

# *“Making a Mark”*

*The Importance of TMS in Establishing  
a Distinct Identity in the Marketplace*

*Dan Greif*

*Siam Premier International*

# *The Importance of Trademarks*

- Trademarks are among the most valuable assets of companies.
- Trademarks protect and enhance products and services.
- Trademarks assist companies in furthering their business.

# Trademarks

- Powerful Marketing Tool
- Drives Sales/Profits
- Positive Associations for consumers
- Expectation of quality product
- Long term relationship

# Value of Trademarks

## **The World's 10 Most Valuable Brands**

A newcomer, Toyota, breaks into the Top 10, while big-name consumer brands come under attack.

<b>RANK</b>	<b>BRAND</b>	<b>2004 BRAND VALUE (BILLIONS)</b>
1	<b>COCA-COLA</b>	\$67.39
2	<b>MICROSOFT</b>	61.37
3	<b>IBM</b>	53.79
4	<b>GE</b>	44.11
5	<b>INTEL</b>	33.50
6	<b>DISNEY</b>	27.11
7	<b>McDONALD'S</b>	25.00
8	<b>NOKIA</b>	24.04
9	<b>TOYOTA</b>	22.67
10	<b>MARLBORO</b>	22.13

**Data:** Interbrand Corp., J.P. Chase & Co., Citigroup, Morgan Stanley

# Trademarks

➤ Brand, name, word, designs, etc. indicating quality and source

- ***“MICROSOFT”***

- ***“IBM”***

- ***“SONY”***

- ***“APPLE”***

- ***“SAMSUNG”***

- ***“COCA-COLA CONTOUR BOTTLE”***

# Trademarks

## ➤ **Must be distinctive**

- Suggestive – *“Microsoft” for software*
- Arbitrary – *“Apple” for computers*
- Fanciful – *“Xerox” for copiers*

## ➤ **Not excluded by TM Act**

- Royal Family symbols -- Thailand
- Emblems of international orgs. -- Thailand

## ➤ **Not identical/similar to registered TM**

# *What a Trademark Is Not*

- No monopoly on use.
- Others free to use TM in truthful ways that do not cause confusion.
- Others free to use TM in merely descriptive or generic manner.
- May be able to use for comparative advertising.

# Trademarks and Geography

- Territoriality principles
- No “global” trademarks
- Famous marks protection
- Potentially perpetual protection



# Trademarks, Copyrights, Patents & Trade Secrets Defined

## Trademarks

- Arbitrary – APPLE
- Suggestive – FANTA
- Coined – XEROX
- Generic -- WATER

# Classification of Marks

**Fanciful**



**Suggestive**



**Descriptive**



**Generic**



# Trademarks – New Myanmar Law

## ➤ Registration at Department of IP -

- Exclusive right to use trademark
- 10 year term
- Unlimited renewals
- Possible cancellation for non use

## ➤ Enforcement -

- Criminal proceedings
- Civil action

# Copyrights Defined

## Copyrights

***Rights in original works of authorship. Copyright rights protect specific expression of an idea created by the author, not an idea itself.***

## Examples

***Books***

***Songs***

***Logos***

***Artwork***

***Commercials***

# *Trademarks v. Copyrights*

- Protects words, symbols and devices
- Protects against uses that are likely to cause confusion
- Provides protection for as long as the mark is in use
- Protects original works and forms of expression
- Protects against certain acts of copying
- Provides protection for the limited period

# Patents

## Patents --

*Right given to exclude others from using/replicating invention, which is given in exchange for the inventor disclosing invention to public.*

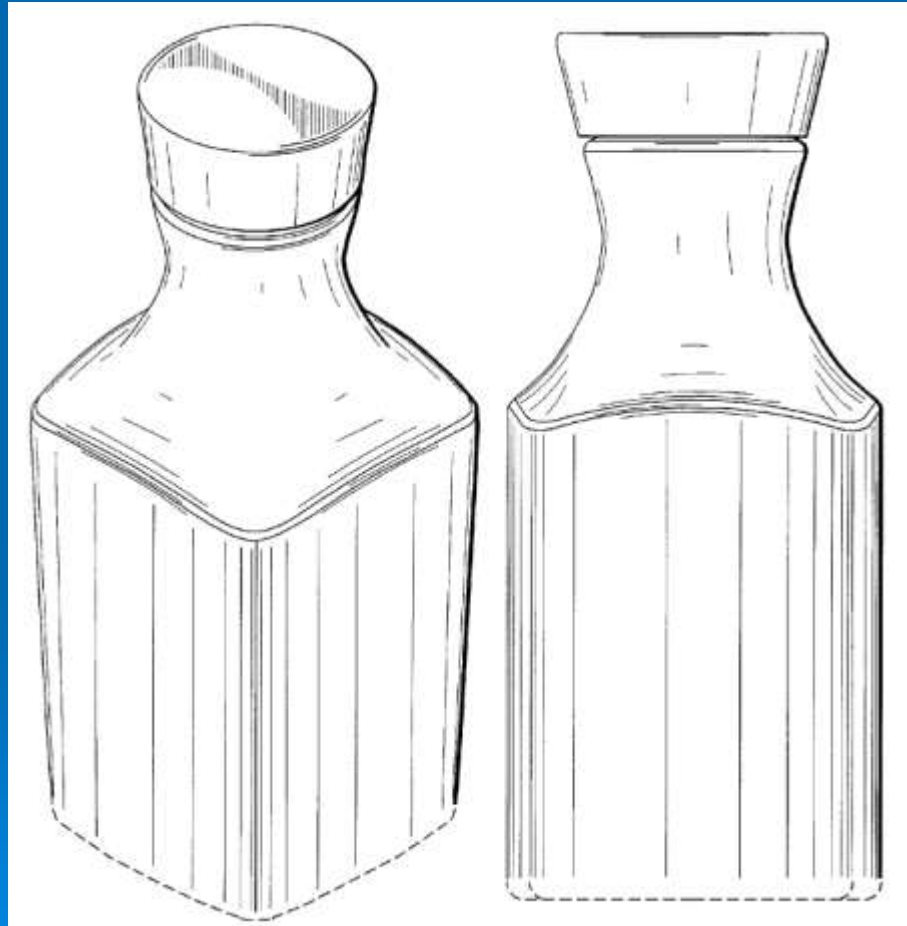
*Novel and non obvious.*

## Design Patents –

*Protect ornamental industrial design.*



# *Design Patent*



# Trademarks v. Design Patents

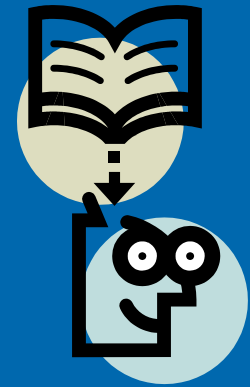
- Protects words, symbols and devices
- Protects against uses that are likely to cause confusion
- Provides protection for as long as the mark is in use
- Protects the aesthetic appearance of products and product packages
- Protects against the making, using, or selling of products that are similar in appearance to the patented design
- Provides protection for limited period



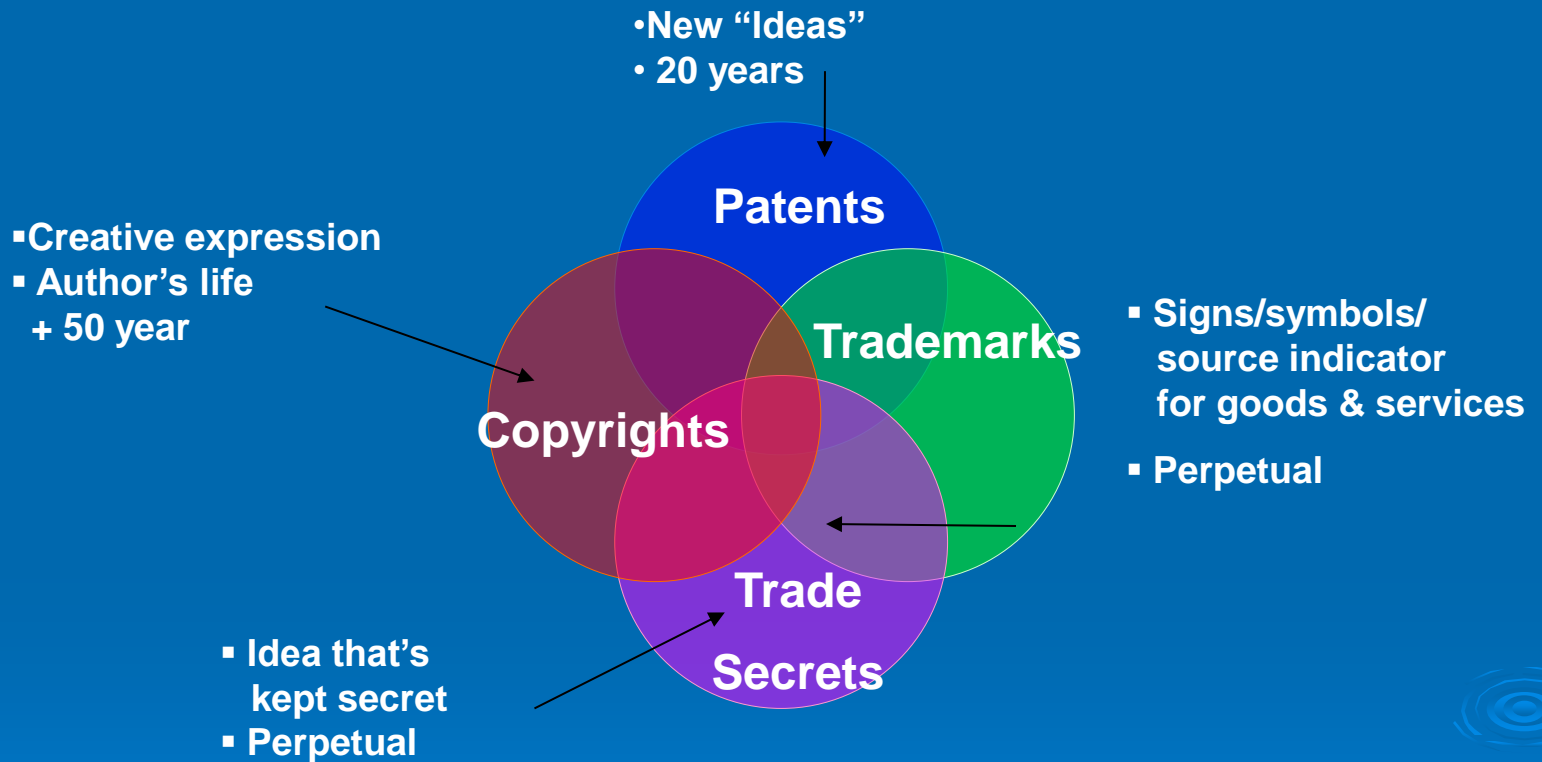
# Trade Secrets

## Trade Secrets

Any valuable business information the owner has taken reasonable steps to keep secret and is generally not known to the public.



# IP Protections



# TRADEMARK SEARCHES

- *A SEARCH IS NEEDED FOR SEVERAL REASONS*



*Respect TM Rights of Others.*

**Caution: Do Not Infringe**


**INFRINGEMENT**



# *Clearance of Trademarks*

- Why Do A Search?
- What Happens if We Don't Get it Right?
- The Search Process

# Trademark Clearance: Both Offensive and Defensive Purposes

- To respect the valid trademark rights of others
  - To market products under trademarks to which clients can acquire exclusive rights
  - To assess the scope of rights to which we may be entitled
- 

# *If Don't Get Clearance Right . . .*



- *Third party can assert a valid claim*
- *May be required to stop using*
- *May have to destroy all packaging and advertising*
- *May be required to pay substantial monetary damages*
- *Public relations embarrassment*

# Trademark Searching: What are we looking for?

- Potential claims of:
  - Trademark Infringement
- Potential strength of mark
- Negative connotations
- Examine both availability and protectability



# TM Risk Analysis -- Key Factors

- Similarity of marks
- Similarity of goods
- Nature of use
- Fame of mark(s)
- Strength / weakness of common elements
- Identity of owner

# Searches are Not 100% Guaranteed



# *The Application Process* *- Global Filing Strategies*

- National Filings
- Paris Convention Priority
- Madrid Protocol

# Penalties For Infringement



# Police Raids



# Raid on warehouse and factory in PERU



# Phuket Destruction



# Penalties For Infringement





# Question & Answer

