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Protection of Well-Known Trademarks under the Internet

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Abstract: As the digital age advances, many trademark registrants have utilized the Internet as a medium to increase the visibility of their trademarks and brands, thereby obtaining greater benefits compared to traditional methods of trademark display, such as physical advertisements and television broadcasts. However, the Internet has also expanded the forms of trademark infringement while breaking down the territorial protection limitations of traditional trademark rights. Well-known trademarks, due to their own popularity and prominence, make them the first target of intellectual property infringement in the Internet environment. And due to the lag in legislation, the trademark infringement caused by the Internet will encounter obstacles in the process of defending rights. Therefore, this paper analyzes the protection of well-known trademarks in the context of the Internet by means of theoretical analysis and overview analysis. At the same time, it takes the problems expected in the protection of well-known trademarks in China as an example and provides corresponding measures to solve the problems. Relative protection is adopted for unregistered well-known trademarks, and with their own higher goodwill and trademark value, well-known trademarks should be given special protection. Extending the protection of well-known trademarks to the network environment is the inevitable development trend of well-known trademark protection.

Keywords: Well-Known Trademarks, Trademarks Infringement, Internet, Anti-dilution protection

1. Introduction

The earliest concept of well-known trademark originated from the Paris Convention, which added the protection clause for well-known trademarks in 1925. To a certain extent, the protection of trademarks breaks through the territorial limitation, and the protection clause states that after any one of the member states of the Paris Convention confirms it, it is effective in the transnational of the member states of the Paris Convention. However, the Paris Convention does not define how to judge whether a trademark is a well-known trademark. In 1999, the WIPO Joint Recommendation made specific provisions on the factors to be considered in determining whether a trademark is well-known, such as the degree of knowledge or awareness of the trademark in the relevant public, the duration and scope of the use of the trademark, the trademark's advertisement and publicity, the value of the trademark, and other specific reference factors, which made the certification of well-known trademarks operational [1]. The WIPO Joint Recommendation defines the relevant public not only as consumers of the goods for which the mark is used, but also as persons involved in the distribution of

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the goods by the merchant or in the distribution channel [1]. At the same time, the WIPO Joint Recommendation broadens the scope of protection of well-known marks to include "conflicting logos, corporate logos, or domain name conflicts" [2]. Although there is no clear definition of well-known trademark in the international arena, it is generally believed that well-known trademark refers to a trademark that enjoys more business in the market after a long period of use and is well-known among the public [3]. The current trademark laws of various countries provide for the traditional protection of trademarks or registration as a prerequisite for obtaining the qualification of protection, but the general international protection of well-known trademarks is generally not based on the prerequisite of registration [1]. At the same time, the traditional principle of trademark protection is to preserve the attributes of the trademark that identify the source of the goods, thus preventing consumers from being confused with it. On the other hand, the principle of well-known trademark protection is to protect the efforts made by the trademark owner in establishing and operating the well-known trademark, and to protect the goodwill and value of the trademark itself, which are higher than those of an ordinary trademark, from the standpoint of the trademark owner. Therefore, the protection of well-known trademarks, unlike ordinary trademarks, does not require the infringement to occur in the same or similar field, i.e., infringement of well-known trademarks may also occur in non-competitive fields.

With the advent of the digital age, the economy has ushered in a new wave of development opportunities. Consumers can absorb more information about goods through the Internet, and the range of goods available to them has greatly increased. For this reason, many trademark registrants can use the Internet as a medium to enhance the visibility of their trademarks and brands and thus obtain greater benefits than traditional trademark display methods, such as physical advertisements and television broadcasts.

However, the Internet has also brought disadvantages to the protection of trademarks that cannot be ignored, including the traditional trademark rights of territorial limitations. At the same time, the Internet has expanded the forms of infringement of trademarks, but due to the lag in legislation, the forms of infringement of trademarks caused by the Internet are either not covered by the traditional trademark law or it is difficult to obtain evidence and thus difficult to defend the rights of the phenomenon. The infringer, without the permission of the trademark owner, uses a similar trademark on the Internet, resulting in the dilution of the trademark and damage to the exclusive right to use the trademark. To a certain extent, the Internet gives infringers a certain degree of protection, as the Internet is an open platform and at the same time has a hidden nature. These characteristics make the existing technology not enough to accurately locate the trademark infringer on the Internet, and because of its wide coverage, it is also impossible to set up a unified regulatory body for the Internet to ensure a unified supervision of trademark infringement. and due to its wide coverage, it is also impossible to establish a unified regulatory body to ensure uniform supervision of trademark infringement on the Internet. As a result, it is difficult to obtain evidence of network trademark infringement. And well-known trademarks because of their own popularity and prominence, so that it becomes the network environment of the brunt of the infringement of intellectual property rights [4]. Therefore, this paper analyzes the protection of well-known trademarks in the background of the Internet by means of theoretical analysis and literature review, and the main angles of analysis include the influence of the Internet environment on the protection of well-known trademarks and the common infringement methods. In addition, the article chooses the protection of well-known trademarks in China as a specific case, and puts forward corresponding measures to solve the infringement of well-known trademarks in the Internet environment. The analysis can increase the attention of consumers and related personnel to the protection of well-known trademarks.

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2. Well-known Trademark Protection in the Internet Environment

2.1. The Impact of the internet environment on the Protection of Well-known Trademarks

Since the last century, the Internet has been developing at an alarming speed, rapidly changing people's business habits. The Internet makes the use of trademarks break through the geographical limitations, many originally limited to a certain area of the well-known trademarks. This may be due to the Internet expanding the geographical nature of its popularity, but it has also caused a different range of countries within the trademark owner to hold similar or the same trademarks, causing conflicts, infringement, and other problems. At the same time, the recognition of trademarks, trademark protection standards, and jurisdiction of trademark protection are difficult to unify among countries, which will pose a certain degree of challenge to the existing trademark protection system.

2.2. The forms of trademark infringement

On the other hand, the forms of trademark infringement brought about by the Internet are also diversified. In addition, the traditional trademark law provides for several forms of trademark infringement, such as without the permission of the registrant, the unauthorized use of the same or similar trademarks for the same or similar products or services, the sale of goods infringing on the exclusive right to use the registered trademark, reverse counterfeiting, and so on. New forms of infringement brought about by the Internet may include infringement through keyword searches. At the same time, it may also cause trademark infringement through domain name squatting, domain name theft, and so on. In addition, there is also infringement of the enterprise's webpage design and even infringement of trademarks through third-party platforms.

2.2.1. Domain name

Domain name is the Internet user's address on the Internet, but consumers can also directly identify the source of goods with strong uniqueness and scarcity of identification [5]. Many companies recognize the importance of domain names in the internet age, and as a result, many types of domain name infringement have developed. For example, a brand may maliciously purchase a branded domain name that is similar to another brand's website and sell a similar category of goods, causing consumers to misunderstand the domain name and thus reap significant benefits from it. In addition, there is the phenomenon of domain name squatting [6]. The act of registering a domain name bearing the proprietary name or logo of an enterprise without the permission of the owner of the trade mark, so as to borrow another person's trade mark for profit. For example, in the case of Marks & Spencer v. One In A Million in the United Kingdom, the defendant registered "marksandspencer.com" as a domain name, and since Marks & Spencer itself is a registered trademark without the enterprise's permission, the defendant's act of registration constitutes infringement of the trademark. The defendant's registration constituted an infringement of the trade mark [7].

2.2.2. Keyword Search Infringement

Keyword searching is an effective way to quickly sift through the Internet and get the information you need. And keyword infringement includes infringement by infringers through keywords in advertisements. Advertisers use search engine service providers to buy other brands of keywords as their own push keywords, and consumers, through the search engine search for the original brand, may enter the infringer's brand or related products interface. Alternatively, when building their own websites not for descriptive and referential use but for deliberate use of keywords identical to or related to the well-known trade mark, users may see the infringer's website when searching for the

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keywords of the well-known trade mark. For example, in the case of Playboy v. Welles in the United States, the cover girl of the defendant's website was chosen as Playboy's playmate of the year, and the website used the cover girl's photo and the term playmate of the year, and the header of the website also used playmate of the year. Playboy argued that the use of the word pmoy was an infringement of the trade mark. The District Court and the Court of Appeal held that the defendant's use of the word pmoy was an infringement of the trade mark because the keyword belonged to Playboy and had nothing to do with the defendant's web site, and that there was no necessity for the use of the word pmoy [8].

2.2.3. Web design infringement and third-party platform infringement

Web design is the information that a company wishes to convey to the outside world, including goods, services, and ideas. An infringer may use another's well-known trademark or logo or otherwise design a web page in a way that is misleading to consumers in an attempt to cause consumers to self-identify the well-known trademark with the web page in a way that is misleading as to its potential relationship. If without the permission of the original brand owner, other companies directly place the brand owner's products for sale on the third-party website trading platform, it will cause certain economic losses and reputational losses to the original brand owner.

2.3. Issues Applicable to the Protection of Well-known Trademarks in the Network Environment

The current trademark law for the protection of network trademark rights and the protection of the corresponding brand still has problems, although the traditional trademark law has made corresponding provisions on trademark infringement, but the network trademark infringement problem is not involved. When the Paris Convention was formulated, the Internet had not yet been vigorously developed, so the new form of infringement of well-known trademarks under the Internet did not make relevant provisions. Although the WIPO Joint Recommendation extends the scope of protection of well-known trademarks to conflicting logos, corporate logos, or domain name conflicts, the WIPO Joint Recommendation is not a binding provision and does not have a mandatory effect. In addition, the rapid development of the Internet environment, such as web page design, keyword search infringement, and other new forms of infringement, neither belong to the scope of goods nor services, whether the traditional rules of trademark law or the WIPO Joint Recommendation of the extension of the protection of the new forms of infringement are involved in the lack of systematic legislative protection.

In the face of new forms of infringement, national and international actions are being taken to protect well-known trademarks. The United States passed the Anti-Domainsquatting Consumer Protection Act in 1999 [9]. It provides a judgement standard for judicial authorities to determine whether domain name squatting is in bad faith, and at the same time protects the rights of bona fide registrants. At the international level, countries are also trying to establish new conventions to deal with the problem of infringement.For example, the Anti-counterfeiting Trade Agreement, which was opened for signature in 2011, sets out in section 5 the procedures for enforcing infringement of trademarks and copyrights in the digital environment, as well as the corresponding obligations of ISPs, and formally incorporates trademarks into the protection of trademarks in the digital environment [10]. But at the same time, ACTA has faced questions about its lack of privacy protection. Although ACTA has not yet come into force, it is still relevant to the protection of well-known trademarks under the Internet.

At present, international trademark infringement in the Internet environment is still focused on the dispute over domain names, and other forms of infringement have not yet introduced relevant rules,

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which are basically taken by the domestic law of each country to regulate. However, there is also a form of international cooperation to face the Internet trademark infringement that has broken through the geographical limitations. For example, WIPO and other intellectual property protection organizations may cooperate with other countries. In 2011, they set up a joint dispute resolution procedure with the Intellectual Property Office of Singapore.

3. Problems and Measures for the Protection of Well-known Trademarks in China

China's current protection principle for well-known trademarks is to adopt absolute protection for registered well-known trademarks and relative protection for unregistered well-known trademarks [11]. China's current law for well-known trademarks and the theory of its trademark dilution problem are insufficient. They still adhere to the traditional theory of confusion, that is, the trademark to confuse consumers. Under this theory, the trademark infringement is based on the same or similar products because only the products that are the same or similar to the consumer will be confused. Although the current law incorporates the issue of well-known trademark infringement, it is still based on the traditional theory of confusion rather than the true theory of trademark dilution. The Trademark Law explicitly provides for cross-class protection of well-known trademarks, i.e., it does not require similarity of goods. However, due to the accumulation of time, the correspondence between well-known trademarks and their goods or services will be diluted, which will lead to the disappearance of the uniqueness of well-known trademarks, and this damage is not included in the scope of the law.

In order to enhance the protection of anti-dilution of well-known trademarks in China, the act of trademark dilution can be systematically regulated by a special chapter in the Trademark Law. As the Internet has increased the means of trademark dilution, the methods of dilution of well-known trademarks are far greater than those listed above. Therefore, while clearly listing the known means in the legislation, the openness of the law should be maintained. Meanwhile, it should also be clear under what circumstances the correct use of well-known trademarks is, such as non-commercial, legitimate, and other constraints. The law should also clarify the responsibility of the infringer. For example, the infringer should immediately stop the infringing behavior, such as stopping the use of the domain name, stopping the use of keyword implantation, and other behaviors. Secondly, if the infringing behavior is domain name squatting, the squatting domain name should be returned to the original brand. Thirdly, the amount of compensation should be given to the original trademark holder, and the amount of compensation should be evaluated on the basis of the consideration of the actual loss of the original registrant due to the infringing behavior. In order to further regulate domain name registrations, it is also possible to set up an opposition procedure and a registration grace period to allow the trademark owner to file an opposition, as well as to implement a regular review of domain name registrations.

The infringement caused by a third party is actually an indirect infringement of alternative infringement. The current legislation for indirect infringement is limited to indirect infringement to help infringement, for alternative infringement, the law is relatively vacant. It should be added to the trademark law for indirect infringement of the specific identification and indirect infringement of alternative infringement of the constitutive elements. In order to prevent a large number of indirect infringements by trademark registrants, there is no way to defend their rights. The public network trading platform should make detailed provisions for trademark infringement. At present, China's trademark law only focuses on the infringement of "notification - deletion" of the provisions, but not in detail, which makes the application of the law difficult. In this case, we can choose to make the "two notices" rule, that is, the trademark right holder in the discovery of network public trading platform has infringed on the trademark rights of goods, can notify the network public trading platform to delete the infringing products, and the platform can require the infringing products of the

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right holder to provide evidence of compliance with the trademark, if the trademark right holder that If the trademark holder thinks that there is insufficient evidence, he can ask the platform to delete the infringing goods [12]. Such a provision can accelerate the speed at which trademark right holders can defend their rights as well as reduce their losses, i.e., they can protect themselves through the liability of the platform instead of going through a lengthy litigation process to get a judgment.

4. Conclusion

It is only a few decades since well-known trademarks were first included in the Paris Convention and nowadays, under the Internet, the drastic change of the Internet has made the original protection of well-known trademarks face difficulties in application not long after the initial stage, which is also due to the fact that the legislation itself has a lagging effect. In the face of the protection of well-known trademarks, both countries and international organisations are making new legislation or conventions in order to adapt to the new environment. With the development of time, the legislative protection of well-known trademarks in the Internet environment will have further development and progress. However, this paper only summarizes and discusses the articles from a theoretical perspective by way of review, lacks case studies, and focuses only on China. Later on, as enterprises and countries pay more attention to the protection of well-known trademarks in the Internet environment, the article can be discussed and summarized in a wide range of contents.

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