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# Marketing Products

Creating IP Culture Among Small  
and Medium-Sized Enterprises

Sofia, October 17 and 18, 2017

**Teresa Nobre, LL.M. IP (MIPLC)**



# **Developing a Brand Image through Trademarks**

**Teresa Nobre, LL.M. IP (MIPLC)**

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# Objectives

- Understand the vital role played by trademarks in reinforcing **brands**, and the differences between brand/ trademark
- How to **create** new TMs that appeal to consumers and are easy to enforce against competitors
- How to **protect** signs, slogans, taglines, logos from unauthorized exploitation or use by others
- How to avoid the **risk of infringing** the TMs of others
- How to **enforce** your rights

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# What is a brand?

Brand refers to the proprietary **visual**, **emotional**, **rational** and **cultural** image that customers associate with a company or a product.

- **Recognition and Brand Loyalty:** a consistent good experience with a product translates into brand preference and loyal consumers
- **Image of Quality:** many consumers buy a brand (not a product) that promises a higher quality
- **Image of Size:** a strong brand projects an image of a large and established business
- **Image of Experience and Reliability:** a strong brand reassures that the business is more reliable and trustworthy

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# What is the value of a brand?

Consumer

Promise and  
delivery of an  
experience

Business

Security of future  
earnings

Legal

Piece of  
intellectual  
property

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# What is the difference between a brand and a trademark?

A “trademark” is often referred to as a “brand”. While a trademark is a vital element of a brand, the meaning of “brand” is much wider.

## A brand includes:

- Trademarks
- Trade dress
- Designs
- Slogans
- Symbols
- Sounds
- Technology
- Concept, image and reputation that connects consumers with specific products/services
- Etc.

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# What is a trademark?

A mark is a **sign** capable of **identifying** and **distinguishing** in the marketplace the products of one enterprise from those of other enterprises.

- Personal name, letters and numerals
- Combination of colours
- Figurative elements, e.g. drawings and shapes
- Taglines, slogans and titles
- Non-traditional trademarks, e.g. single colors and packaging

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## **Trademarks composed of words, numbers, letters**

Provides a broad protection because it limits a competitor's use of any figurative version of the TM that is confusingly similar for the same type of goods and/or services.

Yahoo! ®

ZARA®



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## Stylized version of a word trademark

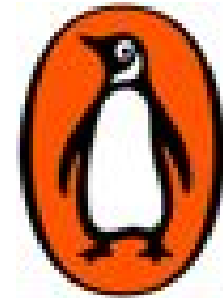
If the trademark owner not only wants to protect the characters but also the design, color, or some other distinctive element, a special form trademark is required.

The image shows the word "YAHOO!" in a stylized, purple, serif font. The letters are bold and have a slightly irregular, hand-drawn appearance. The exclamation point is also in the same purple color and style.The image shows the word "ZARA" in a stylized, black, serif font. The letters are bold and have a slightly irregular, hand-drawn appearance. The logo is enclosed in a thin black rectangular border.

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# Figurative Elements

A trademark registration could also be a logo in and of itself. In such a case, there are no words included as part of the trademark.



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## Figurative elements and words

Letters, numbers and slogans that lack distinctiveness may be hard to register alone, but they may be registered together with a distinctive figurative element.



# Non-traditional marks

TMs based on a single color, appearance, shape, sound, smell, gesture, taste and texture are often difficult (and in most countries not possible) to register.



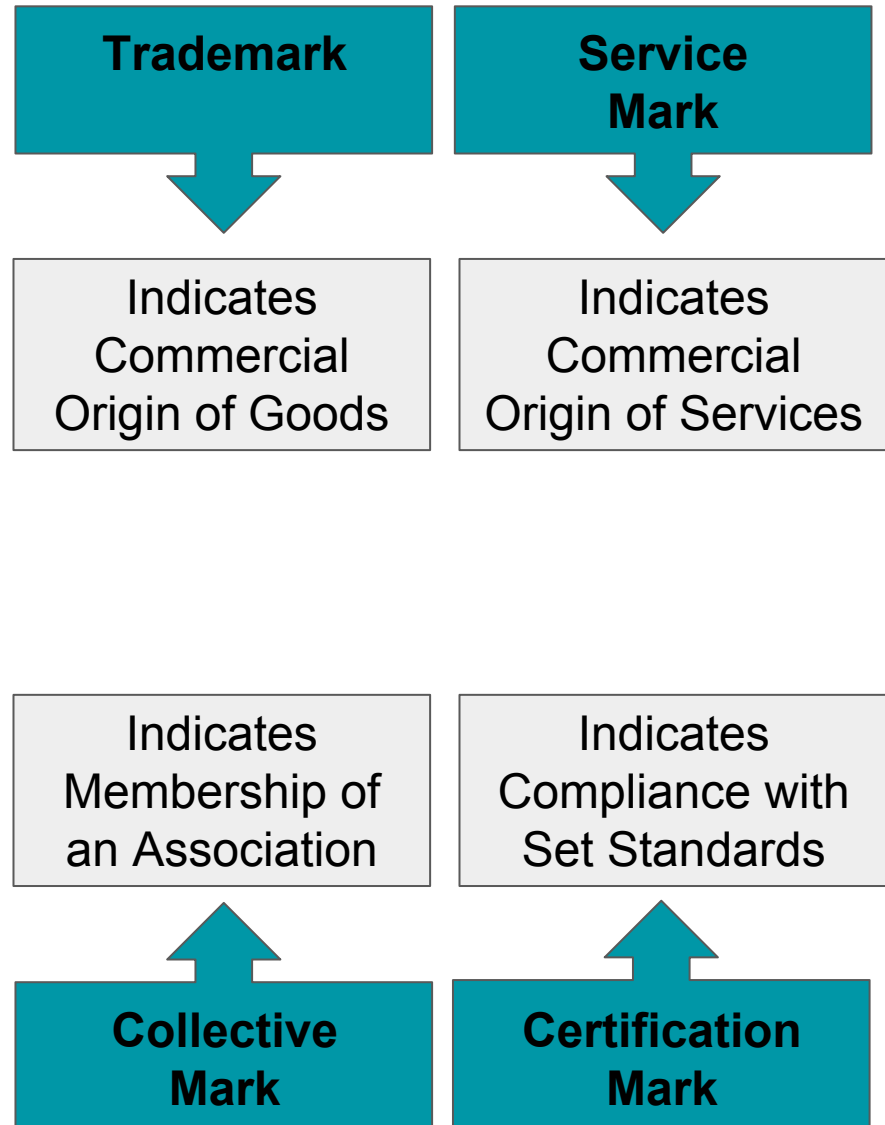
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# What are trademarks for?

- Make it easier for consumers to **find your product**
- Help prevent **consumer confusion**
- Efficient **marketing and communication** tool
- Basis for building **brand image and reputation**
- Valuable and enduring **business asset**
- Make it easier to hire and retain employees
- Effective weapon against **unfair competition**

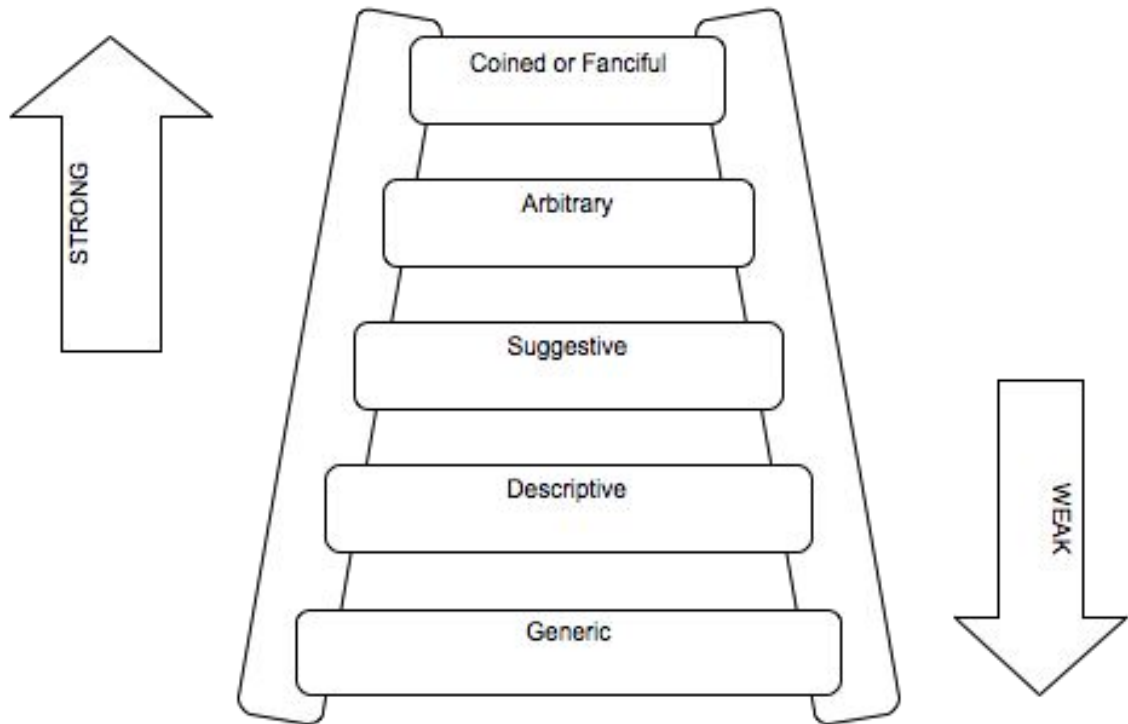
# Types of Marks

Even if you use a collective/ certification mark, ensure the TM remains your priority, as the TM is the only mark that connects the product to your business.



# How to create a strong trademark?

The legal strength of a TM is often inversely related to the appeal of the TM to your marketing team. Your best bet for broad legal TM rights is to select a fanciful or arbitrary TM.



## How to increase the distinctiveness of a TM?

A strong mark is a mark that is distinctive. Distinctiveness refers to how easily customers identify a TM with the products. The likelihood of receiving registration and court protection depends on it.

- Use a **special script** rather than standard letters
  - Identify and use **specific colors**
  - Add a **logo or graphical** elements to the letters
- 
- Strong use of “simple” trademarks over time along with good marketing, to acquire “**secondary meaning**”:





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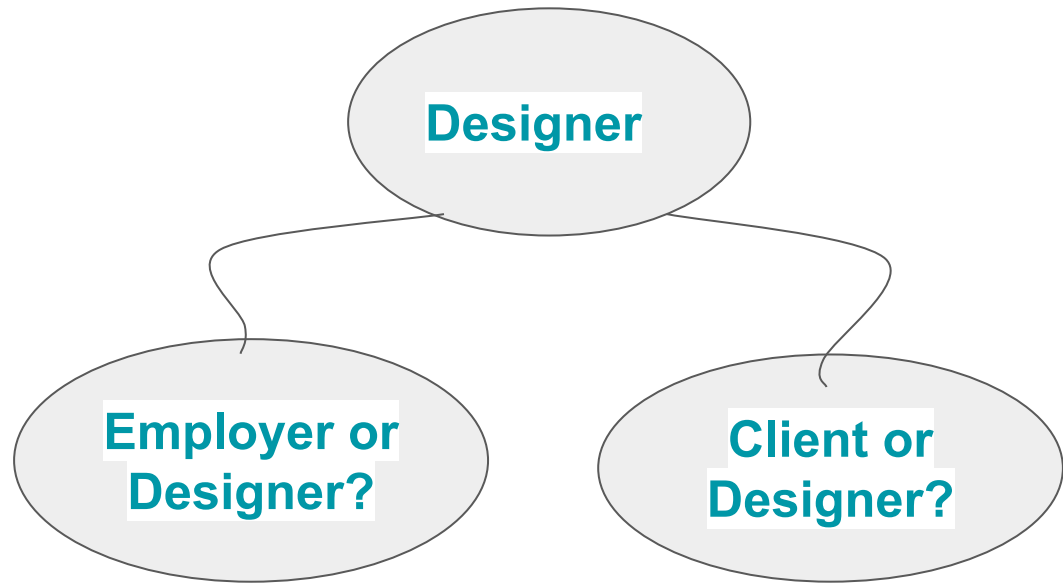
## Checklist to create a trademark



- No one else has registered the TM, or a **confusingly similar** one
- **Domain name** is available
- Sign meets all the **absolute legal requirements** for TM registration
- Avoid **imitating** existing TM
- Select a **strong** TM
- **Easy to** read, write, spell and remember
- No undesired **connotations**
- Do you want to maintain geographic words or signs?
- Protect **figurative** TMs
- Retain **ownership** of artistic TMs and logos

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# Who owns the rights over a logo or artistic trademark?



**Clarify in written issues of ownership with regards to copyright of artistic trademarks and logos!**

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## How to protect trademarks?

Registered trademarks always have stronger protection. Thus, even in countries where trademarks are protected through use, you should register the trademarks.

### Registration

File the appropriate application form at the trademark office (or online)

### Use

Use in the marketplace without registration (in some countries)

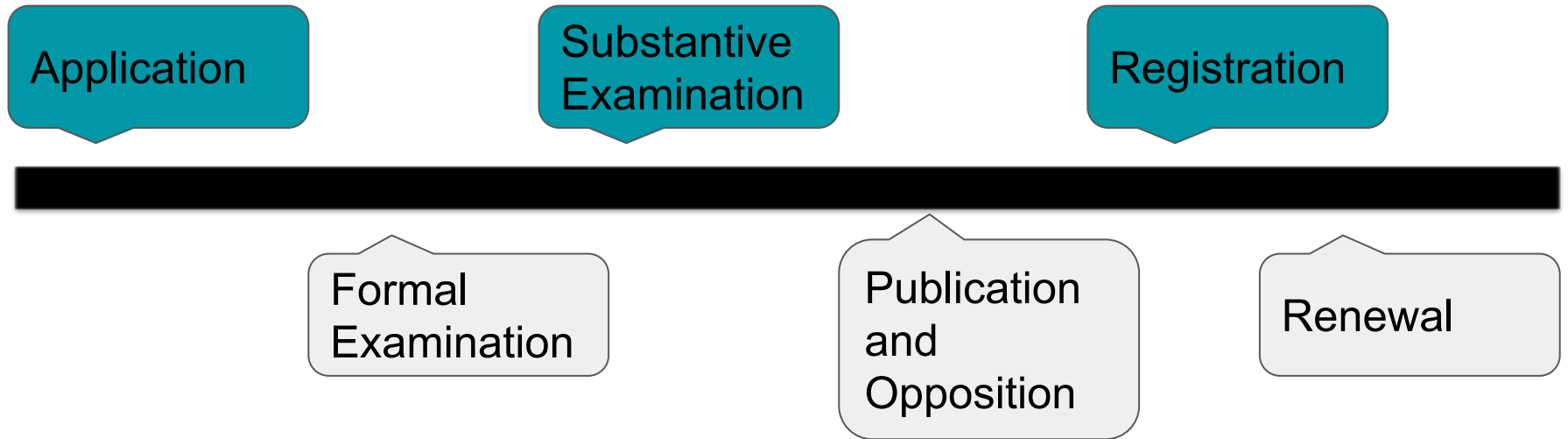
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## Why should you register the trademark?



- Nation-wide or region-wide (group of countries) **exclusivity**
- Easier to **enforce** (presumption of ownership)
- **Deterrence:** allows you to use the ® symbol, appears in search reports, some trademark offices will refuse confusingly similar TMs
- **Valuable asset:** easier to sell and license, and at a higher price
- Obtain **funding or mortgage**
- Prevent importation of **counterfeit goods**

# Registering a trademark: step by step



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# How long does it take to register a trademark?

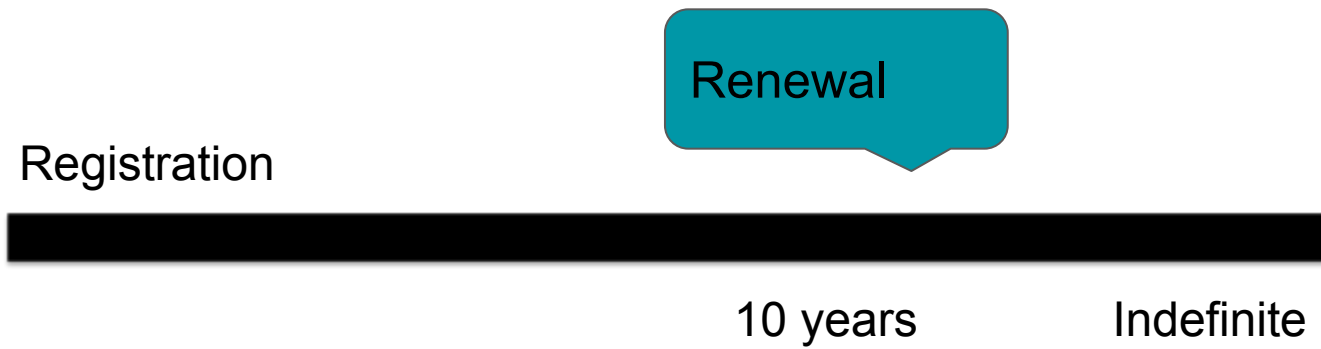
Application

Registration

3 months -  
2 years

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# For how long is your trademark protected?



# How can you register your trademark abroad?

Valid registration of a trademark in your home country gives you rights only in your own country unless your trademark is considered to be a well-known mark.

## National Route

1 TM application  
1 set of fees and deadlines  
**1 country**

## Regional Route

1 TM application  
1 set of fees and deadlines  
**Members of a regional system**

e.g. European Union Trademark (EUTM) application at the EUIPO

## International Route

1 TM application  
1 set of fees and deadlines  
**114 Members of the Madrid System**



# When should you register your trademark abroad?

Application in 1st country

Application in other countries claiming priority date of 1st Application

6 months

Once this period has lapsed, you may still apply for protection in foreign countries, but you won't enjoy of the priority date!

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# What are the main reasons to reject an application?

## Absolute Grounds

- Generic Terms
- Signs devoid of distinctive character
- Signs based on someone's name
- Deceptive signs
- Functional features
- Signs contrary to public order or morality
- Prohibited names or symbols

## Relative Grounds

- Sign conflicts with prior TM rights
- Sign conflicts with other prior rights (copyright, design, business name)

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# Does your sign conflict with a prior trademark?

Conduct a search for relevant countries, relevant products and with respect to “confusingly similar” trademarks.

## DO YOUR SEARCH

- Registered TMs and pending applications on online databases
- Unregistered TMs on the internet, online stores, product guides
- Similar company or domain name
- Phonetic equivalents, foreign language equivalents, spelling variations and the like
- Cultural linguistic searches or language connotation searches
- Phone books and specialized trade directories

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# When can identical trademarks co-exist?

## Different Countries

Identical goods or services – except for well-known marks

## Same Country

- Different goods/services – except for well-known marks; or
- No likelihood of confusion in the marketplace; or
- Coexistence Agreement

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# What rights does the registration provide?

Registration allows you to prevent all others from marketing identical or similar products under an identical or a confusingly similar TM.

You can  
prohibit competitors  
from:

- Affixing the trademark to goods or their **packaging**
- **Stocking** or **selling** goods bearing the trademark or **supplying** services under the service mark
- **Importing** or **exporting** goods under the trademark
- Using the trademark on **business papers, websites** and in **advertising**


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# When does another trademark infringe your rights?

When a competitor uses the same or confusingly similar trademark for the same or similar products, in the same country.

## Factors that increase “likelihood of confusion”

- **Strong** trademark (registered?, distinctive?, used since when?, how much advertising?)
- **Trademarks** are very similar in look (two similar logos), sound (light vs lite) or meaning (white worse vs cheval blanc)
- **Products** are similar or related
- Evidence of **actual confusion** (e.g. misdirected email, survey)
- Products are marketed through the same **marketing channels**



## What should you do if your trademark is infringed?

- Seek **expert advise** (IP lawyer)
- Send a **cease and desist letter**
- Obtain a **search and seize order** to conduct a raid without notice
- Initiate **civil procedures**, or **criminal procedures** in cases of willful trademark counterfeiting on a commercial scale
- Request that infringing goods and materials be **destroyed** or disposed of outside the channels of commerce
- Request measures to **prevent importation** of infringing goods
- **Negotiate** a license

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# Trademark Risk Management

## Planning

- Inventory your trademarks
- Define who is responsible for managing IP assets
- Develop a financial strategy for managing trademarks (maintenance fees, insurance, outside experts)
- Ensure consistent use of trademarks by employees (marketing, advertising, etc.) and document trademark use

## Securing Rights

- Register trademarks in every country where you make or market products

## Enforcement and Monitoring

- Monitor registers and other sources to identify new companies, trademarks, and products that might infringe your rights
- Educate employees on infringement
- Seek advice of outside experts to defend your rights
- Continually evaluate your strategy



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## Are you required to “use” your trademark?

- Use in the marketplace is in some countries a requirement for **registration**, or a prerequisite for **filing an opposition** or **claiming infringement** in court
- Some countries will not officially register a trademark until you have shown **proof of use**
- In many countries, non-use for a number of years (3 to 5 years) is an **evidence of abandonment**
- A descriptive trademark may **acquire distinctiveness** through widespread use

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## What does it mean to “use” a trademark?

use as it is registered or with differences that do not alter the distinctive character



in the course of trade




by the owner or by others but with the owner’s consent



on or in relation to the products for which it is registered



in the territory to which the registration pertains



## How to properly use a trademark to prevent it to become generic?

- Use the ® **symbol**
- **Distinguish** the trademark from surrounding text by using caps, bold or italic fonts, or quotes
- Use your trademark **consistently** (“MONTBLANC®” should not appear as “Mont Blanc”)
- Use the TM as an **adjective**, not as a noun (“Lego’s”), a plural (“tic tacs”), or a verb (“photoshopped”)
- Establish **best practices** and guidelines, and **instruct** employees, suppliers, distributors and consumers

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## Should you use one mark for all products or a new mark for each product?

If you have registered a trademark for a particular product and want to use it on a product in a different class, then you should file a new trademark application.

- Use the **same trademark**, to benefit from the reputation
- Create a **new trademark**, to target a specific customer group or to create a specific image for the new product line
- Use an **additional trademark** in conjunction with the first trademark
- Rely on a new **industrial design** of the product or its packaging
- Use a **different artwork** on the label of the product or its packaging, to signal the new product or variant to the consumers

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## Other legal instruments available to protect signs

- **Copyright:** logos, graphical marks
- **Industrial Designs:** shapes, packaging
- **Trade Dress:** the manner in which a product is presented (“dressed up”)



- **Trade Secrets:** confidentiality of new marks before use/registration
- **Unfair competition laws**
- **Cumulative** protection



## Credits

**This presentation is based upon  
“Making a Mark - An Introduction to  
Trademarks for Small and  
Medium-Sized Enterprises”:**

<http://www.wipo.int/publications/en/details.jsp?id=106&plang=EN>

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# Thank you!

WIPO-KIPO-KWIA IP Wave for  
Creative Women Leaders 2017

Seoul, June 2 and 13, 2017

**Teresa Nobre, LL.M. IP (MIPLC)**



# Using Design to Capture Market Share

Teresa Nobre, LL.M. IP (MIPLC)



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# Objectives

- Understand the role played by designs in reinforcing **brands**
- How to **create** new designs
- How to **protect** designs
- How to avoid the **risk of infringing** the designs of others
- How to actively **monitor** the competitors' designs

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# The role of industrial designs in business

Brand refers to the proprietary **visual**, **emotional**, **rational** and **cultural** image that customers associate with a company or a product.

- **Strengthen brands:** creative designs are often also combined with distinctive trademarks to enhance the distinctiveness of a company's brand(s).
- **Customize products to appeal to specific market segments:** small modifications to the design of some products may make them suitable for different age groups, cultures or groups
- **Create a new niche market:** in a competitive marketplace, many seek to create a niche market by introducing creative designs for their new products to differentiate them from those of their competitors

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# What is a design?

“Design is a funny word. Some people think design means **how it looks**. But of course, if you dig deeper, it’s really **how it works**.”  
Steve Jobs (WIRED, 02.01.1996)

Business

product’s overall  
form and function

Legal

ornamental or  
aesthetic aspects  
of a finished  
product

# What is an industrial design?

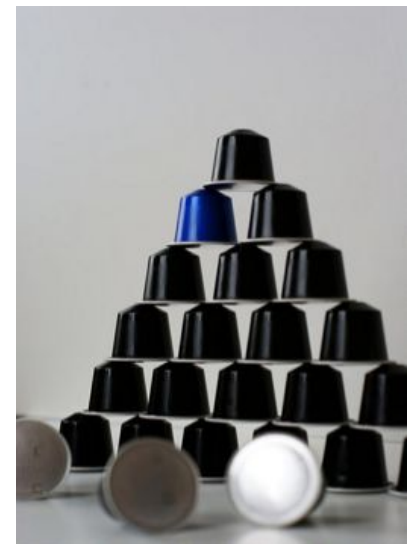
Industrial design refers only to the **ornamental** or **aesthetic** aspects of a finished product, and is distinct from any technical or functional aspects.

- **Three-dimensional features**, such as the shape or configuration of a product
- **Two-dimensional features**, such as images, typefaces, graphic symbols, graphic user interfaces, pictures, drawings, patterns, lines, ornamentation, or color of a product
- **Combination** of one or more such features

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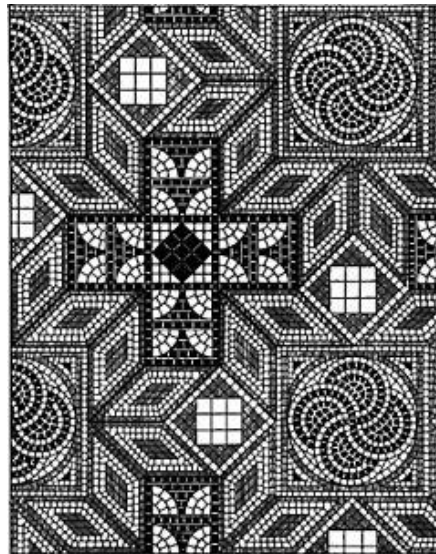
# 3D Designs

Three-dimensional features, such as the shape or configuration of a product



## 2D Designs

Two-dimensional features, such as images, typefaces, icons, graphic interface, patterns, ornamentation, lines or color of a product



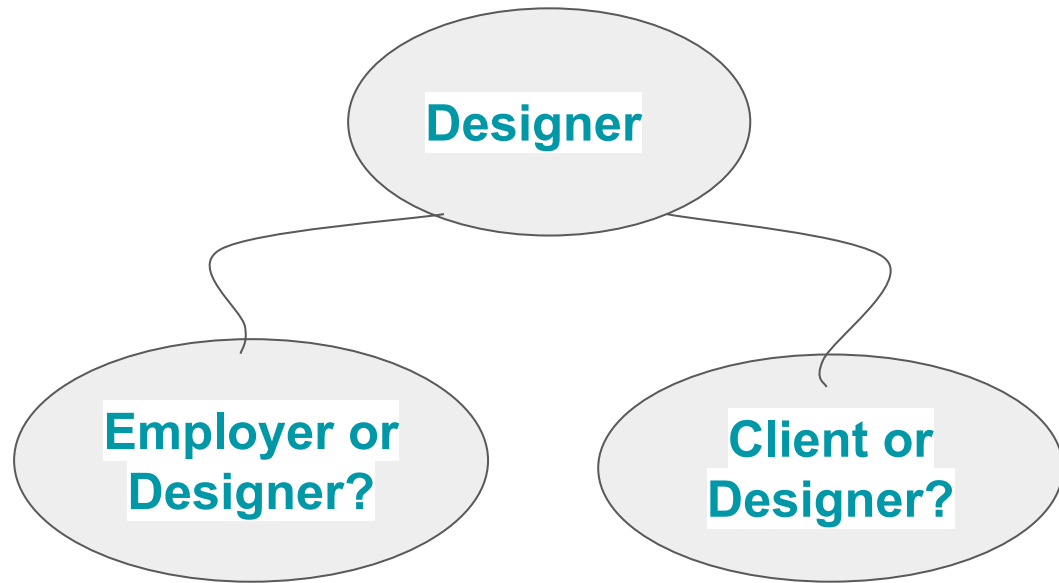
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# What are industrial designs for?

- **Adds value** to a product: makes a product attractive and appealing to customers, and may even be its unique selling point
- Efficient **marketing and communication** tool
- Basis for building **brand image and reputation**
- Valuable **business asset**
- Make it easier to hire and retain employees
- Effective weapon against **unfair competition**

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# Who owns the rights over a design?



**Clarify in written issues of ownership with regards to copyright and industrial design!**



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## How to protect designs?

Registered designs always have stronger protection. Thus, even in countries where designs are protected after being made available to the public, you should register the designs.

### Registration

File the appropriate application form at the intellectual property office (or online)

### Disclosure

Make available in the marketplace without registration (in some countries)

## Registered Design

- ❑ **All designs that meet the conditions**
- ❑ Subject to Registration
- ❑ Costs
- ❑ **10-25 years**
- ❑ **Registration Certificate**
- ❑ **There is infringement whether or not there has been deliberate copying**

## Unregistered Design

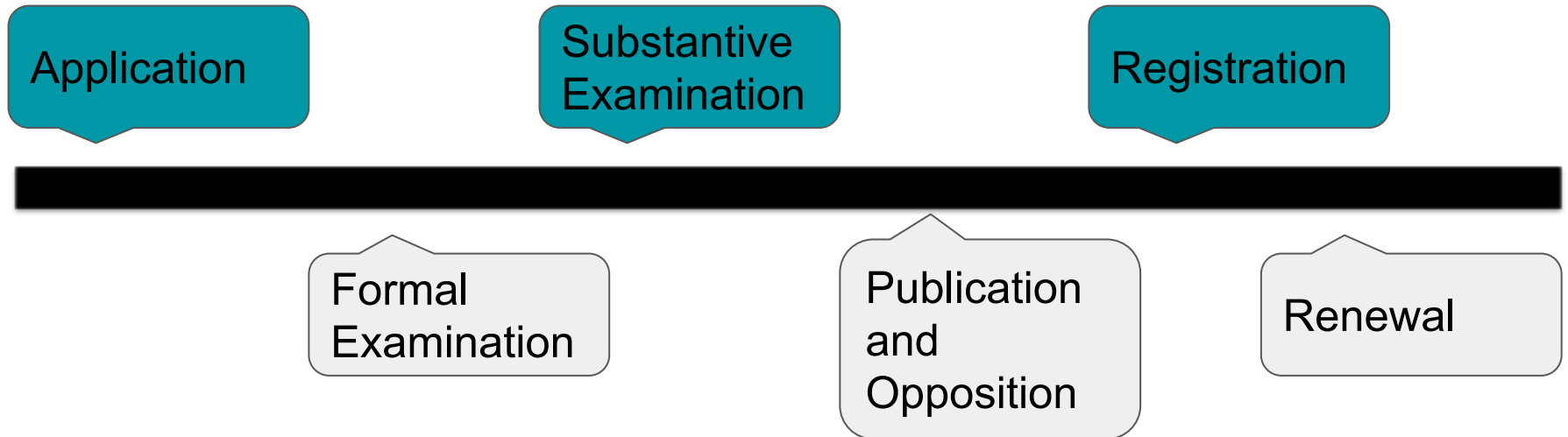
- ❑ **All designs that meet the conditions**
- ❑ **No Formalities**
- ❑ **No Costs**
- ❑ 3 years from disclosure (EU)
- ❑ No proof of ownership
- ❑ There is no infringement if design created independently/ not copied

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## Why should you register the design?

- Nation-wide or region-wide (group of countries) **exclusivity**
- **Longer term** of protection
- Easier to **enforce** (presumption of ownership)
- **Deterrence**: appears in search reports
- **Valuable asset**: easier to sell and license, and at a higher price
- Obtain **funding or mortgage**
- Prevent importation of **counterfeit goods**

# Registering a design: step by step



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# How long does it take to register a design?

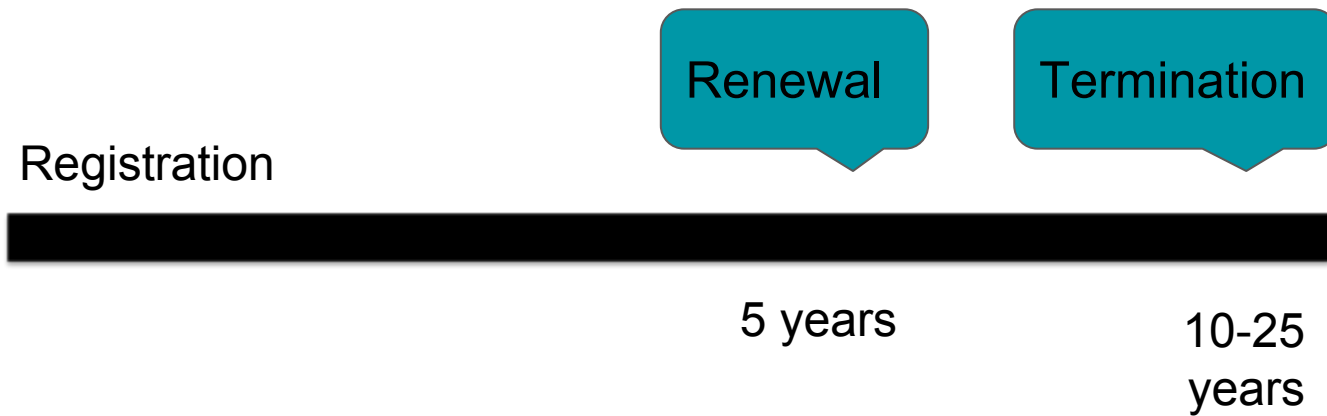
Application

Registration

6 - 12 months

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# For how long is your registered design protected?



# How can you register different designs?

Rule:  
Multiple  
Designs

1 Application =  
10-100 Designs

if they all relate to  
the same product or  
class of products

Rule:  
Single  
Design

1 Application =  
1 Design

Exception:  
Variants

Several variants of the design, if they are applied to the same article and do not differ substantially from one another

Exception:  
Sets

Several designs, if they are all of the same general character which are normally sold together, or intended to be used together, and which share some common design features

# How can you register your design abroad?

## National Route

1 application  
1 set of fees and deadlines  
**1 country**

## Regional Route

1 application  
1 set of fees and deadlines  
**Members of a regional system**

e.g. European Union Design (RCD)  
application at the EUIPO

## International Route

1 application  
1 set of fees and deadlines  
Up to 100 designs  
**66 Members of the Hague Agreement**

Valid registration of a design in your home country gives you rights only in your own country.



# When should you register your design abroad?

Application in 1st country

Application in other countries claiming priority date of 1st Application

6 months

Once this period has lapsed, you will be unable to apply for protection in foreign countries, as your design will no longer be new!

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## What can be registered as an industrial design?

Some countries also require that the product to which an industrial design is applied is “an article of manufacture” or that it can be replicated by “industrial means”

- **New:** no identical design has been made available to the public before the date of filing, or the application for registration, and
- **Original:** the design has been independently created by the designer and is not a copy or an imitation of existing designs, and
- **Individual character:** the overall impression produced by a design on an informed user differs from the overall impression produced on such a user by any earlier design which has been made available to the public.

Can you  
disclose the  
design without  
losing  
“novelty”?

Disclosure

Application

6 - 12 months

In some countries,  
you can enjoy of a “**grace period**”,  
during which you may sell, advertise, publish and/or  
display at a trade show, without losing novelty

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## What are the main reasons to reject an application?

- Designs that do not meet the requirements of novelty, originality and/or individual character
- Designs dictated exclusively by the technical function of the product
- Designs contrary to public order or morality
- Prohibited symbols or emblems

## DO YOUR SEARCH

# Does your design conflict with a prior design?

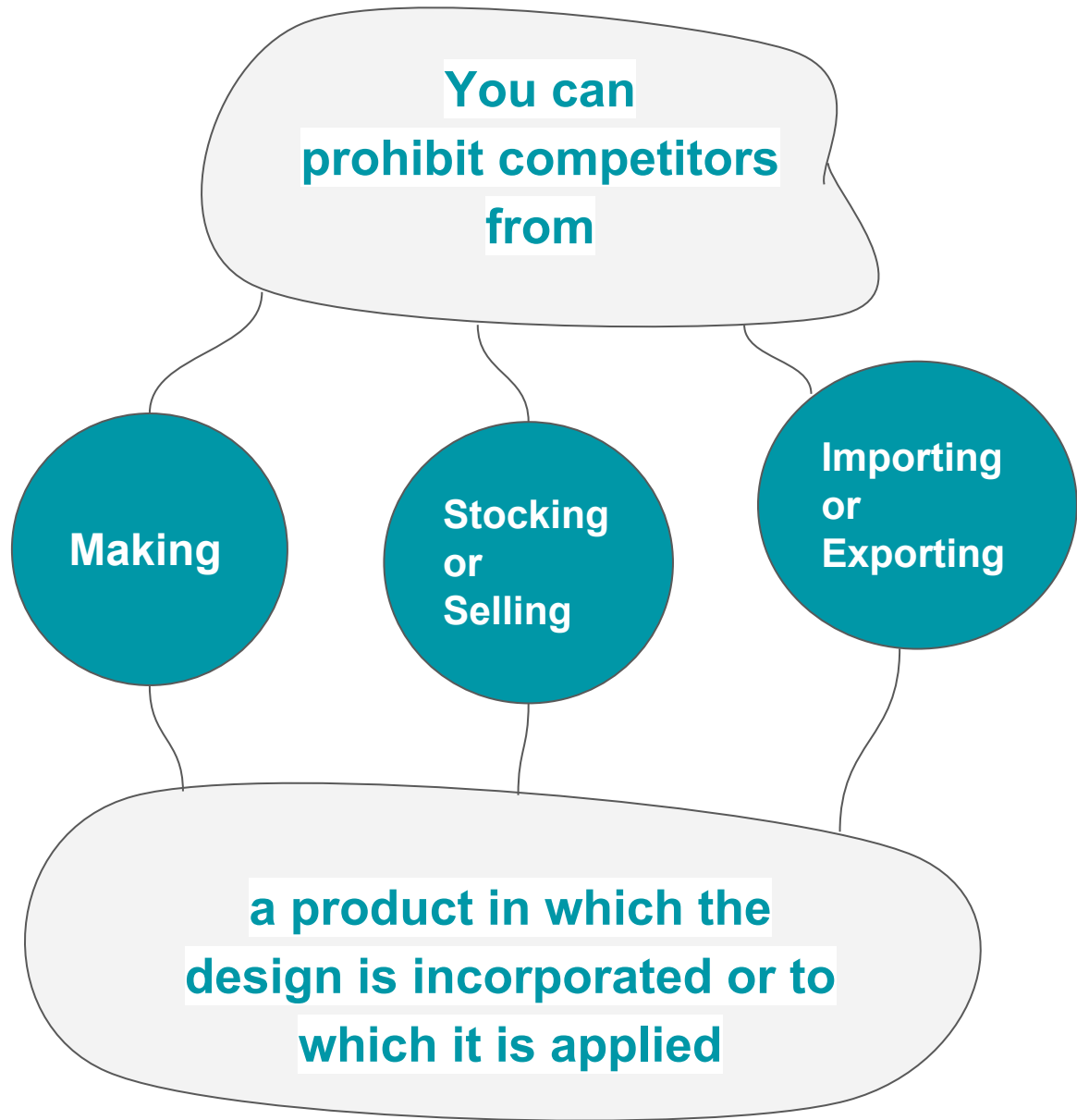
Conduct a search for relevant countries with respect to identical designs or look alike.

- Registered designs and pending applications on online databases
- Unregistered designs on the internet, online stores, product guides, product review websites, crowdfunding sites (product prototypes), manufacturers websites
- Fee-based professional tools
- Specialized publications

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# What rights does the registration provide?

Registration allows you to prevent all others from copying or imitating your product, or marketing similar products, without your authorization.





## What should you do if your design is infringed?

- Seek **expert advise** (IP lawyer)
- Send a **cease and desist letter**
- Obtain a **search and seize order** to conduct a raid without notice
- Initiate **civil procedures**, or **criminal procedures** in cases of willful trademark counterfeiting on a commercial scale
- Request that infringing goods and materials be **destroyed** or disposed of outside the channels of commerce
- Request measures to **prevent importation** of infringing goods
- **Negotiate** a license

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## Other legal instruments available to protect designs

- **Copyright:** some designs may, in some countries, be considered works of art or applied art
- **Trademarks:** if a design functions as a trademark in the marketplace, then it may be protected as a 3D mark (e.g. product's shape or packaging)
- **Trade Secrets:** if you wish to protect your industrial design, it must be kept confidential prior to registration
- **Unfair Competition:** a design may be protected against acts of unfair competition, e.g. slavish copying and acts that may lead to confusion, acts of imitation or use of a third party's reputation
- Cumulative protection



## INDUSTRIAL DESIGN

- ❑ **Designs that are new, original, etc**
- ❑ **Subject to Registration**
- ❑ **Costs**
- ❑ **10-25 years**
- ❑ **Registration Certificate**
- ❑ **There is infringement whether or not there has been deliberate copying**

## COPYRIGHT

- ❑ **Only intellectual creations**
- ❑ **No Formalities**
- ❑ **No Costs**
- ❑ **50-70 years after author's death**
- ❑ **No proof of ownership**
- ❑ **There is no infringement if design created independently/ not copied**

## INDUSTRIAL DESIGN

- ❑ **Designs that are new, original, etc**
- ❑ Subject to Registration
- ❑ Costs
- ❑ **10-25 years**
- ❑ Registration Certificate

## TRADEMARKS

- ❑ **Designs that have distinctive character**
- ❑ Subject to Registration
- ❑ Costs
- ❑ **Renewable Indefinitely**
- ❑ Registration Certificate



## Credits

**This presentation is based upon  
Looking Good: An Introduction to  
Industrial Designs for Small and  
Medium-sized Enterprises:**  
<http://www.wipo.int/publications/en/details.jsp?id=113&plang=EN>

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# Thank you!

Creating IP Culture Among Small  
and Medium-Sized Enterprises

Sofia, October 17 and 18, 2017

**Teresa Nobre, LL.M. IP (MIPLC)**