



WONGPARTNERSHIP

The Strategic Importance and Use of Trade Marks & Geographical Indications for Business Growth and Development of LDCs

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Outline

- Trade Marks
 - Treaty Sources
 - Nature of Rights
- Geographical Indicators
 - Treaty Sources
 - Nature of Rights
- Comparing Trade Mark and GI protection
- Case Studies

This presentation is for general information only and does not constitute legal advice. Please seek specific legal advice before acting on the contents set out herein.

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Treaty Sources – Trade Marks

- Paris Convention for Protection of Industrial Property
 - Recognition of domestic legislation
 - Emblematic marks
 - National treatment, priority applications, well-known mark protection, etc (Art 6)
 - Other protected rights
 - Service marks (Art 6sexies)
 - Collective marks (Art 7bis)
 - Trade names (Art 8)
 - “Unfair competition” (Art 10bis) – competition contrary to honest practices in industrial or commercial matters”

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Treaty Sources – Trade Marks

- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Art 15, 16
 - Defines standards
 - Subject-matter to be protected, the rights to be conferred and permissible exceptions, minimum duration of protection
 - Applies main substantive provisions of WIPO, Paris & Berne Conventions
 - Enforcement
 - Dispute Settlement

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Treaty Sources – TRIPS Agreement

- LDCs
 - Application can be deferred for 10 years from entry into force and extensions upon request (Art 66.1)
 - WTO TRIPS Council has deferred implementation by LDCs to 1 July 2013 (and to 2016 for pharma products)
 - LDCs encouraged to provide specific technical and financial assistance needs to implement TRIPS
 - For more resources, see <http://www.iprsonline.org/>

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Nature of a Trade Mark

- Sign, or any combination of signs
 - Includes words, personal names, letters, numerals, figurative elements and combinations of colours
- Capable of distinguishing the goods and services of one undertaking from those of other undertakings
 - distinctiveness may also be acquired through use
- Visually perceptible
 - other marks may also be registrable
- Registered in relation to identified goods or services

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Nature of a Trade Mark – Common Exclusions

- Absolute grounds
 - Lacking distinctive character
 - Incapable of functioning as a badge of origin
 - Descriptive marks
 - Kind, quality, quantity, etc
 - Misleading marks (eg as to origin)
- Relative grounds
 - Conflict with prior marks

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Nature of a Trade Mark

- Typically acquired through a registration process
- Examination
- Publication
- Opposition
- Grant
- Trade mark registrations to be maintained
 - Use
 - Renewals
 - Maintain distinctiveness

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Rights Associated with a Trade Mark

- Owner must be granted the exclusive right to
 - prevent all third parties
 - from using in the course of trade
 - identical or similar signs
 - for goods or services identical or similar to those in respect of which the trade mark is registered
 - where there is a likelihood of confusion
 - presumed with use of an identical sign for identical goods or services

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Rights Associated with a Trade Mark

- Confers owner a valuable right of property
 - Transfers/Assignments
 - Licensing
 - Security
- Permits business transactions to be structured around IP assets

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Treaty Sources - Geographical Indications

- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Arts 22, 23
 - Geographical indications have to be protected for all products in order to avoid misleading the public and to prevent unfair competition
 - Higher or enhanced level of protection for geographical indications for wines and spirits
 - Generally, protected even if misuse would not cause the public to be misled.

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Geographical Indications

- "FLORIDA" for oranges
- "IDAHO" for potatoes
- "WASHINGTON STATE" for apples
- "PARMA" for ham
- "CHAMPAGNE" for sparkling wine
- "DARJEELING" for tea

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Nature of GI

- Indications which identify a good as
 - originating in the territory of a Member, or a region or locality in that territory
 - where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin
- Registration of a trade mark which uses a GI in a way that misleads the public as to the true place of origin must be refused or invalidated *ex officio*

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Nature of GIs – Exceptions

- No GI protection where term has become generic
- Measures shall not prejudice prior trademark rights that have been acquired in good faith
- Exceptions cannot be used to diminish the protection of geographical indications that existed prior to the entry into force of the TRIPS Agreement

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Rights Conferred by GI Protection

- Interested parties must have legal means
 - To prevent use of indications which mislead the public as to the geographical origin of the good,
 - To prevent use which constitutes an act of unfair competition

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Comparing GIs and Trade Marks

- Collective Marks
 - Marks registered by an association for use by its members
- Certification Marks
 - Marks certifying the product meets certain standards by the certifying body
 - Not an indication of source, only of quality
- GIs
 - GIs meeting quality associated with a geographical region
 - Not necessarily based on registration system

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Strategic Importance of a Brand

- Differentiator of products
 - Brands “speak” to customers
 - Distinguish and identify the source of the product
 - Communicate standards of quality and consistency
- Influence purchase decisions and avoid customer confusion
- Allows customers to find and purchase products
 - Repeat customers
 - Communicate reputation of a brand

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Thank You!

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