RESHAPING TRADEMARK PROTECTION IN TODAY’S GLOBAL VILLAGE: LOOKING BEYOND GATT’S URUGUAY ROUND TOWARD GLOBAL TRADEMARK HARMONIZATION AND CENTRALIZATION

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I. INTRODUCTION

TRADEMARK PROTECTION IN THE GLOBAL VILLAGE: THE NEED FOR GLOBAL HARMONIZATION AND CENTRALIZATION

The world has become a "global village" in which the "medium is the message." A business engaged in international trade uses its trademark as the medium to convey its message. As the medium of the
message, the trademark becomes a valuable business asset which must be protected from unfair competition and deceptive trade practices, including counterfeit products and dilution. However, international trademark protection does not come easy because the global village lacks the framework to provide such protection. Even if counsel possesses knowledge and experience in both international trade and trademark law, international trademark protection may be evasive.

This Article demonstrates the need to rethink and reshape international trademark protection for the global village rather than maintaining a status quo controlled by territoriality. The doctrine of territoriality recognizes that a trademark has a separate existence in each sovereign territory where registered or legally recognized as a mark. This means modern "trademark rights exist in each country solely according to that country's statutory scheme." Thus, international trademark protection must be sought in each country where a business intends to use its association, or other collective group or organization. Id. A "certification mark" demonstrates the use by persons other than its owner "to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization." Id. In this article, trademark includes service mark, collective mark, and certification mark.


4. Yelpaala, supra note 1, at 840 (explaining that the global market demands international counsel possess greater knowledge of related subject matter to handle more complex and innovative transactions).


trademark. However, statutory schemes differ in procedure and substance, which makes obtaining such protection complicated and beyond the financial resources of many businesses engaged in international trade. Further, even when a country offers trademark rights, it may enforce those rights inadequately or ignore enforcement entirely, which, unfortunately, vitiates a country’s offer.

During the past year, international negotiators took a giant leap towards international trademark protection for the global village when they completed The Uruguay Round of the General Agreement of Tariffs and Trade (GATT 94) and The Trademark Law Treaty (TLT). Although

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To register, the international businessman is forced to meet different procedural and substantive requirements in every country, to complete a bewildering variety of different forms in different languages, to cope with different and sometimes unintelligible systems of classifications of goods, to submit electro-types and prints differing in size and number, and to pay disparate official fees in a plethora of currencies. After registration has been obtained, its assignment, licensing or renewal is again subject to differences in national treatment. Perhaps most painful of all, the international businessman’s inability to cope directly with all these differences compels him to retain, in each country in which he desires protection, trademark attorneys or agents to do the necessary, against payment, of course, of a reasonable professional fee for the unravelling of the mysteries of national law.


9. See, e.g., Leaffer, supra note 3, at 274-75 (describing the schism between developed and developing countries in attitudes toward trademark enforcement); Giunta & Shang, supra note 8, at 328. In addition, the United States uses the common law system which relies on case precedent, but many countries (i.e., most of Central America, South America, and Western Europe) rely on the civil law system which grounds itself in the codified law and, generally, ignores case precedent. See Sandoval & Leung, supra note 7, at 152-53. Moreover, civil law does not provide injunctive relief or other pre-trial remedies, unlike our common law system. Id.


11. The Final Act of the Multilateral Trade Negotiations (The Uruguay Round) and Introductory Note, 33 I.L.M. 1125 (1994) [hereinafter GATT 94]. Other documents annexed thereto are reproduced also in volume 33, I.L.M.: Agreement Establishing the World Trade Organization, id. at 1143; General Agreement on Tariffs and Trade 1994, and The Uruguay Round Protocol GATT 1994, included under Agreements on Trade in Goods, id. at 1154; Agreement on Trade-Related Aspects of Intellectual Property, Including Counterfeit Goods, id. at 1197; Agreement on Trade in Services, id. at 1168; Understanding on Rules and Procedures Governing the Settlement on Disputes, id. at 1226; and various Ministerial Decisions and Declarations, id. at 1248. See infra pp. 92-96.
these two agreements leave some problems unresolved, they demonstrate the global village’s desire to provide a basic multilateral framework for international trademark protection. In addition, the United States Trade Representative (USTR) has been negotiating bilateral and regional trade agreements which reinforce and even strengthen the international trademark protection provided in GATT 94.  

This Article advocates the expansion of these endeavors to create adequate protection for the international trademark. The author argues that this expansion cannot occur until international negotiators view the world as the global village it has become. Protectionists must be deserted, and the doctrine of territoriality must be reshaped, or even abandoned, in favor of expansion which strengthens the global village.

The author further argues that global harmonization of national laws to acquire trademark rights and centralization of trademark filings and registrations must occur, because such harmonization and centralization create the foundation for international trademark protection in a global village. Given the lack of substantial opposition to centralization and the current availability of computer technology, a centralized system for international trademark filing and registration could exist today, but negotiators have failed to put in place such a system. This failure will continue until the negotiators embrace the global village and initiate global harmonization.

Furthermore, the needs of both the developed and developing countries must be considered. When initiating global harmonization, the developed countries take the position that the trademark owner possesses a property right in the trademark, and the developing countries take the position that all their citizens need access to information for their economies to grow. The developing countries confront “two often conflicting challenges. First, they must enter and participate in the global marketplace on a substantive basis. Second, they must structure meaningful legal regimes which legitimize their participation.” While the trademark laws in many developed countries are well-established, such laws are still evolving in most developing countries.

In addition, trademark laws among the developed countries may differ, and even directly conflict. For example, to file a trademark, the

14. See Giunta & Shang, supra note 8, at 328-33.
15. Id.
16. Sandoval & Leung, supra note 7, at 147.
United States requires use of, or a bona fide intent to use, a trademark in commerce, but other countries do not require use or even an intent to use. However, this Article's purpose is not to enumerate those conflicts but rather to advocate international trademark protection through global harmonization of national trademark laws and centralization of trademark filing and registration. Thus, this Article focuses only on global harmonization and centralization, and it does not discuss the enforcement of trademark laws or other problems of domestic and international trademark protection.

Part One surveys international agreements containing trademark rights and obligations. It further analyzes the failure of these agreements to protect trademarks in the global village. At best, they provide a minimum standard for international trademark protection. Generally, they do not address global harmonization of national trademark laws. This failure prevents the establishment of a viable centralized trademark filing and registration system, even if these international agreements address centralization.

Part Two proposes that multilateral, regional, and bilateral agreements provide the medium for global harmonization and centralization. Section One of Part Two recommends that the Council for Trade-Related Aspects of Intellectual Property be the primary initiator of global harmonization and centralization. Section Two of Part Two further recommends that regional and bilateral agreements strengthen and reinforce a Council for TRIPS' initiative for global harmonization and centralization. Finally, this Article concludes, optimistically, that a Council for TRIPS’ initiative supported with regional and bilateral agreements can provide adequate trademark protection in the global village.

II. INTERNATIONAL AGREEMENTS: THE FAILURE TO PROTECT TRADEMARKS IN THE GLOBAL VILLAGE

This section delineates, in historical order, the principal international agreements which contain trademark rights and obligations. In addition, it demonstrates the lack of international trademark protection

19. These agreements, which include treaties and conventions, may be multilateral, regional, bilateral, or bipartite.
because none of these agreements provide both harmonization of national trademarks laws and centralization of trademark filing and registration.

A. Paris Convention for the Protection of Industrial Property of 1883, as revised and amended (Paris Convention)

In 1883, the Paris Convention established intellectual property rights and obligations in an international agreement, resulting in the first multilateral agreement addressing trademarks. Prior to this time, a few bilateral treaties, some involving the United States, and at least sixty-nine bipartite treaties offered some form of trademark protection to foreigners. Although the Paris Convention addresses trademarks and other marks, patents, utility models, and industrial designs, this Article examines only the rights and obligations relating to trademarks.

The Paris Convention provides trademark protection based on national treatment, priority rights, and registration. National treatment prohibits a country from providing less favorable trademark treatment to foreigners than to its citizens, but no requirement of reciprocal treatment exists. The Paris Convention further prohibits any signatory from

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On March 20, 1883, eleven countries signed the original convention, the Convention of the Union of Paris, and the United States became a signatory in 1887. Today, the Paris Convention has 103 members, but not all signatories have signed the same version. Generally, the most recent version signed by all nations in question constitutes the applicable version unless, when ratifying or acceding, a nation excluded certain articles of that version. John B. Pegram, Trademark Law Revision: Section 44, 78 TRADEMARK REP. 141, 151 (1988).

The later versions tried to preserve the original numbering of the articles. Beginning with the Washington Conference, any new provisions which did not fit into the old article was inserted as a new article having French ordinal suffixes bis, ter, quinter, quinquies, sexies, and septies. See id. at 154.


[The Nationals of any country of the Union shall, as regards the protection of [trademarks], enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement
requiring domicile or establishment in its country to obtain trademark protection. National treatment for trademark protection existed prior to the Paris Convention and has continued as the basis for most international agreements offering trademark protection. The Paris Convention has been criticized because of its use of national treatment which allows a country to avoid providing trademark protection for foreigners if it does not provide trademark protection for its citizens.

However, the Paris Convention initiated the right of priority, which creates a nationally-based priority filing date. The filing date of a duly filed trademark application in one of the Union countries can be claimed as a right of priority at any time within six months in corresponding applications in other Union countries. The domestic laws of each country determine the conditions for the filing and registration of a trademark. The Paris Convention does not provide for centralized filing or registration. Thus, a trademark owner must file and register in each country where protection is desired unless another agreement exists which provides for centralization of filing and registration.

of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

Id.

The Union consists of the Paris Convention signatories and exists for the protection of industrial property, including trademark protection. Id. art. 1.

24. Id. art. 2.

25. See Pegram, supra note 20, at 154.


27. See Pegram, supra note 20, at 155 (explaining no prior bilateral treaty contained right of priority).

28. See id.; Paris Convention, supra note 20, art. 4.

29. Paris Convention, supra note 20, art. 6. Article 6 provides: (1) a trademark registration application by a national of a Union country in any Union country “may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal has not been affected in the country of origin,” and (2) “[a] mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.” Id.

30. See Browning, supra note 3, at 342 (explaining that the Paris Convention “does not provide trademark protection across Paris Union members’ borders”).

31. Paris Convention, supra note 20, art. 19. “[T]he countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention.” Id. This allows additional agreements without violating the international agreement principle of specialty.
Although the Paris Convention sets some minimum standards for national trademark laws in Union countries, no serious discussion regarding harmonization of national trademark laws has occurred among Union countries. Since the global village did not exist in 1883 and was only in its infancy during the Stockholm Convention in 1967, the lack of such discussion during those times can be understood. However, the global village does exist today, but the International Bureau and the World Intellectual Property Organization have been unwilling to seriously discuss global harmonization of national trademark laws. This has resulted in failed attempts to create a global centralized trademark filing and registration system. Such failure supports the author's argument that global centralization of trademark filing and registration will not be viable without global harmonization of national trademark laws.

B. Madrid Agreement Concerning the International Registration of Marks of 1891, as revised and amended (Madrid Agreement)

In 1891, some of the Paris Union countries established the Madrid Agreement to create a uniform system for the international filing and registration of trademarks. The Madrid Agreement allows its member countries to "secure protection [in all Madrid Union countries] for their

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32. Paris Convention, supra note 20, arts. 6-11 (enumerating specific rights and obligations of trademarks and other marks). This Article's purpose is not to enumerate such rights and obligations in any international agreement, but rather to determine if global harmonization of national trademark laws, and centralization of trademark filing and registration occurred, and if not, whether such harmonization and centralization should occur.

33. See Yelpaala, supra note 1.

34. The Paris Convention established the International Bureau to administer the Convention. Paris Convention, supra note 20, art. 15.

35. The International Bureau was incorporated into the World Intellectual Property Organization when it took over the administration of the Paris Convention and the Madrid Unions. See infra pp. 79-80.

36. See infra pp. 76-78, 81-84.


38. "The countries to which this Agreement applies constitute a Special Union for the international registration of marks." Madrid Agreement, supra note 37, art. 1(1) [hereinafter
[trademarks], registered in the country of origin, by filing the said [trademarks] at the International Bureau\textsuperscript{39} . . . , through the intermediary of the Office of the said country of origin.\textsuperscript{40} This extends the Paris Convention's territoriality principal by allowing individual national registrations in the Madrid Union if the trademark applicant procedurally followed the Madrid Agreement and its Regulations, and the individual countries, where registrations are sought, approve the application based on their individual national laws.\textsuperscript{41} Without such approval, the registrations by themselves confer no substantive rights because such rights flow only from the national laws where the applicant sought registration.\textsuperscript{42} Thus, filing a trademark registration application with the International Bureau offers a single location to apply for trademark registration in multiple Madrid Union countries, but extends no substantive rights unless and until the individual national trademark offices recognize the trademark registration as valid under their national laws.\textsuperscript{43}

Although general support existed in the United States for a centralized trademark filing and registration system, the United States did not join the Madrid Agreement. The United States' rejection was based on numerous objections. First, the Madrid Agreement requires the filing of a trademark application based on perfection of a home country or basic

\textsuperscript{39} See Paris Convention, supra note 20 The International Bureau was incorporated into the WIPO when it took over the administration of the Paris Convention and the Madrid Unions. See infra pp. 79-80.

\textsuperscript{40} Madrid Agreement, supra note 37, art. 1(2).

\textsuperscript{41} See Browning, supra note 3, at 342-43 (describing the method of filing and registration); Samuels & Samuels, supra note 10, at 442-43 (enumerating the Madrid Agreement's specific articles pertaining to filing and registration); Joseph Greenwald & Charles Levy, Madrid Agreement Concerning the International Registration of Marks, Introduction, 1 B.D.I.E.L. 759 (1994) (explaining not only filing and registration procedure, but also Madrid Agreement facilitates trademark filing in different countries by allowing applicant to file one application, in one language, and to pay one set of fees to seek protection in multiple jurisdictions); Roger E. Schecter, Facilitating Trademark Registration Abroad: The Implications of U.S. Ratification of the Madrid Protocol, 25 GEO. WASH. J. INT'L L. & ECON. 419 (1991) (finding Madrid Agreement provides efficient, economical means to obtain simultaneous trademark protection in numerous foreign countries and explaining procedure).

\textsuperscript{42} Samuels & Samuels, supra note 10, at 442.

\textsuperscript{43} See Browning, supra note 3, at 343 (citing INT'L TRADEMARK ASS'N, MADRID PROTOCOL: A PRACTITIONER'S GUIDE (1993)).
registration requirement. This disadvantages the United States trademark applicant because registration takes longer in the United States than in most countries. Next, the Madrid Agreement requires a twelve month time limit for refusing to register a trademark registration. This time limit is too short because examination of a trademark in the United States involves a lengthy process. For the United States to complete its examination within twelve months would require giving Madrid Union Application priority over domestic applications which would cause a longer pendency for domestic applications. The Madrid Agreement also requires the inclusion of a central attack provision which requires the trademark protection resulting from the Madrid registration to cease completely if within five years from the date of such registration, the home country registration is successfully attacked, in whole or in part. This is considered to be unfair to the United States trademark owners because the United States has many more grounds for attacking registration than most other countries. Next, the Madrid Agreement lacks a use or bona fide intent to use requirement for filing or registration. This disadvantages the United States which requires use or intent to use for registering a trademark. The Madrid Agreement also lacks a standard description for classifying goods and services in trademark registrations. The Madrid Agreement increases the likelihood of increased dead wood (abandoned trademarks) on the national registry.

Thus, since the Madrid Agreement conflicted with aspects of United States trademark law and did not harmonize national trademark laws, its centralized filing and registration system could not be accepted by the Untied States. However, regardless of the shortcomings of the Madrid Agreement, support was not lost for a centralized trademark filing and registration system.

44. See Samuels & Samuels, supra note 10, at 443-44.
45. Id.
46. Id.
47. Id.
48. Id.
49. See Samuels & Samuels, supra note 10, at 443-44.
50. Id.
51. Id.
52. Id.
53. Id.
54. See Samuels & Samuels, supra note 10, at 443-44.
55. See Anthony R. DeSimone, In Support of TRT, 63 TRADEMARK REP. 492 (1973); infra pp. 77-78, 81-86.
C. Pan American Convention of 1929, as revised, including the General Inter-American Convention for the Protection of Trademarks (Pan American Convention)

The Pan American Convention of 1929, as revised, consists of two separate parts: a Convention for Trade Mark and Commercial Protection, and a Protocol on Inter-American Registration of Trade Marks. This Convention was the first attempt in the Western Hemisphere to harmonize national trademark laws and provide a centralized filing and registration system. Although the Convention provides for national treatment and a centralized filing and registration system, it does not strengthen the Paris Convention nor the Madrid Agreement. However, it does show the desire for cooperation among countries located in the same region even before the world had become a global village.

Fourteen nations of the Western Hemisphere, including the United States, but not Canada, are parties to at least one of the conventions. The United States is a member of the Pan American Convention, but it renounced the Protocol in the mid-1940s. The Bureau administering the Convention, the Inter-American Trade Mark Bureau, was located in Havana, Cuba, but it has closed. Compared to the Paris Convention, this Convention never acquired any significance. Now, with GATT 94 and other recent regional developments, this Convention becomes irrelevant.

D. Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 1957, as revised (Nice Agreement)

The Nice Agreement constitutes an international trademark classification agreement compatible with the global village. When registering a trademark, most countries require the applicant to describe the goods and services to be protected. However, such description may be problematic because trademark classification systems in various countries

57. See Browning, supra note 3, at 356.
58. Id.
59. See infra pp. 100-102.
differ in the particularity of their description requirements. Thus, the International Bureau\textsuperscript{61} established the International Classification system,\textsuperscript{62} creating specific descriptive classes for filing an international application. If, at any time, the International Classification system needs to be changed or revised, the Committee of Experts may make such changes or revisions.\textsuperscript{63}

The Nice Agreement exemplifies an agreement which embraces the global village, but it merely addresses the issue of descriptive classification of trademarks. The Nice Agreement is procedural in nature; it does not address any substantive trademark issues. No rights or obligations flow from any classification designation in the Nice Agreement.\textsuperscript{64} However, it does facilitate trademark searching which may help to prevent trademark confusion and infringement.\textsuperscript{65}

\textbf{E. Convention Establishing the World Intellectual Property Organization of 1967, as revised (WIPO)}

The WIPO\textsuperscript{66} has attempted to govern international intellectual property matters since it entered into force in 1970. The expressed objectives of the WPO are “to promote the protection of intellectual property throughout the world through cooperation among States and, where appropriate, in collaboration with any other international organization,” and “to ensure administrative cooperation among the Unions.”\textsuperscript{67}

\textsuperscript{61.} See Paris Convention, \textit{supra} note 20. The International Bureau was incorporated into the world Intellectual Property Organization when it took over the administration of the Paris Convention and the madrid Unions. \textit{See infra} pp. 79-80.

\textsuperscript{62.} Nice Agreement, \textit{supra} note 60, art. 1(1). Although Article 1 requires the use of the International Classification system, Article 2(2) allows each member country to “reserve[] the right to use the classification either as a principal or as a subsidiary system.” \textit{Id.} art. 2(2). The author contends that this reservation causes no substantial problems so long as the International Classification system is used.

\textsuperscript{63.} \textit{Id.} art. 3(3).

\textsuperscript{64.} \textit{Id.} art. 2(1).

\textsuperscript{65.} See Browning, \textit{supra} note 3, at 354.


\textsuperscript{67.} WIPO, \textit{supra} note 67, art. 3.
The WIPO succeeded the International Bureau for the Protection of Intellectual Property which the Paris Convention created. In 1974, the WIPO became a specialized agency of the United Nations with its headquarters in Geneva, Switzerland. It has a General Assembly, a representative body consisting of delegates from each of its 116 member states, which appoints its Director General.

Currently, the WIPO administers seventeen multilateral and regional agreements, such as the Paris Convention, the Madrid Agreement, and the Nice Agreement. Within its committee structure, two groups focus on international trademark law: the Permanent Committee on Industrial Property Information ad hoc Working Group on Trademark Information (PCIPI/TI) and the Committee of Experts on the Harmonization of Laws for the Protection of Marks (CEHLPM). The PCIPI/TI explores trademark information collection and storage including trademark search systems, examination methods, application numbering systems, and classifications. The CEHLPM examines harmonization of the trademark laws and recently developed a trademark administration treaty to facilitate worldwide trademark filing called the TLT.

At its inception, some WIPO convention delegates thought "[the WIPO's] existence [would] affect trademark rights at least in the same of affording a better structured and administrated vehicle through which our trademark interests [could] be identified and debated." However, by 1987, the United States General Accounting Office, Division of National Security and International Affairs (GAO) concluded that although the WIPO constitutes the foremost multilateral intellectual property forum, the government had made only limited progress towards strengthening international intellectual property rights and obligations through the WIPO. The GAO further concluded that this limited progress was due to the United States government actively opposing the efforts of developing countries to weaken existing international standards for trademark

68. See Paris Convention, supra note 20 and accompanying text; see also Browning, supra note 3, at 341.
69. See Cordray, supra note 26, at 122 n.1.
70. Id. at 122 n.2.
71. See Browning, supra note 3, at 352.
72. TLT, supra note 12; see infra pp. 92-96.
73. See McAuliffe, supra note 66.
74. Id. at 124 n.8. Dissatisfied with the WIPO's lack of progress in protecting and enforcing intellectual property rights, the United States, in 1986, shifted its efforts from the WIPO to the GATT's Uruguay Round negotiations. Id. at 121.
While agreeing with the GAO’s conclusion, the author continues to argue that international trademark protection will remain inadequate until both the developed and developing countries view the world as a global village and begin serious efforts toward harmonizing national trademark laws.

F. Vienna Trademark Registration Treaty, 1973 (TRT)

The TRT resulted from the WIPO’s failure to negotiate a revision to the Madrid Agreement acceptable to the countries, including the United States, which refused to accede to the Madrid Agreement but wanted to participate in an international filing and registration system. When the negotiations deadlocked, the WIPO asked the United States for a solution, and the United States responded by proposing the TRT.

The TRT created a compromise between those countries establishing ownership based on registration without priority of trademark use and those requiring priority of trademark use. It eliminated the Madrid Agreement’s requirement of home registration and eliminated the United States’ priority of trademark use requirement in favor of a declaration of intention to use. In addition, it allowed a minimum of three years with a discretionary extension to five years or more before trademark use becomes mandatory. It also permitted national law to bar an infringement action until after actual trademark use occurred within its borders.

However, the international trademark community views the TRT as a failure. Although over fifty countries participated in the Vienna diplomatic conference, the TRT was ratified only by the five Paris Union

75. Id.


The TRT went to the Vienna diplomatic conference on May 12, 1973. Although the United States signed it on June 12, 1973, it never ratified the TRT due to the TRT’s inherent conflict with its trademark law (both the Lanham Act and common law). See Browning, supra note 3, at 346.

77. See infra pp. 82-83.

78. The use of registration in the TRT’s title constitutes a misnomer because the TRT provides for filing but not registration. See Walter J. Derenberg, The Myth of the Proposed International Trademark "Registration" Treaty (TRT), 68 TRADEMARK REP. 433, 438 (1978).

79. See Frayne, supra note 8, at 422-29.

80. See Derenberg, supra note 78, at 438-39.
countries which brought the TRT into force: Burkina Faso, Congo, Gabon, the Soviet Union, and Togo. In addition, the TRT no longer appears in the publications listing current treaties in force. The author argues that the basic compromise contained in the TRT could have been a beginning for harmonization of national trademark laws, but the international trademark community was not ready for the global village which was only in its infancy at that time.

G. Protocol Relating to the Madrid Agreement Concerning the International Regulation of Marks of 1989 (Madrid Protocol)

After the TRT failed to attract sufficient signatories to make it viable, the Madrid Union requested the WIPO to continue considering changes to the Madrid Agreement which would allow Great Britain, Ireland, Denmark, Greece, and the United States to join. The WIPO responded with the Madrid Protocol. Initially, the international trademark community, including the United States, hailed the Madrid Protocol as acceptable to everyone.

Although the Madrid Protocol was similar to the Madrid Agreement, the Madrid Protocol seemed to cure the ills of the Madrid Agreement for several reasons. First, the Madrid Protocol allowed an international trademark application (WIPO application) based on a mere filing of a national trademark application rather than a perfected national registration. In addition, it extended the time to refuse the WIPO application from twelve months to eighteen months. It also revised the fee structure by allowing a member country to charge its national fees for examining the WIPO application. The Madrid Protocol further

81. See Browning, supra note 3, at 346.
82. See Browning, supra note 3, at 347-48. In addition, the Madrid Union wanted the WIPO to consider how to link the Madrid Agreement and the proposed European Community Trade Mark. See id. at 348.
85. See infra pp. 82-83.
86. Madrid Protocol, supra note 83, art. 2(1).
87. Id. art. 5(2)(b).
88. Id. art. 6(3)(4).
diminished the negative effects of central attack because an attacked registration could be converted into a separate national registration with an effective filing date of the original WIPO application's filing date. Finally, it designated French and English as the official languages.

Anticipating ratification of the Madrid Protocol, Congress introduced implementing legislation. Initially, this legislation received wide support from the Clinton Administration, Congress, and the domestic trademark and intellectual property associations. Unexpectedly, the Administration withdrew its support because of the Madrid Protocol provisions relating to the intergovernmental organizations and their voting rights. However, the Administration had "no problem with the substance of the treaty beyond these issues."

The House of Representatives passed the implementing legislation on October 3, 1994, but before passing this legislation, the House of

89. Id. art. 8(7)(a).


91. Madrid Protocol, supra note 83, art. 14 (requiring four instruments of ratification, one of which must be from a Madrid Union member).


Under the terms of the Protocol, members may be countries or, under certain conditions, intergovernmental organizations with regional trademark offices. These organizations would receive a vote in the assembly of the members in addition to votes exercised by the member states of the organization. They would also be counted towards the members needed for the Protocol to enter into force, in addition to their member states. Finally, there is no provision for the intergovernmental organization to make a declaration of its competence. The United States does not accept such an expansion of the role of intergovernmental organizations and their members. In other agreements, we consistently have insisted on safeguard provisions to prevent concurrent voting and double counting, and on a declaration of competence.

The Administration recognized the problems when giving its endorsement, but, at that time, viewed it as "an exception to the general obligations . . . problems were outweighed by the benefits of the agreement. But the EU recently has been citing the Madrid Protocol as precedent for similar voting rights in the negotiations on the TLT and the Hague Agreement on Industrial Designs." U.S. Will Not Join Madrid Protocol on International Trademarks, 48 Pat. Trademark & Copyright J. (BNA) No. 1180, at 81-82 (May 19, 1994) (describing the Journal's conversation with Attorney Advisor Carlisle Walters from PTO's Office of Legislation and International Affairs).

95. Id. at 82.
Representatives took into consideration the Administration's position. The House of Representatives amended the legislation (H.R. 2129) with the following new language on the effective date: "Subject to satisfactory resolution of the issues relating to voting rights of Member nations under the Madrid Protocol, this Act shall take effect on the date on which the Madrid Protocol enters into force with respect to the United States."

The Madrid Protocol has not entered into force because only Spain has ratified it to date. The history of the Madrid Agreement, the Trademark Registration Treaty, and the Madrid Protocol evidences the desire for an international centralized filing and registration system, but prove that desire is not enough. Although the global village existed when the WIPO began its negotiations which resulted in the Madrid Protocol, the international trademark community refused to recognize the global village.

**H. The General Agreement on Tariffs and Trade (GATT 94)**

1. A Brief History

The words, "The General Agreement on Tariffs and Trade," or "GATT," belong to a multilateral trade agreement concluded in October 1947 between 23 developed and undeveloped countries (GATT 47). This occurred immediately after World War II, a time when most agreed that economic recovery depended on restoring and expanding former levels of international trade. However, the war left two major barriers: high...
The GATT 47 provided a means to substantially reduce tariffs and limit the right to use other trade restrictions. In addition, it established five basic principles which continue to evolve: the most favored nation principle, the national treatment principle, the tariff concession principle, principle against nontariff barriers, and the fair trade principle.

Since GATT 47, seven additional rounds of negotiation have occurred: Annecy (1949), Tourquay (1950), Geneva (1956), Dillon (1961), Kennedy (1962-67), Tokyo (1973-79), and Uruguay (1986-1993). The first five rounds concentrated on reducing tariff barriers to trade in goods. The sixth round, the Tokyo Round Codes, focused on reforming dispute resolution and reducing non-tariff barriers to trade in goods, including regulatory measures to deal with counterfeit goods. This was the first time a GATT round discussed trademark rights, although it was only in the context of controlling infringement of trademark rights.

The Tokyo Round permitted member countries to approve separate Codes, and they were bound only by the Codes they signed and approved. The Uruguay Round (GATT 94) departed from the first six


100. Id.
102. See Marshall A. Leaffer, Protecting United States Intellectual Property Abroad: Toward a New Multilateralism, 76 IOWA L. REV. 273, 299 (1991) (enumerating and explaining GATT's basic principles, citing GATT's article numbers); John W. Head, Making International Trade Less Foreign: A "Nutschell" for NonSpecialists on the Changing Rules Governing International Trade, J. KAN. B. ASS'N 42, 43 (1992) (enumerating and explaining GATT's basic principles, citing GATT's article numbers). Since this Article focuses on trademark protection in international trade, the author relies on Leaffer's explanations for the principles that do not relate to trademark protection; and, for those principles that do relate, they are explained throughout this Article.
103. See HUDEC, supra note 99, at 3-273; see also JOHN H. JACKSON, RESTRUCTURING THE GATT SYSTEM 37 (1990).
106. Id.
rounds because it included an intellectual property annex\textsuperscript{108} and established the World Trade Organization (WTO)\textsuperscript{109} among other initiatives.\textsuperscript{110} In addition, it was an "all or nothing" agreement, meaning that a signatory had to agree to the entire agreement with its annexes and be bound by it, or not be a member country.\textsuperscript{111} Could this mean the GATT 94 signatories recognize our global village and will embrace it by promoting global harmonization of national trademarks laws and centralization of filing and registration?

2. Trademark Protection in GATT 94: The TRIPS

"I gavel the Uruguay Round has concluded . . . . Today, the world has chosen openness and cooperation instead of uncertainty and conflict. This is a success that will reinforce economic growth," declared GATT's Director General Peter Sutherland to the representatives from the 117 member countries in Punta del Este, Uruguay, on December 15, 1993.\textsuperscript{112} Although the Uruguay Round took seven years to complete, and "at times seemed more likely to reveal the irreconcilable trade rivalries of the post-cold war world than its determination to pursue a quest for freer trade, lower tariffs and greater economic cooperation," it resulted in GATT 94 "provid[ing] the basis for global economic growth and cohesion into the 21st century."\textsuperscript{113} Since GATT 94 now exists, and the United States recently enacted implementing legislation,\textsuperscript{114} this section analyzes


\textsuperscript{109} Agreement Establishing the World Trade Organization, approved April 15, 1994, 11 Int'l Trade Rep. (BNA) No. 16, at 636 (Apr. 20, 1994) [hereinafter WTO]. "The WTO shall provide the common institutional framework for the conduct of trade relations among its Members . . . ." \textit{Id.} Art. II(1). GATT struggled for almost one-half of a century without a formal organization, but the WTO now exists to administer GATT 94.

\textsuperscript{110} Other innovative initiatives in GATT 94 include the Trade-Related Aspects of Investment Measures (TRIMS), Trade in Services, and the Dispute Settlement Understanding.

\textsuperscript{111} \textit{See} Lowenfeld, \textit{supra} note 99, at 478-79; \textit{The GATT Lady Sings: What the New WTO Will Mean for the U.S. and World Trade}, 11 Int'l Trade Rep. (BNA) No. 15, at 595 (Apr. 13, 1994) (quoting John H. Jackson, a scholar in GATT, "[n]o longer will the Tokyo Round approach of side codes--resulting in 'GATT a la carte'--be the norm," but rather WTO will reinforce "single package" idea that country must accept all Uruguay Round agreements annexed to WTO, with few exceptions, or nothing at all).


\textsuperscript{113} \textit{Id.}

\textsuperscript{114} Uruguay Round Agreements Act, Pub. L. No. 103-465, 108 Stat. 4809 (1994) [hereinafter URAA]. The URAA was enacted under the "fast-track" mechanism for trade agreements, which mandates Congress to approve or reject the entire implementing legislation
only the TRIPS agreement. It does not discuss the negotiations after the Tokyo Round leading to the Uruguay Round and the inclusion of intellectual property into GATT 94.\textsuperscript{115}

“The TRIPS agreement establishes substantially higher standards of protection for a full range of intellectual property rights that are embodied in current international agreements, and provides for the effective enforcement of those standards both internally and at the border.”\textsuperscript{116} The TRIPS consists of a preamble\textsuperscript{117} and seven parts, divided into a total of 73 articles.\textsuperscript{118} Although TRIPS covers seven forms of intellectual property, this Article addresses only trademarks. First, it

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\textsuperscript{116} Intellectual Property Rights, Trade Information Center and GATT Uruguay Round, U.S. Dep't Com. (Dec. 10, 1993); see also TRIPS, supra note 108. With few exceptions (and none related to trademarks), the TRIPS obtained its aims: “establishing adequate minimum standards for the protection of intellectual property rights; ensuring availability of effective procedures, internally and at the border, for enforcing those rights; and taking advantage of the procedures in the GATT for the settlement of disputes regarding the Members' obligations to establish the minimum standards and the enforcement procedures.” \textit{Id.} Carlisle E. Walters, \textit{Multilateral Trademark issues Affecting the United States}, 367 Prac. Law Inst./Pat. 67 (1993).

\textsuperscript{117} TRIPS, supra note 108. The Preamble sets forth the TRIPS' purpose “to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade . . . .” \textit{Id.}

\textsuperscript{118} TRIPS, supra note 108.
discusses the articles relevant to trademarks. Then, it analyzes whether the GATT 94 signatories recognized the global village and embraced it through global harmonization of national trademark laws and centralization of trademark filing and registration.

Articles 15-21 establish the minimum standards for protecting trademarks in member countries. Other articles provide support for and enforcement of Articles 15-21.

Article 15 delineates the subject matter capable of constituting a registered trademark. Such subject matter consists of any signs, including personal names, letters, numerals, figurative elements and color combinations or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings. Even if a sign possesses no inherent capability to distinguish the relevant goods or services, it may still be registered based on distinctiveness acquired through use. A member country may condition registration on a trademark's visual perceptibility. In addition, registration may be conditioned on use, but filing may not be conditioned on actual use. An application must not be refused solely on the basis that the intended use has not occurred within three years from the date of filing the application. In addition, the nature of the goods and services connected with the trademark must not be an obstacle to registration. A trademark must be published before registration or promptly thereafter, and other member countries must be afforded a reasonable opportunity for cancellation. Member countries may also be afforded an opportunity to oppose registration. Finally, a member country may deny registration on grounds other than those in Article 15(1), providing such grounds do not derogate from the Paris Convention.

Article 16 confers to a registered trademark owner exclusive right to prevent all unauthorized third parties from using, in the course of trade, a sign affixed to identical or similar goods or services as those goods or services connected with an owner's registered trademark, if such use

119. Id. art. 15(1).
120. Id.
121. Id.
122. Id. art. 15(3).
123. TRIPS, supra note 108.
124. Id. art. 15(4).
125. Id. art. 15(5).
126. Id.
127. Id. art. 15(2); Paris Convention, supra note 20.
would result in a likelihood of confusion. However, this exclusive right must not prejudice any existing prior rights, nor affect a member country from extending rights based on use. In addition, Article 16 expands the protection offered to well-known marks under Article 6bis of the Paris Convention. When determining if a trademark is well-known, knowledge of that trademark in the relevant public sector must be considered; this includes knowledge obtained from the trademark's promotion which may include any promotion in international trade. This also applies to a sign affixed to goods or services, even if the goods or services are not similar to the goods or services connected to a registered trademark, if such use would indicate a connection with a registered trademark that is likely to damage the registered trademark owner’s interest.

Article 17 allows a member country to provide limited exceptions to the trademark rights. However, before permitting any exceptions, the legitimate interests of the trademark owner and third parties must be considered.

Article 18 requires a minimum term of seven years for an initial trademark registration, which shall be renewable indefinitely. Like the initial registration term, each renewal term must be at least seven years.

Article 19 explains that when a member country requires use of the trademark to maintain registration, the registration may be cancelled only after non-use for at least three continuous years, unless the trademark owner can show a valid reason for non-use. The use of a trademark by a third person, subject to the owner's control, must be recognized as a use for maintaining the registration.

Article 20 prohibits special requirements which cause an unjustifiable encumbrance upon the use of a trademark in the course of

128. TRIPS, supra note 108, art. 16(1). A presumption in favor of likelihood of confusion exists, if a sign appears to be identical to the registered trademark. Id.
129. Id.
130. Id. art. 16(2)(3); Paris Convention, supra note 20, art. 6.
131. TRIPS, supra note 108, art. 16(2).
132. Id. art. 16(3).
133. Id. art. 17 (fair use of descriptive terms constitutes a limited exception).
134. Id. art. 18.
135. Id.
136. TRIPS, supra note 108, art. 19(1). Circumstances beyond the owner’s control creating an obstacle to use, such as import restrictions on or other government requirements for goods or services protected by a trademark, constitute a valid reason. Id.
137. Id. art. 19(2).
trade. However, this does not preclude requiring a trademark to identify the undertaking producing the goods or services along with, but without linking it to, the trademark distinguishing the specific goods or services in question of that undertaking.138

Article 21 allows member countries to determine conditions on trademark assignment and licensing. At the same time, it prohibits requiring compulsory licensing and requiring the transfer of the business when assigning its trademark.139

In addition, TRIPS provides trademark protection similar to those sections of the Lanham Act addressing filing and prosecution of trademark applications by the United States Trademark office.140 The TRIPS also supports the status quo controlled by territoriality, which allowed President Clinton to sign GATT 94 without considering the need for global harmonization of national trademark laws or the viability of a centralized trademark filing and registration system. Furthermore, TRIPS requires member countries to comply with Articles 1-12 and 19 of the Paris Convention141 which do not harmonize national trademark laws.142

However, TRIPS does evidence a desire to establish international standards for trademark rights and obligations by the 117 countries who signed GATT 94 in Marrakesh, Morocco, on April 15, 1994. These countries agreed to implement national legislation to meet TRIPS' minimum standards for trademark rights and obligations. For some member countries, such implementation involves a measurable change in policy. Most developing and least-developed member countries possess inadequate national trademark laws, and some possess no national trademark laws. This implementation of national trademark laws in the

138. Id. art. 20. Requiring a trademark’s use in a special form or in a manner detrimental to its capability to distinguish goods or services of one undertaking from those of other undertakings constitute special requirements, which are prohibited, encumbering unjustifiably the trademark’s use. Id.

139. Id. art. 21. See 15 U.S.C. § 1060 (1994). See also Walters, supra note 116. The transfer of a business may be distinguished from the goodwill associated with the trademark. This distinction is relevant, as some countries, including the United States, do not require a valid trademark assignment to include the transfer of the business with the trademark but do require a transfer of “the goodwill of the business connected with the use of and symbolized by the [trade]mark.” Id.


141. TRIPS, supra note 108, art. 2(1)(2) (prohibiting any trademark provision in TRIPS from derogating the existing obligations which member countries may have to each other under the Paris Convention); Paris Convention, supra note 20, arts. 1-12, 19.

142. See supra text accompanying notes 11-18.
developing and least-developed member countries constitutes what could be the beginning of global harmonization and centralization.

In order to accomplish this beginning, TRIPS addresses the concerns of the developing and least-developed member countries by providing transitional arrangements that entitle developing and least-developed countries to delay implementing TRIPS for four years beyond the one year extended to the developed countries, except for Articles 3 (national treatment), 4 (most favored nation treatment), and 5 (multilateral agreements on acquisition or maintenance of protection) of Part I which must be implemented within one year. In addition, the provisions for patent protection of pharmaceutical and agricultural products are extended an additional nine years.\textsuperscript{143} The transitional arrangements also require that the developed countries provide technical and financial cooperation to the developing and least-developed countries.\textsuperscript{144} Further, a Council for TRIPS must be established to monitor the operation of TRIPS and implement cooperation with the WIPO.\textsuperscript{145} International cooperation, including the exchange of information, must be instituted to eliminate international trade in counterfeit goods which infringes trademark rights.\textsuperscript{146} Finally, TRIPS provides the registered trademark owner with specific civil and criminal procedures for enforcement of trademark rights within each country and at each country's borders.\textsuperscript{147} However, TRIPS lacks a global centralized trademark filing and registration system. The author argues such a system would provide the basis for information exchange, and without such basis, enforcement would be difficult if not impossible.

I. The Trademark Law Treaty, 1994 (TLT)

The most recent effort to harmonize national trademark laws and to create a centralized global trademark and registration system resulted in the Trademark Law Treaty (TLT). However, the TLT does not provide any harmonization or centralization, but it does establish common procedures for national trademark filing and registration, and creates

\textsuperscript{143} TRIPS, supra note 108, arts. 65-66. See, e.g., Meltzer, supra note 115, at 30. This view demonstrates the United States approved GATT 94 due to what it perceived as protecting its sovereignty rather than viewing the world as a global village. If the United States recognized and embraced the global village, it would advocate the need to grant developing and least-developed member countries additional time to conform their legal systems to TRIPS.

\textsuperscript{144} TRIPS, supra note 108, art. 67.

\textsuperscript{145} Id. arts. 68, 71 (requiring Council for TRIPS to review implementation of TRIPS five years after agreement establishing WTO entered into force).

\textsuperscript{146} Id. art. 69.

\textsuperscript{147} Id. arts. 41-61.
standardized international application forms which all trademark offices must accept.\(^{148}\) The WIPO\(^ {149}\) initiated the TLT discussions following the lack of participation in the TRT\(^ {150}\) and the Madrid Protocol.\(^ {151}\) Anticipating an increase in international trademark application filings,\(^ {152}\) the WIPO convened six sessions of its Committee of Experts on the Harmonization of Laws for the Protection of Marks (CEHLPM) to discuss a draft trademark harmonization treaty.\(^ {153}\)

At the first session, in 1989, the CEHLPM discussed harmonization of substantive trademark law.\(^ {154}\) Harmonization also dominated the discussion at the second session but proved too controversial.\(^ {155}\) Since the CEHLPM participants maintained their protectionist attitudes, refusing to discuss seriously global harmonization of national trademark laws or even a centralized trademark filing and registration system, the remaining sessions ignored substantive trademark law.\(^ {156}\) These sessions focused on a draft trademark treaty prepared by the WIPO’s International Bureau, which addressed only administrative and procedural matters, including implementing regulations and model international forms for filing and registration.\(^ {157}\)

148. See TLT, supra note 12.
149. See WIPO, supra note 67.
150. See TRT, supra note 76.
151. See Madrid Protocol, supra note 83; see also infra p. 151. Although the United States did not join the Madrid Protocol, it recognized the importance of an international trademark filing and registration system, and, thus, it committed to joining such a system if the system provided safeguard provisions including voting rights. See State Dep’t Announcement That U.S. Will Not Join Madrid Protocol, supra note 94.
152. See Browning, supra note 3, at 352.
153. See Walters, supra note 116.
155. See, e.g., Hearings, supra note 84 (supporting attempt to first harmonize current trademark formalities rather than substantive law because difficult to harmonize different national trademark laws); Samuels & Samuels, supra note 10, at 437-38 (describing participants’ lack of hope in reconciling substantial differences in world trademark law); Walters, supra note 116 (explaining that the United States expressed interest in a trademark harmonization treaty to create business certainty and uniformity in obtaining international trademark protection but emphasized that the treaty must recognize United States trademark law, including use-based rights, and allow United States to enact substantive trademark law); Louis T. Pirkey, Treaty Would Harmonize Many Trademark Laws, NAT’L LAW J., Oct. 31, 1994, at C17.
156. See id.
157. See Walters, supra note 116.
On October 10, 1994, the WIPO’s Diplomatic Conference for the Conclusion of the TLT occurred in Geneva. Ninety-seven countries and intergovernmental organizations, and twenty non-governmental organizations\(^5\) attended and discussed the CEHLPM draft treaty.\(^6\) On October 27, 1994, the Conference adopted the TLT.\(^7\) The 117 countries and international organizations signed the “Act of Presence” which concluded the Conference; thirty-five countries, including the United States, signed the TLT, which opened for signature on October 28, 1994, for one year.\(^8\) The WIPO member countries and certain intergovernmental organizations may join the TLT even if they are not a member of the Paris Convention.\(^9\)

The TLT contains twenty-five articles\(^10\) and regulations consisting of eight rules\(^11\) and eight model international forms.\(^12\) It applies to “marks consisting of visible signs, provided that only those Contracting Parties which accept for registration three-dimensional marks shall be obliged to apply this Treaty to such marks,”\(^13\) and to “marks relating to goods (trademarks) or services (service marks) or both goods and services.”\(^14\)

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158. See WIPO, supra note 66, at 2. “The participation of non-governmental organizations in the preparatory meetings and in the Diplomatic Conference ensured that the views of the users of the trademark system were taken into account.” Id.

159. See id.

160. See State Dep’t Announcement That U.S. Will Not Join Madrid Protocol, supra note 94 and accompanying text. Only one obstacle occurred having the potential to kill the TLT: the European Union (EU) demand of the same voting rights it received in the Madrid Protocol. (These voting rights resulted in the United States refusing to sign the Madrid Protocol.) See U.S., 96 Other WIPO Members Conclude International TLT, 49 Pat. Trademark & Copyright (BNA) No. 1203, at 22 (Nov. 10, 1994). The EU claimed it was entitled to its own separate vote since trademark applications may be filed both with national patent offices in the EU member states and through the recently established European Harmonization Office for the (European) Internal Market. Id. The United States opposed such a separate EU vote throughout the negotiations and at the Diplomatic Conference. Unlike the negotiations for the Madrid Protocol, the WIPO officials reached a compromised solution. The TLT eliminated the “Assembly” of member countries, avoiding the need of voting procedures since any voting would be through the WIPO’s General Assembly. Id.

161. See Diplomatic Conference Adopts TLT, supra note 154.

162. See id. at 2; U.S., 96 Other WIPO Member Conclude International TLT, supra note 160, at 23 (explaining that the TRIPS agreement bound all GATT 94 signatories to Paris Convention, and most GATT 94 signatories belong to WIPO, so not requiring membership in Paris Convention lacks any diplomatic significance).

163. See TLT, supra note 12.

151. See id.

165. See id.

166. See id. art. 2(1)(a).

167. See id. art. 2(2)(a).
However, it does not apply to "hologram marks and to marks not consisting of visible signs, in particular, sound marks and olfactory marks," nor does it apply to "collective marks, certification marks and guarantee marks." The TLT establishes maximum procedural requirements which a member country may impose prior to granting an application filing date, a trademark registration, or recording an assignment or license. The United States Patent and Trademark Office is drafting proposed legislation to implement the TLT which will cause only procedural changes to United States trademark law since the TLT contains no substantive trademark law provisions. The major United States trademark organizations, including the International Trademark Association, trademark owners, and bar associations, support the TLT which has no substantial opposition.

Although the TLT provides no global harmonization of national trademark laws or centralization of trademark filing and registration, the author argues that the TLT constitutes a step towards global harmonization and centralization. First, an exchange of ideas must occur for the international trademark community to recognize the global village and to move toward it. The TLT has encouraged such an exchange of ideas. Although the participants decided global harmonization of national trademark law was not feasible at that time, they continued their discussions until a common procedure and application for trademark filing and registration was developed and approved. The TLT emerged as the treaty evidencing these discussions.

"[The TLT] will have a clearly positive economic impact in a global economic environment in which trademarks become increasingly important." The numbers of registered trademarks are staggering. The WIPO has handled over three hundred thousand actual trademark registrations, and has estimated seven million national trademarks are registered worldwide, including numerous duplications for registrations in

168. See TLT, supra note 12, art. 2(1)(b).
169. See id. art. 2(2)(b).
170. See id. art. 3(7); Walters, supra note 116.
171. Telephone Interview with Andrew D. Lawrence, Attorney-Advisor, P.T.O., U.S. Dep't Com. (Jan. 4, 1995) (explaining proposed legislation implementing the TLT will simplify filing and registration application). See also Samuels & Samuels, supra note 10, at 439-40 (analyzing draft TLT and its effect on United States trademark law); Pirkey, supra note 155 (analyzing draft TLT and its effect on United States trademark law).
172. See Hearings, supra note 84.
173. See Pirkey, supra note 155, at C18.
174. See supra note 155.
different countries.\textsuperscript{175} When considering the number of registrations and the important differences in relevant national trademark law throughout the world, the TLT constitutes an important step in unifying the international trademark community toward global harmonization and centralization. Furthermore, the TLT shows that compromise can solve differences when the participants want to proceed toward embracing the global village.

III. IMPLEMENTATION OF TRADEMARK PROTECTION IN THE GLOBAL VILLAGE

In 1995, multilateral, regional, and bilateral agreements provide the medium for acquisition and maintenance of trademark rights and obligations in the global village. Part Three discusses the role of this medium in implementing trademark protection through global harmonization of national trademark laws and centralization of trademark filing and registration.

A. Multilateral Implementation: Council for TRIPS and WIPO

The global village demands multilateral implementation of trademark rights and obligations. Once the international trademark community recognizes and embraces the global village, the need for multilateral implementation becomes self-evident. Both the WIPO\textsuperscript{176} and the Council for TRIPS\textsuperscript{177} may negotiate global harmonization and centralization. This section analyzes whether the WIPO or the Council for TRIPS, or both, should initiate such negotiation.

As previously discussed, the WIPO functions as a specialized United Nations' agency, administering numerous agreements with trademark rights and obligations. If the Council for TRIPS did not exist, the WIPO would provide the primary medium to negotiate global harmonization and centralization.\textsuperscript{178} However, the Council for TRIPS does exist; and, it exists, in part, because the WIPO conceded jurisdiction of intellectual property rights to the Uruguay Round.\textsuperscript{179}

\textsuperscript{175} U.S., 96 Other WIPO Members Conclude International TLT, supra note 162, at 24.
\textsuperscript{176} See supra p. 79.
\textsuperscript{177} See supra note 18 and accompanying text.
\textsuperscript{178} See supra pp. 79-81.
\textsuperscript{179} See Cordray, supra note 26, at 141. The developing countries argued GATT lacked jurisdiction over intellectual property rights because Article 18 of the Paris Convention required any improvement in intellectual property be made through revisions of the Paris Convention. However, the WIPO lacks a mandate from its members to revise the Paris Convention and, further, has no funding, so it refuses to revise the Paris Convention, or increase its enforcement. \textit{Id}. Thus, the TRIPS agreement became part of GATT 94, and falls within the scope of Article
Article 68 of TRIPS authorizes the member countries to assign to the Council for TRIPS the responsibility to negotiate global harmonization and centralization:

The Council for TRIPS shall monitor the operation of this Agreement and, in particular, Members' compliance with their obligations hereunder, and shall afford Members the opportunity of consulting on matters relating to the trade-related aspects of intellectual property rights. It shall carry out such other responsibilities as assigned to it by the Members, and it shall, in particular, provide any assistance requested by them in the context of dispute settlement procedures. In carrying out its functions, the Council for TRIPS may consult with and seek information from any source it deems appropriate. In consultation with WIPO, the Council shall seek to establish, within one year of its first meeting, appropriate arrangements for cooperation with WIPO.¹⁸⁰

No substantial discussion occurred at the Uruguay Round regarding global harmonization¹⁸¹ and centralization with respect to trademarks. However, TRIPS provides that "[i]n order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system."¹⁸² The author argues this provision can be extended to include a notification and registration system for trademarks,¹⁸³ but without harmonization of national trademark laws because such a system would

¹⁸⁰ See supra note 18.

¹⁸¹ The TRIPS establishes minimum standards, not harmonization. See TRIPS, supra note 108.

¹⁸² See TRIPS, supra note 108, art. 23(4).

¹⁸³ Author argues that an extension of Article 23(4) of TRIPS to trademarks does not conflict with Article 62(1), which allows member countries to require "as a condition of the acquisition or maintenance of the intellectual property rights provided under Sections 2 through 6 of Part II, compliance with reasonable procedures and formalities. Such procedures and formalities shall be consistent with the provisions of this Agreement." See TRIPS, supra note 108, art. 62(1).
lack effectiveness. The author further argues the Council for TRIPS must take charge and be the dominating force to propel global harmonization and centralization because unlike the WIPO, TRIPS provides enforcement for trademark rights and obligations. This enforcement will occur through the WTO's dispute settlement mechanism.\footnote{184. See WTO, supra note 109.}

In addition, the WTO provides the institutional framework needed for global harmonization and centralization. As the Ministers declared in Marrakesh, Morocco, on April 15, 1994, when accepting and acceding to GATT 94:

\begin{quote}
[T]he establishment of the World Trade Organization (WTO) ushers in a new era of global economic cooperation, reflecting the widespread desire to operate in a fairer and more open multilateral trading system for the benefit and welfare of their peoples. Ministers express their determination to resist protectionist pressures of all kinds. They believe that the trade liberalization and strengthened rules achieved in the Uruguay Round will lead to a progressively more open world trading environment.
\end{quote}

 Ministers welcome the fact that participation in the Uruguay Round was considerably wider than in any previous multilateral trade negotiation and, in particular, that developing countries played a notably active role in it. This has marked a historic step towards a more balanced and integrated global trade partnership. Ministers note that during the period these negotiations were underway significant measures of economic reform and autonomous trade liberalization were implemented in many developing countries and formerly centrally planned economies.\footnote{186. Marrakesh Ministerial Declaration, April 15, 1994, 33 I.L.M. 1263, 1264.}

However, the Council for TRIPS must not ignore the WIPO, because Article 68 of the TRIPS requires the Council for TRIPS to establish appropriate arrangements for cooperation with the WIPO, and the WIPO possesses a tremendous amount of expertise in international trademark law, both procedurally and substantively. The WIPO's main

\footnote{185. See TRIPS, supra note 108, arts. 64, 68.}
activity, which occupies two-thirds of its 450 staff, involves registration of patents, trademarks, industrial designs, and appellations of origin rather than negotiation. In addition, the WIPO offers technical assistance to its member countries on drafting intellectual property legislation and managing their offices. Thus, the Council for TRIPS should propose a working arrangement with the WIPO, which allows it to take advantage of the WIPO's skill and expertise, especially in light of the TRIPS' lack of staff and the controversial issues involved in implementing global harmonization and centralization.

The ideal situation would be for the United Nations to transfer its jurisdiction over the WIPO to GATT 94, but the author does not advocate considering such a transfer until the Council for TRIPS proves its worth as a global protector of trademark rights and obligations. For the present, the author advocates the Council for TRIPS establishes with the WIPO a respectful, working relationship in which they recognize and embrace the global village and initiate the negotiation of global harmonization of national trademark laws and centralization of trademark filing and registration.

B. Regional and Bilateral Implementation

Since the end of World War II, the United States relied primarily on GATT to establish international trade policy. Except in rare cases, the United States viewed bilateral and regional agreements as, at best,


188. *Id.*

189. *Id.* (explaining TRIPS currently operates with a staff of one and a half persons).

190. Issues encountered in implementing global harmonization of national trademark laws and centralization of filing and registration are as follows: defining trademark and trademark protection; protecting prior vested rights; priority of rights; status of regional, national, and local trademarks; limited amount of words for trademark use; use, bona fide intent to use, or non-use requirements to file and/or register; concurrent use; secondary meaning; unfair and deceptive trade practices; abandonment; dilution; opposition; cancellation; confusion; review of refusal to register; counterfeiting; gray markets; parallel markets; anti-trust violations; territoriality; licensing and distribution rights; differing views of developed and developing countries; enforcing rights including multilateral, regional, and unilateral sanctions; effect of technological advances for computerized searching, filing, and registering. *See Harmonization (Uniform Systems),* 82 TRADEMARK REP. 912 (1992) (listing numerous issues but not TRIPS); *see also Centralization (Unified System),* 82 TRADEMARK REP. 919 (1992) (listing numerous issues but not TRIPS); *Effect of National and International Trademark Offices Granting and/or Recording Rights,* 82 TRADEMARK REP. 944 (1992) (listing numerous issues but not TRIPS); *Trademark Counterfeiting,* 82 TRADEMARK REP. 969 (1992).

191. This article uses the term “bilateral agreement” when two countries are parties to the agreement; “regional agreement” when more than two countries are parties to the agreement and
ineffective, and at worst, a serious threat to GATT members' commitment to the multilateral process. However by the mid-1980's, the government began to challenge this conventional position as causing, in part, its trade deficit.

The passage of the Canada-United States Free Trade Agreement helped to support the challenge against the conventional position. In addition, with the passage of the North American Free Trade Agreement and the signing of the Summit of the Americas Declaration of Principles and the Plan of Action (Summit DOP/POA), the conventional position crumbled. Regional integration emerged as the United States' new

all parties are within the same hemisphere; and "multilateral agreement" when more than two countries are parties to the agreement and at least two of the parties are located in different hemispheres.

192. The United States perceived bilateral and regional agreements as jeopardizing GATT's most favoured nation principle. Article 4 of the TRIPS defines most-favoured-nation.

With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members. Exempted from this obligation are any advantage, favour, privilege or immunity accorded by a Member: (a) deriving from international agreements on judicial assistance and law enforcement of a general nature and not particularly confined to the protection of intellectual property; (b) granted in accordance with the provisions of the Berne Convention (1971) or the Rome Convention authorizing that the treatment accorded by a function not of national treatment but of the treatment accorded in another country; (c) in respect of the rights of performers, producers of phonograms and broadcasting organizations not provided under this Agreement; and (d) deriving from international agreements related to the protection of intellectual property which entered into force prior to the entry into force of the Agreement Establishing the WTO, provided that such agreements are notified to the Council for [TRIPS] and do not constitute an arbitrary or unjustifiable discrimination against nationals of other Members.


197. Christopher P. Lion, Regional Trade Arrangements in the Western Hemisphere, BUS. AM., Dec. 1994, at 17. Regional integration occurs through a free trade area, customs union, or common market: customs unions ("the CU") eliminate trade barriers between member countries while maintaining them with third countries not participating in the agreement, and they maintain
These regional agreements support GATT. They pose no threat to GATT since they constitute GATT-consistent agreements. They require their provisions to be interpreted consistent with GATT's provisions. In addition, most of these agreements include intellectual property rights and obligations, which, at least, meet TRIPS' minimum standards, or a higher standard.

Such agreements promote a dialogue on international trademark protection, and further, they encourage countries to address trademark rights and obligations in international trade. They provide an additional medium for understanding not only international trademark issues but also the global village. The author argues a GATT-consistent bilateral or regional agreement, which provides strong trademark protection, constitutes a viable medium to encourage the Council for TRIPS to work toward global harmonization of national trademark laws and centralization of trademark filing and registration.

-specific information-

common external tariff (CET) nomenclature and rates for third countries; free trade areas ("the FTA") also eliminate trade barriers between member countries while maintaining them with third countries not participating in the agreement, but they maintain their own tariffs; and a common market provides for harmonization of fiscal and monetary policies, but the CU and FTA do not provide such harmonization.

198. However, the concept of regional integration is not new. Many years ago, Europe embraced regional integration, and formed the European Union ("the EU"), formally the European Community. The EU regulates trade within the borders of its member countries; its regulation includes trademark rights and obligations. In 1988, the EU began trademark harmonization in earnest with a harmonizing directive. First Council Directive to Approximate the Laws of the Member States Relating to Trademarks, Dec. 21, 1988, O.J. EUR. COMM. (No. C 104) [hereinafter "Harmonizing Directive"]. See also James E. Rosini & Christopher C. Roche, Trademarks in Europe 1992 and Beyond, 19 AM. INT'L PROP. L. ASS'N Q.J. (1991).

For additional information on bilateral and regional agreements the author refers the reader to an in-depth article written by C.A. Primo Braga and Alexander J. Yeats, which provides an analysis of "minilateral and managed" trade throughout the world, listing statistics and the major bilateral and regional trade agreements. See C.A. Primo Braga & Alexander J. Yeats, Minilateral and Managed Trade in the Post-Uruguay Round World, 3 MINN. J. GLOBAL TRADE 213 (1994).

199. See, e.g., Summit DOP/POA, supra note 183, at 12.

IV. Conclusion

In the global village, trademarks constitute valuable business assets, but they lack the protection valuable business assets customarily receive. The GATT 94 and, in particular, TRIPS, provide hope that adequate global protection can be provided for trademarks. However, such protection will evade the global village until the Council for TRIPS works in conjunction with the WIPO to harmonize national trademark laws and creates a centralized filing and registration system.

The international trademark community must take an active role in their own governments to ensure global trademark protection. GATT-consistent bilateral and regional agreements, which address trademark protection, serve as impetuses to the Council for TRIPS to work toward global trademark harmonization and centralization. In addition, all people and their governments must abandon yesterday’s ideas of protectionism in favor of today’s global village. Then, and only then, will trademarks receive adequate global protection.