

Well-known Marks Doctrine: Where Do We Go From Here?

By Tashia A. Bunch*

I. Introduction

Have you ever been traveling to another country and noticed a restaurant you thought that you recognized from back home only to dine there and find a different quality of food and service? The point of trademarks is to allow consumers to associate goods and services with a particular mark so when consumers see the mark they know what to expect for their money. Companies invest large sums of money to create this brand recognition. It is unfair to allow others to impede upon that recognition simply because the business has yet to use the mark in commerce in that country.

The well-known marks doctrine is used to stop these trademark pirates.

Two recent court decisions have illuminated two very important issues regarding the doctrine, namely, its validity in federal law and the test to be used to apply the doctrine. The Second Circuit Court of Appeals determined that the well-known marks doctrine has no basis in federal trademark law.¹ Prior to the Second Circuit decision invalidating the doctrine in federal law, the Ninth Circuit Court of Appeals created a test to apply the well-known marks doctrine based on the goals of trademark law and the doctrine.² This article discusses the recent

* Tashia Bunch graduated *cum laude* from Hampton University in 2003. She then attended Howard University School of Law where she participated on the Charles Hamilton Houston National Moot Court Team and was a recipient of the Nathan Burkan Memorial Competition Award, which is sponsored by the American Society of Composers, Authors and Publishers, for her Computer Law paper, "Protecting P2P and the Music Industry." Tashia graduated from Howard University School of Law in 2006 and was then admitted as a member of the Virginia State Bar later that same year. In her spare time, she teaches Literature to sixth graders in Alexandria through the Higher Achievement mentoring program. Since September 2006 she has been a Trademark Examining Attorney with the United States Patent and Trademark Office.

1 ITC, Ltd. v. Punchgini, Inc., 482 F.3d 135 (2d Cir. 2007).

2 Grupo Gigante S.A. de C.V. v. Dallo & Co., 391 F.3d 1088 (9th Cir. 2004).