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Harmonizing famous trademark protection: brand dilution and recognition under trips and the madrid protocol

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ABSTRACT

This article examines whether the interaction between the TRIPS Agreement and the Madrid Protocol provides coherent international protection for well-known marks against dilution. The study uses normative doctrinal research and comparative document analysis. The corpus comprises six primary instruments and guidance texts - the Paris Convention, the TRIPS Agreement, the Madrid Protocol, the Regulations under the Protocol, the WIPO Joint Recommendation on Well-Known Marks, and the WIPO Madrid Guide - together with fifteen scholarly sources selected from official, publisher, and institutional repositories. Documents were coded according to legal status, fame threshold, scope of protection, treatment of dissimilar goods and services, procedural effect, and enforcement consequence. The analysis finds that TRIPS Article 16(3) establishes a minimum substantive extension for registered well-known marks where use on dissimilar goods or services indicates a connection and is likely to damage the owner's interests, but it does not define blurring, tarnishment, evidentiary thresholds, or remedies. The Madrid Protocol centralizes filing and administration while preserving national examination, refusal, and enforcement; therefore, international registration does not create a unitary substantive right. The WIPO Joint Recommendation supplies more detailed recognition and anti-dilution factors, but it remains non-binding. The principal gap is thus the absence of operational alignment between substantive standards and the administrative registration system. The article proposes a four-part alignment framework: common fame factors, an express and balanced dilution ground, reasoned and interoperable national decisions, and coordinated WTO-WIPO guidance with capacity support. The findings are doctrinal and do not claim uniform national implementation.



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Introduction

Trademarks perform more than a source-identification function in contemporary markets. For globally recognized brands, the mark also concentrates reputation, advertising investment, consumer trust, and licensing value. Digital commerce intensifies the cross-border circulation of signs and branded content, while trademark rights remain territorially granted and enforced. This structural mismatch makes well-known marks vulnerable to uses that may not confuse consumers about immediate commercial origin but may weaken distinctiveness, damage reputation, or appropriate the attraction of the mark. The classic account of dilution described this harm as the gradual whittling away of a mark's uniqueness (Schechter, 1927). Later

scholarship has shown, however, that dilution is not a single, universally accepted concept; it may refer to blurring, tarnishment, or unfair free-riding, and each formulation raises different evidentiary and competition concerns (Beebe, 2006; Franklyn, 2004; Senftleben, 2009).

International trademark law addresses this problem through instruments with different legal functions. Article 6bis of the Paris Convention requires protection of well-known marks against conflicting marks for identical or similar goods where confusion is likely. Articles 16(2) and 16(3) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) extend the framework to services and, for registered well-known marks, to dissimilar goods or services when use indicates a connection with the owner and is likely to damage the owner's interests (World Intellectual Property Organization [WIPO], 1967; World Trade Organization [WTO], 1994). These provisions establish binding minimum standards, but they do not define dilution by blurring or tarnishment, prescribe a uniform evidentiary threshold, or create a single international enforcement forum.

The Madrid Protocol performs a different function. It enables an applicant to seek protection in multiple Contracting Parties through a centralized international application and registration process. Yet each designation remains subject to examination, refusal, invalidation, and enforcement under the law of the designated Contracting Party (WIPO, 2007, 2024). The Madrid System therefore reduces administrative transaction costs without converting national trademark rights into a unitary international title. Treating the Protocol as a substantive protection instrument obscures this distinction and can lead to overstated claims about legal harmonization.

A further layer is supplied by the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks. It provides non-exhaustive factors for determining whether a mark is well known and expressly addresses impairment or dilution of distinctive character and unfair advantage. However, the Recommendation is soft law: it guides national authorities but does not eliminate domestic discretion (WIPO, 2000). The international architecture is therefore composed of binding substantive minimum standards, a binding administrative registration mechanism, and non-binding interpretive guidance. The central problem is not the total absence of rules, but the lack of operational alignment among these layers.

This article addresses that problem through three research questions: (1) what substantive protection against non-confusing use can be derived from the Paris Convention and TRIPS Articles 16(2) and 16(3); (2) what legal effect does the Madrid Protocol create, and why does that effect not harmonize fame, dilution, or enforcement standards; and (3) what form of international alignment could improve predictability without transforming the Madrid System into an overbroad unitary right? The article contributes by distinguishing substantive harmonization from procedural centralization and by developing an alignment framework grounded in the legal function of each instrument. This distinction is important because harmonization should improve coherence while preserving safeguards for competition, expression, and legitimate descriptive or comparative use under national law and TRIPS Article 17.

Literature Review

Well-known marks, famous marks, and dilution

The expressions "well-known mark" and "famous mark" are often used interchangeably, although they may perform different functions in national systems. International instruments primarily use the term "well-known mark." TRIPS Article 16(2) directs authorities to consider knowledge of the mark in the relevant sector of the public, including knowledge acquired through promotion. The WIPO Joint Recommendation develops this approach through factors such as recognition, duration and geographical extent of use and promotion, registrations, successful enforcement, and associated value. It also states that these factors are guidelines rather than cumulative preconditions (WIPO, 2000). This flexible model avoids requiring universal public recognition, but its open texture leaves room for divergent evidentiary practices.

Dilution differs from ordinary infringement because it may arise without competition between the parties or a likelihood of confusion. Blurring concerns impairment of distinctiveness through repeated association with unrelated sources; tarnishment concerns harmful associations that degrade reputation; and free-riding concerns unfair appropriation of the mark's attractive power. Scholars disagree on whether these interests should be protected through a distinct dilution action, unfair competition, or carefully limited extensions of infringement law (Dogan & Lemley, 2008; Franklyn, 2004; Simon, 2006). The disagreement matters internationally because TRIPS Article 16(3) uses the concepts of connection and likely damage rather than the vocabulary of blurring or tarnishment. It supports protection beyond similar goods and services, but it does not itself settle the conceptual boundaries of dilution.

Substantive harmonization and procedural centralization

TRIPS is a minimum-standards agreement. Its structure combines international obligations with space for national implementation. Dinwoodie and Dreyfuss (2012) describe this relationship as a resilient international framework in which members retain regulatory flexibility. Such flexibility can accommodate legal diversity, but it also produces variation in definitions, burdens of proof, defenses, and remedies. In trademark law, this means that a common treaty obligation may be operationalized through substantially different domestic doctrines.

The Madrid Protocol, by contrast, is designed to coordinate filing and administration. Its practical value is significant, but it does not supply a common test for well-known status or dilution. An international registration functions as a bundle of territorial effects rather than a single supranational right (WIPO, 2024). The literature sometimes discusses TRIPS and Madrid together as elements of an international trademark regime, yet fewer studies isolate the legal consequences of their functional difference. This article uses that difference as the central analytical lens: TRIPS concerns minimum substantive protection, Madrid concerns procedural access, and the WIPO Joint Recommendation supplies non-binding substantive guidance.

Method

This study applies normative doctrinal legal research combined with comparative document analysis. Doctrinal research is appropriate because the research questions concern the content, relationship, and coherence of legal norms rather than behavioral or statistical outcomes. The method identifies authoritative legal texts, interprets their internal structure, and evaluates their interaction within a reasoned normative framework (Hutchinson & Duncan, 2012; Taekema, 2018). The comparative component follows an analytical and structural approach: instruments are compared according to their legal function and the specific problem they regulate, rather than being treated as formally equivalent texts (Van Hoecke, 2015).

The documentary corpus contains six primary materials: (1) Article 6bis of the Paris Convention; (2) Articles 15-17 of the TRIPS Agreement, with particular attention to Article 16; (3) the Madrid Protocol as amended in 2007; (4) the Regulations under the Madrid Protocol in force on November 1, 2025; (5) the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks; and (6) the 2024 WIPO Guide to the Madrid System. Fifteen scholarly sources were retained to explain dilution theory, international intellectual property structure, and legal methodology. Foundational sources before 2000 were included because the modern dilution doctrine originates in Schechter's 1927 analysis; otherwise, priority was given to later scholarship that directly interprets international or comparative trademark protection.

Primary documents were retrieved from the WTO Legal Texts database, WIPO Lex, and WIPO Publications. Secondary literature was identified through publisher and institutional law-review repositories using the terms "well-known trademark," "famous mark," "trademark dilution," "TRIPS Article 16(3)," "Madrid Protocol," "international trademark registration," and "trademark harmonization." The search was completed in July 2026. Sources were included when they: (a) directly analyzed one or more of the selected instruments or dilution concepts; (b) had identifiable authorship and publication data; and (c) were official legal materials, peer-reviewed scholarship, academic books, or established law-review articles. Wikipedia entries, duplicated references, incomplete citations, and sources without a direct connection to the research questions were excluded.

Analysis proceeded in three stages. First, each primary text was interpreted grammatically, systematically, and purposively. Second, relevant provisions were coded in a comparative matrix using six dimensions: legal status, protected subject, fame threshold, scope beyond similar goods and services, procedural effect, and enforcement consequence. Third, the relationship among the instruments was assessed against four criteria: normative clarity, consistency of recognition, procedural interoperability, and enforceability. Findings were triangulated by checking treaty text against official WIPO guidance and scholarly interpretation. The method does not code national legislation or case law and therefore does not support statistical claims about the percentage of jurisdictions that comply with TRIPS.

Table 1 <Documentary corpus and analytical framework>

Component	Operational question	Principal evidence
Substantive minimum standard	What protection is legally required for well-known marks, including use on dissimilar goods or services?	Paris Convention Article 6bis; TRIPS Articles 16(2)-(3)
Recognition standard	Which factors may establish that a mark is well known, and are they mandatory or flexible?	TRIPS Article 16(2); WIPO Joint Recommendation Article 2
Administrative procedure	What does international registration centralize, and which decisions remain national?	Madrid Protocol; 2025 Regulations; WIPO Madrid Guide
Dilution-related harm	Does the instrument address connection, likely damage, impairment, dilution, or unfair advantage?	TRIPS Article 16(3); WIPO Joint Recommendation Article 4
Harmonization assessment	Do the instruments produce normative clarity, consistent recognition, procedural interoperability, and enforceability?	Cross-instrument doctrinal comparison

Results and Discussions

TRIPS provides a substantive extension, but not a complete dilution code

The first finding is that TRIPS Article 16 creates a binding but limited substantive floor. Article 16(2) incorporates Paris Convention Article 6bis for services and requires consideration of knowledge in the relevant sector of the public, including knowledge resulting from promotion. Article 16(3) extends Article 6bis to goods or services that are not similar to those for which the well-known mark is registered, provided that the challenged use indicates a connection with the owner and the owner's interests are likely to be damaged (WTO, 1994). This is a material extension beyond the Paris Convention's confusion-oriented protection for identical or similar goods.

Nevertheless, Article 16(3) should not be described as a complete international anti-dilution statute. It does not use the terms blurring or tarnishment, define the type or degree of likely damage, establish a uniform fame threshold, prescribe evidence, or identify remedies. It is also textually tied to registered well-known marks when protection is sought for dissimilar goods or services. Gervais (2021) and Simon (2006) treat the provision as an international basis for broader protection, but the treaty language still leaves substantial implementation choices to members. The result is a shared minimum obligation without a shared operational test.

This distinction resolves part of the conceptual ambiguity in the original framework. TRIPS addresses a situation associated with dilution - unauthorized use beyond similar goods that exploits or harms a famous mark - but it frames the legal test through connection and likely damage. National laws may implement this obligation through dilution, unfair advantage, reputation-based infringement, or another equivalent doctrine. The treaty therefore harmonizes the protected interest at a general level, while leaving doctrinal form and proof to domestic law.

The WIPO Joint Recommendation supplies detailed guidance, but remains soft law

The second finding is that the WIPO Joint Recommendation fills several textual gaps. Article 2 lists six non-exhaustive categories of evidence: recognition in the relevant sector, duration and geographical extent of use, duration and geographical extent of promotion, registrations and applications, successful enforcement, and value associated with the mark. It clarifies that these factors are not cumulative preconditions and that a state should not require use, registration, or an application in that state as a condition of well-known status (WIPO, 2000). This framework supports flexible recognition of marks that acquire cross-border reputation through advertising, digital media, and international trade.

Article 4 goes further than TRIPS terminology. For conflicts involving any goods or services, it identifies three alternative concerns: a connection likely to damage the owner's interests, unfair impairment or dilution

of distinctive character, and unfair advantage of distinctive character. These formulations separate confusion-related protection from dilution and free-riding. They also respond to the conceptual plurality identified by Senftleben (2009) and Kur and Senftleben (2017). However, the Recommendation was adopted as guidance for member states. Its value lies in interpretive convergence rather than direct enforceability. A national authority may draw on its factors, but an applicant cannot treat the Recommendation as a self-executing source of uniform rights.

The Madrid Protocol centralizes administration, not substantive protection

The third finding is that the Madrid Protocol cannot cure substantive divergence by itself. The System permits a centralized application, formal examination by the International Bureau, international registration, and notification to designated Contracting Parties. The legal effect of a designation is then determined within each designated territory, and national or regional offices retain the power to issue refusals under applicable law. The 2024 WIPO Guide accordingly presents the international registration as a mechanism for managing protection across multiple members, not as a unitary trademark title (WIPO, 2024).

This procedural architecture has two consequences. First, the holder may obtain efficient multi-territorial filing, renewal, and recordal while still facing different fame thresholds, dilution doctrines, evidence requirements, defenses, and remedies. Second, refusal or invalidation in one designation does not automatically determine the outcome in another. The Protocol produces interoperability of administration, but not uniformity of legal judgment. Dinwoodie and Dreyfuss's (2012) account of national flexibility within international intellectual property law helps explain why this is a structural feature rather than a drafting error.

Table 2 <Comparative findings on famous-mark protection>

Instrument	Legal character and function	Protection beyond similar goods/services	Principal limitation
Paris Convention, Article 6bis	Binding treaty minimum focused on well-known marks and conflicting registrations or use.	Generally linked to reproduction, imitation, or translation for identical or similar goods where confusion is likely.	Does not establish a general dilution standard for dissimilar goods or services.
TRIPS, Articles 16(2)-(3)	Binding WTO minimum standard extending Paris protection to services and certain dissimilar goods or services.	Yes, for registered well-known marks where use indicates a connection and likely damage to the owner's interests.	No express definition of blurring, tarnishment, proof, defenses, or remedies.
Madrid Protocol and Regulations	Binding procedural system for centralized filing, registration, renewal, and recordal.	No independent substantive rule; scope depends on law in each designated Contracting Party.	International registration is not a unitary right and national refusals and enforcement remain decisive.
WIPO Joint Recommendation	Non-binding guidance for recognition and scope of protection.	Yes; includes likely damage, unfair impairment or dilution, and unfair advantage.	Soft-law status means adoption and application may vary among states.

The harmonization gap is operational rather than purely normative

Taken together, the instruments reveal an operational harmonization gap. At the normative level, the international regime recognizes the need for enhanced protection of well-known marks. At the administrative level, the Madrid System enables a single filing route. Between these levels, however, there is no binding mechanism that standardizes how national offices identify fame, distinguish dilution from confusion, weigh evidence, or explain the relationship between international registration and domestic protection. The same mark may therefore be efficiently designated in many territories but evaluated under materially different substantive tests.

This fragmentation should not be answered by maximal protection. Dilution rights are exceptional because they extend beyond confusion and market proximity. Overbroad protection may impede comparative advertising, parody, commentary, descriptive use, and legitimate competition. Dogan and

Lemley (2008), Franklyn (2004), and Senftleben (2011) warn that dilution can become detached from trademark's market-information function. A coherent international approach must therefore combine enhanced protection with a disciplined harm requirement and safeguards for third-party interests.

Capacity differences also matter. States with limited access to market surveys, valuation evidence, specialized examiners, or searchable enforcement records may apply recognition factors unevenly. Reichman (2009) and Helfer (2004) show more broadly that international intellectual property standards operate within diverse developmental and institutional settings. Formal convergence without evidentiary and administrative support may therefore produce only nominal harmonization.

A substantive-procedural alignment framework

The analysis supports a four-part alignment framework. First, national and regional authorities should use a common evidentiary core derived from WIPO Article 2. The factors should remain non-exhaustive and should not become rigid cumulative conditions, but decisions should identify which factors were relevant and why. This would improve transparency without eliminating contextual judgment.

Second, implementing law should distinguish ordinary confusion, connection-and-damage protection under TRIPS Article 16(3), and an independent dilution or unfair-advantage ground. The latter should require proof of likely unfair impairment, tarnishment, or unfair advantage, rather than mere mental association. Protection should also preserve proportionate exceptions and defenses for descriptive, comparative, expressive, and other legitimate uses, consistent with TRIPS Article 17 and domestic constitutional principles.

Third, designated offices operating within the Madrid System should issue reasoned decisions using interoperable categories for well-known status, the relevant public, the protected interest, the asserted harm, and the legal consequence. WIPO could develop a voluntary decision template and searchable taxonomy linked to Madrid Monitor. This would not make national decisions binding across borders, but it would expose points of convergence and divergence and reduce repetitive evidentiary uncertainty.

Fourth, WTO and WIPO should coordinate interpretive guidance and technical assistance. Joint guidance could explain the minimum content of TRIPS Article 16(3), the relationship between connection and dilution-related harm, the role of the WIPO factors, and the non-unitary effect of Madrid registration. Capacity support should include examiner training, access to international trademark databases, and practical methods for assessing recognition without demanding prohibitively expensive evidence. The objective is not complete substantive uniformity, but predictable implementation of a common minimum standard.

Conclusions

The first research question is answered by the text of the Paris Convention, TRIPS Article 16, and the WIPO Joint Recommendation. International law requires enhanced protection for well-known marks and, under TRIPS Article 16(3), extends protection for registered well-known marks to dissimilar goods or services when use indicates a connection and is likely to damage the owner's interests. This extension addresses conduct associated with dilution, but TRIPS does not create a complete international dilution code. The WIPO Joint Recommendation provides clearer recognition and harm categories, including unfair impairment, dilution, and unfair advantage, but its soft-law status limits uniform enforceability.

The second research question is answered by the procedural structure of the Madrid Protocol and its Regulations. The Madrid System centralizes filing and administration, while designated Contracting Parties retain substantive examination, refusal, invalidation, and enforcement. International registration therefore improves access to territorial protection but does not harmonize national standards for fame or dilution. The doctrinal evidence supports describing the current regime as substantive minimum harmonization combined with procedural centralization, rather than as a unitary international trademark system.

The third research question is addressed through the proposed alignment framework: a common but flexible evidentiary core, an express and balanced dilution ground, reasoned interoperable national decisions, and coordinated WTO-WIPO guidance with capacity support. This model seeks greater predictability without converting exceptional famous-mark protection into property rights in gross.

The study is limited to international instruments, official guidance, and selected English-language scholarship. It does not analyze a defined sample of national statutes, trademark-office decisions, or court judgments and therefore cannot measure actual convergence among jurisdictions. Future research should construct a jurisdictional dataset, code national implementation of TRIPS Article 16(3) and WIPO factors, and compare outcomes in Madrid designations involving the same or similar marks. Such empirical and comparative work would test whether the proposed framework reduces fragmentation in practice.

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