

WIPO Forum on Strengthening IP Management in African Universities.

Topic:

*Effective use of Commercial identifiers
in Branding strategy
for Business competitiveness*

19th October, 2018

Laico Hotel, Nairobi.

Introduction

What is a brand?

- Unique sign, symbol or design that by association or convention are used to identify a product or company and differentiates it from its competitors.
- The goal of a brand name is to create a recognizable entity be it a name or logo of a product or a company.
- Thus a brand represents your total image, reputation and business in the public eye.

Introduction

What is a brand?

- Global aspects of a good brand
 - Identity
 - *Great identity helps shape consumer perceptions- in form of names, logos, designs*
 - Image
 - *A great brand stand out in a crowded marketplace and more importantly reduce that buying decision-making process.*
 - Personality
 - *A visible brand has a 'voice' that shout-out inspiring that meaningful feelings of attachment.*

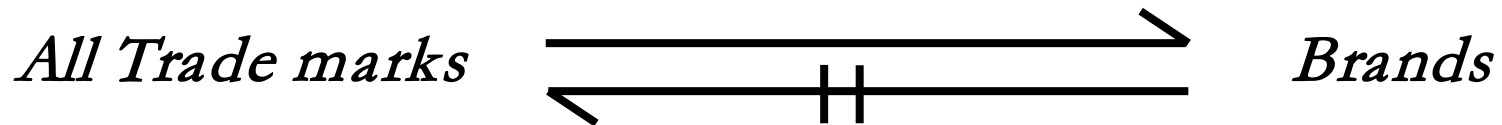
Introduction

- Global aspects of a good brand -cont/.
 - Character
 - *A good brand automatically creates association with certain styles that often reflects or dovetails with a customer's self-expression.*
 - Reputation
 - *A famous brand engenders feelings of trust, reliability, and loyalty. It is a basis for building a clientele or consumer following.*
 - Culture
 - *Strong brands cast a vision and communicate the company's unique value proposition and honest business practices*

Introduction

Some differences to note:

- A Brand represents your reputation and business in the public eye.
- Trade marks legally protects those aspects of your brand that are unique and specific to your product or company.



- Industrial Design protects overall aesthetic or ornamental features of a product.

Introduction

- Industrial Designs, Trade Marks and Geographical Indications are Intellectual Property (IP) tools used in branding strategy for competitive advantage.
- Note:
 1. It is important to protect your brand's intellectual property to avoid the brand dilution.
 2. “Consumers are starved for time and overwhelmed by the choices available to them. They want strong **brands** that simplify their decision making and reduce their risks.”
(Kevin Lane Keller, Tuck School of Business)

Trade Marks.

- What is a trade mark?
 - is a distinctive sign, used by a merchant to **identify** its goods or services and to **distinguish** them from those produced or provided by others.



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Effective use trade mark in branding

1. Nature of Mark- when designing your TM

- Designing nature of mark: any distinctive sign: letter, numeral, word, name, heading, label, signature, slogan, device, packaging, colour or any combination thereof, whether in 2D or 3D form.

- Using Letters:

B



KU

- Using Numbers:

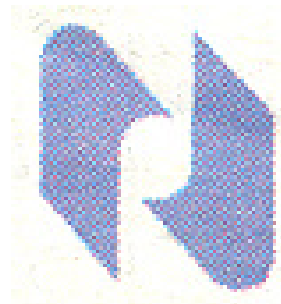
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- Using device/logo:



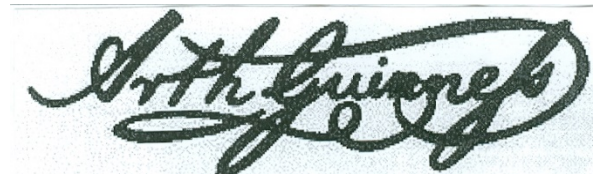
Effective use trade mark in branding

1. Nature of Mark- when designing your TM

- Combination:



- Slogans: *“my country my beer”*, *‘we are you’*

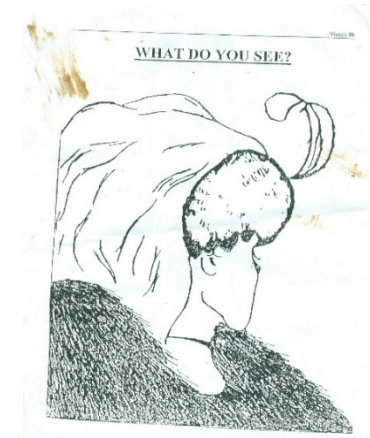


- Signature & labels:

- Double meaning:



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Effective use trade mark in branding

2. Categories of trade marks- when choosing your TM

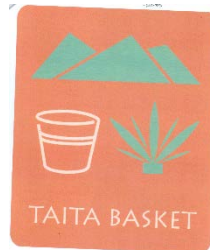
Trade marks



Service marks



Collective marks



Certification marks



Wellknown marks



Effective use trade mark in branding

3. Function of trade marks- when using your TM

- Identifies the product and it's origin
- distinguishes between products made by different competitors
- acts as guarantee of product quality.
- acts as assurance of genuine products
- advertises the product.
- A vehicle for creating an image and building a goodwill of the product
- A source of information (*silent ambassadors*)

Effective use trade mark in branding

4. Scope of rights- when using your TM as weapon of protection

- Registration gives you the right to exclude others from marketing identical or similar products under an identical or a confusingly similar mark
- Rights established through use(unregistered)
- Rights are forever (subject to renewal every 10 year)
- Rights are territorial (secure foreign markets)
- Basis for granting damages as judicial relief in case of infringement (injunction plus damages)

Effective use trade mark in branding

5. Value of a trade mark- when using your TM as an asset (property)

- Trade mark is a valuable asset in any business.
- Source of revenue in form of royalties in a license
- Critical element in franchising business
- Acts as collateral in securing loans(*Movable Property Security Rights passed into law in 2017 included IP*).
- Key component in mergers and acquisition (selling/assignment)

Effective use trade mark in branding

6. Marking with **TM** or **®** - when using your TM as warning(minefield)

- Use of “**TM**” or **®** marking as notice to the public.
- Enable Courts to easily assess wilful infringement
- Provide grounds for enhance damages in lawsuits

Key considerations when selecting or creating your TM

• 1. Distinctiveness Continuum



Key considerations when selecting or creating your TM

2. Display – Ensure your TM of choice is easy to:

- See,
- Read and,
- remember



Key considerations when selecting or creating your TM

2. Display – Ensure your TM of choice is easy to: (cont/.)

- **write,**
- **spell and**
- is suitable to all types of advertising media



Key considerations when selecting or creating your TM

3. Perception

- It does not have any **undesired connotations** in your own language or in any of the languages of potential markets e.g.
 - “Mugoroki Restaurant” in Taveta town (? In Kikuyu)
 - “Khumon” tyres from Japan ... (? In Kalenjin)
 - Choice of colours?
 - Ford “Pinto” cars? ... (Brazilian slang for male genital)
- “Preservative” (prèservatif) means “Condom” in French language



“Fart” means Speed in Danish language



Key considerations when selecting or creating your TM

4. Domain name

- corresponding **domain name** (i.e. Internet address) is available for registration

Key considerations when selecting or creating your TM

5. Legal requirements (Absolute refusal)

- Your TM of choice is NOT:
 - **Generic term**
 - **Descriptive term**
 - **Deceptive term**
 - **Geographically Descriptive or Deceptive**
 - **Merely a Surname**
 - **Morally offensive or scandalous**

Key considerations when selecting or creating your TM

5. Legal requirements (Relative refusal)

- Your TM of choice is NOT identical or similar to prior registered Mark:

1. Visual similarity



2. Phonetic similarity

Ruuts Beer vs Roots beer®

3. Conceptual or meaning similarity

Gomobile vs Bemobile

INDUSTRIAL DESIGN

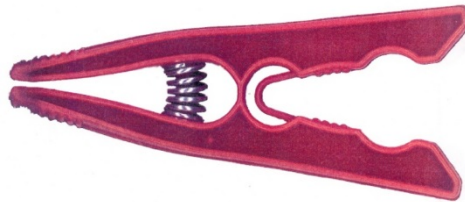
- What is an Industrial Design?
 - an industrial design refers to the ornamental or aesthetic features of a product. In other words, it refers only to the visual appearance of a product **and NOT** the technical or functional aspects.
 - Its those design features that made a product attractive and appealing to the eye.
 - It may be in 3-D based on the shape, form or surface of the object, or 2-D based on the object's patterns, lines or colours.

Subject matter of Industrial Designs

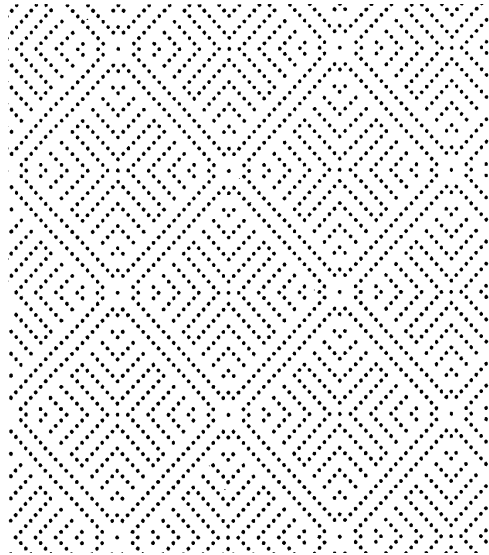
- Any products of industry:

fashions, handicrafts, technical and medical instruments, watches, jewellery, household products, toys, furniture, electrical appliances, cars; architectural structures; textile designs; sports equipment; packaging; containers and “get-up” of products

Examples of Industrial Designs



Examples of Industrial Designs



Importance of Industrial Designs to a Business

- Customize products to appeal to specific market segments:
 - *Co's use ID features to make a difference or make statements about new ways of doing things or new lifestyles*
- Create a new niche market.
 - *the aesthetic appeal of a product can determine the consumer's choice (can be the unique selling point-USP)*

Importance of Industrial Designs to Business

- Strengthen the brands image.
 - *Co's use ID to continually reinvent themselves and invigorate their brands(logos)*
 - *Emotive IDs boost the brands by continually connecting with consumers emotionally*
- It adds value to a product.
 - *ID renders an object attractive and appealing, thus increasing its marketability and therefore adds to its commercial value.*

Why protect an ID?

- the creator is granted the exclusive right to prevent others from unauthorized copying, imitating, making, selling, or importing any product in which the design is incorporated or to which it is applied

Requirements for ID registration

- **New**
- **Original** – independently created
- Design must have “**individual character**” – when overall impression is evaluated against others already known in relevant field.

Geographical Indication (GI)

Introduction

- Geographical indication is an indication which identifies a product as originating from a territory, or a region or locality and that the quality, reputation or other characteristics of the product are exclusively or essentially attributable to that geographic region.
- ‘Attributable’ factors includes:
 - Soil,
 - Climate,
 - Rainfall
 - Altitude
 - Human factor- heritage, cultural practices,

Subject matter

Geographical Indications may be used to protect:

- Agricultural Products
- Handicrafts
- Industrial Products
- Natural or Manufactured goods

Subject matter

Geographical Indications may be used to protect:

- Agricultural Products



Tea in Kericho



Champagne wine



Subject matter

Geographical Indications may be used to protect:

- Industrial Products



Swiss watches

Subject matter Subject matter

Geographical Indications may be used to protect:

- Handicrafts



Kisii Soapstone



Taita Basket weaving

Subject matter

Geographical Indications may be used to protect:

- Natural or Manufactured goods



- Koriema Goats from Baringo

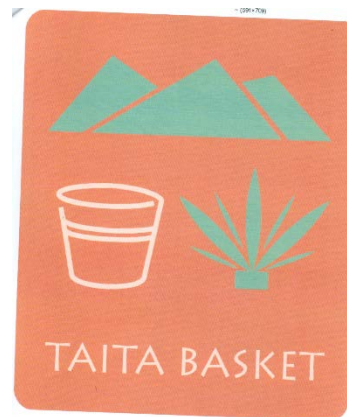


Roquefort Cheese

Protecting GI in Kenya

- Currently Kenya does not have a GI law in place but a bill has been drafted specifically tailored for the protection of Geographical Indications.
- However, since Kenya is a member of WTO and a signatory to the TRIPS Agreement, Articles 22-24 of the TRIPS Agreement obligates member states to put in place mechanism to protect GI's.
- Therefore, the GI's are currently protected as Collective Marks under the Trade Marks Act.

Examples of potential GI's protected as Collective Marks in Kenya



“ECHUCHUKA”
for cosmetic products



THANK YOU.

Q&A

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