

INTERNATIONAL AND REGIONAL TRADEMARK SYSTEMS



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TRADEMARK FILING IS ABOUT STRATEGY

NATIONAL ROUTE VS. REGIONAL/INTERNATIONAL ROUTES

REGIONAL ROUTE: EX THE COMMUNITY TRADEMARK

INTERNATIONAL ROUTE: THE MADRID SYSTEM

TRADEMARK FILING IS ABOUT STRATEGY

Before filing and protecting a mark, it is recommended for a company to:

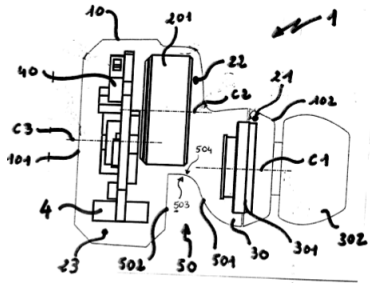
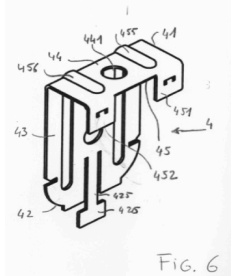
- link the IP strategy with the business strategy of the company;
- identify the territories where protection may be sought;
- anticipate future business development/new products;
- define a TM strategy (defensive, offensive etc...);
- implement a strategic/cost effective filing strategy;
- anticipate possible registrability issues/ infringements of IP.

IDENTIFY TERRITORIES



IDENTIFY IP ASSETS

PATENTS



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GAULTIER



TRADEMARKS

Prōpagānda

COPYRIGHT

Books
Press articles
Software
Databases
Music
Photographs
Web pages
Pictures
Sculptures
Multimedia works ...

DESIGNS



OTHER IP

Know-how
Know-why
Trade secrets
Geographical indications
Plants breeder's right
Integrated circuit layout
Traditional knowledge...

What is a mark?

Any sign that can be represented graphically (words, symbols, images, etc...) which is used to differentiate in the market products or services from different companies.

To be valid the sign shall **be DISTINCTIVE** and **AVAILABLE** and **not be prohibited by law**

What is a mark?

Word marks

LOUIS VUITTON

L'OREAL

BMW

Semi figurative marks

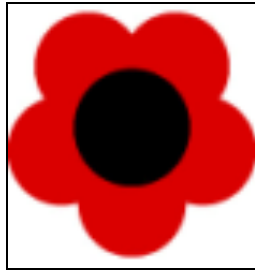
Pr̄p̄agānda

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What is a mark?

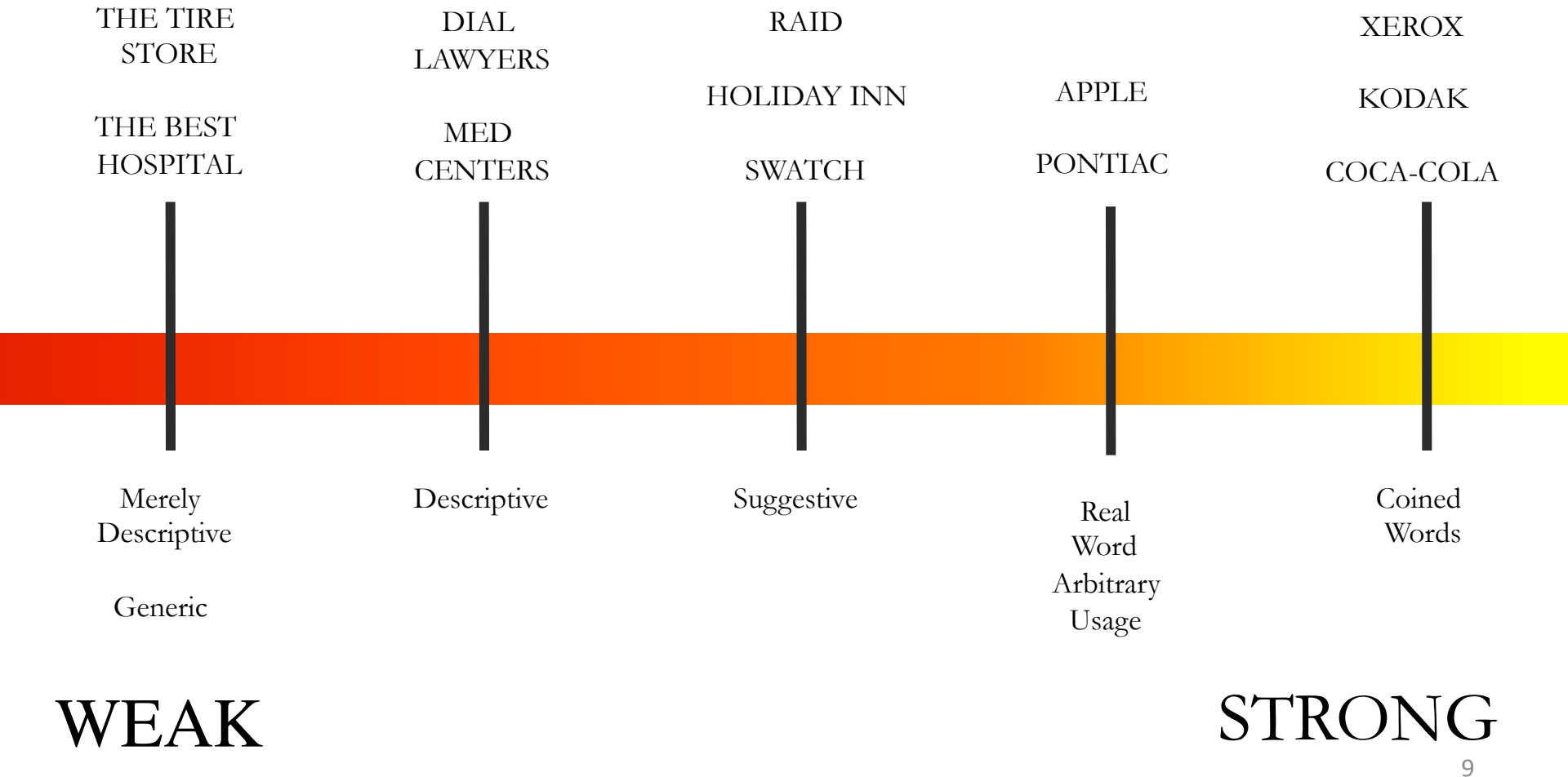
Figurative marks



Three dimensional marks



HOW TO CHOOSE THE RIGHT NAME FOR A TRADEMARK?



Regional System: the Community Trademark (CTM)

Unitary Character

A CTM is a trade mark valid across the European Union (27 countries), registered with OHIM in accordance with the provisions of the CTM Regulations. The Community trade mark is **unitary in nature**, i.e. it is valid everywhere in the European Union, and gives its proprietor **exclusive rights** enabling them to prohibit any third parties from using the sign in their commercial or industrial activities. It is not possible to limit the geographic scope of protection to certain Member States.

Simple procedure

The unitary nature of the Community trade mark, which covers all the countries of the European Union, means that formalities and management can be kept simple, there being:

- a single application
- a single language of procedure
- a single administrative centre and
- a single file to be managed.

Regional System: the Community Trademark (CTM)

Reduced costs

This simple procedure results in considerably reduced costs as compared with the overall costs of national registration in all or many of the countries of the European Union.

Filing a Community trade mark application is not expensive: EUR 900 to file online (e-filing) or EUR 1050 if you use the paper form.

Option of claiming the seniority of national trade marks

The Community trade mark has been designed to complement the national systems of protection. If an applicant or proprietor of a Community trade mark already holds a prior identical national trade mark for identical goods and services, they may claim the seniority of that mark. This allows applicants/proprietors to preserve their prior rights even if they surrender their national trade mark or do not renew it.

Right of priority

A Community trade mark applicant can claim the priority of an identical earlier national or international registration filed for the same goods and services during a period of six months from the date of filing of the first application, and thereby benefit from the effects of the earlier date.

Regional System: the Community Trademark (CTM)

Obligation of use which is easy to meet

CTMs shall be put to genuine use in the Community within a period of five years following registration (Article 15 CTMR). Genuine use may be found when the mark has been used in only one part of the Community, such as in a single member state or in a part thereof. Any person (legal or natural) can protect their registered CTM against revocation on the grounds of lack of use – provided it is put to genuine use in the Community after the initial five-year post-registration grace period or if there are proper reasons for such non-use.

Broadened legal protection which is accessible to all

Infringement proceedings may be brought before the **Community trade mark courts**, which are national courts designated by the EU member states to have jurisdiction in respect of Community trade marks. Decisions may have effect throughout the EU. This can avoid the need to prosecute infringers in each member state. Only the Community trade mark has such protection across the whole of the European Union.

Regional System: the Community Trademark (CTM)

The CTM system provides for **one single registration** procedure, consisting of:

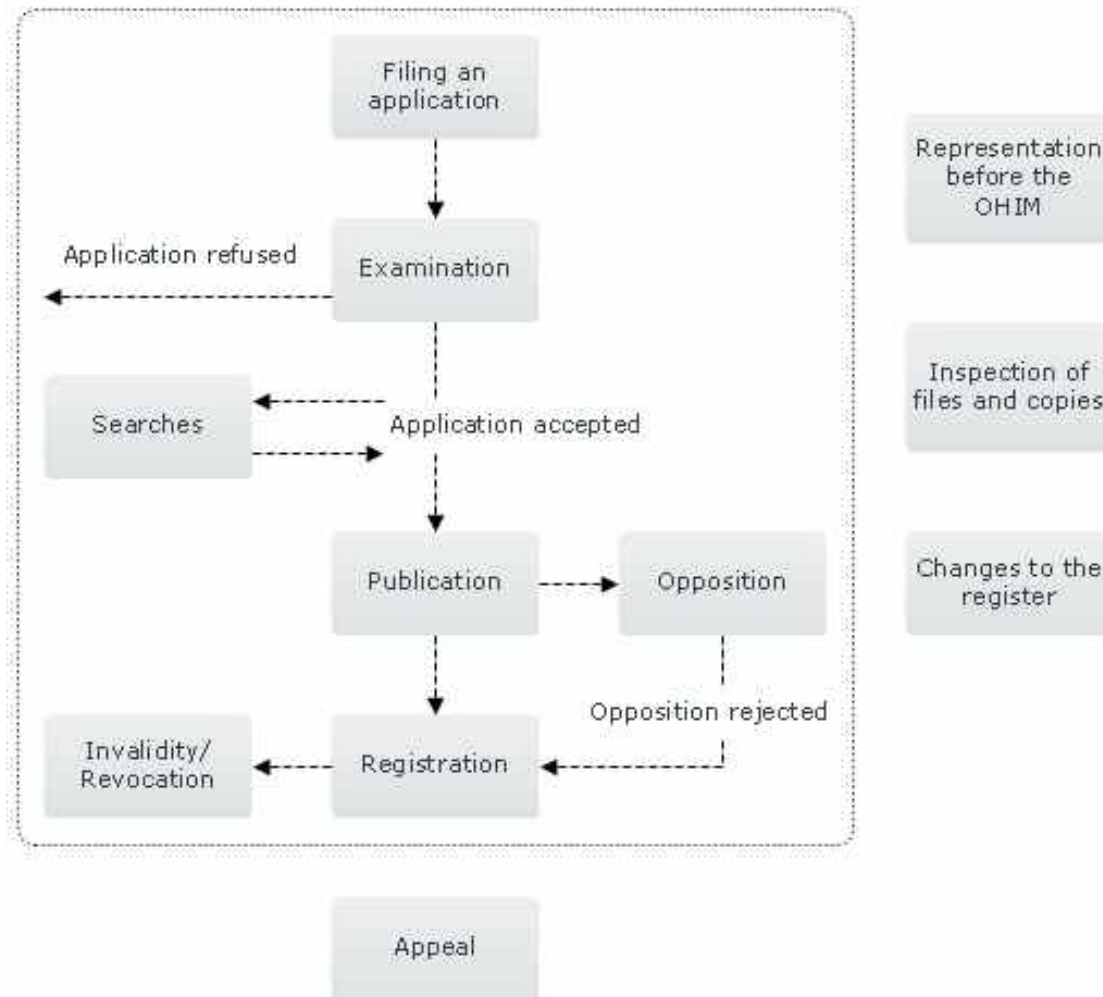
- a single application
- a single language of procedure
- a single administrative centre and
- a single file to be managed.

There are two different ways to obtain protection for a trade mark in the whole EU:

1. A Community trade mark: an exclusive right that protects distinctive signs, valid across the EU, registered directly with OHIM in Alicante in accordance with the conditions specified in the CTM Regulations.

2. An international trade mark designating the European Union (EU): likewise an exclusive right but administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva according to the Madrid Protocol. WIPO processes the application and then sends it to OHIM for examination according to the conditions specified in the CTM Regulations. This has the same effect as applying directly for a Community trade mark.

Regional System: the Community Trademark (CTM)



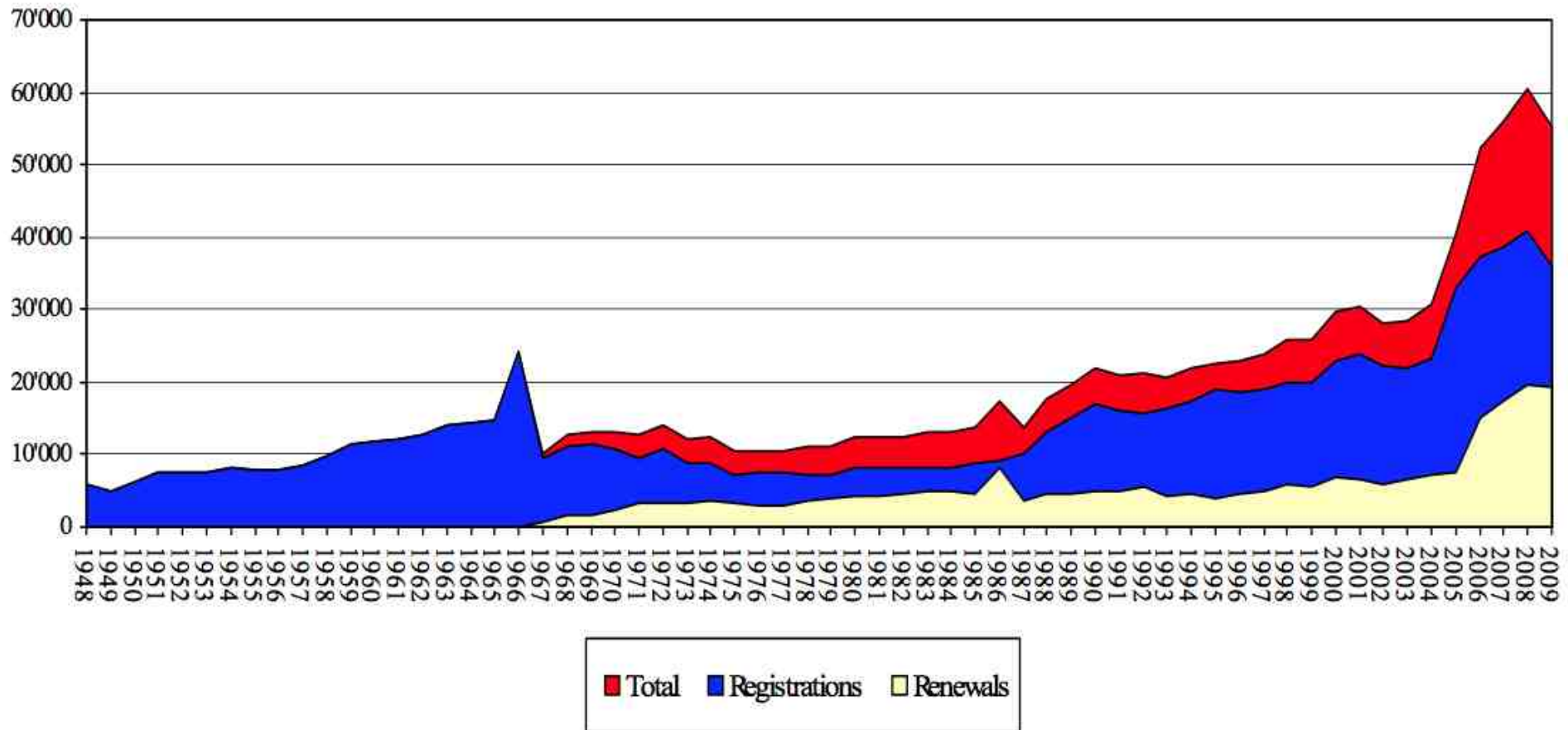
International System: the Madrid System

The system of international registration of marks is governed by two treaties:

- **the Madrid Agreement** Concerning the International Registration of Marks (1891)
- **the Protocol Relating to the Madrid Agreement**, adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996.
- Completed by common regulations and administrative instructions and administered by the International Bureau of WIPO, which maintains the International Register and publishes the WIPO Gazette of International Marks.

85 countries (only one country Algeria is member of Agreement only)

International System: the Madrid System



International System: the Madrid System

Who may use the Madrid System?

An application for international registration (an “international application”) may be filed only by **a natural person or a legal entity which has a real and effective industrial or commercial establishment** in, or is domiciled in, or is a **national of, a country which is party to the Madrid Agreement or the Madrid Protocol**, or who has such an establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol, or is a national of a Member State of such an organization.

International System: the Madrid System

How to use the Madrid System?

- Need a basic application in a Contracting Party (CP) of the Madrid System
- Need to fulfill requirements of establishment, domicile or nationality
- International Application (IA) can be filed only if basic application has been registered (Agreement only) or applied for (for countries parties to the Protocol)
- IA must be presented to the International Bureau (IB) through the Office of Origin (OO)
- Possibility to claim priority (Art. 4 Paris Convention)
- Pay a basic fee ; a complementary fee for each designated contracting party for which no individual fee is payable; a supplementary fees above three classes except for countries with individual fees.
- For Least Developed Countries, reduction of basic fee by 90%
- If application complies with requirements, publication in the Gazette and IB will notify each CP.
- CP will examine application (12 months, 18 months possible for Protocol countries who make a declaration). In case of objection the CP will notify the IB. National rules apply in case of objection.

International System: the Madrid System

More flexibility introduced by the Protocol:

- 1) Country of office of origin is party to Agreement only=only states member to Agreement can be designated
- 2) Protocol only=only states member to Protocol
- 3) Both Agreement and Protocol=any other contracting party.

Dependence on the basic application (5 years), however under Protocol transformation into national mark is possible

International System: the Madrid System

Advantages

National route

Different procedures

Different languages

Different fees in local
currencies (exchange-rate
implications)

Management

Recording of changes
(in each separate country a
different procedure)

Representative required
from outset

Madrid

One procedure

One language (E/F/S)

One currency (CH)

Same protection as a national registration

One procedure in respect of all countries

Representative required only in case of
refusal

EXERCICE 1

A Thai company X,Y,Z Co. Ltd would like to register the brand “OISHI” for restaurants in **Korea, Europe, USA, China** and **the United Arab Emirates**. The Thai company has filed **on June 1, 2011** a trademark application in Thailand and is now asking you to recommend a filing strategy (national/regional/international).

- 1) What questions would you ask to X,Y,Z?
- 2) What strategy (ies) can you recommend and why?

EXERCICE 2

A Korean national would like to protect two trademarks “Lady Gaga” and “Wonder Girls” for cosmetics in Europe, USA, China and Japan.

He is asking for your advice on how to protect these marks through the international trademark system.

- 1) What questions would you ask to the applicant?
- 2) What strategy (ies) would you recommend and why?

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INTELLECTUAL PROPERTY

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