

WELCOME TO ...

# MAKING A MARK



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WIPO Training of Trainers Program on Intellectual Property  
and Small and Medium Sized Enterprises  
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# Overview

1. Trademarks as a mean to increase the power of marketing
2. Building the brands
3. How to get trademark protection
4. Trademark management

Some materials of Giulio C. Zanetti, Director , Strategic Networks Department and IP Specialist of IDLO are used in these slides with his authorization



- 1. Trademarks as a mean to increase the power of marketing**

# Why brand is valued for your business?



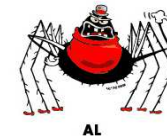
Great unbranded beer

Same great taste, higher price, more preferred

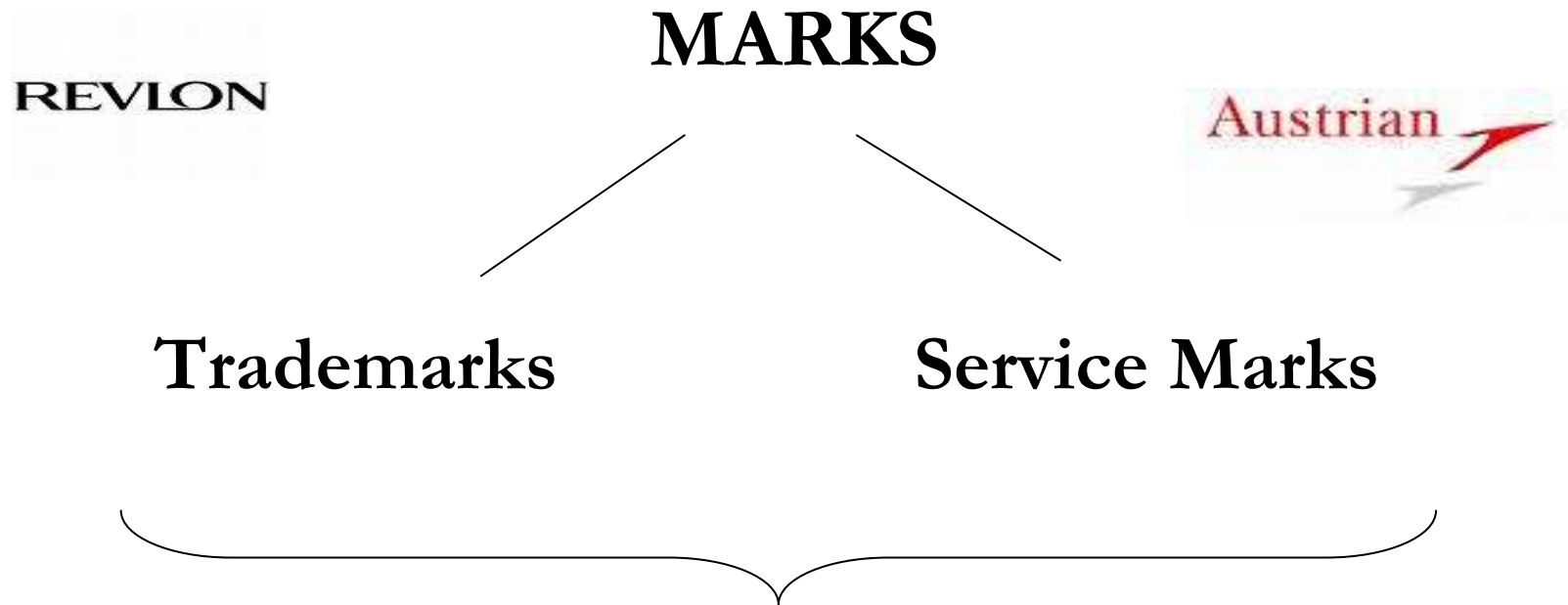
Source: Interbrand

# Why brands are valued for your business?

- Recognition, Consumer Loyalty and Attachment
- Image of Quality, Size, Experience and Reliability
- One of the most effective marketing and communication means
- One of the most valuable and durable SME's business assets
- Trademarks are the legal basis of SME's goodwill and branding



# Introduction in trade marks



## PRINCIPLE OF SPECIFICITY

Nice Classification: International Classification of goods and Services for the Purpose of the Registration of marks under the Nice Agreement

# What is a trade mark?

**Any visual sign capable of distinguishing the goods/services of one natural person/legal entity ... from others, including ....**

**TRIPS: art 15**

Article 120 of the Act of 30 June 2000 on Industrial Property Law: requirement for visual representation

## **WORDS (word marks)**

Adidas Starbucks Whirlpool Nestlé Volkswagen

Sony Harley Davidson Philips Just Do It Lufthansa

Siemens Lays Red Bull Java Vodafone JVC

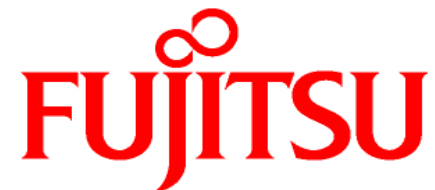
Gatorade Coca Cola Shell Ford Apple Levis

Rolex Microsoft PepsiCo RayBan Zippo Bic

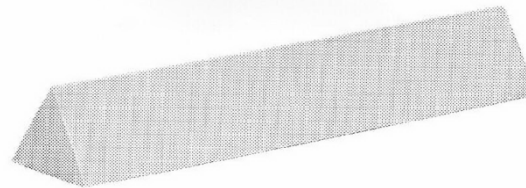
Transition Herbalife Belhard Sellotape Pfeizer



## LOGOS (figurative marks)



# OBJECTS (3-D marks)



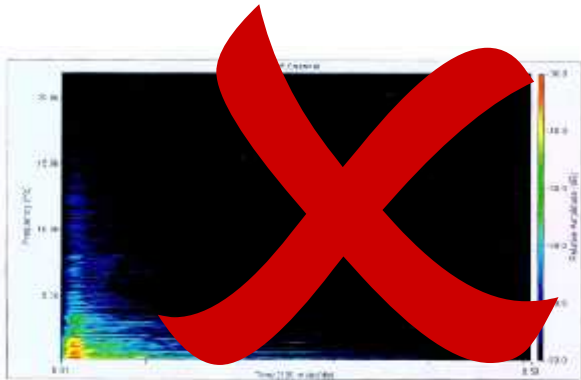
# SOUNDS (sound marks)



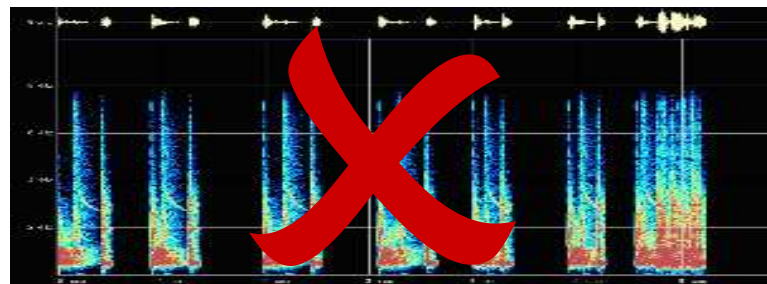
(A musical staff depicting the first notes of Beethoven's *Für Elise*)



(Tarzan yell)

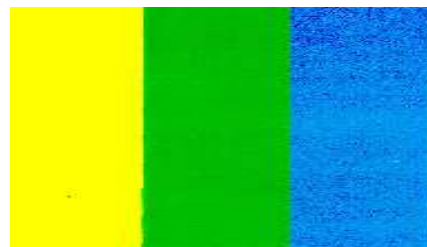
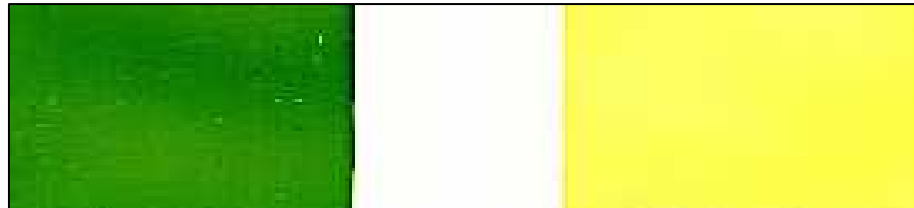
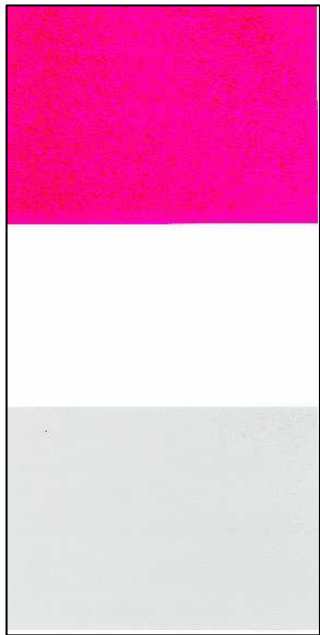
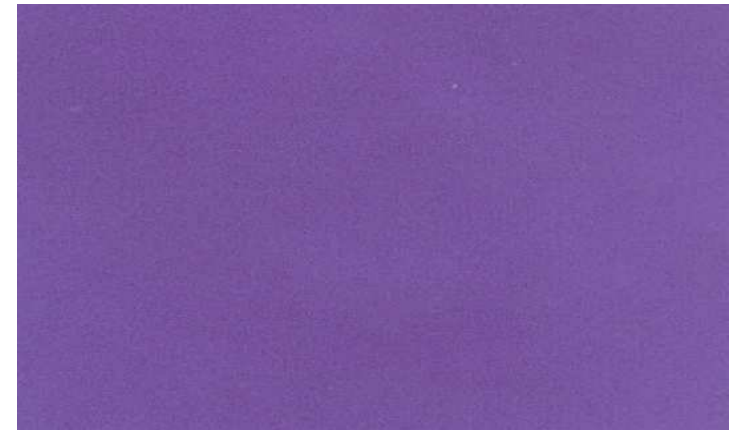


(Sound of tennis balls being hit)



(Popping)

# COLOURS OR COMBINATIONS (colour marks)



## SMELLS (Olfactory /smell marks)

“The strong smell of bitter beer applied to flights for darts” (UK trademark; Unicorn Products Limited)



“Fresh floral fragrance reminiscent of Plumeria blossoms for sewing thread and embroidery yarn - US TTAB(1990)”



“The smell of fresh cut grass” for tennis balls (EU R 156/1998-2)



# What TM protection gives you?

## 1) Right to use the trademark

- to affix the trademark on or use in any other way **in relation to the goods for which it is registered**, use on business papers and in advertisement
- to introduce the goods /services to the market under the trademark
- Import/export

## 2) Right to prevent others from the use of the trademark in commerce in a way that it is likely to confuse consumers

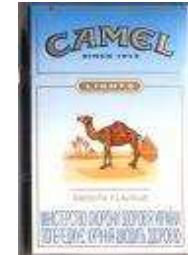
- right to object to any use of his trademark by a third party *for goods for which it is protected (specified in the registration)*
- protection generally extends to the use of *similar trademarks for similar goods*, if such use is likely to confuse the consumer

### **3. Building the brands**

# 1. Meeting the legal requirements

## CHARACTERISTICS

+ Distinctiveness



+ “Novelty” (availability)



- NOT Misleading, Descriptive, Generic,  
Contrary to public order/morality



# DISTINCTIVENESS

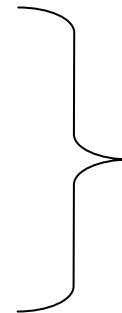
Assessed in Relation with:



❖ Goods/Services (**Principle of Specificity**)

❖ Laws/Jurisprudence

❖ Average Consumer



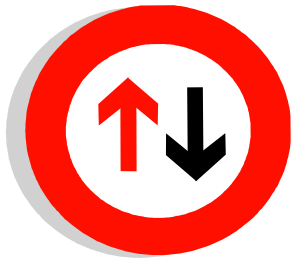
of country  
concerned  
(**Principle of  
Territoriality**)

# How can the distinctiveness be increased?

- 1) **Special script**
- 2) **Special colour (colour claim/limitation)**
- 3) **Logo (non descriptive)**
- 4) **G/S limitation**

# DISTINCTIVENESS

## > Vulgarization



*Piña Colada*

## > Secondary Meaning ... *how can you prove it?*

# Case: Roses Only

Source: Smart Start IP Australia



- James Stevens, hereditary florist whose family have operated in Sydney since 1967
- **Business concept:** Men want three things when they shop for flowers: speed, convenience and roses
- **Solution:**
  - Internet as a sales tool
  - Boxed flowers as the marketing instrument

**Naming right:**

New business “Roses Only” was launched in 1995



# Case: Roses Only

Realizing well the importance to protect the business brand:

- Both words 'roses' and 'only' are somewhat generic words, with the assistance of experts both the words and the distinctive two branches with thorns image were registered as trade marks
- The brand dominates Australian online flower sales, is expanded into the New Zealand and UK markets
- Plans to protected the trade mark under the Madrid system to cover the markets that are earmarked for possible expansion (US and Japan)



Composite AU Trade Mark : 768804  
Word: Roses Only  
Image: 2 BRANCHES WITH THORNS:  
for Classes 35, 39, 44,  
Reg. from 1998  
Owner: Roses Only and  
Lush Flowers Pty Ltd

Word: Roses Only: AU Trade Mark :  
1216124 for Classes 35, 39, 44,  
Reg. from 2007  
Owner: Roses Only and Lush  
Flowers Pty Ltd



## Case: Roses Only

- In 2005 the business was expanded into fresh fruit delivery under a new trade mark 'Fruit Only' again with the stylised branches
- There have been instances of Roses Only's IP being infringed on a regular basis – monitoring and quick reaction
  - e.g. registration of the domain name 'Flowers Only' by another large online flower retailer
  - putting forward a case to the Australian domain name administrator and returning the name.



## “NOVELTY” (availability)

- > **Identical or Similar Signs**
- > **For Identical or Similar Goods/Services**
  - **If similarity: risk of confusion/likelihood of association**
  - **If identical M for identical g/s = presumption**

TRIPS: art 16(1)

## Possibility for trademarks coexistence



 Delta



 DELTA DENTAL



# **SIMILARITY b/w signs**

## **3 criteria**

- 1) Conceptual similarity**
- 2) Visual similarity**
- 3) Phonetical similarity**



# SIMILARITY b/w g/s

## Criteria:

- 1) Same class? ... *not necessarily*
- 2) Same purpose
- 3) Same public (consumers)
- 4) “Cross-substitutability”



# A MARK MUST NOT BE

- **DESCRIPTIVE (in the broad sense)**
- **GENERIC**
- **MISLEADING / deceptive**
- **CONTARY TO PUBLIC ORDER AND MORALITY**



“Garum” for  
Fish preserves

“Screw You” for sun glasses,  
clothing,  
sport items and beverages,  
all items relating to sex

- **Let's discuss it on a practical example...**  
take a look at Exercise 1

# Well known marks

## - What is a W-K mark? (criteria)



WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks 1999

WIPO Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet 2001

# Well known marks

## - Consequences:

→ Exception to 2 principles !!!

Paris Conv: art 6bis  
TRIPS: art 16(2)

... for identical/similar g/s = even if not registered

... for dissimilar g/s = only if registered

Dupont-shoes, Kodak-pianos; Dogiva for pets food

## 2. Language requirements

- Proposed sign should be easy to read, spell, remember for all types of advertising media
- Consider potential exports
- Absence of any undesirable or negative connotations in any other relevant languages



### 3. Trademark search

to make sure that it is not identical or confusingly similar to the existing marks in the relevant category of products

1. For registered trademarks, trademarks applications: relevant international and national databases  
[www.wipo.int/amc/en/trademark/output.html](http://www.wipo.int/amc/en/trademark/output.html)
2. Potentially conflicting not registered trademarks (search engines Google, Yahoo!, Yandex, online shops, directories etc)
3. Identical or similar trade names and domain names
4. Professional full search (phonetic, linguistic, specialized field directories)



### **3. How to protect trademarks**

# Process of obtaining and life of a trademark

- Application for registration
  - Priority: 6 months
- Examination (Formal/Substantial)
- Granting or Refusal for granting
- Duration: 7 years (TRIPS), but: 10 years ... for ever!

..... Why?

- Renewal
- Publication and Excess to the Register

Territorial character of rights



# Cancelation for lack of use

## NO USE:

- ⇒ Uninterrupted period TRIPS: art. 19
- ⇒ Of at least 3 years (Poland - 5 years)
- ⇒ Without valid reasons
- ⇒ Total or partial

## **Trademark rights are NOT obtained automatically**

- with a trade name registration
- with a domain name registration
- in all other languages
- in relation to other classes of goods
- in all other countries with a registration in a particular country (TERRITORIAL rights)

# Case: Beware of the Dog

Source: Smart Start IP Australia

Kristy Andrusko originally opened her business for funky pet care products, including collars, beds and pet fashion in 2003 under the business name of Lush Puppy



- Selling her products to retail outlets
- Launching In 2004 Lush Puppy's retail stores with much bravado, as Channel 10's small business program, *Bread TV*, followed Kristy's start up journey
- a huge beginning, selling out of many products within the first couple of weeks

## Case: Beware of the Dog



Soon after receiving a letter by the legal advisor of another business informing her that **her business name** was infringing another company's **registered trade mark**, and that legal action would result if she didn't cease trading under the Lush Puppy name

Taking the decision to abandon the Lush Puppy business name, which meant:

- destroying all of her existing Lush Puppy stock
- closing down her website
- deregistering her business name
- losing her wholesale business and
- all of the goodwill generated from Lush Puppy's exposure on *Bread TV*

# Case: Beware of the Dog

- Quick identification of a new name the Puppy Phat
- Search and registration of “the Puppy Phat” as a trademark and as a business name, as well as of a couple of other names that Kristy is thinking of expanding with in the future
- The lesson learned: to consider from the early stages importance of IP and branding: “Business owners need a business name to operate, but to protect yourself, your business and your brand; a registered trade mark is the important thing.”

AU Trade Mark : 1006751  
Word: Puppy Phat  
Owner: Phatitude Pty Ltd  
Reg. from 2004  
For classes: 3, 18, 20, 35, 40



# How much does it cost?

*\*as for the end of 2010*

Fees	Basic Fee (online filing /paper form)	Additional Fee	Renewal
US	325 / 375 USD \$ per international class	"intent to use" application \$100	400 USD \$ per class
Germany	EUR 300 / 290	EUR 100 per class	EUR 750 Add.fee from 4 <sup>th</sup> class EUR 260
Poland	PLN 550/500	PLN 120	PLN 200
CTM (EU)	EUR 900 / 1050	EUR 150 per class	EUR 1500 /e-renewal EUR 1350 Add. Fee from 4 <sup>th</sup> class - EUR 400

**Madrid system** (international application):

**Basic fee**

653 Swiss francs (B&W) or 903 Swiss francs (any color)

**Supplementary fee**

100 Swiss francs for each extra class over 3 classes

**Complementary fee(s)**

100 Swiss francs for each designated country, unless the country requires an individual fee; and/or

**Individual fee(s):** no higher than the equivalent national filing and registration fees



## **4. Trademark Management**

- **Let's discuss it on a practical example...**  
take a look at Exercise 2

# Trademark management

- **How to use the TM?**
  - Use the ® ™ symbols to denote a registered mark
  - Don't use the mark as a noun or verb
  - Don't use the mark as a plural Distinguish the mark from surrounding text
  - Use your mark consistently
  - Establish clear and cogent mark usage policies and guidelines
  - Respect the trademarks of others
- **Monitor the use of your trademarks**
- **Regular audit of trademarks**

## Case Study: Vuvuzela horn



- Distinctive sound of the 2010 World Cup
- Application for registration of vuvuzela as a south African trade mark by Masincedane Sport, a South African company that has manufactured plastic vuvuzelas since 200; USA; CTM 009194821 registration in 2005 for the word VUVUZELA для сл. Т/У:
  - Class 15: for musical instruments
  - Class 28: games and playthings, toys and sporting articles



Incorrect use of the name on the company website

No actions to assert or enforce its CTM rights

If as the result vuvuzela becomes the common name in the EU to these particular horns among the public, then the CTM will be liable to be revoked

**Thank you for your attention!**



**Any Question?**

WIPO's website for SMEs :

[www.wipo.int/sme](http://www.wipo.int/sme)

Contact address: [larysa.kushner@ehu.it](mailto:larysa.kushner@ehu.it)