A Well-Known Mark Carol: Moving Beyond the Spirits of our Trademark Past
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Abstract

The well-known mark doctrine presents a conundrum in American trademark law. Allowing a foreign mark that is neither registered nor used in the United States (albeit a well-known one) to usurp the priority of a home-grown, domestic mark (which may have been adopted in bad faith) is seemingly abhorrent to our historical theories surrounding the use and protection of trademarks. As such, even though protecting foreign well-known marks has been a non-binding obligation of the United States since 1925 and a binding treaty obligation since the 1990s, the doctrine is not applied as a matter of law. Further, courts and scholars discuss the well-known mark doctrine as if it is a controversial concept. Why is this?

The majority of the scholarly commentary has not answered this question. Most have looked at one of two questions: the first, whether the well-known mark doctrine has been adopted federally in the United States (the Second Circuit ruled in 2007 that it has not been) or the second, why providing well-known mark protection in the United States is critical. Missing from these discussions is an analysis of the underlying causes of our failure to fully adopt and embrace the well-known mark doctrine. This article attempts to fill in this gap and posits that one of the underlying causes of this failure is found in the three-headed spirit of our trademark past: use, goodwill and territoriality.

Trademarks have historically been territorial, and only use of a trademark in commerce in a certain territory begets goodwill, and that goodwill is what the law protects. As such, detractors of the well-known mark doctrine argue that protecting a foreign well-known mark that is neither registered nor used in the United States provides naked protection to a word, which is harmful. But in so arguing, these opponents fail to acknowledge the evolution of use, goodwill and territoriality that has taken place in other areas of trademark law. The modern incarnations of use, goodwill and territoriality vitiates such arguments. This article attempts to shed the light on this evolution in order to provide a path that moves us beyond the three-headed spirit of our past and finally protect foreign well-known marks as a matter of law.

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