

Signs and emotions:

A brief introduction to the
role of TM for businesses

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Roadmap...

- 1) Business use of distinctive signs
- 2) Trademarks: legal aspects
- 3) TM protection: national, regional and international.

1) Business use of distinctive signs

- Communication tool:

- Crucial for identify

- * technical aspects of products

- * the qualities of products

- Brand plays a terrific role in the psychology of consumers for the choice of product and services: What product to chose; why this product; what this product will add to my daily life....

./.. Business use of distinctive signs

The TM allows to distinguish its own products to those of competitors

The TM is a crucial tool in the enterprise **marketing** campaign; indeed through a fair marketing policy an enterprise:

- consolidate its image

 - It helps in building an identity, image and reputation on the market

- Improve the reputation of its own products and strengthen the relationship with the clients

 - The quality of the products, pushes clients to remain linked to the TM owner. At the same time the trust of the clients, imposes the producer to keep a high standard in products marked with its TM



./.. Business use of distinctive signs

- It improves the value of intangibles on the market
A well exploited TM can become an important economic asset



Coca-cola: 68.9 Mld de US\$ **Microsoft :** 65.1 Mld. de US\$ **IBM:** 52.7 Mld. de US\$

- When Exploited in a dynamic way the TM can reward the owner with high incomes
- An intangible asset, when adequately managed, can be crucial for getting support from private and public investors.

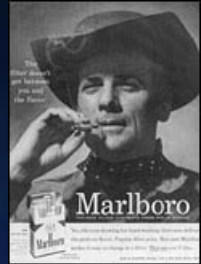




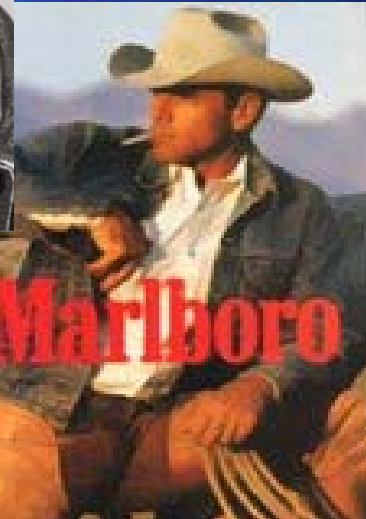
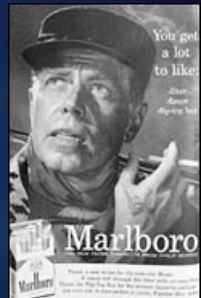
Marlboro



1955



1956



1973









2) TM: Legal aspects

Any **distinctive sign** (words, letters, numerals, drawings, pictures, shapes, colors, logotypes, labels) or combinations of signs, that can be **graphically represented**, used to distinguish goods or services may be considered a trademark

./.. TMs: Elements composing a TM

■ Conventional TMs:

A Word



A combination of words **International Business Machines**



Letter (acronym) or numbers

A Designs



The merger of words
and designs



./.. TMs: Elements composing a TM

- Non Conventional TMs:
Sounds (music, noises, jingle,etc....)



Colors



TM tri-dimensionals



Smells



* Nokia, OHIM application N1040955. Signature tune of Nokia Corporation
** Tarzan yell, OHIM application N. 000736827

Collective TM

- Marks used to distinguish goods or services produced or provided by members of an association.
- ◆ Aim: identifies products or services coming from a given association
- ◆ CTM are used for testifying a standard level of quality or other elements established by the consortium running the collective TM
- ◆ For using the Collective TM a business have to be member of the CTM consortium and respect the conditions of use imposed by the consortium regulation



Certification TM

- ◆ Aim: Marks used to distinguish goods or services that comply with a set of standards and have been certified by a certifying authority.
- ◆ certifying products/services common features, especially quality, ingredients, processing methods.
- ◆ Differently from the Collective TM, the use of Certification TM do not require SMEs to be member of an association/consortium. Enterprises dealing with the regulation can use it.
- ◆ Certification TM can only be granted by a third entity, called “certifying authority” that certify that all production methods used by the company deal with the regulation.
- ◆ The use of a certification TM impose the respect of a “user regulation”, explaining i.e.: the methods of production



./.. TM that cannot constitute a TM:

* Absolute ground for refusal:

- 1) Signs lacking a distinctive character:
 - Water, wine, chair, coffe, world, etc...
- 2) Signs considered to be contrary to public order or morality.
- 3) Deceptive TM, Sign that can mislead consumers :
 - Geographical origin of the product
 - Product characteristics or ingredients
- 4) Flags, armorial bearings, official hallmarks and emblems of states and international organizations: ONU, Governments, Ministries, etc..

* Relative ground for refusal

- 1) TM identical or similar to exiting TM, i.e.: INTELL v. INTELLE;
NIKE v. NIKY.

Selecting a good TM

- Find a good TM
 - enough distinctive
 - Easy to read, memorize and to be use in advertising campaigns
 - Avoid negative meaning in the language of the country: Nova, Pajero,
 - It is always better to check the existing TM, in order to avoid potential disputes
 - check the possibility to register a DN that recall or is identical to your TM
 - Invented words: easy to protect and to be memorized (kodak)
- Remember to protect all aspect of your TM
 - Word
 - Shape three-dimensional
 - Logo
 - Color(s)
 - packaging
 - sound
 - smell, (where possible)



Protecting TM in the appropriate market

■ Select a given market

- National route
- Regional route
 - OAPI (Organisation Africaine de la Propriété Intellectuelle)
 - ARIPO (Organisation Régional Africaine de la Propriété industrielle)
 - OHMI (Office de l'Harmonisation du Marché Intérieur)
 - BBM (Bureau Bénélux des Marques)
- International route, Madrid system

■ Check the Market

- Licensing or Franchising contract: you should verify that the licensee or the franchisee respect the contract obligation
- Enforce your right in the case of abusive use by third people.

3) TM protection: national, regional and international.



Few Strategies for Protecting Your TM on an International Scale

■ National Route



■ Regional Route



■ Internacional Route, Madrid system

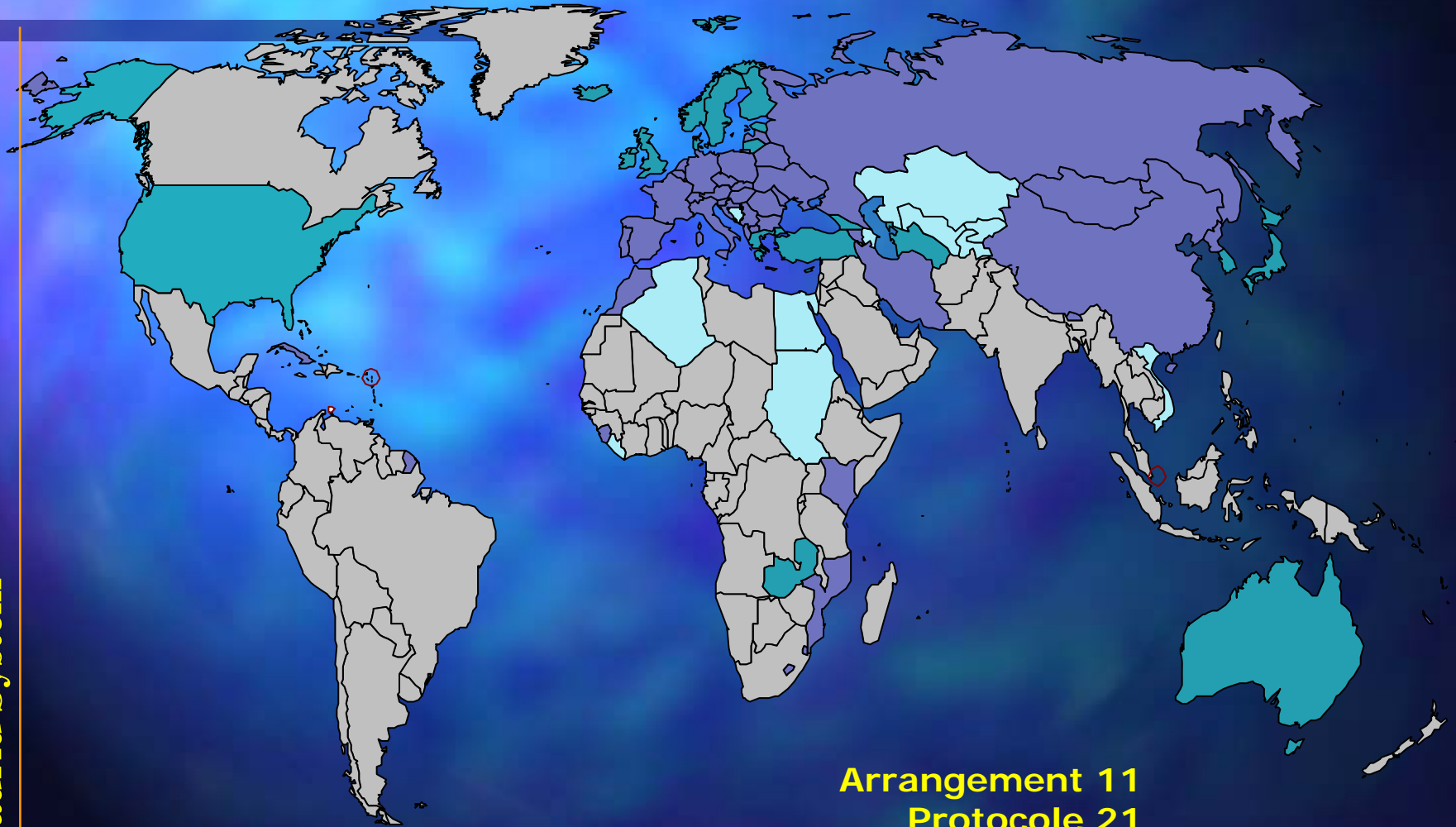


Madrid System

- 1 system two treaties :
 - Madrid Agreement (1891)
 - Madrid Protocol (1989)
- The main advantage of the Madrid system is of granting the registration of TMs in about 80 member countries
 - By using 1 unique procedure
 - 1 unique administrative file management
 - 1 language (EN, FR, ES)
- More than 135.000 users; 412,000 international registration in force = 4,800,000 National TMs
- Extremely useful for SMEs since costs are reduced of 10/20 times

./.. The Madrid System

(data 2008: about 80 members))



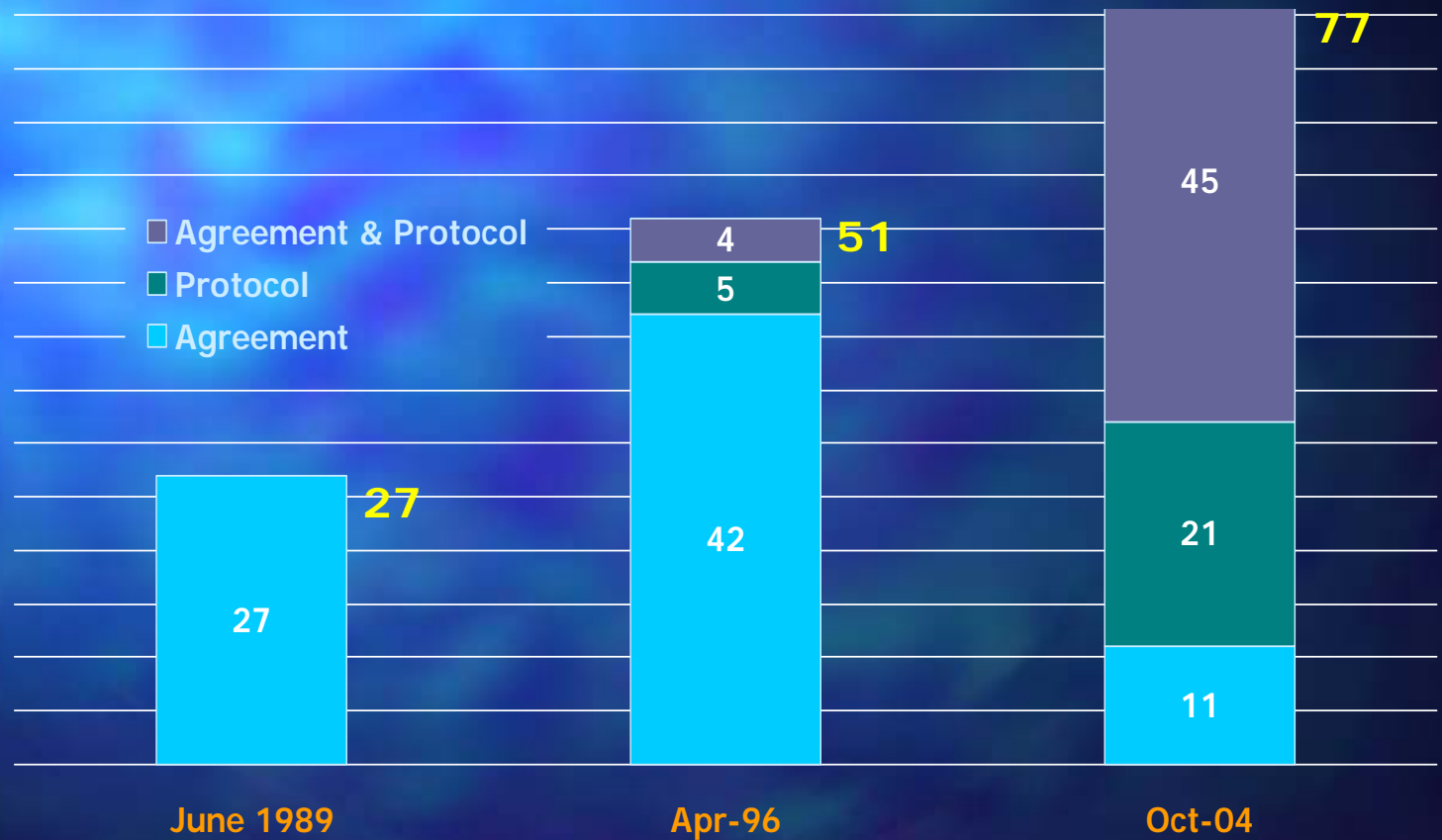
Arrangement 11
Protocole 21
Arrangement and Protocole 45

./.. Madrid System

Madrid Agreement (1891)

Madrid Protocol (1989)

Madrid System



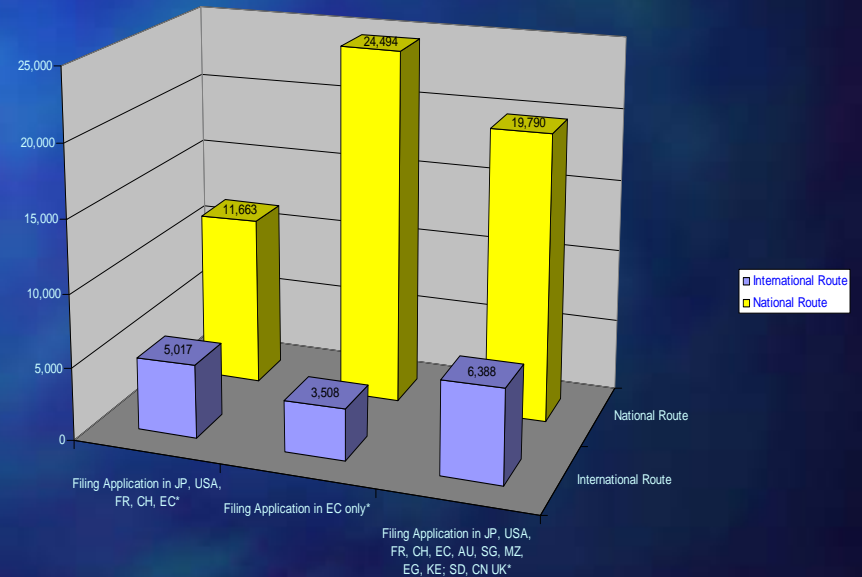
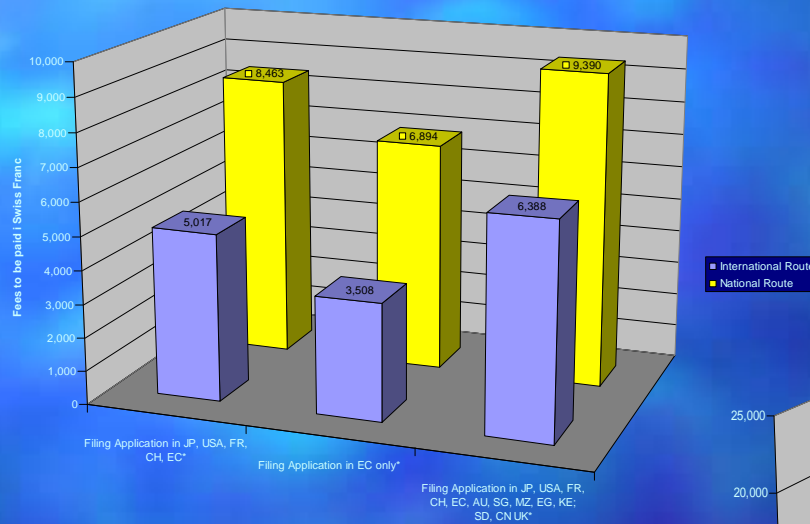
The Madrid system and its functioning

Main Aspects

- 1 application,
 - 1 language (FR, EN, ES),
 - 1 set of fees,
- Lodged by a natural or legal entity, having an:
 - business establishment
 - domicile
 - nationality
- 1 unique system of management:
 - National Office,
 - Formal examination,
 - registration,
 - notification and publication,
 - Possible refusal by contracting parties

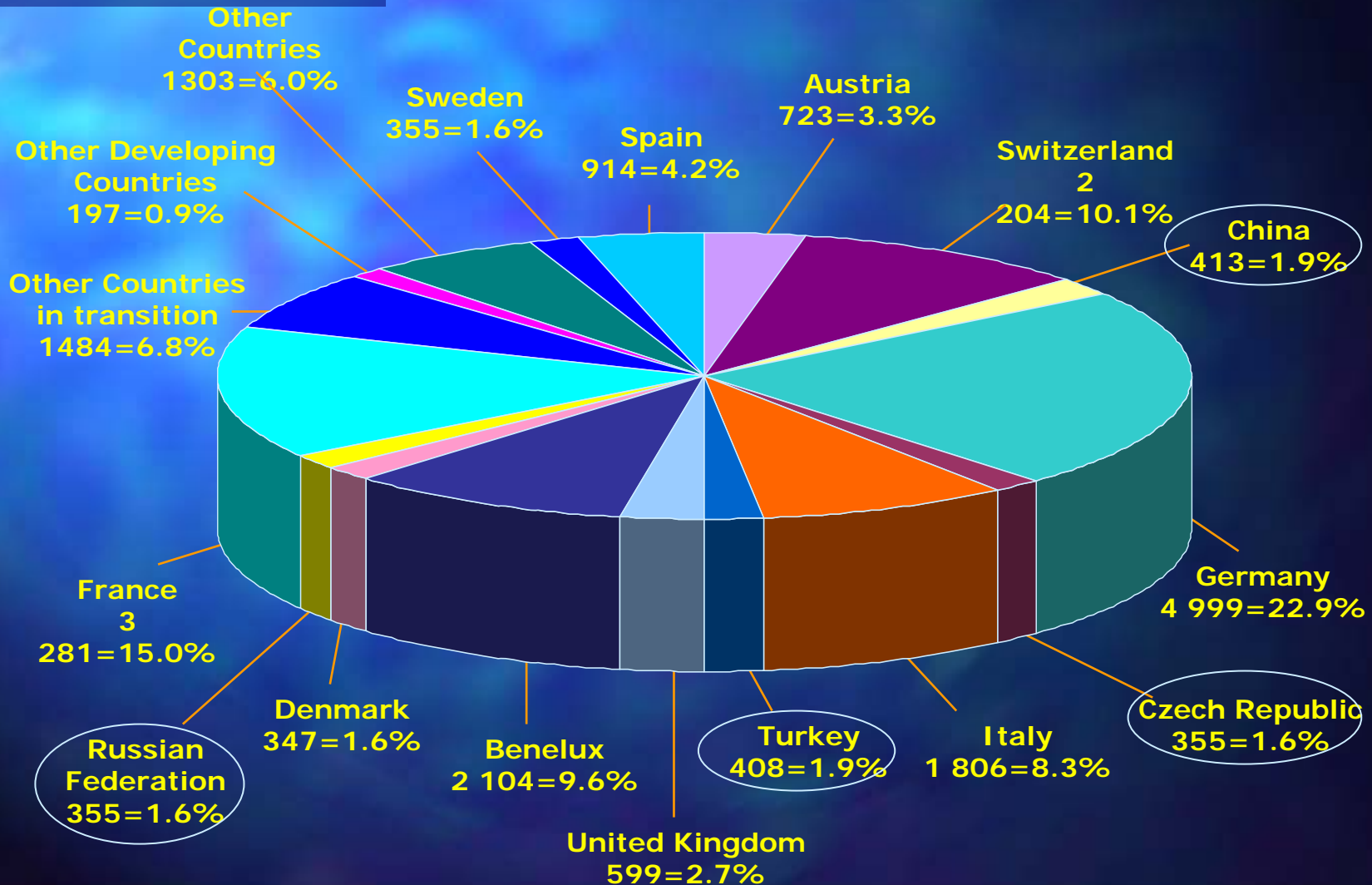
./.. Madrid system costs simulation

Madrid System data 2003



Madrid System's Main users

Madrid System data 2003



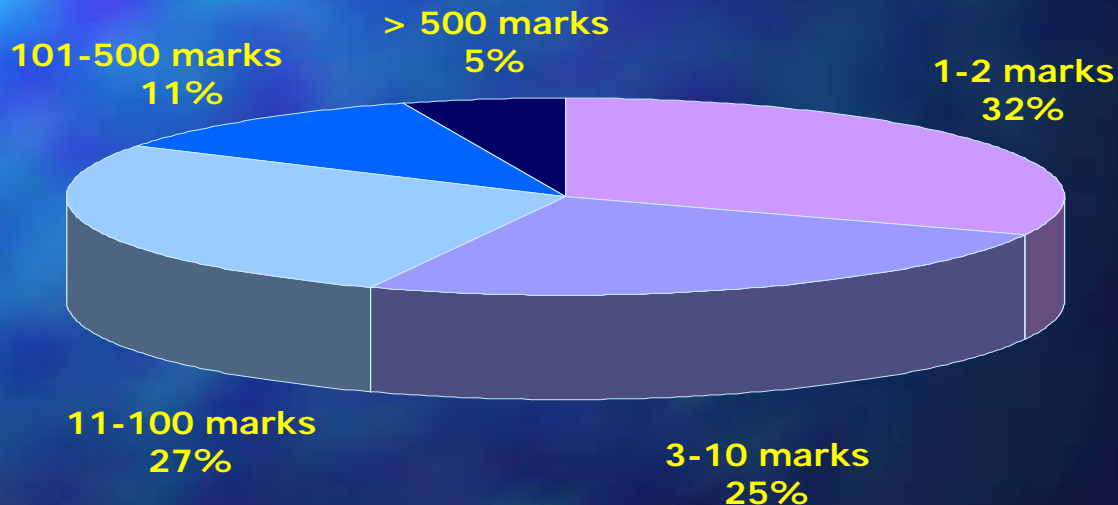
Registration by owners' categories

Owners



TM grouped by owners	N. Of Owners	
1-2 marks	104900	80.00%
3-10 marks	21408	16.33%
11-100 marks	4555	3.47%
101-500 marks	245	0.19%
> 500 marks	18	0.01%
Total	131126	100.00%

Registrations more than (400,000)



Thanks!

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