes the rules for relations with trademarks, in particular, the recognition of trademarks as publicly available. The first paragraph of subparagraph (b) of paragraph 9 of the decree establishes the grounds for recognizing a trademark as well-known, while these grounds are based on a system of independent but interrelated relations.

The trademark is studied and evaluated separately in accordance with the rules established for the recognition of publicity. As a result, it is



concluded that the brand may or may not be known to everyone.

The Paris Convention for the protection of industrial property was the result of the first international effort to standardize and simplify the protection of intellectual property rights in Member States. It was acceded to on 20 March 1883 by the first eleven countries and has been revised several times over the intervening century¹.

The first important provision of the Paris Convention is that the conditions for the filing and registration of trademarks are to be determined by the member states' laws. The Convention is thus concerned with the harmonization of substantive but not procedural trademark law². In these registration procedures, one of the most important grounds for refusal is lack of sufficient proof of the fame of a trademark in order to be considered well-known under the Convention.

The Paris Convention is also silent regarding any requirement that a trademark which is being considered as well-known one actually be in use in the country in question. The Paris Convention is an international agreement. In most countries, an international convention is not self-executing and has no force of law until enacted into domestic legislation. Thus, despite the fact that many countries including all the Member States of the European Union and Uzbekistan, have acceded to the Paris Convention, this does not automatically mean that all of its requirements have been made part of each country's domestic law. Article 6bis of the Paris Convention deals with three legal issues:

1. The obligations of members to protect a well-known trademark by refusing or cancelling the registration of any mark which infringes the well-known mark,

2. That determinations of well-known trademarks will be based upon (a) a decision of the competent authority of the registered country, or (b) a decision of the competent authority of the country where the mark is used; and

3. Defining infringements of well-known trademarks to include the reproduction of the whole or the essential part of the mark, or an imitation, or a translation of such mark which can create confusion with the well-known mark.

¹ The International Convention for the protection of Industrial Property signed as of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979.

² Guy Tritton (editor), *Intellectual Property In Europe*, (Thomson – Sweet & Maxwell Publisher, 2002), p. 192.

The Paris Convention is also silent regarding any requirement that a trademark which is being considered as well-known one actually be in use in the country in question. This implicitly permits a trademark to be considered protected by its well-known status in a Convention State even though it has never been in use there. This is because that in general the Paris Convention has no requirement of use of a trademark in member countries in considering the registration and protection of such trademark. Indeed, according to the Convention, the requirement of use of trademark should be specifically stated by the national laws.

These provisions are based upon provisions of the Paris Convention specifically referencing Article 6bis. However, TRIPs has effectively developed on Article 6bis of the Paris Convention by providing amplification and expansion of its provisions.

First, protection of well-known trademarks may be applied to both goods and services.²⁴ This extension is one of the most important provisions of TRIPs applicable to the Paris Convention because service marks have become increasingly more important to international trade and contribute to the development of the global trade system.

Second, in order to determine whether a trademark is well-known, member states are required to take into account knowledge of the trademark in the relevant sector of the public, including the knowledge in the member concerned which has been obtained as a result of the promotion of the trademark.

Third, protection for well-known trademarks may also be applied for marks even when the applied trademarks are for goods or services which are not identical or similar to the goods or services in respect of the trademark is registered.

Thus, the TRIPs Agreement may be seen as an important step in the protection of well-known trademarks on a global scale. It is also significant for extending the protections of the Paris Convention to all WTO countries. Therefore, even though the TRIPs Agreement itself is not self-executing, Membership in the WTO mandates adherence to it and accordingly it has greatly expanded compliance to the Convention to all WTO members. It should be noted that TRIPs sets down only minimum standards for well-known trademark protection. The TRIPs agreement may be considered as a basic minimum for well-known trademark protection and WTO members are free to extend protection depending on their particular circumstances³.

The Madrid Agreement concerning the international registration of marks was signed on

³ Clark W Lackert and Maren C Perry, "Global protecting well-known and famous marks: a global perspective", *Building and Enforcing Intellectual Property Value*, 2008.



April 14, 1891⁴, by the first four countries of the Paris Union. This Agreement aims at establishing a special union for the international registration of trademarks. It governs only proceedings regarding the application and registration of trademarks by providing facilities in order to ensure that the registration of trademarks will be carried out quickly and effectively in Member States. It does not contain substantive provisions directly concerning the protection for well-known trademarks.

It should be noted that the Madrid Agreement only deals with procedural matters. However, this Agreement has also contained an article relating to well-known trademark protection. Under this provision, member countries are permitted to refuse an application for registration of marks or certification of protection for marks based on the grounds set forth in the Paris Convention for the protection of industrial property, including the registration of marks, which are protected as well-known trademarks. Such international registration may be invalidated (in whole or in part) at any time by a competent national authority of Member States insofar as its territory is concerned. However, owners of marks, which are so registered, must be given a timely opportunity to establish and defend their rights.

It should be noted that the Madrid Agreement only deals with procedural matters. However, this Agreement has also contained an article 31 relating to well-known trademark protection. Under this provision, member countries are permitted to refuse an application for registration of marks or certification of protection for marks based on the grounds set forth in the Paris Convention for the protection of industrial property, including the registration of marks, which are protected as well-known trademarks. Such international registration may be invalidated (in whole or in part) at any time by a competent national authority of Member States insofar as its territory is concerned. However, owners of marks, which are so registered, must be given a timely opportunity to establish and defend their rights.

As in many other countries, it is quite difficult to make a determination regarding the fame of a trademark in order to protect it as such in Uzbekistan. Normally, determinations regarding well-known trademarks are based on the provisions of

⁴ The Madrid Agreement concerning the international registration of marks was signed on April 14, 1891 under the auspice of the Paris Union on the industrial property, revised at Brussels on 14 December 1900, at Washington on 2 June 1911, at The Hague on 6 November 1923, at London on 2 June 1934, at Nice on 15 June 1957, and at Stockholm on 14 July 1967, and amended on 28 September 1979. It consists of 27 articles.

international conventions even though these provisions are not specific or clear enough to apply in practice. Therefore, reference is made to various national laws. This is all well and good but the law of one country is often very different from the law of another. According to Uzbekistan law, in order to make a decision recognizing a well-known trademark the competent authorities must use evidence and documents submitted by the trademark's owner as well as other information collected by authority itself concerning the fame of the trademark.

Although there are criteria set out in the law it is difficult for competent authorities to determine the fame of a trademark because these standards or criteria are not always sufficiently clear for application. There are many standards provided under which the same trademark would be considered as a well-known or denied protection. In order to prove that a trademark is well-known and should be protected by the special legal regime, competent authorities must, by the trade mark law of Uzbekistan consider legal the following criteria:

- The number of relevant consumers who were aware of the mark by purchase or use of goods or services bearing the mark, or through advertising;
- The territorial area in which goods or services bearing the mark are circulated;
- Turnover of the sale of goods or provision of services bearing the mark or the quantity of goods sold or services provided;
- Duration of continuous use of the mark;
- Wide reputation of goods or services bearing the mark;
- Number of countries protecting the mark;
- Number of countries recognizing the mark as a well-known mark;

However, the concept of famous trademarks is not statutorily set forth and a proper approach is rarely encountered in practice. As long as a trademark becomes famous, it should have been treated as well-known for a certain period of time. The legal regime for well-known trademark protection and famous trademark protection are the same. In other words, there is no need to have a larger scope of protection for famous trademarks because the current legal framework applied to well-known trademark protection may also be completely applicable to famous trademarks. A distinction between a well-known and a famous trademark only makes sense from a theoretical perspective. There is often confusion among "well-known trademarks" and "widely used and recognized trademarks", or between "widely used and recognized trademarks" and "ordinary trademarks". In order to avoid such confusion, the law should precisely define any distinctions among them.

Although trademark law of Uzbekistan the law does not state it explicitly, these legal criteria should be non-exhaustive. It may be seen that all



criteria provided are so informative, general and qualitative that they cannot be applied effectively in practice. They obviously need more specific supplements in order to at least quantify each of them. Therefore, such criteria should be used flexibly by courts and competent authorities according to the facts of each case. In some special cases authorities may apply other criteria based on evidence and arguments submitted by the applicants.

Many people should know and be able to distinguish such a mark from among many different ones in the market. However, there are some practical issues that need clarification when we apply this criterion, such as how should we define a consumer's awareness? and how do we quantify the percentage of people with knowledge of the mark sufficient to deem it well-known?

Many questions remain regarding the other criteria. For example: what is meant by the "territorial scope of circulation of goods or services"? and should the territory be the original country of the mark's origin or the country where the mark is being considered? how does one calculate the "widespread goodwill" of goods or services bearing the mark? how does one define the level of "turn-over" received from the mark as well as the "volume" of goods sold or services supplied in order to consider a mark to be well-known?

Thus, although we have statutory law on the subject, it cannot be used effectively because many questions are yet to be addressed. These are at present the greatest challenges to the legal system in Uzbekistan regarding well-known trademark protection. There is a need to have a proper explanation of the statutory criteria in order to guide the authorities on the exact manner to perform their assigned tasks.

In principle, a trademark will be normally considered well-known when it is used widely in Uzbekistan. This is provided for under the law. However, in some cases, a trademark may also be considered well-known even if it has not been registered or used in Uzbekistan. The result depends upon subjective consideration by the authorities. The vagueness of the law gives more flexibility to an authority to make decisions concerning well-known trademark protection, but it also creates ambiguity that sometimes damages the interests of interested.

CONCLUSION

Globalization and international integration are bringing opportunities to developing countries to obtain and use the technical advances of other countries to improve their own economies. Globalization has also created many challenges for these countries to face. In this regard, Uzbekistan has also had opportunities to study and learn useful lessons from other legal systems, especially from developed country legal systems.

It is necessary to internalize the legislative achievements and practical experience of other legal systems into the Uzbekistan legal system for the protection of well-known trademarks. However, such internalization must be made with care. It is most important that experiences from other legal systems be applied to the specific context of Uzbekistan conditions. Solutions should be adapted to the needs of a transforming Uzbekistan economy; secondly, any changes should be made based on Uzbekistan socio-economic conditions focusing on effective solutions; and thirdly, any improvement of the legal system should not be contrary to general policies of the State of Uzbekistan.

One of the main purposes of this thesis was to find suitable ways to improve the legal system for well-known trademark protection in Uzbekistan. In order to do so, apart from a general theoretical exploration and investigation of the legal framework of well-known trademarks, it also requires a complete evaluation of the current situation of the Uzbekistan's legal system. Such an evaluation aids in a deeper understanding of which actions must be continued and what are the weak points that need to be addressed.

Our results show that the Uzbekistan's legal system has had significant legislative and enforcement success in the area of protection for well-known trademarks. This may be seen by the examination of cases as well as the statistical data concerning the number of certificates of trademark registration issued in recent years. Despite that, it cannot be denied that there remain significant areas for the system's improvement to be carefully considered and resolved.

Based upon the results of the previous chapters, the author has made suggestions for improvement of the Uzbekistan's legal system for well-known trademark protection. Those solutions focus on different aspects of the issues in question including legislative, administrative, and judicial activities as well as multi-dimensional impacts on society. Among them, the three most important and strategic solutions at the moment are, amendments to the Law on Trademark, the creation and publication of lists of well-known trademarks, and the establishment of a professional court with competence over intellectual property cases. In addition, the other suggested solutions should play a significant role in improving and developing the legal system on well-known trademark protection in Uzbekistan.

Uzbekistan has acknowledged the great importance of protection for intellectual property rights for patents, industrial designs, copyrights, and trademarks. In recent years, the Government has taken a number of steps to ensure legal guarantees of such rights. In Uzbekistan, intellectual property in general, and trademarks in particular, have already



played a crucial role in the development of the economy, especially in its efforts towards harmonization and globalization. Uzbekistan has become the member of the Paris Convention and the 1989 Madrid Protocol since 2006.

This comparative research demonstrates that the Uzbekistan's legal system for well-known trademark protection has been well-developed due to the Government's efforts to learn from and adopt from the experiences of other countries as well as in joining and internalizing the provisions of the international legal framework. However, such attempts have not yet been completely effective to create an advanced legal system for well-known trademark protection, especially in the context of globalization and international economic integration.

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