

Trademarks



WHAT IS A TRADEMARK?

“A SIGN CAPABLE OF DISTINGUISHING GOODS AND SERVICES”

- visible
- non-visible
 - capable of being represented graphically

VISIBLE SIGNS

- WORDS
- LETTERS AND NUMERALS
- DRAWINGS
- COLORS AND COMBINATION OF COLORS
- THREE-DIMENSIONAL SIGNS

NON-VISIBLE SIGNS

- CAPABLE OF GRAPHIC REPRESENTATION
 - Audio Signs (Sound Marks)
 - Olfactory Marks (Smell Marks)

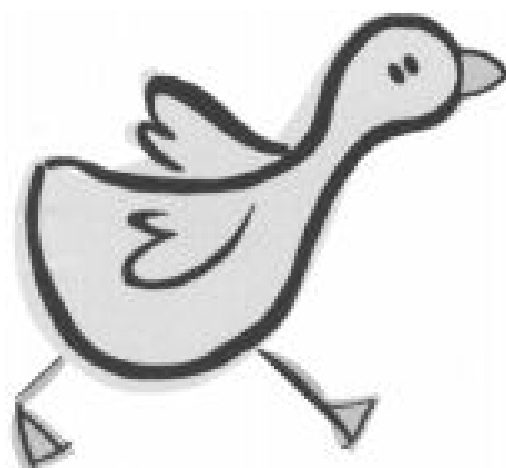
WORDS

- NAMES
 - McDonalds
 - WH SMITH
 - Mars
- FANTASY WORDS
 - Kodak
 - Kit Kat
 - Swatch

LETTERS & NUMERALS

- M&M
- IBM
- 501
- 320
- S 500
- A6
- No 5

DRAWINGS



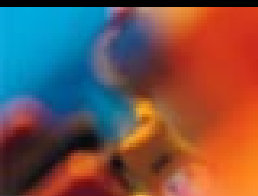
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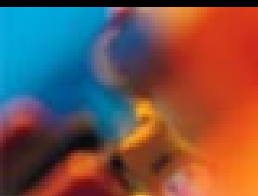
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COLORS AND COMBINATION OF COLORS





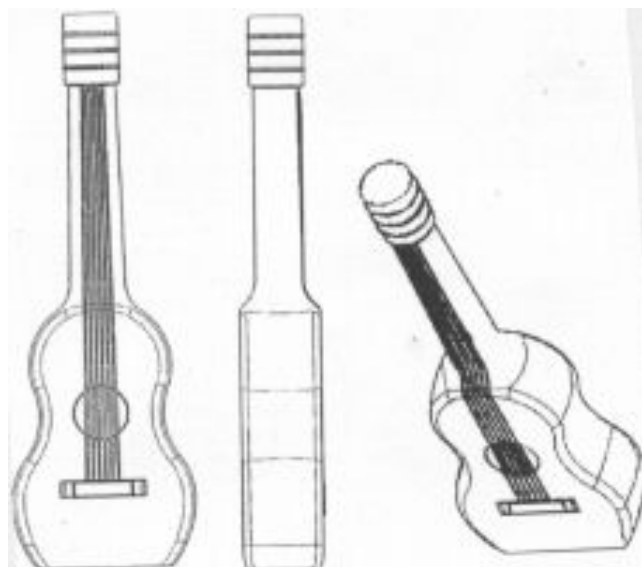
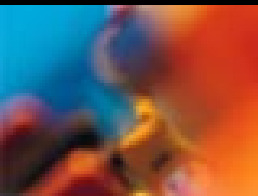




3D SIGNS







OTHERS

- **OLFACTORY MARKS**
 - “a high-impact, fresh floral fragrance reminiscent of plumeria blossoms” for embroidery yarn
- **AUDIO MARKS**

DISTINCTIVE SIGNS

- Signs which DESCRIBE the goods or services on which they are used are DESCRIPTIVE and therefore NON-DISTINCTIVE
- Social and cultural environment is important
- Decision on a case by case basis
- Effect of use

DISTINCTIVE

- fanciful or coined signs
 - “SWATCH” for watches
 - Baby-Dry for diapers
- signs adopted arbitrarily in respect of the goods or services for which they are used
 - “apple” for computers
 - “camel” for cigarettes

NON-DISTINCTIVE SIGNS

- reference to geographical origin
“INDIAN” for tea

EXCLUSION FROM PROTECTION

- **DECEPTIVE SIGNS**
 - “ORWOOLA” for goods made 100% of synthetic materials
- **CONTRARY TO MORALITY OR PUBLIC ORDER**
 - “JESUS” for jeans

FLAGS AND NATIONAL EMBLEMS

Use reserved for public authorities





EXAMPLES

- **FRUMATO**
 - a drink made from a mixture of fruit juice and tomato juice
- **MOOTEL**
 - portable cowsheds
- **RAPID RICE**
 - prepared dishes

More examples

- **FLAME CHEATER**
 - fire extinguishers
- **GLOW WORM**
 - electric lamps
- **4711**
 - perfume
- **IBM**
 - office equipment

More examples

- GM
 - motor vehicles
- SAHARA
 - biscuits
- THAI
 - silk
- ARCTIC
 - motor oil
- NUDE ELLIE
 - rice

SCOPE OF RIGHTS

- The exclusive right to use the mark
- The right to prevent others from using an identical or similar mark for identical or similar goods or services
- The right to prevent others from using an identical or similar mark for dissimilar goods or services

“USE”

- Offering the goods or services
- Affixing the mark to the goods or their packaging
- Putting the goods on the market or stocking them for that purpose
- Importing or exporting the goods under the mark
- Use on business papers or in advertising

SCOPE OF EXCLUSIVITY

(i)

- identical marks for identical goods or services
- examples:
 - “LACOSTE” for shirts
 - “SWATCH” for watches
 - “TOYOTA” for cars
 - “NIKE” for sportswear
 - “AMERICAN EXPRESS” for banking

SCOPE OF EXCLUSIVITY

(ii)

- similar marks for similar goods or services
- subject to **CONFUSION** as to the origin of the goods or services

Questions:

- Is there confusion as to the origin of the goods or services?
- Marks are not compared by the consumer side by side
- Confusion can also arise from similarity in pronunciation
- Decision on a case-by-case basis taking into account all elements

- “LACOSTE” for denim trousers
- “TOYOTA” for motorbikes (bicycles, photo cameras)
- “SWATCH” for thermometers
- “LOWCOST” for shirts
- “TOY-YOH-TAH” for cars
- “SWOTCH” for watches
- “AMXPRESS” for banking

SCOPE OF EXCLUSIVITY

(iii)

- similar marks for dissimilar goods or services
- conditions:
 - mark is well known or famous
 - aspect of unfair competition
 - dilution
 - free-ride

Examples

“MARS” for condoms

“BENZ” for underwear

“ROLLS ROYCE” for a nightclub

COUNTERFEITING

- IMITATION OF A PRODUCT GIVING THE IMPRESSION OF BEING GENUINE
- mostly in relation to luxury goods
- but also spare parts, pharmaceutical or chemical products, consumer products
- genuine goods must be known to the public

REMEDIES

- INJUNCTIONS
 - interlocutory
 - *inter partes*
 - *ex parte*
 - permanent
- DAMAGES
 - lost profits
 - recovery of infringer's profits
 - reasonable royalty

REMEDIES, continued

- **RIGHT OF INFORMATION**
 - source of goods
 - channels of distribution
- **DESTRUCTION and DELIVERY UP**
 - important in cases of counterfeiting

ACQUISITION OF RIGHTS

- USE
- REGISTRATION
- COMBINED
 - first-to-register (prior use may be recognized)
 - first-to-use (prior registration may be recognized)

USE

- No formalities required
- First user obtains right
- No transparency
- Uncertainty before product launch
- Problems for determination of priority

REGISTRATION

- First applicant obtains right
- Registration formalities
- Transparent
- Clear cut priority
- International standards require to provide for registration and to grant international priority rights

REGISTRATION FORMALITIES

- Filing of an application which contains usually
 - identity (nationality) and address of applicant
 - reproduction(s) of the mark
 - specification of goods and/or services
 - fees

SPECIAL QUESTIONS

- Who can file an application (own a mark)?
 - need for commercial activity?
- Can **one** application for the same mark relate to **different** goods and services?
- Classification systems
 - classification of goods and services
 - classification of figurative elements of marks

EXAMINATION

- Formal examination
- Examination as to absolute grounds for refusal
 - **IMPORTANT: lack of distinctiveness may be overcome through use**
- Examination as to relative grounds for refusal (prior rights)
- Publication for opposition
- Registration

USE REQUIREMENT

- Bona fide intention to use the mark at the moment of filing the application
- Use when registered
- Consequence of non-use?
- Valid use
 - by owner
 - on owner's behalf
 - under owner's control
 - with owner's consent

RENEWAL

- Registration of marks may be renewed
- Potentially indefinite
 - different from patents and copyrights

LICENSES

- Reasons
 - business expansion
 - business diversification
- Special questions
 - exclusive or non-exclusive license
 - registration requirement?
 - quality control?
 - rights of licensee?

TRANSFERS

- Reasons
 - merger and acquisitions
 - raising of cash
- Special questions
 - with or without corresponding undertaking or goodwill?