

BRAND PROTECTION



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Interbrand's 2012 Best Global Brands

2012 RANK	2011 RANK	BRAND	SECTOR	2012 BRAND VALUE \$m	% CHANGE (Brand Value)
1	1	Coca-Cola	Beverages	77,839	8%
2	8	Apple	Technology	76,568	129%
3	2	IBM	Business Services	75,532	8%
4	4	Google	Technology	69,726	26%
5	3	Microsoft	Technology	57,853	-2%
6	5	GE	Diversified	43,682	2%
7	6	McDonald's	Restaurants	40,062	13%
8	7	Intel	Technology	39,385	12%
9	17	Samsung	Technology	32,893	40%
10	11	Toyota	Automotive	30,280	9%
11	12	Mercedes-Benz	Automotive	30,097	10%
12	15	BMW	Automotive	29,052	18%
13	9	Disney	Media	27,438	-5%
14	13	Cisco	Business Services	27,197	7%
15	10	HP	Technology	26,087	-8%

What is a trademark ?

- any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings

What is a trademark ?

- Different types of trademarks :

- Word trademarks

COCA-COLA

- Figurative trademarks



- Semi-figurative trademarks



What is a trademark ?

- Different types of trademarks :
 - **Slogans** :
 - “Love work play”;
 - “Vorsprung durch Technik” ;
 - “Mannen weten waarom”; etc...

What is a trademark ?

- Color marks:



- Sounds :



Registration : territory

- Registration is required with an office (national or supra national)
- It is a “territorial” right : rights only in the territories where the trademark is registered
 - Eg : Benelux 240 € / EU : 900 €

Registration : goods & services

- A trademark is registered only in relation to specific types of goods or services (arranged in “classes”)
 - E.g. Lotus for food, for cars and for paper towels ; Levi's for jeans and for painting, etc...



Registration : goods & services

- Nice classification

List of Goods and Services by Class Order

Goods

[1](#) [2](#) [3](#) [4](#) [5](#) [6](#) [7](#) [8](#) [9](#) [10](#) [11](#) [12](#) [13](#) [14](#) [15](#) [16](#) [17](#) [18](#) [19](#) [20](#) [21](#) [22](#) [23](#) [24](#) [25](#) [26](#) [27](#) [28](#) [29](#) [30](#) [31](#) [32](#) [33](#) [34](#)

Services

[35](#) [36](#) [37](#) [38](#) [39](#) [40](#) [41](#) [42](#) [43](#) [44](#) [45](#)

Registration : may not be descriptive

- A trademark can be refused if it describes the goods or services for which registration is applied for
 - Example : Apple for apples is not ok but Apple for computers is ok.

Registration : may not be descriptive

- Even if it has been registered, it can still be annulled by a Court if it was not distinctive:
 - Example “**Texto**” : Cour d’appel de Paris 1ère chambre Arrêt du 23 septembre 2009 (cf www.legalis.net) : *“qu’il convient de constater qu’à la date du dépôt de la marque “Texto”, ce terme était devenu usuel pour désigner un message envoyé par téléphonie et qu’il n’était pas associé à la société SFR ;”*
- Or if it became descriptive : aspirin, cellophane, escalator, pedalo, etc...

There is no such thing as a xerox.

You can't make a xerox. You can't go to the xerox.
And you can't xerox anything. Ever.

You can make copies on the Xerox copier.

You can go to the Xerox copier or to a Xerox computer.

You can read a Xerox textbook.

It's taken us a lot of years to get our good name. And we
intend to keep it. So we thought we ought to tell you how to
use Xerox.

When referring to our trademark Xerox, it should always be
followed by the descriptive word for the particular product,
such as "Xerox copier" or "Xerox computer" or "Xerox textbook."

You know the old saying, "We don't care what you say
about us as long as you spell our name correctly?"

Well, we do care.

Spell it right. But please use it right, too.

XEROX

P. S. Please make copies of this.

Registration : except if secondary meaning

- If, through intensive use/advertising, the public does not see it as descriptive but as an indication of origin
 - Example : QUICK for fast-food restaurants

Registration : but can be suggestive

- A suggestive (>< descriptive) sign can be registered....
- But it usually enjoys a narrower scope of protection
 - Example : Baby-dry for diapers

Registration : Fantasy names

- Fantasy names are usually easier to protect and enjoy a broader protection
 - Examples : Kodak, Google, etc...

What rights does it give ?

- The proprietor shall be entitled to prevent all third parties (not having his consent) from using in the course of trade any sign... which meet any of the three conditions :
 - Double identity, or
 - Likelihood of confusion, or
 - Enhanced protection.

What rights does it give ?

- Double identity
 - any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;
- Example :
 - Coca-Cola registered for soft drinks against
 - Coca-cola used for soft drinks

What rights does it give ?

- Likelihood of confusion
 - any sign where, because of its identity with or similarity to the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
- Examples :
 - Mobistar registered for telecom services against
 - Mobitel for telecom services
 - Mobistar for computers

What rights does it give ?

- Enhanced protection
 - any sign which is identical with or similar to the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.
- Example

What rights does it give ?

- If you have a mark and you meet in any of those conditions, you are entitled to :
 - an order to stop using your mark
 - damages for the unauthorized use

What rights does it NOT give ?

- Any right against :
 - Test-Achat making a bad (but objective) comment about your services and using your trademark
 - A competitor making a comparative advertising (provided that some conditions are met)
 - Someone using the mark in a totally unrelated sector (unless it takes unfair advantage of the reputation of the mark)
- Any automatic right to use the trademark !
 - Attention : there may still be valid prior rights covering the trade mark (copyright, trade name, company name etc...)

Registration : Avoiding problems

1/ With the offices :

- Avoid descriptive signs
- Avoid too suggestive signs
- If too suggestive, include a graphical element that has distinctive character

Registration Avoiding problems

2/ With third parties :

- Have good agreements in place with the person who “created” the trademark (esp. if it contains some copyrighted materials, such as a slogan or a logo!)
 - Un sourire, une carte, c’est payé (Proton)
 - Pairi Daiza (Parc Paradisio)

Registration Avoiding problems

3/ With third parties who have prior rights:

- Owners of prior rights may oppose the registration of the trademark within 2 months from publication
- Important to make an “availability search”
- Prior trademarks in the Benelux
(<http://register.boip.int>)
- Prior Community trademarks
(<http://oami.europa.eu/ows/rw/pages/QPLUS/databases/searchCTM.fr.do>)

Avoiding problems

- Prior company names
(<http://kbopub.economie.fgov.be/kbopub/zoekwoordenform.html?lang=fr>)
- Check the availability of the domain name
(www.dns.be, www.internic.net)
- Perform searches in search engines like Google
- Extremely important : even after the opposition deadline, third parties with prior rights may still revoke the mark and prevent you from using (your mark)... for five years !

Conclusions

- The earlier/the more.... the better
- Your mark must be distinctive and available
- Check if third parties may have rights
- Think about the territorial protection, the type of mark (word / figurative)
- Describe correctly the products/services
- File as soon as possible (at least in the Benelux) to allow time for potential oppositions