

# **“Making a Mark” – The Role of Trademarks in Branding**

WIPO Training of Trainers Program on  
Effective IP Asset Management by SMEs

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# This Presentation

1. Why should you listen?
2. What are trademarks and why do we need them?
3. Trademarks vs branding
4. What rights does trademark registration provide?
5. Trademarks do not grant a monopoly
6. How to select a successful trade mark?
7. How to register your trade mark?
8. How to enforce your trade mark rights?

# Question 1

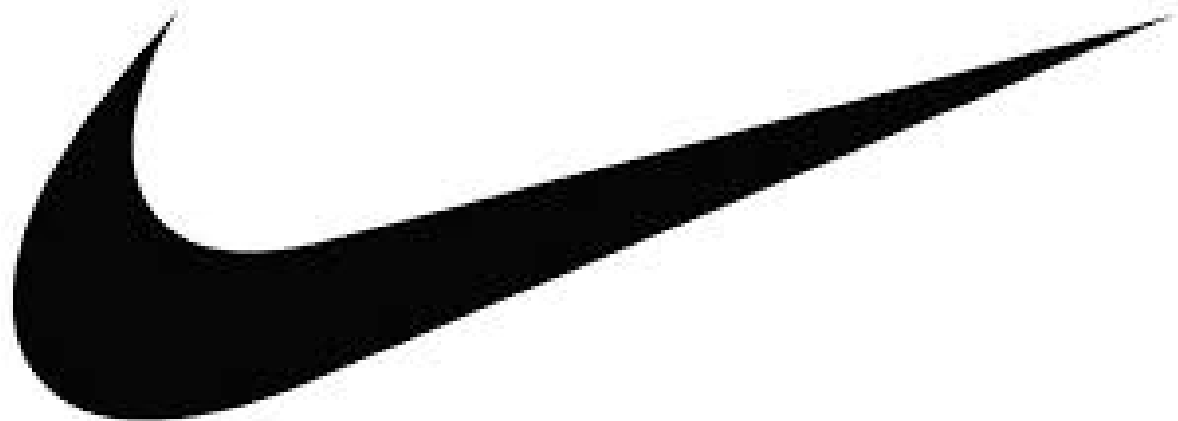
**WHY SHOULD YOU LISTEN?**

# 4 Common mistakes made by SMEs

- Focusing on trademarks, instead of **branding**.
- Not registering TM that **need** to be registered.
- Wasting time and money by registering **worthless trademarks**.
- Wasting time and money by filing TM applications that have **no chance of being approved** by the IP Office(s).

## **Question 2**

**WHAT'S THE DIFFERENCE BETWEEN  
A BRAND AND A TRADEMARK?**



# What is a Brand?

- A collection of **perceptions** and **expectations** in the mind of consumers ...
- which is established through consistent **marketing**, public relations efforts and money.

# What is a Brand?

- A strong brand will **engender feelings of trust, loyalty and recognition** in the customer's mind
  - will result in **market success**
  - will increase the **value** of the company.



# What is a Brand?

## ■ Branding Basics: “The four Ps”

- Product
- Price
- Place
- Promotion

# What is a Brand ?

■ A brand typically consists of:

- name
- identifying mark
- subsidiary marks
- logo
- slogan
- images, colors, symbols
- mental concepts, vision

Nike, Inc.

Nike, Nike Golf, Nike+, Nike Pro

Brand Jordan, Converse  
swoosh, jumpman

Just do it.

Celebrity endorsement, black & white

To bring inspiration and innovation to  
every athlete in the world.

If you have a body, you are an athlete

# Importance of Branding for SMEs

## Characteristics of today's Industry:

- Very changeable environment
- Intense competition caused by globalization
- Becoming more and more difficult for a company to maintain long term success



Firms without any **distinct features**, without a clear **vision** or specific mission, or without permanent **values**, will sink in the mass

# The Importance of Branding for SMEs

- Branding can take a commodity product and imbue it with qualities that make consumers choose it over any other.
- **At the heart of branding lie trademarks!**

## **Question 3**

**WHAT IS A TRADEMARK?**

# What is a Trademark?

- “A sign capable of **distinguishing** the goods or services produced or provided by one enterprise from those of other enterprises”

# Forms of Trademarks

## ■ Traditional trademarks

- Words
- Personal Names
- Letters
- Numerals
  
- Logos
- Pictures & Drawings
- Arrangements of Colors
  
- Combinations

# Forms of Trademarks

## ■ Non-conventional trademarks

- Slogans
- Movie/book titles
- Single colors
  
- 3D signs (shapes or packaging)
- Moving images, holograms
- Sounds
- Smells
- Gestures
- Fluid/mutating marks



# Function of Trademarks

- TM address the question “**which?**” rather than “**what?**”
- The function of TM is not to help a person choose sea salt over body lotion, but for a person who wants sea salt to decide which one.

- **Distinctive sign:** Identifies certain goods/services as those produced or provided by a specific person or enterprise
- **Exclusive rights:** To prevent others from using identical or similar marks on identical or similar goods
- **Renewable** indefinitely ! 
- **Registration** is required in most countries (exception: well-known trademarks)

After P,  
all they have...

## **Question 4**

**WHAT RIGHTS DOES TRADEMARK  
REGISTRATION PROVIDE?**

# Registration Provides **Exclusive** Rights

- The exclusive rights allow you to prevent all others from marketing **identical or similar products** under an **identical or a confusingly similar mark**.

# Registration Provides Exclusive Rights

- You will be able to prohibit competitors from :
  - affixing the mark to goods or their **packaging**;
  - **stocking or selling** goods bearing the mark, or supplying services under the mark;
  - **importing or exporting** goods under the mark; or
  - using the mark on business papers, websites and in **advertising**.

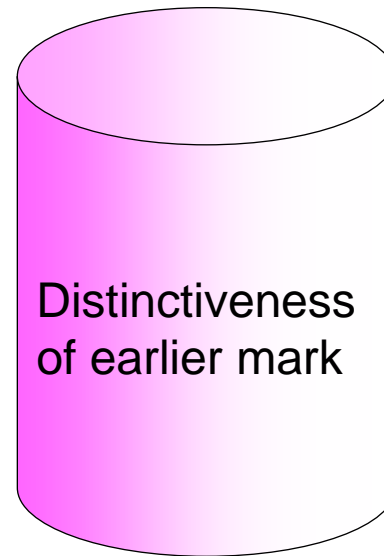
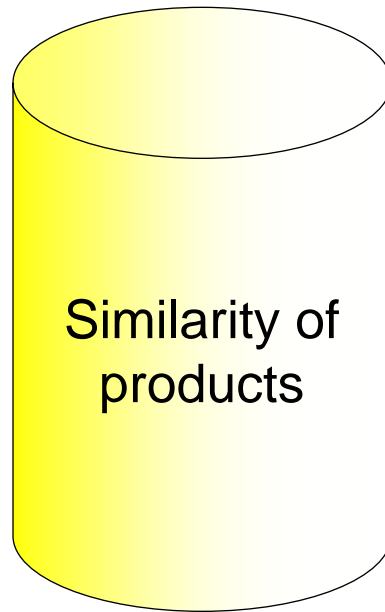
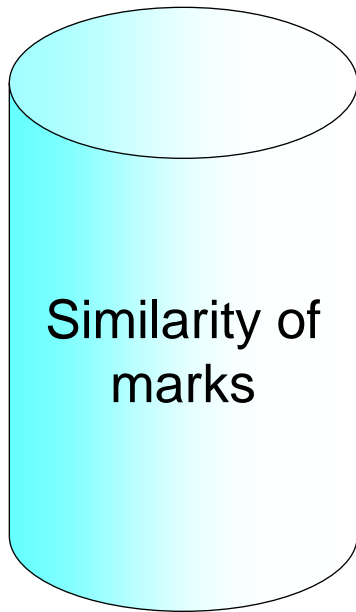
# But! Exclusive Rights are Limited to...

- the **countries** in which you have registered the mark;
- the **goods/services** for which the mark is registered;
- situations in which consumers are **likely be confused** by the infringing mark.

**APPLY**

**apl**

# Likelihood of Confusion

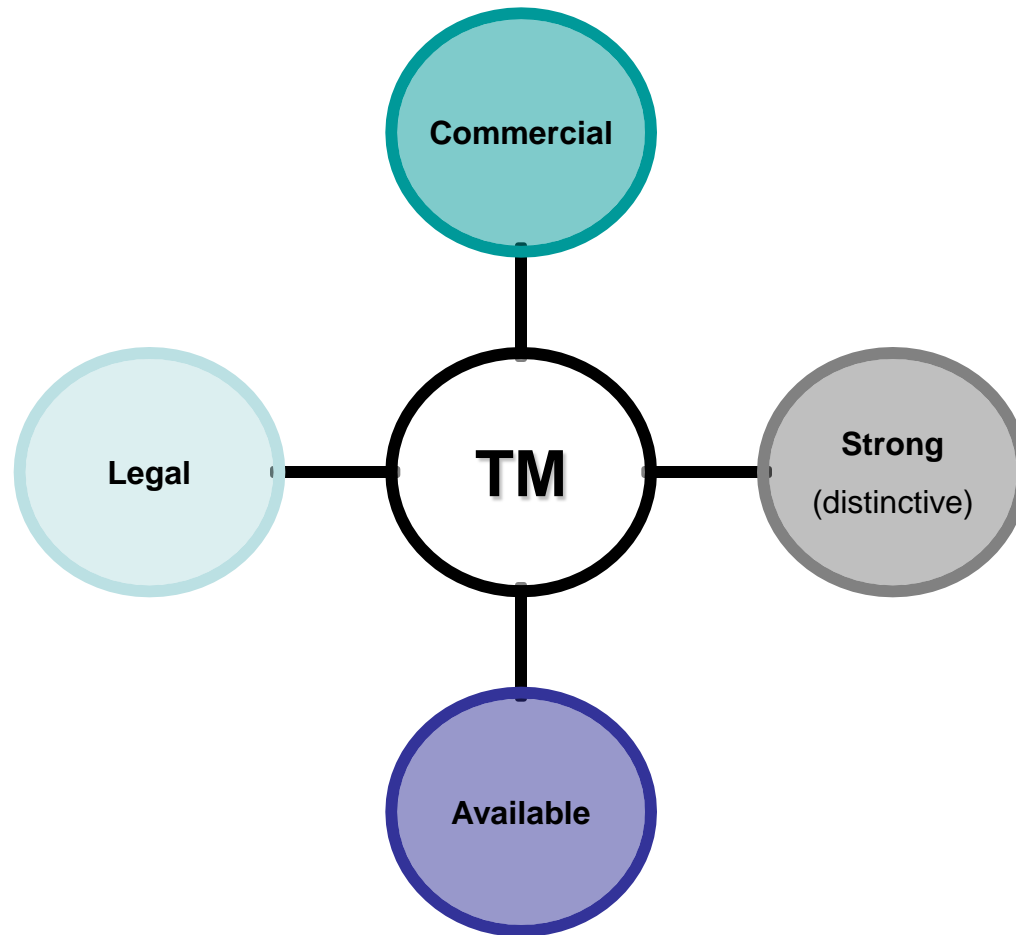


## **Question 5**

# **HOW TO SELECT A SUCCESSFUL TRADEMARK?**



# How to select a successful mark?



# 1. Check Legal Factors: Grounds for Refusal

- **Generic words or signs**

- **SALT** to sell Death Sea salt

- **Descriptive words or signs**

- **SOFT** to sell bed linen

- **SWEET** to sell wine

- **Geographic words or signs**, if they are geographically descriptive

- **AMMAN BAND**

- **Deceptive words or signs**

- **“ORWOOLA”** for 100% synthetic material

- **Marks contrary to public order/morality**
- **Flags**, armorial bearings, official hallmarks, emblems
- **Functional features**
  - E.g. shape of the handles and blade assembly for a pair of scissors, which is necessary for the functioning of the scissors
  - E.g. handle as such on a coffee cup



## ■ **Prior trademark rights**

- Having two identical (or very similar) marks for the same type of product could cause confusion among consumers.
- Well-known marks ...
- Trademark search!

## ■ **In many countries, other prior rights**

- Name, image, copyright, geographical indication, appellation of origin, industrial design, other industrial property right.

## 2. Choose a Strong Mark

- **Fanciful:** strongest, but great marketing effort needed
  - STELLA ARTOIS, for beer
- **Arbitrary:** very strong, still great marketing needed
  - SUNNY, for mobile phones
  - APPEL, for computers



- **Suggestive** : attractive for marketing, but less protection
  - SUNNY, for lamps
  - KASTEELBIER (CASTLE BEER), for beer
- **Descriptive**: not protected, unless distinctive character established through extensive use
  - SWEET, for chocolate
  - RAPID, BEST, INNOVATIVE, for computers



# 3. Check Commercial Factors

- Easy to read, write, spell and remember
- Suitable to all types of advertising media
- Avoid negative connotations in your own language + potential export markets
  - E.g., Negro for t-shirts (SP-ENG)
- Domain name, twitter, facebook, etc available?
- Support with **graphic elements** (colors, designs) to enhance the impact of the TM on consumers

# 4. Check Availability

- Home country and potential export markets
- Current product lines and potential future products/services
- Trademark search





## Question 6

# HOW TO REGISTER YOUR TRADEMARK?



# Three Ways to Register

## ■ The National Route

- Industrial Property Protection Directorate
- [www.mit.gov.jo](http://www.mit.gov.jo)
- see Making a Mark

## ■ The Regional Route

- African Regional Industrial Property Office (ARIPO) for English-speaking African countries ([www.aripo.org](http://www.aripo.org));
- Benelux Office for Intellectual Property (BOIP) ([www.boip.int](http://www.boip.int));
- Office for the Harmonization of the Internal Market (OHIM) for Community trademarks (CTM) in the countries of the European Union ([www.oami.europa.eu](http://www.oami.europa.eu)); and
- *Organisation Africaine de la Propriété Intellectuelle* (OAPI) for protection in French-speaking African countries ([www.oapi.wipo.int](http://www.oapi.wipo.int)).

## ■ The International Route

- Madrid System

# Advantages of Madrid

- You can register your mark in all the (92) countries party to the system by **filing**:
  - a single international application;
  - in one language;
  - subject to one set of fees and deadlines.
- Thereafter, the international registration can be **maintained** and renewed through a single procedure.
- The Madrid system thus **reduces** the **administrative burden** and **costs** involved in registering and maintaining marks in multiple countries.
- See: [www.wipo.int/madrid](http://www.wipo.int/madrid).

## **Question 7**

# **SOME TRADEMARK TRICKS & TIPS FOR SMEs**

# Tip 1: Trademark Search

## ■ IP offices

- [www.wipo.int/directory/en](http://www.wipo.int/directory/en)

## ■ WIPO Global Brand Database

- [www.wipo.int/reference/en/branddb/](http://www.wipo.int/reference/en/branddb/)
- Free of charge brand-related searches

## ■ ROMARIN

- [www.wipo.int/madrid/en/romarin/](http://www.wipo.int/madrid/en/romarin/)
- All international TM recorded under Madrid

## ■ Google

## ■ NameChk.com

- Social networking websites

# Tip 2: Use or Lose

## ■ **Obligation to use the mark 3 years after registration**

- In relation to all the products or services
- As it is registered

## ■ **Use of the mark includes ...**

- Placing mark on products or packaging
- Offering TM goods for sale; stocking TM goods; importing/exporting TM goods
- Use TM on invoice, advertising, business paper, etc.
- Through license

## ■ **Use in a consistent way + ®**

# Tip 3: Protecting Abroad

## ■ Choose a local language mark. Register all variations

- Consult language specialists and be sure to select a strong mark that has resonance with the local consumers
- Arabic mark: you may be required to provide translation or transliteration into local language

## ■ Monitor carefully for infringing marks

- Marks that *sound* and *look* similar, or have the same *meaning*. Also prior registered *domain names*.

## ■ Get familiar with the local trademark system

## ■ File broadly

- In all relevant classes. Also for products you might use in future.
- Even if you are only manufacturing (not intending to sell there)
- Even if you only grant licenses there

## ■ File in time

- 6 month priority term
- Before actual **importation** of any goods and even prior to meeting or **negotiating** with other businesses in the foreign countries (esp if first-to-file country)



## Question 8

# HOW TO ENFORCE YOUR TRADEMARK?



# Another TM Infringes Your Rights ...

- when a competitor uses the **same or a confusingly similar** mark
- for the **same or similar** products
- in a country where your mark is protected
  
- Most times, the question becomes whether a specific mark is too close to yours, so that the consumers are **likely to be confused**.

# Remedies

- **Cease and desist letter**

- Surprise action by **search and seize order** (if willful infringement)

- **Border measures**

- Many customs can search, examine and seize goods that they suspect infringe trademark (or other IP) rights.

- **Arbitration and Mediation**

- **Court proceedings**

# CONCLUSIONS

- In most businesses the brand, and the trademark, are one of the most valuable assets.
- Branding is an expensive exercise that takes time. But, once consumers ask for your product by name, a business is set to capitalize for years to come.
- Doing a proper search and knowing the basics on TM can help avoid wrongful applications and wrong trademark registrations.

# The Role of Trademarks in Branding

Thank You!

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