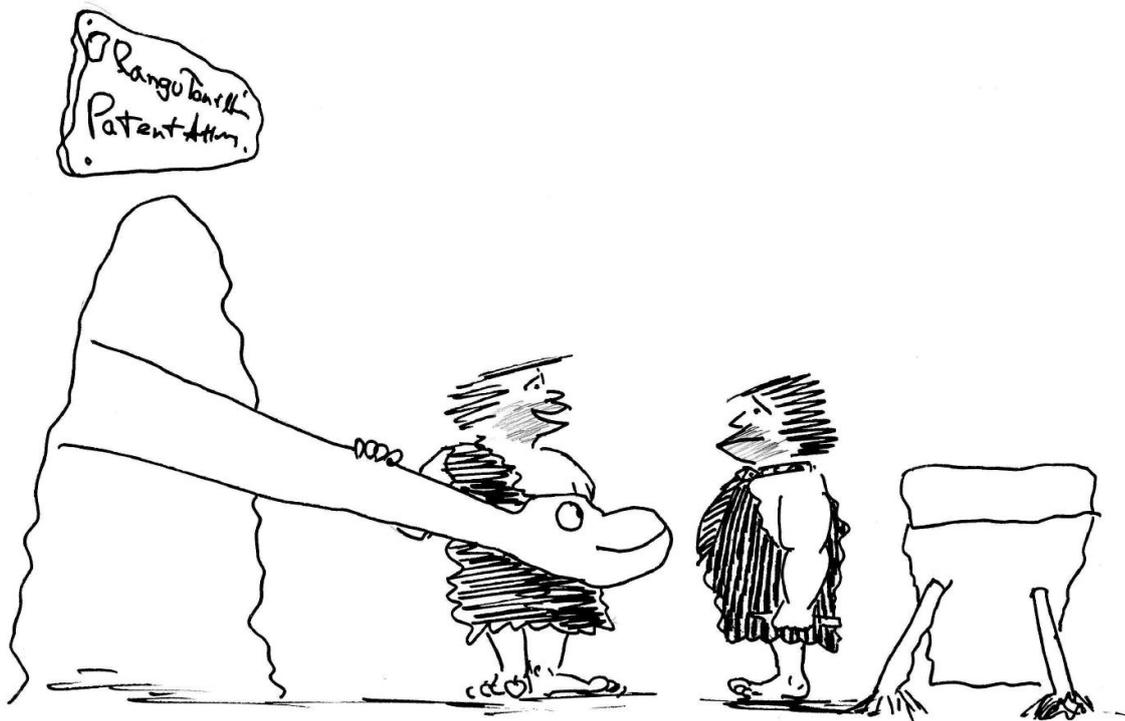


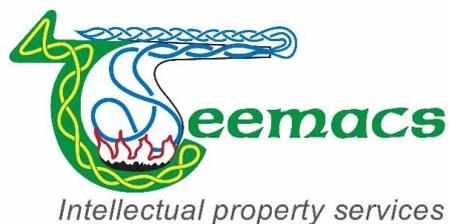
To mark it, to mark it

A guide to trade marks and their use



*...and when I press him here, he sucks up all the rubbish in the cave! I'm going to call him a **dynos** !!!*

DYSON and the Dyson logo are registered trade marks of Dyson Research Ltd. Parody of Dyson logo used with the gracious permission of Dyson Research Ltd.



About the Author...
(with apologies to Gilbert and Sullivan)

*When I was a lad, I served a term
As patent tech. assistant in a big paint firm
I wrote applications and I argued and tried
Patent offices to show that grant was justified
And this sort of thing so suited me
That now I'm patent attorney in industry.*

Acknowledgement

My grateful thanks to all of you out there who helped me with this revised version by offering comments, corrections, criticisms, suggestions and advice, some of which I ignored, which is why the booklet still exists. The responsibility for any errors (not to mention the mediocre drawings and terrible jokes (or is it mediocre jokes and terrible drawings?)) is entirely mine. The responsibility for any views or opinions expressed herein is also entirely mine.

N.B.

All costs mentioned herein were correct (more or less) at June, 2013, but, because of the tendency of official fees to fluctuation (and exchange rates to go up and down like yo-yos), they should be taken as general guides only.

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TRADE MARKS – A QUICK GUIDE

Basic facts

1. What's a trade mark?

Any distinctive sign that indicates the source of goods or services in the course of trade.

2. “Trade mark” or “trademark”?

The two-word variant is British in origin, the single word American. But, as Fred sang to Ginger, you say to-may-to, I say to-mah-to, so let's call the whole thing off and say either (or was that eether?) is fine.

3. Any distinctive sign? Really, truly, honestly?

These days, yes, pretty much. It can be a word or a symbol. It can be the shape or the colour of goods, It can even be a sound or a smell. All it has to be is distinctive of the goods and services of the proprietor, and be able to distinguish those goods and services from those of competitors. “Distinctiveness” is the trade mark equivalent of a patent's “novelty”.

4. And how distinctive is “distinctive”?

Like Rolls-Royce's traditional horsepower figures, “adequate”. It must be capable of distinguishing the goods or services of the proprietor from those of other traders. Most importantly, it must not be something that can cause deception or confusion to the purchasing public (the cardinal sin of trade marks usage), so you can't copy someone else's mark (unless you intend to use it in a country where that someone else doesn't trade).

Conditions are stricter if it is desired to register the mark. Here, words and symbols that are descriptive of the character or quality of the goods or services, or which are common in the particular market, cannot be monopolised. The old classic question is, “would anyone else, without improper motives, reasonably wish to use this mark?” Geographical names and surnames also (generally) cannot be registered.

To make it more complicated, distinctiveness will vary according to other factors, such as the nature of the goods and services, and the knowledge required of the purchasing party. For example, it will be assumed that someone in the market for computerised machine tools occupying the space of the average house will know a lot more about his or her market than will the ordinary guy or gal in the market for washing detergent from the supermarket down the road. The former will be considered much more knowledgeable than the latter, and this means that marks that would be regarded as too similar for a detergent use may not be for more specialised purchases.

The same consideration would apply for normal consumers buying something expensive that is not a casual daily transaction, e.g. a piano.

For hints on choosing a good trade mark, see Appendix 1

5. Wait a minute, you said “surnames”! What about McDonalds?

Well, McDonald is certainly the most common of the Scottish Mc/Mac names. However, the trade mark is not the surname itself, but *McDonald's*. Widespread use, plus rigid control as to how it is used, have made it distinctive. It does not stop a trader called McDonald using his or her own name, even for the sale of hamburgers, provided it is not done in a way that infers a connection with the McDonald's Corporation, and that therefore seeks to trade on its goodwill.

6. *Goodwill? That sounds a bit antique.*

Far from it. Goodwill is very important – it is, as one court once put it “the magnet that draws in custom”. Establishing goodwill in a mark is essential, so that customers will buy the same brand again, even extending to other goods and services under the same brand, because of a positive previous experience.

7. *Is goodwill still important in specialised markets, such as the machine tool business you mentioned above?*

Good point. Yes, it is, but generally not so much as it is in retail markets. Specialised customers, say, washing powder manufacturers shopping for surfactants or enzymes, are interested only in performance – they generally couldn't care less what the supplier chooses to call the stuff, so long as it delivers the desired performance at the right price. They will buy surfactant A from manufacturer X and surfactant B from manufacturer Y, and the fact that X gives its surfactant A a fancy name will influence the decision not at all. This is why the most valuable trade marks (Apple[®], Coca-Cola[®], Microsoft[®]) are all retail marks.

8. *Now you said “brand” back there in 6 – is there a distinction between “brand” and “trade mark”.*

Congratulations for staying awake this long! The two words are often used interchangeably, but in general “trade mark” refers to the mark itself, and “brand” includes not only the mark but also the entire periphery surrounding it – how it is presented, the way it is used and under which circumstances, etc.

9. *“In the course of trade” – what does that mean?*

Quite simply, a trade mark must be used in the course of normal commerce for the sale of marked goods and services.

10. *And if I register a trade mark and not use it in the course of trade?*

You may lose the registration. The basic truth is “use it or lose it”. You can get away with non-use for a while, but if there is a long period of non-use, a third party can have the registration annulled.

11. *So, people can't register trade marks and sit on them and block other people and even hold them to ransom, right?*

In general, that's correct. Some countries, e.g., the USA, are very strict, and demand that proof of actual use (e.g., a label) be submitted on an occasional basis. And all countries have laws that allow a mark that hasn't been used to be removed from the Trade Marks Register for non-use.

The “holding to ransom” does unfortunately occur. There have been cases in which people, scanning internationally-circulated magazines (and now, of course, websites), have registered marks for goods that have not yet arrived in their country and have relied on the desire of the proprietor to get the goods on the market to pay for the rights.

12. *Speaking of registration, do I have to register?*

No, in which case you can use anything you want, provided it doesn't cause deception or confusion of the public.

If you don't register, you may have relatively little protection if someone else decides to use your mark or something very like it.

13. *Do I have any protection if I don't register?*

It depends on the country. For example, in common law countries (UK and British Commonwealth, Ireland, USA), there are substantial common law rights in trade marks – someone filing and even registering your mark can be stopped. The problem is that it involves what's called a passing-off action, where you have to show that you have suffered damage to your reputation and/or business, and this can be a lengthy, expensive and uncertain business.

Registration reverses the onus of proof – registration is held to be *prima facie* proof of distinctiveness and an infringer has to prove that s/he didn't infringe.

14. *But registration will cost a bomb – won't it?*

Actually, no. Trade mark registration is bargain-basement compared with patents. Moreover, provided you look after your mark and pay the renewal fees, the registration will last forever.

15. *I need to renew? How often do I need to do that?*

Every 10 years is typical these days.

16. *With regard to US use, that's easy! I just cobble a label together and sell a few through a friendly trader!*

Inadvisable and unlikely to succeed. The USPTO is quite good at detecting this sort of thing.

17. *Is there anything I simply can't register, apart from the descriptive terms, obscenities, geographical names and surnames you've already mentioned?*

Many things, often dependent on the country. For example, there is a universal prohibition on the registration of national flags and the emblems of the Olympic movement, the Red Cross/Red Crescent and the UN and its various specialist organisations. National prohibitions include the representations of Royalty (the UK), the chrysanthemum crest (Japan) and the word ANZAC (Australia and New Zealand).

In addition, the US Supreme Court has asserted the supremacy of the US Constitution's right to free speech over the US trade marks act's prohibition on the registration of obscene or scandalous marks, so FUCTION could be registered.

Registering a trade mark

18. OK, say I want to register my mark. What do I do next?

First of all, find out whether the mark is available to you for the goods and services you want.

19. And how do I do that?

Do a search, or have one done for you. These days, most trade mark offices of any significance have websites that allow you to search the Register. Remember not to restrict your search to identical marks – always bear in mind the possibility of imperfect recollection or mispronunciation over the telephone. So, if your mark is, say, WOTSIT, also look at WHATSIT, WETSUIT, WHITSUN, etc.

This is where a professional search (easily organised by a trade mark attorney) can help – it will consider these aspects, and also look at other potential sources of difficulty, e.g. domain names. It will also help prevent you, for example, from inadvertently trying to register a swear word in the language of a country in which you wish to sell.

20. OK, that accounts for the mark – where does this “goods and services” business come into it? I can’t have it for everything?

Well, yes, you can, but only if (a) you’re prepared to pay a lot of money, and (b) you’re either going to use it for all possible goods and services, or you’re happy to run the risk of removal from the Register for non-use.

The only exception to this is one that, as a new applicant, doesn’t concern you – famous trade marks. Some marks, e.g. Coca-Cola[®], are so well known that use on anything will immediately suggest a connection in the course of trade with the Coca-Cola Company. Such marks cannot be used by third parties under any circumstances on any goods and services, except with the permission of the proprietor.

21. But I am going to use it! But not for everything.

Then you will most certainly lose it for the goods and services in respect of which you don’t use it. Better first to register in respect of those goods and services for which you will use it, plus a reasonable extension of them, and then (depending on the country) either amend the goods and services or file a new application to cover the new goods and services.

So, you need to decide on what goods and services for which you want registration, and then find the appropriate classifications.

22. The what?

You have to apply for the goods and services as defined in the International (Nice) Classification (the French town, not its attractiveness). Some national offices still have their own classifications, but Nice is predominant. (Some, e.g. Canada, had no classification system, but Canada will shortly adopt Nice). It divides all goods and services into 34 goods and 11 services classes. Your trade mark attorney can help here, but the Nice Classification may be found here:

These days, you can file a single application covering multiple classes (there are still a few countries that require an individual application for each class).

23. I've had a look at this Classification. There's a lot of stuff in there! How exactly do I have to define what I want?

It's undesirable to put in something such as "all goods included in Class 1". The ideal is to cover in general terms the goods and services that you want, plus a reasonable extension of them (goods and services to which your future activities could reasonably expand).

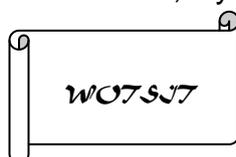
In any case, the classifications are not meant to be so very precise. If you are making, say, paints for artists, you can simply cover "paints, varnishes and lacquers" (class 2). However, it is wise to emphasise your specialist niche by making it "paints varnishes and lacquers, including oil- and water-based paints for use by artists". This may save your hide if someone happens to have the same trade mark for paints used exclusively on cars on a production line.

24. What if I diversify into goods and services that I didn't anticipate?

Depending on the country, you will either need a new registration or you will need to modify the existing registration, to cover the new goods and services.

25. What if I want to modify the mark?

Then you may need a new registration. A word mark in simple black and white print covers all forms of the mark. So, WOTSIT covers **WOTSIT**, **WOTSIT**, **WOTSIT**, **WOTSIT**, *WOTSIT*, and *WOTSIT*, to name but a few. However, if you want to register, say



so that the logo is covered (the word in the logo is covered by the registration of the word), then you need a new application.

26. Then what?

A search is always a good idea, to make sure that nobody else has a mark that is identical or similar in respect of the same or similar goods and services.

27. And exactly how similar is "similar"?

This is a hard question to answer and here you may need expert guidance. With regard to the marks themselves, do not simply consider side-by-side comparisons. Consider that the marks will probably be seen separately, without the chance of comparison, and bear in mind the possibilities of imperfect recollection and mispronunciation over the telephone.

With regard to the goods or services, they may not be identical, but will they be sold to the same groups of consumers via the same trade outlets, such that customers may infer that they originate from the same source? Will the customer, happy with his WOTSIT electric

drill, and seeing a WOTSIT frying pan a couple of aisles further down the store, think that they originate from the same manufacturer and mistakenly purchase one?

28. Can I search for such things myself?

Some databases will unearth similar marks, but not all. So, if you really want to register WOTSIT, look as well for WOTSIT, WATSIT, WHATSIT, WETSIT, WHETSIT, WITSIT, WUTSIT, WOTSET, etc.

A trade mark attorney will be better equipped to do such a search. Moreover, s/he can search for related things, such as similar Internet domain names.

29. Which will cost?

Of course. Trade mark attorneys are not charitable institutes. But better that than throwing away money by filing an application that then falls on its face.

30. OK, my search is clear. What then?

You prepare (or have your agent prepare) the official forms and file.

31. Where?

If this is a first application, generally in the trade marks office of the country in which you are resident, and in which presumably you are going to use the mark.

32. Can I register my mark, even though I don't intend to use it and reserve it and/or keep other people from taking it?

You didn't read **13**, did you? Non-use can be extremely hazardous to your mark's health. All trade mark laws have provisions for removal from the Register on the grounds on non-use (typically after a non-use period of 5 years). Some countries are stricter – in the USA, you have to prove use at every renewal.

33. So, I've filed. When do I get my registration?

This depends on the country. The European countries typically register within 6 months. For countries with a stiff examining system, it can be longer.

34. Can the office object?

Yes. There are two types of grounds for objection, absolute and relative. Absolute is a consideration as to whether the mark is inherently distinctive (Is it a geographical name or a surname? Is it descriptive? Does it contain scandalous or improper matter?) Relative is whether there are other marks that are the same or similar, in respect of similar goods and services.

The trade mark offices of many countries (e.g., continental Europe) only consider absolute grounds, leaving relative grounds to opposition. Those of British-type law countries (and the EUIPO, which registers EU Trade Marks (EUTMs) for the EU), will generally also consider relative grounds in examination. In most of these cases, the office will ask whether you want to modify the application (for example, by reducing the scope of goods and services to avoid overlap). It may also inform the proprietor of a potentially conflicting

mark of the existence of your application, giving that proprietor the opportunity to oppose the registration.

35. *So, I can get through but be opposed by someone else?*

Yes.

36. *On what grounds?*

The usual one is that your combination of mark and goods/services is so close to another as to lead to deception and confusion of the public.

37. *Is opposition expensive?*

It'll almost certainly involve professional representation before the trade mark office – you'll almost certainly need that. It's generally not horrendously expensive.

In many cases, it won't come to a hearing. Opponents often are satisfied with a modification of your goods and services that will, in their view, adequately separate the areas of operation of their mark and yours. Indeed, oppositions are often filed simply to keep the case alive and allow time for discussion and agreement, with the opposition then being withdrawn.

38. *So, once I've got my registration, I've got it forever?*

Provided you pay the renewal fees every 10 years (with proof of use if the USA is involved) and look after it, yes.

39. *What do you mean "look after it"?*

You use it in such a way that it never becomes generic, like "linoleum", "pyrex" and a multitude of other former trade marks.

40. *How do I do that?*

Observe the basic rules set out on p.17 in the next section.

41. *When can I put the ® beside it?*

When it's registered, and not until. It is an offence in many countries to represent an unregistered mark as registered.

42. *What can I do until then, to indicate that this is my property?*

In most countries, superscript TM will work. WOTSIT™ does not indicate any legal status, only that this word is proprietary. However, some German courts have considered TM to mean registered, and this can lead to problems under Germany's Unfair Competition laws. The legal situation is in a state of flux, so for Germany it is best to avoid TM until registered.

Filing in other countries

43. I want to do business in other countries. How do I go about registering my mark there?

When you file in your home country, the Paris Convention (of which nearly all countries are members) allows a six-month Convention period. That is, if you file in the desired country/ies within 6 months of your original application, that/those country/ies treat your application as if it had been filed there on the date of filing in the home country (the “priority date”). You have priority even over a local application for the same mark in respect of the same goods or services, filed there the day after your priority date.

44. And I have to file in every single other country I want?

Yes, but there are ways to make that easier.

45. Such as?

An International application under the Madrid Arrangement/Protocol.

44. Which is what, exactly?

Madrid, which is run by WIPO, the World Intellectual Property Organisation in Geneva, is a mechanism for filing and registering a trade mark in a lot of countries at once with the filing of a single application.

The Arrangement was the original treaty, designed for countries that registered trade marks relatively quickly (e.g. much of continental Europe). The International registration was based on the national registration. The Protocol is a parallel agreement that allowed the countries with stiffer examination requirements and therefore longer times to registration (e.g. UK, USA, Australia, the Nordic countries) to base their International applications on a national application.

45 Sounds like a great idea! Expensive?

Not particularly. You can find out the official costs on WIPO’s Madrid Fee calculator here:

<http://www.wipo.int/madrid/en/fees/calculator.jsp>

Plug in your country of origin and the number of classes, and then select your countries. Provided you don’t wish to cover the entire universe, it can be surprisingly reasonable. And if your mark goes through to registration everywhere, these are the only fees you’ll pay. If you hit problems in one or more countries, you have to reckon on attorneys’ fees.

46 So, how do I go about an International Application?

An International Application must be based on a home registration or application. You file your home and International applications at the same time. In the International application form, you designate the countries in which you want protection.

47 And then what?

The International application is examined on formal grounds only by the International Bureau of WIPO (e.g., whether the goods and services you have designated are in the appropriate classes). It will then issue an International Registration certificate. If your

designated countries don't come up with a final refusal within one year of that International Registration, the International Registration is deemed to extend to those countries.

48 *So, the designated countries can refuse?*

Yes. You still have to pass the local requirements, which usually includes the possibility of opposition proceedings. If a designated office raises objections, you have to engage a local trade marks attorney to handle them.

49 *And if there are no objections, no local trade mark attorney is needed?*

Correct – it is handled entirely through WIPO. You will still need some local representation (e.g., in the USA, to file the necessary documents at the right time, to meet its especially strict proof of use requirements).

50 *I hear there's a single trade mark that covers the whole of the European Union. Where does this fit into things?*

The EU Trade Mark (EUTM) covers the whole EU. It is registered by the EU Intellectual Property Office (EUIPO) in Alicante, Spain. The EUTM may be designated in an International application.

51 *What if my mark is anticipated in, say, Lithuania and nowhere else? Is that the end of my EUTM?*

Not necessarily. There are provisions for conversion of a EUTM into a series of national trade mark applications in such circumstances.

52 *What effect did "Brexit" have on my EUTM?*

The UK parts of the EUTM became individual national rights.

Effect of registration

53 *OK, I have my registration. What does this mean?*

It means that the mark is now your property. And like other property it can be sold or licensed.

54 *So, if I register in a foreign country, I can license someone there to use the mark and I don't incur the costs of starting a business?*

Correct. This is how McDonald's Corp. and similar companies work – people buy a McDonald's franchise and undertake to comply with all McDonald's standards (from the décor to the type of potato used for the French fries), and in return they get the right to use the name.

However, it is essential that rigid control over use of the mark is maintained. In the case of McDonald's, it is done by inspectors who arrive unannounced and incognito. In other cases, say, a factory making goods under licence, the licensee is usually expected to submit regular samples for inspection.

Infringement of trade marks

55 Once I have my registration, I can sue anyone else for infringement of my mark?

Yes.

56 And what does this get me?

Usually some kind of injunction (a court order forbidding further infringement) and some kind of damages.

57 Any dangers in it for me?

Make sure that you're actually using the mark as registered in respect of the goods or services for which the mark is registered!

58 What if someone doesn't use my mark, but produces a package that looks like mine, so that people can buy it by accident, rather than mine. Surely that's infringement!

Not necessarily, but it will almost certainly be actionable. Copying of what is called "trade dress" does constitute infringement under US law. In common law countries, it is considered a form of passing-off. And most countries have laws against misleading or deceptive conduct in business.

Use of trade marks

59 On the subject of use, must I use the mark?

Yes, the basic rule is use 'em or lose 'em.

60 And how do I lose 'em?

If you haven't used your mark for a period (typically five years), a third party can apply for its removal from the Register. In some countries, if you don't use for at least 5 years and then start using again, it's as if that period of non-use never happened. However, in other countries, that period of 5 years is a permanent sword of Damocles, and if proven, can result in removal from the Register, even if you have many years' use after the non-use period.

In addition, some countries, notably the USA, require proof of use in commerce as a condition of renewal, and you have to produce an actual label in the case of goods (or an invoice in the case of services).

A different way to lose 'em is to allow them to become generic –avoid this by adhering to the rules of use on p.18 in the next section.

61 If I've licensed someone else to use it in other countries as per 53 above, does that count as use by me?

Yes – but remember the need for quality control of the licensee.

Renewal of trade mark registration

62 What if I overlook the ten-year renewal period?

The Paris Convention allows a six-month grace period within which a renewal fee can be paid, with surcharge. Many national legislations have extra provisions for restitution, but these tend to be more expensive and more tricky (for the Paris Convention's grace period, no questions are asked, but for national procedures, there may be a deeper enquiry as to the circumstances of the failure, whether all due care was taken, etc.).

The Internet and trade marks

63 There's this guy in Outer Mongolia who's selling his stuff under my mark on his Internet website. I can sue him for infringement, can't I?

Not necessarily. If his target clientele is in the East Asian area, and you just happen to be able to access his website, this is not infringement. It will only be infringement if he is deliberately targeting countries in which you have a registration.

64 What about people who use my mark as a domain name? Surely I can stop them!

Again, not necessarily. Domain names are NOT trade marks, and they are allocated on a first-come, first-served basis. In addition, it is possible to register very similar names (e.g., if London store Harrod's has harrods.com, it cannot stop someone else from registering harrod.com or harr0ds.com). And the fact that someone else uses your trade mark as a domain name does not entitle him or her to use it as a trade mark. But it can be confusing, and incidences of confusion can be brought to ICANN, the international registry for domain names. Perhaps you should have thought of registering your most popular trade mark as a domain name – or even a gTLD.

65 A – what?

gTLD (generic Top Level Domain). You are no doubt familiar with the usual TLDs, such as .com, .org, .biz, .gov, etc. You now have the possibility of making your trade mark or brand a gTLD. For example, a large chemical company could have .basf or a large car manufacturer .ford. Very expensive.

66 So, are you saying that I should register all my trade marks as domain names?

No, that would constitute overkill, and is simply not necessary. As previously mentioned, the registration of a domain name does not give the owner of that domain name the right to use the name as a trade mark – and if s/he uses it in a deceptive manner, there are means by which ICANN can cancel the registration or have it reassigned it to you.

With the arrival of gTLDs, there is now an associated so-called “clearinghouse” administered by ICANN, where trade mark owners can register their marks. If anyone seeks to register the mark as a gTLD, a warning is sent to the trade mark proprietor.

Miscellaneous

67 Back in 18 you mentioned “famous trade marks”. How famous is “famous”?

These days, most trade marks laws have provision for the protection of marks that are so well known that their use on anything else, no matter how remote that is from their actual use, would be considered to emanate from the proprietor, or be used with its permission. Nearly everyone seeing **Coca-Cola** on machine tools would assume that the Coca-Cola Company had either branched out into the business, or had given its permission for the use. The same can be said for other marks (**Microsoft, Apple, Rolex**, etc.).

There are nowadays few specific registration provisions for such marks (some British-type law countries still have a Part D of the Register for so-called “defensive” registrations).

68 Since we’re on the subject of other marks, are there any other sorts of marks?

There are other types. For example, there are collective marks (marks owned and used by members of an association of traders) or certification marks (marks that indicate that goods and services comply with certain standards). The owners of certification marks do not trade in the goods and services, but ensure that the goods comply with certain standards.

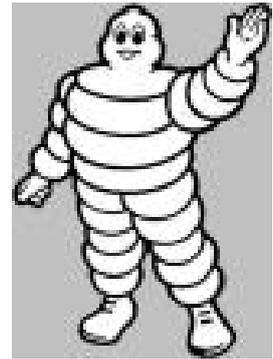
Some countries still have defensive registrations. These seek to protect very well-known marks from abuse. Most countries who had them (mostly British-type law countries) have replaced them with famous trade marks legislation.

69 Where do geographical indications fit into this?

These are not trade marks, merely indications that the goods originate in particular geographical areas. Only goods originating in those areas are entitled to the indication. The best-known are the French *appellation d’origine* and *appellation contrôlée*. Thus, “champagne” can be applied only to sparkling wines fermented in the bottle and that originate from the Champagne region around Épernay. A recent addition has been Darjeeling for tea (the quantity of “Darjeeling” tea sold vastly exceeds the actual quantity of tea grown in the region).

1. Introduction

You probably all recognise the gentleman on the right. He celebrated his 100th. birthday in 1998, but still looks fit and not ready to retire (retyre?). He is Monsieur Bibendum, the Michelin rubber man. He has been used by Michelin in its advertising for all of that time.

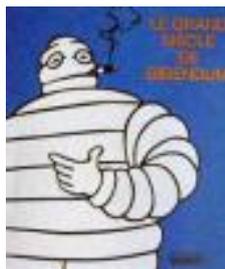


Bib has changed slightly over the years (as tyres became wider, so did his, and he lost his monocle and cigar), but has remained essentially the same, and remains the supreme symbol of Michelin, instantly recognisable, with a vast reservoir of goodwill behind him. Unlike so many other companies who have dumped famous old trade marks in search of spurious image updating, Michelin has stayed true to Bib and has benefited accordingly. Bib is a fine example of what good trade marks practice is all about.

Of all the forms of intellectual property, none is more familiar in this commercial world than trade marks. We are confronted with them everywhere, in newspapers, on advertisement hoardings, on public transport (inside and outside), covering racing cars of all kinds (and their drivers), soccer players' shirts, etc. The people in the depths of the Amazon jungle may not know what a patent is, but they know about Coca-Cola® which has been up there for years. In a competitive commercial environment, advertising agencies are doing their best to imprint the trade marks of their clients on our consciousness (and unconsciousness).

As a result, good trade marks are valuable commodities. An annual assessment of various famous trade marks gives the values of marks such as **Coca-Cola** and **Microsoft** as hundreds of millions of dollars *per annum* (see Appendix 5). Yet this value is often not perceived by marketing people, who often seem to prefer descriptive, short-lived names, in the apparent belief that these communicate better to the public. This, I believe, is not the best way to go about business. If a reputable business has a good, distinctive trade mark, an enormous amount of goodwill towards the mark can build up, leading the public to want to buy more and/or other goods from the same source.

In this little booklet, the emphasis will be on trade marks which are registered or registrable, but many of the comments also apply to unregistered trade marks. It goes without saying that, if you have any questions on trade marks and their use, your trade marks attorney would be happy to answer them.



2. *Basic Concepts*

(i) What is a trade mark?

A trade mark is **a symbol which distinguishes the goods and services of the owner from the goods and services of other traders in the course of trade** and which indicates a connection of the goods with the owner.

It is actually not necessary that the public know the identity of the owner. In 1970, I joined an Australian paint company then called BALM Paints Ltd. (the word was a acronym of **British Australian Lead Manufacturers**). BALM Paints was the best-kept secret since the formula of Coca-Cola® - nobody in Australia (and this was attested by surveys) had the faintest idea what BALM Paints was. But absolutely everyone in Australia knew its major trade mark DULUX, because DULUX was the best-selling paint in the country. Eventually BALM Paints became Dulux Australia, but I think you see the point. Everybody knew DULUX paint to be a quality material and its reputation helped persuade them to buy more, even if they had no idea who was the proprietor. As a result, the owner of DULUX (whoever it was) acquired a valuable marketing tool.



The three ages of Dulux (Australia)

(ii) What is a registered trade mark?

This is a trade mark which has been **officially entered on a national or supranational trade marks Register**. This involves at least a formal examination of the mark, usually an assessment as to whether it is distinctive of the proprietor, and in many countries a comparison with marks already on the Register, to make sure that the same mark (or a deceptively similar mark) isn't registered twice. When it has passed these hurdles, it is registered, a registration certificate is issued (see Appendix 3) and you can start indicating the mark as registered, for example, with the symbol ®. This has actual legal status in only a few countries (e.g., the USA), but it has become internationally recognised as an indication of registration.

It should be remembered that **in many countries it is an offence to represent an unregistered trade mark as registered**. A completely safe way of indicating a proprietary interest without indicating registration is by using a superscript "TM". Thus, you'd write Coca-Cola®, but UNREGISTERED™.

Note carefully the national nature of trade marks. If you have a registration in, say, Switzerland only and a rival starts using your mark in France, you cannot prevent him from doing so; only a registration in France can do that. Of course, you could register your trade mark everywhere where you wish to deny it to your competition, but it is a requirement in all countries that trade marks be used; non-use means that the registration could be vulnerable to removal from the Register. Some countries, e.g., the USA, are enormously strict on this. "Use 'em or lose 'em" is the general idea which you should always bear in mind. More on use (and non-use) on p.20.

(iii) Why bother with registration?

Quite simple. Registration gives you a title to the mark; it becomes your property, able to be sold, licensed or assigned. Moreover, **registration is prima facie evidence of distinctiveness**. Anyone infringing the mark has to prove that s/he doesn't infringe and/or the proprietor doesn't have a right to the mark.

This is the reverse of the unregistered situation in many countries. The proprietor of an unregistered mark whose mark is infringed generally has to prove that (a) s/he has a reputation in the mark, and (b) his/her reputation and/or business has been damaged by the activities of the alleged infringer. Registration removes the need to do this.

A further plus point for registration is that **most countries** in the world are so-called “first to register” countries, that is, the **first person to register the mark gets the rights**, even if someone else has been using it as an unregistered mark for decades. This means that the registered owner can stop the first user from using the mark. This contrasts with the situation in the so-called “first to use” countries (generally countries with British-type common law, such as British Commonwealth countries and the USA), where the person who is the first to use the mark in commerce has the rights to it. This does not stop anyone else from registering it in respect of the same goods or services, but it will stop him/her from using it. In both cases, if you have a good trade mark, the best way to avoid problems is registration (providing that this is possible).

(iv) “In the course of trade”

A registered trade mark must be used in commercial dealings in goods and services. If it isn't, it may become liable to removal from the Register (see more at p.21)

3. *History*

Traders have been marking their goods since time immemorial. The practice goes back at least to classical times when potters marked their jars so as to indicate their maker and designer. There even exist Roman infringements (pottery imported into England from Belgium, but bearing fake Roman marks). Examples can be seen in the British Museum.

After a lapse during the Dark Ages, trade mark use began to spread rapidly, starting in the 12th.-13th. centuries. William Caxton, England's first printer, marked his products “W.74.C” (a reference to 1474, when he started printing). In important commercial centres such as the Hanseatic towns, merchants' guilds maintained their own registers of both local and foreign marks. By the 16th. and 17th. centuries, Germany had a fairly comprehensive code of trade mark law and in France there occurred in the 16th. century several reported instances of “passing off”-type actions.

The first statutory protection given to trade marks of which I am aware was given to the marks of the Cutlers' Company of Sheffield (*Cutlers' Company Act* 1623). The Company kept a Register of marks of its members which lasted down to its abolition with the arrival of the British Trade Marks Act of 1994.

For the rest of the British population, protection could only be had under common law (non-statute law regulating many basic rights in England (and now the Commonwealth and the USA) and decided by precedent). From this evolved the common law action of “passing off” which a person aggrieved could bring against someone who copied his/her trade mark and was attempting to “pass off” counterfeit goods as genuinely-marked goods. The basis of the action was well stated by Lord Justice James in the 1880 case *Singer Manufacturing Co. v. Loong*:

“No man is entitled to represent his goods as being the goods of another man; and no man is permitted to use any mark, sign or symbol, device or means, whereby, without making a direct false representation of himself to a

purchaser who purchases from him, he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate customer.”

The earliest such action known was in 1618.

However, to succeed in a passing off action, the person aggrieved had first of all to prove that s/he had a reputation in the mark, and this was time-consuming and expensive. The case of *Rodgers v. Nowill* (1847) lasted 5 years and cost the plaintiff £2,211 (something of the order of £150,000 (€187,000/\$US233,000) in present day money – a lot any way you look at it).

This situation became more unsatisfactory with the rise of industrial and commercial society and the proliferation of trade marks on a large scale, and traders pressured the Government for better protection of their marks, in particular for some sort of system, like the Sheffield system, which allowed the creation of rights by registration. Some countries and three of the Australian states (individual colonies in those days) had already introduced such a system. The result was the passing in 1875 of the *Trade Marks Registration Act*. UK Trade Mark No. 1, registered under this Act, is still on the Register – it is the red triangle label of brewery Bass Charrington, still in use today. The alleged reason why it is No.1 is that, on the day when the first trade mark applications were received, Bass sent an enormous drayman with its application. This gentleman marched straight to the front of the queue – and nobody objected! (The other more boring version is that an employee queued all night to be the first – nobody really knows).



Registration systems had proliferated well enough by the early 1880s for trade marks to be included in the 1883 Paris Convention.

4. *Trade Mark Law for Beginners*

The purpose of this section is to set out the basis for trade marks registration and why some things are registrable and others are not. It is not actually necessary to read it, but doing so will give you a better appreciation of the rationale behind trade marks.

(i) Distinctiveness

This is **the key quality of a good trade mark**, the equivalent of novelty in a patent.

As previously mentioned, a trade name distinguishes the goods and services of the proprietor from those of other traders. It follows from this that, in order to be registrable, the trade name mark must be capable of doing this. In other words, it must be inherently distinctive or capable of becoming distinctive of the proprietor. Very strict standards were once applied; these have eased considerably in recent years, so that many more marks are now registrable than was once the case. However, **there are some things that are virtually impossible to register**; we'll cover these in greater detail later.

So, **how distinctive is “distinctive”?** The obvious answer is the one that Rolls-Royce traditionally gave for its engine horsepower figures (“adequate”). There is no easy way to define this. It **depends on a variety of factors**, the most important of which are

(a) the nature of the purchasers of the goods/services;

- (b) the nature of the goods/services;
- (c) the nature of the comparison between the mark and the closest similar marks.

(a) The **addressee** for a patent is “a person skilled in the art”, so a microbiological patent does not have to explain everything to non-microbiologists. For a trade mark, the addressee is **“the general public”**. But “the general public” is **not always the same**. For example, a fragrance company sells fragrances, not to the general public but to its “general public”, the perfume or household products industry. It is therefore selling to knowledgeable professionals who have to meet strict performance standards. This is not the same as selling washing-up liquid to the general public and the same criteria of distinctiveness cannot apply. Such skilled people are deemed to be considerably more knowledgeable of their market area than is the general public about washing-up liquid, and therefore less likely to be confused by similar marks. This is taken into account in determining distinctiveness.

This can also apply in specialised cases to the general public. In a famous case, PIANOLA was initially refused because of a prior registration of NEOLA, but a court later held that the goods involved (pianos) were major purchases and not casual daily transactions. Therefore, people in such a market would choose and discriminate carefully and would not be confused by a close phonetic similarity.

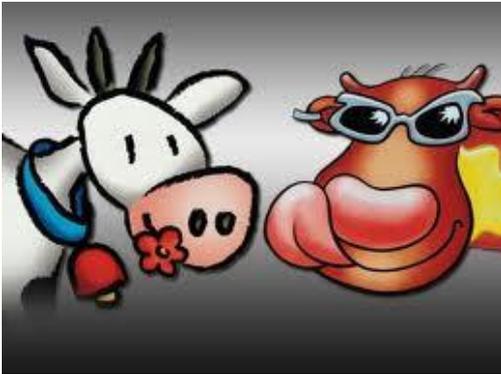
(b) It is usually the case that it is possible for the same mark to be registered by different people for different goods and services. Thus, the owner of PONGO in respect of deodorant would have no grounds for stopping a toy manufacturer selling PONGO toys, if there was no dishonest intent on behalf of the toy manufacturer. However, this is not always the case; there are two major exceptions

- (i) “goods/services of the same description”. The goods or services may not be the same, but are they sold to the same group of customers through the same trade outlets? In this case there could be confusion. For example, if, say, Company A was selling GLOOPY concrete additives to builders and the totally unrelated Company B started supplying builders with GLOOPY measuring instruments, there is a possibility that even knowledgeable builders would think that the instruments emanated from or were in some way approved by Company A. Worse, if the instruments were of poor quality, Company A’s reputation in GLOOPY could suffer. In this case, Company A would have a legitimate ground of complaint against the instrument manufacturer.

The goods “of the same description” can be quite different. In Australia, Southern Cross, the maker of all these artesian windmills in the Outback was able to stop another manufacturer from registering SOUTHERN CROSS for refrigerators, because both types of goods were sold side-by-side in stores in country towns.

- (ii) Famous trade marks. There are trade marks that are so well-known that any other use of them, no matter how remote from the goods with which they are normally associated, would imply some connection in the course of trade. Thus, the name of SHELL on cigarettes or COCA-COLA on industrial chemicals would imply at least permission by the owners, especially in an age of widespread trade mark licensing and franchising. Nowadays, most countries have special provisions for the protection of such famous trade marks. See more on p.30.

(c) The **comparison** to be made is **not** the placing of the two marks **side by side** and **visually comparing**. Also taken into account are things such as **imperfect recollection** and **poor pronunciation over the telephone**. Thus, RYSTA was refused registration because of a prior registration of ARISTOC, for similar goods. Similarly, in an old Australian case, *Jafferjee v. Scarlett*, a flour manufacturer was refused registration for his mark of two athletes running because another flour manufacturer was using a mark with two javelin throwers – the judge commented that the public would remember “the flour with the two men on it”.



How now, cool cow?

A recent German regional court case puts a new slant on this. On the left, Flecki, from the German supermarket chain Aldi, on the right Paula, from the German food manufacturer Dr. Oetker. Both were used on puddings. Paula was the subject of a EUTM. Deceptively similar? The judges thought not. But both were cows. However, the judges thought that the cows were visually different – Flecki was thin, Paula was plump and (I kid you not) was “cool”, because of the cool shades. Now, if only Jafferjee or

Scarlett had put some cool shades on those athletes of theirs...



Ehhhh...what's up, Doc?

While on the subject of animals, I would be remiss if I didn't mention Lindt & Sprüngli's unsuccessful efforts to monopolise chocolate bunnies, seen here with a German rival.

In EU law, the factors considered for identical or closely-resembling marks include, nature, purpose, method of use, whether the goods are in competition with each other or intended complementary and close connection.

(ii) Things which (in general) cannot be registered

Basically, these are

- descriptive or laudatory words
- geographical names
- surnames
- small groups of letters and numbers

(a) Descriptive or laudatory words Traders have the right to use normal descriptive language on products, so naturally **anything descriptive (or misdescriptive) or laudatory is inherently unsuitable for registration**. If the answer to the classic question “would another person wish to use this without improper motives?” is “yes, forget registration. This does not necessarily mean that it cannot be used as a trade mark - one of the biggest selling lines of the abovementioned BALM Paints/Dulux Australia was SUPER ENAMEL. Everyone knew it and liked it, but registration was totally out of the question - and there was no way to prevent a competitor describing its product as a “super enamel”, provided the competitor didn't try to trade on the reputation of SUPER ENAMEL, for example, by copying the label get-up.

A descriptive word cannot be made less so by changing the spelling, for example, by calling a cleaning product KWIKLEEN (“quick clean”). It is also not permissible to use a

foreign equivalent, for example, “sauber” (German for “clean”) would not be registrable in England in respect of a cleaning product.

This does not mean that a word must be completely devoid of meaning to be registrable. In a classic old English House of Lords case, the mark SOLIO was allowed in respect of photographic papers, even though the mark has a reference to “sol” (the sun). This, in their Lordships’ opinion, was a “skilful and covert allusion” to the character or quality of the goods, rather than a direct reference. Such reasoning works in many places in the world, although things ain’t wot they used to be and the allusion need no longer be quite so “skilful and covert” as the one in SOLIO. In another example, TUB HAPPY was allowed for children’s clothes. The original objection of descriptiveness of the washability of the clothes was overruled by the court which pointed out that clothes could not be “happy” and that the mark was a fanciful allusion to the quality of washability.

(b) Geographical names The basic rule is: if the primary significance of the proposed mark is geographical, **forget it**. Two classic British cases are good examples - everyone in the respective trades knew YORKSHIRE copper pipes and LIVERPOOL cables, but no matter how many truckloads of evidence the proprietors filed, nothing could overcome the inherent primary geographical significance of the words. Ignorance is no salvation; Boots Ltd. in England chose LIVRON for a medicine without knowing that there was a Belgian town of the same name in which medicines were made, and did not get registration. Had Livron been a small, insignificant village, perhaps Boots would have succeeded, but Livron was a substantial town.

However, again the prohibition is not absolute. It has long been accepted that NORTH POLE would be registrable in respect of bananas (the geographical area not being noted for their cultivation, at least not in the current state of global warming). And in a famous British case, TIJUANA SMALLS in respect of cigars was accepted, despite the existence of a Mexican state and city of the same name, because (a) Tijuana was an arid area, where tobacco was not grown, and (b) at the time, the name “Tijuana” to the ordinary British public primarily meant the then very popular U.S. band Herb Alpert and the Tijuana Brass. So, who knows? Perhaps YORKSHIRE and LIVERPOOL could be registered in Outer Mongolia.

(c) Surnames **In many countries, a surname is not registrable**, or only registrable with considerable evidence. Dulux, my former employer, was the Australian licensee of The Benjamin Foster Company of the USA, at that time the company for insulation coatings. Foster’s Australian attorneys attempted to register FOSTER as a trade mark in Class 2 (coatings) - and the Australian Trade Marks Office cited the Melbourne telephone directory under “F”! Eventually registration was obtained but only with the help of an enormous amount of evidence of use to show distinctiveness. The European Union IP Office is much more lenient with surname registration.

A surname can more easily be registered if rendered in a particular form, e.g. in fancy lettering or as a part of a device or logo (such as the Dupont oval), but a disclaimer to the name itself will generally be required, that is, the applicant acquires exclusive rights to the name in that particular form only.



Of course, when one thinks of surnames as trade marks, those of us with any connection with children think of THAT surname. How did it manage? After all, not only is McDonald the most common of all the Scottish Mc/Mac names, but also all English speakers at least will be aware that old McDonald had a farm (E-I-E-I-O), prior to moving downstream into fast



alleged food. The reason is probably that the registered word mark is not McDONALD, but McDONALD'S. The other factor would be sheer volume of use; there could be no doubt that McDonald's in the field of fast food is distinctive. However, in no way could McDonald's prevent any McDonald, old or otherwise, using his/her name on a place of business, unless the use was calculated to utilise McDonald's reputation.

Nobody can be denied the use in good faith of his/her own surname. But it must be in good faith. An interesting example of the opposite was a Melbourne trader by the name of Koodak (his real name) who tried to use it in such a way as to infer a connection with Eastman Kodak and thereby to gain from the goodwill. The resulting court case acknowledged the right to the use of his name, but not in a deceptive manner.

Rare surnames can be registered in most places. An attempt by Ciba to register CIBA in the UK was initially prevented because there is a rare surname "Ciba". However, the House of Lords finally decided that registration was allowable because of the rarity of this name. In doing so, it established a *de minimis* rule that relied on how often this name occurred in major telephone books, e.g., Greater London. This sort of ruling has been accepted in many countries where surnames are otherwise generally regarded as unregistrable, the maximum number of mentions in telephone books or electoral rolls permitted for registrability varying from place to place. However, even this is not enough in some places – the Swedish Trade Marks Office refuses all surnames, even rare ones where the owner has agreed to its registration.



Frl. Jellinek, wishing upon a star

And what about full names or first names? Things appear easier here. A full name is regarded as more distinctive than a surname. Moreover, one of the most famous of all marks is a first name. The world has long forgotten Emil Jellinek, distributor of Daimler cars in France at the turn of the century, but there are few who have never heard of his daughter,

Mercedes. In 1900, Jellinek took 36 cars from Daimler, one of his conditions being that they were named "Mercedes", and the rest, as they say, is history. (By the way, the tristar proudly borne by Mercedes also originated with Daimler – the Benz part is the laurel wreath that surrounds it – the companies merged in 1926).

(d) Small groups of letters and numbers There is no problem with letters as part of or forming a logo – "BP" for example. And of course the letters can be disguised – ESSO is a phonetic rendition of "S.O." (Standard Oil). However, in general, **small groups of letters alone are difficult to register**, because so many other people could legitimately also want to register them.

However, again there are exceptions; if I say the three letters "IBM", does it conjure up in your mind anything other than that IBM? And of course there's BMW. And we are all thankful that the Badische Anilin- und Soda-



BASF Fabrik got its letters registered, before we all broke our jaws on the name. And the Financial Times, that pink thing behind which all London City gents hide themselves in the morning commute, got "FT" registered (with considerable evidence of use being required). In addition, US practice with regard to small groups of letters is relatively lenient. And recently the Swedish Appeal Court allowed the registration of one single letter ("D", since you ask), but stressed that this was exceptional.

French car manufacturer Automobiles Peugeot S.A. designates its cars by numbers, always with a zero in the middle - 105, 206, 304, 805, etc. (not forgetting Lt. Columbo's 403), so much so that it was commonly believed that Peugeot had registered all three-digit

numbers with a zero in the middle. This is pure myth, because **small numbers are regarded as not being distinctive** (Peugeot may have had a “505” model, but so did Levi’s!) and are therefore generally difficult to register, even with substantial evidence of use. Peugeot does register the car numbers, but in some places, it has to be in conjunction with the company name, e.g. “Peugeot 206” in the UK.

PEUGEOT 206 stylized letters
 INTL CLASS: 12 (Vehicles)
 STATUS: REGISTRATION
 GOODS/SERVICES: LAND VEHICLES; AUTOMOBILES; MOTORCYCLES AND CYCLES; ENGINES; SUSPENSION SHOCK ABSORBERS; ANTI-THEFT ALARMS FOR VEHICLES; HEAD RESTS FOR VEHICLE SEATS; DRAWBARS FOR TRAILERS; REVERSE MOTION ALARMS; HORNS; PROTECTING STRIPS;

However, numbers have been registered. When Napoleon’s army occupied Köln (Cologne), they numbered all the buildings sequentially in French military fashion. The little perfumery at Glockengasse 9 was given the completely unmemorable “4711”, and has never looked back. The sheer volume of use and the unusual nature of the number (which ensures that nobody else would legitimately want to copy it) have ensured its registrability. Many countries now allow the registration of numbers (Peugeot naturally has a few of these...).



(e) Other problem marks

Position marks. This is the placing of something on a particular position on an article. In general, this is not regarded as distinctive. In one case, German soft toy maker Steiff sought to register two Community trade marks consisting of things attached to a teddy bear’s ear, one a metal stud, the other a fabric tag attached by such a stud. The court held that these could not be held as indications of commercial origin.



..and yet the Frenchy with the fancy red soles can get away with it! Bear-faced cheek, if you ask me!

However, positional marks can be allowed. Louboutin shoes with their red soles were allowed, but not the red aglets of Think (see p.11 below). The difference with Louboutin (and the flag tag on Levi’s jeans) is the provision of evidence that these indeed had become distinctive and indicative of the source of the goods.

(iii) Forbidden marks

Any mark which consists of or contains **scandalous or improper matter is usually unregistrable**. In one example, an application for JESUS was refused on the ground that it would offend an appreciable number of people. In a recent US case, a lady, who sold rooster-shaped chocolate lollipops in South Carolina, home of the Gamecocks football team, was refused when she sought to register COCK SUCKER. The trade marks for the Washington Redskins were removed from the US Register for being offensive to native Americans. However, a recent US Supreme Court decision held that the USPTO refusal of THE SLANTS (a derogatory name for Asians) for a Chinese-American rock band violated the First Amendment right to free speech. This was followed by the positive decision regarding FUCT for clothing. So, perhaps skins will again be red and, er, poultry orally soluble...



Don’t even think about oral proceedings...

Most countries have lists of **particular symbols which cannot be registered**. Typical examples include national flags and the flags or emblems of states, cantons, countries, provinces, etc. (although the US is now proposing to allow State and local governments to register flags and insignia). The Olympic symbol, the Red Cross symbol

and the various UN insignia are protected more or less universally. In addition, there are many specific provisions, for example:

- U.K. - representations of royalty.
- Japan - the chrysanthemum crest.
- U.S. - representation or signature of a deceased US President during the lifetime of his widow, except with the widow's permission.
- Taiwan - representations of Dr. Sun Yat-Sen (curiously, PR China does not specifically prohibit the use of Chairman Mao!).

(iv) Registrable trade marks

In addition to the various exceptions previously referred to, the main categories of registrable marks are the following:

(a) Invented words **A word which has absolutely no meaning is a very good mark.** It can be used in any form desired and will remain distinctive. One of the very best is (or was) KODAK.

(b) Slogans Catchy slogans have always been around and have been extensively used in advertising and promotions – Coca-Cola was famous for having them and changing them regularly to update its image for each new generation of drinkers - we had “Coke adds life”, “It’s the real thing”, “Coca-Cola is it”, and so on. And for years the DuPont logo was accompanied by “better things for better living...through chemistry”.

With the trend for companies to have mission statements, more and more companies have looked for slogans to typify them, and they can often be found on the companies' home pages. Such **slogans are registrable, even if they are in common use** – the fact that Microsoft Corporation has registrations for “Where do you want to go to today?” doesn't prevent people from using it in normal speech. Nestlé is hoping for the same result in its attempt to register “Have a break”, without the normally accompanying “have a Kit Kat”.



(c) Devices and logos “Device” is trademarkspeak for a mark with pictorial elements. A logo is a type of device, usually a relatively simple identifying symbol with strong visual appeal. These are **generally very distinctive** - think of Lacoste's alligator, Daimler Benz's tristar, BMW's blue and white roundel (not actually a whirling propeller), the shell device of (who else?) Shell, the apple of, er, Wotisname, and Monsieur Bibendum previously referred to. It is not always so – for example, many Scotch whiskies utilise heraldic devices that can be confusingly similar.

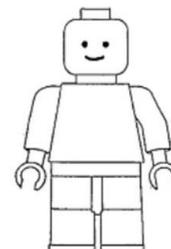


(d) Shapes Up to recently, in a large part of the world, a trade mark had to be something applied to the goods - it could not be the goods themselves. Perhaps the most celebrated of all shapes, the “Coca-Cola” bottle, could not be registered as a trade mark in, for example, the U.K. This has now changed and the Coke bottle is now registrable nearly everywhere.

However, **not all shapes are registrable**. Lego tried (and failed) to register its eponymous blocks as 3-D marks, which would presumably have allowed Lego to sue as trade mark infringers people who made compatible blocks (Lego's registered design protection on the blocks having long since expired). It was held that the functionality of the block and its features were too fundamental to permit registration.



blocked!!



...but not me!

(As an aside, one of Lego's other ploys for extending its protection was to argue precisely the opposite, after the design protection on the blocks had expired. It argued that, as every feature of the blocks was dictated by function, the design protection had always been invalid, and that therefore the blocks were protected by copyright in the original drawings, which lasts a whole lot longer than the design protection. Once it had stopped laughing, the court didn't see it that way...). However, Lego did succeed in registering its man as a 3D mark, the CJEU saying that not all of its features were functional



Gimme a break!

Functionality also features in Cadbury's fight with Nestlé over the latter's attempted registration of the shape of the Kit Kat™ bar. The UK High Court decision has refused registration (lack of distinctiveness).

For a **good shape trade mark**, you **should steer away from (a) shapes that are purely functional** (like the Lego block and (in the UK anyway) the Kit Kat bar) and (b) **shapes that are not different from the norms and customs of the industry** (one reason for the failure of the Lindt bunny on p.6 – chocolate bunnies were common around Easter time). The CJEU (Court of Justice of the European Union) put it thus: the test for a shape-of-goods mark was whether the mark enabled an average consumer, "without conducting an analytical or comparative examination or paying particular attention", to distinguish the goods concerned from those of other traders. The Court observed that only a (shape-of-goods) trade mark which departs **significantly** from the norms or customs of the sector and thereby fulfils its essential function of indicating origin possesses the distinctive character necessary for registration.

(e) Colours **Colour can be a factor in deciding whether a trade mark is distinctive**, and trade marks can be restricted as to particular colours. Previously, if a trade mark was registered without reference to colour, it is deemed registered for all colours. However, OHIM (the Community Trade Mark Office - see p.17) has just introduced a so-called new European Common Practice on B/W-colour marks that will substantially change the scope of protection of B/W marks. Basically, a B/W mark will only cover a colour mark if the differences are insignificant. This is contrary to many national laws (e.g. the UK)

But can a **particular colour** itself be **registered as a trade mark**? The answer is **yes**, and already a number of colours have been registered. For example, in Australia, Pink Batts are well-known roof insulation materials (batts of fibreglass insulation, coloured a distinctive pink). This colour has been registered in respect of insulation materials. A recent example of a colour as a trade mark have been the characteristic red soles of the luxury shoes of Christian Louboutin. How registrable are M. Louboutin's soles is currently (April 2018) before the CJEU. Failures have included the purple colour (Pantone 2685C) of Cadbury's chocolate wrapping and the red aglets (the metal bits at the end of shoe laces) of Think Schuhwerk shoes.



'Pon my sole!

(f) Others Modern trade marks legislations permit the registration of any distinctive sign, so **sounds, smells and tactile marks** (how something feels) can also be registered.

For example, OHIM accepted “the smell of fresh-cut grass” as registrable in respect of tennis balls.

List of goods and services

Nice classification: 28
List of goods and services: Tennis balls.

Description

Description of the mark: The mark consists of the smell of fresh cut grass applied to the product.

In another case, the New Zealand Trade Marks Office accepted the so-called “Sunlight squeak”, the sound of a thumb being rubbed on a freshly-washed plate, as a trade mark. Television advertising for Unilever’s “Sunlight” dishwashing liquid had long shown this (an oblique reference to the English expression “squeaky clean” (i.e., very, very clean)). This is not universal; for example, Italy will not accept fragrance or tactile marks.

Perfumes have generally been held as non-registrable, because they smell differently to different people, and cannot therefore be characteristic of the goods.

5. *How to register a trade mark*

(i) Initial steps

In the case of a **word mark**, it is **best to apply** for the word **in normal typescript**. This covers the word in all forms and in all colours. Thus PONGO covers PONGO and **PONGO** and *Pongo*.

The trade mark attorney will check whether the proposed trade mark is distinctive. Naturally, anything descriptive (or misdescriptive) will be rejected. A further consideration is whether the proposed mark means anything in another language. There are many hilarious stories of reputable companies inadvertently choosing innocent-sounding words only to find later that they had a rather more interesting meaning in another language. For example, an international cosmetics manufacturer decided on DRECK because it “sounded masculine and virile”, and only found out later that it was German for “filth”. Or, even worse, a US company selected an agreeable-sounding name for the Indian market, only to find that it was the slang expression in one of the major Indian languages for the most feminine part of the female anatomy.



Even big US corporations can get it wrong. The most celebrated example of major corporate foot-in-mouth disease was the selection by General Motors of the name “Nova” for a new model of Chevrolet. GM was probably thinking of something heavenly, like the

thing on the left, as opposed to something earthly, like the thing on its right, at least everywhere south of the Rio Grande (*no va* in Spanish = “doesn’t go”).

Mighty Standard Oil of New Jersey (now ExxonMobil Corp) had a near-miss. Having the right to the famous ESSO de mark in less than half of the US States as a result of the

Sherman anti-trust break-up, and seeking a mark to use in all states and internationally (eventually choosing EXXON), Jersey Standard first considered an old Company mark ENCO, but found that this meant “stalled car” in Japanese.

If the desired trade mark appears distinctive, the next thing to do is to have a search done, to see whether anyone else has it. A patent attorney can do (or arrange) this. In addition to commercial databases, there are specialist organisations that can give very detailed results. One such specialised agency is the Belgian Compu-Mark firm. The very best searches are by the US organisation Thomson + Thomson. These (regretfully only of the USA) cover not only registered Federal marks but also State marks, unregistered common-law marks and Internet domain names. A T+T search is invariably a mighty mountain of paper, but it is a very reliable guide to the world’s most desirable market.

Your application having been cleared for take-off, application is made in the appropriate Trade Marks Office. With the exception of some supra-national organisations (further described below), trade marks are obtained on a national basis.

(ii) Goods and services: Classification

Trade marks are **registered in respect of particular goods and services** and both goods/services and classes must be specified on application. Most countries adhere to a classification system for goods and services, the most universal being the **International (Nice) classification** with its 34 goods and 11 services classifications. This is shown at Appendix 2. There are still a (decreasing) number of national classification systems in use. The usefulness of the classifications system is that many countries permit an application in respect of “all goods/services included in class whatever”.

Some countries do not have service classes (yet). Canada is unique in having no classification system whatsoever and you apply in respect of the specific goods and services that you want (but this will change as Canada will soon sign up for Nice).

In the major countries, you can now cover as many classes as you want with a single application. However, in some countries (e.g. many Latin American and Middle Eastern countries), only one class per application is permitted. Thus, in these latter countries, three applications are needed to cover classes 1, 2 and 19. As previously mentioned, some countries will let you apply for “all goods in class whatever”, but others will not. USPTO insists on quite a precise description of the goods desired, and in Canada you have no choice but to be relatively precise.

In some countries (e.g., the USA and Canada), you must state whether the application is based on intent to use or actual use.

But how precise does the definition of goods and services have to be? Once upon a time, you could get away with saying “all goods in class 1”, but no longer. However, you do not have to spell them out with absolute precision (although it would be good if you could). As an ECJ statement put it in the *IPTranslator* case (where the services were defined by the short Nice Class heading only), “it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark”.

(iii) Examination of trade mark registration applications

The nature and standard of examination varies considerably. Trade marks may be examined on absolute grounds (i.e., whether the trade mark itself is inherently distinctive) and/or relative grounds (i.e., whether there exist similar trade marks already registered in respect of the same or similar goods and services). Most trade mark offices do at least one of these, many do both. For example, Switzerland and Germany examine on absolute grounds only. The UK cites what it believes to be similar marks, and invites comment. If the comments don't satisfy, it will inform the owners of the cited marks of your registration, and they may oppose. The USA still examines on both absolute and relative grounds.

If the application survives examination, it is generally advertised in an official publication and is open to opposition for a period of some months. If no opposition is filed (or if any opposition is successfully overcome) the mark is registered and a registration certificate issued.

During the examination process, several different ways of avoiding identical or similar marks are possible. One not allowed is altering the basic character of the mark, which must remain unchanged. The basic alterations allowable are

- (a) restrictions of the goods and services;
- (b) disclaimers or conditions.

Restrictions of goods and services are very common. If you file an application for registration of a trade mark in classes 2, 17 and 19, and someone has a registration of an identical mark in class 2, the abandoning of class 2 can often be sufficient to achieve allowance. However, sometimes "goods of the same description" considerations can get in the way. To take a simple example, you might have a class 2 application for "house paints" and someone else might have the identical mark for "wallpaper paste" (class 1). As these goods are both sold to home decorators, it could well be that some offices will not permit your application because the goods are sold to the same group of customers (home decorators) in the same shops.

It is possible to amend or restrict the goods within classifications, but never in a way that broadens the scope. For example, if you apply for registration of a mark in class 17 in respect of "all goods in class 17" but are really only interested in flexible electrical conduits, restriction to those goods could avoid an earlier registration by someone else of a deceptively similar Class 17 mark in respect of "sealing compositions".

Disclaimers are common in trade marks practice. A typical example is the registration of a surname in fancy lettering. Trade Marks Offices will generally allow registration provided the applicant disclaims the right to the exclusive use of the surname. In other words, the rights of the applicant in the mark extend only to the name in that form.

Another frequently-encountered disclaimer occurs when a mark contains descriptive matter which is common to the trade and which other traders could legitimately want to use. This can occur not only with word marks, but also with pictorial devices. For example, if a lawn mower trader uses a pictorial representation of a lawn mower, this entitles the trader to use that particular representation and no other, and a disclaimer to the use of a device of a lawn mower *per se* may be required. The disclaimer is noted on the trade marks certificate.

Other conditions that may be required include a restriction to a particular geographical area. This can happen, for example, when a mark is well known in a particular area, but not so well known (or perhaps not at all) outside that area, and it runs into trouble with another mark.

Another occasionally-seen condition is the requirement to display the origin of the goods near the mark. This can be required if there could be deception or confusion as to their origin. This was one solution to the problem of the two Carl Zeiss firms which appeared after the Second World War, one in West Germany, the other in East Germany, both wanting to use the famous trade mark of the old Carl Zeiss Stiftung (Foundation), both having some right to it and it not being clear whose mark it really was.

(iv) Allowance, Registration and Opposition

When a trade mark application is allowed, it is generally published via an official publication, and the application is **open to opposition** by third parties for a limited period. If there is no opposition, or if opposition is successfully overcome, the mark will be registered. However, in some countries (e.g. the USA and Canada) the mark will not be registered until the Trade Marks Office receives proof of actual use of the mark, in the form of specimens of labels or copies of invoices or brochures.

At registration, you actually acquire property in the mark and receive your registration certificate. Some examples are shown in Appendix 3.

(v) Renewal

Unlike patents, **trade marks can be kept going forever, so long as the renewal fees are paid**. The common term for a trade mark registration is 10 years, but there are variations. Should the renewal fee not be paid on time, the Paris Convention provides for payment within 6 months of the expiry date with payment of a surcharge – but not all countries apply this (e.g., Argentina).

In some countries, e.g. the USA or Taiwan, **a registration will be renewed only if the proprietor can prove that the mark is being used**. This must be done by the submission of samples (actual labels, invoices, advertising material, etc.). In Taiwan, if you haven't used the mark, you can substitute use by advertising the mark in a local newspaper. However, in the USA, it must be real use – and if you haven't used the mark in respect of a portion of the goods in the original specification of goods, that portion must be deleted.

6. *International Arrangements and Applications*

Nearly all countries in the world have trade marks legislation, even those who do not have patents legislation. For many years, the most notorious hold-outs were the Arab countries in the Persian Gulf, where the only way to get any sort of protection was by publication of a cautionary notice in a newspaper. Nowadays, the few hold-outs are relatively unimportant. You still cannot file a trade mark application in the Vatican, but as Italian intellectual property laws apply there, there's no problem.

(a) The Paris Convention

The Paris Convention applies to trade marks as it does to patents, and it is possible to claim the filing date of a first trade mark application as a priority date in a Paris Convention country. In the case of trade marks, the **Convention period is 6 months** (patents, 1 year). Most countries in the world are Paris Convention members with respect to trade marks; as with patents, Taiwan is the major exception.

(b) The International Registration (Madrid) System

The Madrid System started in 1891, only a few years after the (1883) Paris Convention. It consists of two parallel agreements, the Madrid Agreement and the Madrid Protocol, which share a common set of regulations. The idea is that **one can apply for trade mark registration in a number of countries simultaneously via a single application** lodged with the International Bureau of the World Intellectual Property Organisation (WIPO) in Geneva. It is thus similar in concept to the PCT in the world of patents, with the exception that it can result in registrations (there is no such thing as a PCT patent).

In an application **under the Agreement**, a **“home” application is filed. When this is registered, an International application designating the desired countries is filed in Geneva via the “home” office.** If all formalities are complied with, the mark is registered immediately with respect to all designated countries. A designated office has one year from the International Registration date to produce a final refusal with respect to its particular territory, otherwise the International Registration is deemed valid for that country. Renewal of the mark in all countries is handled centrally. If the home registration is lost within 5 years of application, the International application is also lost.

The problem with the Agreement for **countries with tough examining systems** (such as the UK, the USA and the Nordic countries) was that such countries **had no chance of complying with the “one year final refusal” requirement mentioned above.** To overcome this, the **(1989) Protocol was introduced**, which allowed the filing of an **International application based on a home application**. This allowed non-Agreement countries to join, and the UK and the Nordic countries duly became Protocol members. USA, Japan, Singapore, Australia, and Ireland have subsequently joined the Protocol. OHIM, the European Community Trade Mark system can also be designated via the Madrid system. Thus, the home application and International application are now filed simultaneously in the national office.

In the Madrid System, there are Protocol-only countries (UK, Nordic countries) and countries that adhere to both Protocol and Agreement (e.g. France, Germany, China, Benelux, Switzerland) – the last Agreement-only country, Algeria, changed in 2015. The list of present members is shown at Appendix 4. Nationals of countries that are not party to the Madrid Agreement/Protocol cannot apply for International Registration – it is not even possible for such a national to acquire an International Registration by assignment.

The number of countries continues to rise. Canada (June 2019) and Brazil (2.October 2019) are the latest members, and Argentina is considering membership.

The Madrid System is **very convenient and relatively inexpensive**. Costs for an application in 3 classes, based on a US home application and covering the European Union (via a EUTM (see below) Switzerland, and Japan is CHF2459 (\$US2564). And, if your mark is a good one, and all the designated countries accept it, you won't have to bother with attorneys in most of those countries, which will substantially reduce your costs.

(If a designated office objects, it usually means that you'll have to appoint a representative in that country to deal with the local trade marks office).

WIPO's calculator for official fees for an International application may be found here:

<http://www.wipo.int/madrid/en/fees/calculator.jsp>

Just enter the country of origin and the number of classes, and then tick the desired countries.

(c) The European Union Trade Mark (formerly the Community Trade Mark)

This type of mark, a single mark **covering all countries of the European Union with a single, unitary registration**, came into being in 1995. Applications are processed by the European Union Intellectual Property Office, formerly OHIM (Office for the Harmonisation of the Internal Market). After a vast, unseemly amount of politicking, it was finally located in Alicante, Spain, as part of a big share-out of EU institutions in 1993.

Unlike the Madrid System, it is possible for non-member states of the EU to obtain EUTMs, but this must be done through an agent domiciled in the EU (analogous to the European Patent Office's requirements).

The entire procedure, application, examination, registration and opposition, is carried out in Alicante. The end-result is a EUTM registration that is valid for the entire territory of the EU. Should an EUTM be successfully opposed on the basis of a prior application in one EU state, it may be converted to national applications in EU states where no conflicting mark exists.

An EUTM registration costs €900 (currently about \$US1128), for 3 classes, if filed electronically. To this would have to be added agents' fees (if an agent in the EU is needed).

(d) Other supra-national arrangements

The best known is **Benelux**. It is **not possible to register a trade mark in Belgium, the Netherlands or Luxembourg, but only in all three together.**

The Francophone countries of Africa have formed OAPI (Organisation Africaine de la Propriété Industrielle), which has a unitary trade mark law.

7. *Rules for using trade marks correctly*

The rules of good trade mark practice are few and simple, but marketing departments often find them anathema because they can mess up their preferred layouts. However, most major companies with important trade marks have strict guidelines on trade mark use. The rules are directed particularly towards registered trade marks, but many also apply to unregistered marks, and comments on their application to unregistered marks are also given. They are universal in use; they apply to labels, brochures, point-of-sale material and correspondence, especially correspondence that goes outside the Company. For a humorous take on these rules, see Dave Barry's column "Let's humor the lawyers" at the following link (reproduced with the kind permission of the *Miami Herald*)

<http://www.miamiherald.com/living/liv-columns-blogs/dave-barry/article13067867.html>

1. **A registered trade mark must be used exactly as registered**

Registration of a word in normal print gives you the right to use it in any form. However, in the case of marks that are or include devices or in which fancy printing is part of the distinctiveness, this must be adhered to.

With an unregistered mark, there is no such restriction, but it is always advisable to use a trade mark in a consistent manner.

2. **A registered trade mark must stand out from the surrounding text as something special**

The public at large must see immediately that, if the mark is a word, it is a special word. This is easily enough achieved on a label or in point-of-sale material where the mark usually occupies centre stage, but it is also essential in a body of text – and it must be done every time the mark appears. So,

NOT “... to this mixture pongo flavourising agent was added. The pongo flavourising agent had the effect of ...”

OR “... to this mixture Pongo flavourising agent was added. The Pongo flavourising agent had the effect of ...”

OR EVEN “... to this mixture PONGO flavourising agent was added. The Pongo flavourising agent had the effect of ...”

BUT “... to this mixture PONGO flavourising agent was added. The PONGO flavourising agent had the effect of ...”

It is not important how the mark stands out, so long as it does. It can be capitalised (as here), different font, italics, different colour, underlining, etc. Or it could be rendered Pongo™, or, when registered, Pongo® (see 4 below).

In the case of unregistered marks, this is, again, not so critical, but it is advisable to follow this practice.

3. **A registered trade mark must be used adjectivally**

Did you notice how, in the previous example, PONGO was always qualified by “flavourising agent”? This is essential. Even on a label, descriptive matter should not be too far away. So, use the trade mark as an adjective, never as a noun. An even bigger crime is to use it as a verb (“You should pongo your recipe...”). This also applies to unregistered marks.

4. **A registered trade mark must be indicated as registered**

This can be done by putting a small “reg’d” or the R in a circle symbol ® beside the mark. (® has legal status only in the USA and Sweden, but it has become universally accepted as a registration symbol). In text, if the mark stands out from the text, it need only be used at the first appearance of a trade mark. Another variation is to put an asterisk (*) beside the mark at its first appearance and have at the bottom of the page the legend “* registered trade mark”.

However, an alternative to Rule 2. above would be to use ® at each appearance of the mark in the text. This would then be sufficient “standing out” and capitalisation, etc. could be dispensed with. Thus, our example from 1. would become

“... to this mix Pongo® flavourising agent was added. The Pongo® flavourising agent had the effect of ...”

Of course, this applies only to registered trade marks – remember that in many places it is an offence to represent an unregistered trade mark as registered. An unregistered mark can have its trade mark status indicated by placing the letters "TM" beside it, for example, WOTSIT™; if it is an important mark, it is advisable to do so. It should be noted that, in some countries, e.g. France and Germany, TM and ® may be considered equivalent, and TM may be considered misleading advertising if the mark is not registered. In this case, it is best to indicate the mark with an asterisk at first appearance and qualify this with “* Trade mark of...”

5. **Two registered trade marks should not be used side-by-side**

This is a “should not” rather than a “must not”. The problem is that it might dilute the effect of the two individual marks. Say that my old employer, with a substantial reputation in DULUX has a popular product called SPRUCE, also registered. Advertising to the effect “use DULUX® SPRUCE® for your house” does SPRUCE a disservice as it suggests that this is the Dulux version of SPRUCE (i.e., there could be a SPRUCE by other major paint manufacturers). This principle also applies to unregistered marks. It is fine to put a registered mark next to an unregistered mark, but it does both a disservice. It’s better to let SPRUCE stand on its own feet, and use DULUX as the company identifier.

6. **Registered trade marks with different proprietors must never be used side-by-side**

This can be a problem when a Company takes a licence from another Company and the licensor wants its mark used on labels, etc. To take an unlikely example, say the Coca-Cola Company decides to license Pepsico to make and sell COKE. Absolutely the last thing Coke would want to see on labels is PEPSI COKE. In such a case, in text, it would be just COKE, with a footnote somewhere in the text to the effect “COKE is a registered trade mark of the Coca-Cola Company. Made under licence from the trade mark proprietor by Pepsico, Inc.”. The same would apply in labelling – the COKE and the PEPSI would be substantially separated, with footnote of the type given above prominently on the label. The same principle applies to unregistered marks.

7. **Exceptions**

Yes, there are exceptions to these rules, but none that apply to most of us (sorry!). Take the following sentence:

“Charles consulted his Rolex once more and lit another Marlboro, while he waited for his Mercedes to come.”

So, why do I get away with it here? Simply because there are some finished products that are so strongly identified with their markets that nobody would ever think of using a

descriptive name – there is simply no necessity. I know of no car manufacturer that insists on your saying, “Buy a WRECKAGE motor vehicle”, rather than “buy a Wreckage”. No, we all buy Fords, Toyotas, BMWs, without any indication of registration or qualifying descriptive word, and the manufacturers are happy for us to do so and say so. Ditto cancer sticks and watches. And, more recently, the various iProducts of Apple. However, only products in specialised niches can get away with this. In the mundane and highly competitive world of supermarket products, this simply would not work, so the rules should be adhered to.

8. *Miscellaneous Topics*

(i) Trade marks as property; licensing

Like a patent, **a registered trade mark is property. It can be bought, sold, used as security for a mortgage, etc., just like any other asset.** Most countries also provide for the licensing of trade marks.

It is quite common to do this in companies with subsidiaries in countries other than their home countries. Often when there are transfers of technology, patents, know-how, etc., trade marks are also involved. One of the most visible manifestations of today is franchising, which McDonald’s Corp. has turned into an art form. The person wishing to take up a McDonald’s franchise acquires the rights to use the various McDonald’s trade marks, and this (along with all other facets of the McDonald’s deal) is rigidly policed by the McDonald’s Corporation in the USA.

In some old British law countries, there still exist so-called “registered user” provisions (under this type of law, licensing of trade marks is not permitted, because it was considered as “trafficking” in trade marks as items of commerce in their own right). If a trader wished to use the mark of another trader, they entered into a registered user agreement, wherein the user was obliged to maintain certain standards of the trade mark owner (with respect to quality, etc.) and the owner had the right (even the duty) to check this from time to time. If the registered user is a subsidiary, this is no great problem.

(ii) Collective/Certification Trade Marks, Geographical Indications and *Appellations d’Origine*

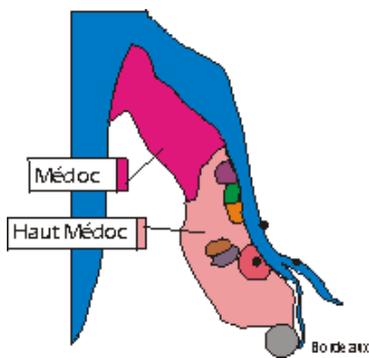


Collective or certification trade marks are marks that are used on goods from a variety of manufacturers either because they belong to an association of traders (collective) or because the goods or services comply with some common requirement(s),



for example, origin, quality, accuracy (certification). The Trade Marks Office must be satisfied that the applicant is suitably qualified to do whatever certification it is and that the rules for awarding the mark are adequate. The applicant, naturally, cannot be a manufacturer of the goods! Perhaps the most well-known certification mark is the “Woolmark” of the International Wool Secretariat. Other examples include the marks of standards institutes, for example, the “kite” mark of the British Standards Institution. The EU trade marks system has just introduced certification marks.

Appellations d’origine are not trade marks, but are **indications that the products so designated come from particular geographical regions.** The French are particularly strong on this, especially in respect of their wine industry – they believe that famous names with a strong regional identity should only be used by traders in that region. Thus,



“champagne” should be used not for all sparkling wines fermented in the bottle *à la méthode champenoise*, but only for those originating in the Champagne area around Rheims in France. The principle is becoming more universally recognised; for example, the growers in the Beaujolais Region were able to stop Australian growers who used the same grape variety.

...and nowhere else, merci

It has gone further than that. One the big Paris *parfumeurs* launched a perfume called “Champagne”. In the subsequent court case, the perfume manufacturer said that there was no possibility that anyone would confuse the perfume with the wine. However, the court held that this was a deliberate attempt to trade on the name of the wine and thereby to acquire some of its positive image. The perfume manufacturer had to find a new trade mark.



*And no putting in any of your bl***y rubbish I am telling you!*

Geographical indications provisions can now be found in many national laws. Most of the successes in the *appellations* area have been in the French wine industry. Its cheese industry has not been so successful, so my local supermarket still stocks “Swiss Camembert” cheese. However, India has recently been successful in getting the appellation Darjeeling restricted only to teas grown in the area (currently, the quantity of tea sold as “Darjeeling” dwarfs the amount actually grown there). A



Och, wha says ye cannae ha' it an' eat it?

recent candidate is Dundee cake.

(iii) Use of trade marks

Trade marks must be used. The basic principle can be simply stated: **“Use ‘em or lose ‘em”**. However, this is applied with different degrees of rigour in different parts of the world – the Holy Writ of intellectual property, the Paris Convention, is silent on the subject. As previously mentioned, **some countries require evidence of actual use before they will register a trade mark**. Many others, e.g. USA, require evidence of use as a condition of renewal. In addition, some countries require evidence of use at some point during the period of registration – the USA requires it between the 5th and 6th anniversary of registration.

Non-use of a trade mark is universally recognised as a **ground for removal from the Register by the action of a third party**. However, this is applied in different ways. A mark becomes liable for removal by third party action if it is not used for a certain period – three and five years are the most common periods. The object is to allow for the removal of marks on which people are “sitting”, keeping them without using them.

But what if a proprietor starts using his mark again after a long time of non-use? In some countries (e.g. U.K., Switzerland), the period of non-use is then forgotten and cannot be the basis of any action for removal. On the other hand, there are countries where it is not forgotten, and a mark becomes liable for removal for a period of non-use longer than that prescribed, even if use of the mark has commenced or recommenced. Some examples of this latter type of country are Russia and Brazil.

The message is clear; you should register only trade marks that you intend to use and not seek to “reserve” marks on the chance that you might one day wish to use them.

This raises the difficult issue of trade mark piracy, which regrettably happens a lot in some places. Pirates often see overseas trade marks before they come to the particular country and register them first, generally to extort money from the original owner. The only real counter to this is to decide very early where a trade mark will be used and to register it and use it there.

In a recent case involving EUTMs (ONEL v. OMEL), the question arose as to whether use in a single Contracting State is sufficient use. The CJEU held that it depended on the market and the circumstances – in some cases it could be sufficient.

(iv) Infringement of trade marks and remedies

A trade mark is **infringed when someone other than the proprietor uses the mark or a mark so close as to cause deception or confusion to the public on the same goods or “goods of the same description”**.



The advantages of having a registered trade mark come into play here; registration is considered proof of distinctiveness and the onus is on the alleged infringer either to show that s/he’s not infringing or that the mark is in some way no longer distinctive of the registered proprietor. All the usual remedies apply – an injunction (to stop further infringement), seizure of goods, damages, delivery up of goods, etc. Under the provisions of most trade marks Acts, Customs officials can seize goods bearing infringing marks as they come into the country. This is especially useful for famous manufacturers that are often the target of counterfeiters. It is well known that the sales of fake LOUIS VUITTON bags and ROLEX watches far exceed those of the genuine articles.

(v) Parallel Imports

This is all very well if a deceptive trade mark is being applied, but **what if the goods are the genuine article**, with the trade mark applied by the proprietor and the goods having been bought legitimately? Can British supermarket chains legitimately buy LEVI’S jeans on the US market, bring them into the UK and sell them at a price which considerably undercuts Levi Strauss’s own UK prices? Answer in this case, no, according to the consolidated judgements of the European Court of Justice in *Levi Strauss v. Tesco* and *Zino Davidoff SA v. A&G Imports*. The issue involved is the so-called “exhaustion of rights” principle, that is, whether the trade mark owner’s selling the goods “exhausts” the right to sue the purchaser and reseller for trade mark infringement. The court held that exhaustion applied only when the owner had given unequivocal consent – “implied” consent (silence of the owner) is not sufficient. This follows on from the *Silhouette* case in which the Austrian manufacturer of high-class spectacle frames succeeded in an action to stop the sale of genuine (non-current) “Silhouette” frames by a trader who had legitimately acquired them. **In most countries, so-called “grey market goods” are not permitted**, so the mark owners can theoretically charge what they want, without fear of competition from cheap imports of their own products. However, in the European context anyway, an extreme price differential could attract some very unwelcome attention from those dealing with restrictive trade practices.



(vi) How to lose your trade mark

(1) **Don't pay the renewal fee.** When the possible six months grace period under the Paris Convention runs out, you can recover your registration only by proving that you hadn't meant to abandon the mark and that you took action to recover it as soon as you found out.

(2) **Don't use the mark at all** – after a time, a third party may apply to have it removed from the Register for non-use (See p.21 above).

(3) **Use it in such a way that it becomes generic.** One way of doing this is, paradoxically, allowing it to become too famous and thus generic, thus no longer identifying the source of the goods and services and becoming deceptive or confusing. Consider the graveyard below.



And how did all these marks come to be here? Their owners were careless and the marks became part of the language. If you have a unique product and you don't give it a descriptive name as well as a trade mark, you invite the public to use the trade mark as a descriptive word. This is what happened with PYREX. Instead of talking about PYREX heat-resistant glass, the company (Corning Glass) talked about Pyrex, and before anything could be done, it became part of the language. The English language is a graveyard of former trade marks, and I am sure you can think of others. Chesebrough-Ponds fought a valiant rearguard action to prevent VASELINE becoming generic, and succeeded, although it still made the Oxford Dictionary (“(Proprietary name for) a kind of petroleum jelly”).



generically speaking, of course

My old Australian employer Dulux made DUCO, a nitrocellulose-based lacquer that helped make possible the modern automotive production line. As a result of this

dominance, the mark became almost synonymous with car paint, and, having read the classified advertisements in *The*

Age (Melbourne's main newspaper) on Saturday, I spent my Monday writing letters to dealers whose adverts contained “1998 model, red duco”, “reducing done here” and the like.

On the subject of things automotive, General Motors used to own the trade mark



and no doubt shuddered each time a French speaker got a cool drink from “le frigidaire”. Not sure if current owner Electrolux feels the same.



How to avoid this? Stick religiously to the rules for using trade marks correctly, given in Section 7. Another way is to advertise the mark in the newspapers. Johnson & Johnson, whose “Band-Aid” mark verges on becoming generic (some would say that it has already well and truly arrived) has occasionally taken this approach. *Stick to this sort of wording, guys*

(vii) Consumer Protection and Trade Practices Legislation

Many countries now have such laws on the statute books. Their intention is the protection of the consumer from “sharp” business practices. An example of these is copying of label get-up, so that, at a casual glance, the copy looks the same as the genuine article. The provisions of such legislation can usefully augment the options possible to a trade mark proprietor who is seeking to defend his rights. The problem here is that court action is involved, which is invariably expensive.

(viii) Trade marks and the Internet

The arrival of the Internet and its entry into the everyday lives of many businesses and individuals has raised new trade marks questions. Trade marks are generally registered and used in individual countries. Prior to the Internet, knowledge of a local mark was restricted to the country in which it was registered, and any advertising material appeared in local media that were not circulated elsewhere. Suddenly, this has all changed; **with the advent of websites, a local trade mark has a potential world-wide audience**. Anyone who finds the website is confronted with the mark, which may be registered in the home of the website owner but not in the home country of the reader. **Does this matter? Basically, no**. An Internet website is considered in the same light as a local paper which has been sent overseas; nobody reading the paper expects the advertisements therein to apply in the reader's country, so there is no problem. However, if the website is targeted at the recipient country, and the website owner is using a trade mark the rights to which are owned by someone else in the target country, questions of infringement arise in the normal way.

Thus, if a website prompts interest in the goods in other countries to the point where export is considered, the trade marks situation must be regularised in the usual way - a search ideally followed by registration, if the mark is available. If the mark is not available, because someone else has the rights in the country concerned, a new mark must be sought, and thought should be given to changing the website name, so that infringement problems do not arise. In this regard, the Internet has not changed anything and the same rules apply. The difficulty is that the situations encountered are sometimes unprecedented, and deciding exactly how and under what circumstances these rules apply will keep lawyers happy for years to come. Much of the difficulty comes about as a result of the advent of domain names, at which we shall now look.

(ix) Domain names and associated trade mark problems

Domain names are the easy-to-remember website addresses for the Internet. More precisely, they are the identifiers of addresses (which are actually numerical codes uniquely identifying websites and which allow them to be contacted). The three most familiar domains are the .com, .net and .org domains, three of the so-called global “Top Level Domains” (TLDs). Others include .gov (for US government organisations), .edu (for certain educational establishments), .int (for organisations established by international treaties), .biz (for businesses) and .info (for use by anyone).

In addition, companies can now have their own names registered as TLD – for a substantial fee, of course. The first of these so-called generic Top Level Domain Names (gTLDs) are in the currently in the process of being registered. Some examples; .melbourne (by the State of Victoria, Australia), .arab (by the League of Arab States), .alfaromeo and .ferrari (by Fiat) and .microsoft (by you couldn't possibly guess who).

Domain names are allocated by registries. The .com, .net and .org TLDs are allocated by ICANN, the Internet Corporation for Assigned Names and Numbers. The others are allocated by other bodies; for example, the .biz TLDs are allocated by a US organisation, Neulevel, Inc., under an agreement with ICANN. Registration is generally first-come, first served. ICANN has established a disputes resolution procedure, the URDP (Uniform Dispute Resolution Policy). Disputes are heard on its behalf by established dispute resolution services, including the arbitration service of WIPO.

In addition to ICANN and other TLD registries, there are national registries. And this is where the problems start. There are also country code TLDs (“ccTLDs”), which are registered by individual country registries. These ccTLDs have a two-letter country code appended to them. Thus, my micro-patent firm has a TLD of www.teemac.com and the Swiss ccTLD www.teemac.ch. However, it is quite feasible that someone else could legitimately register and use www.teemac.ie - it might well be that Terence MacSwiney of Cork, well-known Irish purveyor of a drastic weight reduction business, decided that his locally well-known initials “T-Mc-S” are just the thing for the address of his new website. And I could do nothing about it. And a potential client looking for the minute patent firm Teemac GmbH could be confronted with extremely valuable information on how to live on only 10 pints of Guinness a day. However, there is no confusion (apart from the initial confusion of being confronted by “before” and “after” photos of happy Irish(wo)men).

The basic problem is that a domain name is an address. And, like a street address, only one person can have it. This leads to **two important distinctions with respect to trade marks:**

1. With trade marks, **different people can own the same mark even in the same country.** For example, MBT, a former employer, had a US federal registration of the trade mark MEYCO in respect of admixtures and concrete spraying equipment in the USA. This could happily coexist with, for example, a federally-registered MEYCO in respect of lawn seed by a Louisiana firm, a federally-registered MEYCO in respect of hi-fi equipment by a California firm, a Texas state registration of MEYCO in respect of cookies and use as an unregistered mark in Oregon in respect of timber products. However, **what happens if they all wanted meyco.com? Answer, four disappointed parties.** In addition, as previously mentioned, trade marks are generally national. If MEYCO wasn't registered in respect of admixtures in, say, Algeria, someone else can legitimately register it. However, again, only one of MBT and the Algerian trade mark owner can get meyco.com.

2. **Because it is a unique address, minor variations are considered as being completely different.** Thus, in trade mark law, the owner of the trade mark **Harrods** would be able to stop someone who tried to use **Harr0ds** or **Harrod** on the grounds of deceptive or confusing similarity. Theoretically, this does not hold true of a domain name - the addition of a hyphen or a terminal “s” to a well-known brand name could be enough to allow blatant piracy. As a result, the previously-described UDRP has been made to apply not only to identical names but also to those which are confusingly similar.

The “first-come, first-served” nature of domain registration has caused problems, the best known one being so-called “cybersquatting”, the practice of registering a well-known brand as a domain name before the owner does and holding the owner to ransom. A sharp journalist registered mcdonalds.com before That Other McDonalds thought of it, and only assigned it to the King of the Golden Arches when said King agreed to make a royal donation of computer equipment to a primary school.

This sort of thing has caused a shift in practice, such that the proprietor of a trade mark is considered to have rights and can often have a domain name reassigned, even though the other owner “got in first”. Thus, in the *Madonna* case, Ms. Ciccola was assisted in having madonna.com assigned to her by the fact that her name was registered as a trade mark in the USA.

The URDP considers both legitimate interest and good faith (or lack thereof) on the part of the registrant in its considerations of who should legitimately own a domain name. Julia Roberts was successful in having juliaroberts.com assigned to her. WIPO acted as arbitrator and found that the registrant of the domain name had registered a number of other famous names in the same manner (e.g., alpacino.com), and had no intention of using them legitimately. On the other hand, the musician Sting failed to get sting.com assigned to him. He had no trade mark registration of STING and tried to argue that he had unregistered (common law) rights in the name. However, the owner of the domain name, a Mr. Urvan, was able to demonstrate that he also had been nicknamed “Sting” for some years, and he also argued the various common English meanings of the word. As sting.com is now the official Sting website, I presume Sting paid the \$25,000 Mr. Urvan wanted.

Cases involving “**metatags**” show a more conventional use of trade mark law in an Internet-related case. Metatags are the **keywords used to describe the contents of a website**, so that Internet search engines can find it. They are **invisible to the user, but are visible to the search engine**. A successful UK supplier of software for the road haulage industry found that its major competitor was using the supplier’s major trade marks as metatags. These were included on the web page in the same colour as the background, so that they were invisible on the screen, but appeared in the printed version of the page. The UK High Court held that this was both infringement of the marks and passing off.

But does the use in a domain name of a registered trade mark infringe the rights in that mark? There is no straightforward answer. The basis of trade mark infringement is the causing of deception or confusion to the public by the counterfeit. But this confusion may last only so long as it takes to open the website from the results obtained on a search engine. My potential client mentioned above, searching for Teemacs, will almost certainly not think that I have moved from intellectual property work to weight reduction, except in cases of pure desperation of one kind or another. In addition, it is clear that many websites are aimed purely at a local clientele, and are therefore harmless. However, if there is a deliberate attempt to utilise someone else’s registered trade marks or deceptively similar marks in one of their markets, these are clear grounds for infringement action.

The ideal defence would be for the trade mark proprietor to register all his most important trade marks as TLDs in the desired domains, both globally and in the national registers in which he wished to do business. Depending on the number of marks involved, this could be an expensive undertaking – different registries charge different amounts, but a typical figure for a TLD is \$US5000. This is much more expensive than the average trade mark application, but it does have the advantages of essentially covering the world for a one-

time fee – there are no renewal fees (apart from the small annual fees for renewal of the TLD) and, even better, no user requirements. Given the increasing importance of the Internet as a medium for communication and advertising, it is a false economy to ignore this sort of protection.

(x) gTLDs and the Trademark Clearinghouse

With the arrival of gTLDs (more than 2000 applications have been received and the first are expected to be approved by the end of April 2013), more problems arise for trade mark owners. Say you are the proprietor of the registered trade mark PONGO, and someone else applies for the gTLD .pongo. Now your reputation in your trade mark might be such that you couldn't care less whether someone else has spent all that money getting .pongo registered for nothing – after all, the gTLD owner could never sell PONGO goods or services. However, it could be a nuisance and cause confusion.

Enter the Trademark Clearinghouse (TMCH),

<http://trademark-clearinghouse.com/>

which commenced operation on 26 March 2013. This is a database set up by ICANN, in order to assist trade mark owners. A trade mark owner may register his or her trade marks in the TMCH for authentication and validation (registration fee currently \$150/mark/year). While this does not enable an owner to block a gTLD, it provides several mechanisms to assist potentially aggrieved trade mark owners to defend their property:

- (a) The Sunrise Period: This is an initial period of at least 30 days before new gTLDs are offered to the general public. During the Sunrise Period, verified trade mark owners (i.e. trade marks registered in the TMCH) can apply for domain name(s) matching their trade mark(s) before the domain names are made available to the public.
- (b) Trademark Claims Service: Following the Sunrise period, this is a notification service to notify both trade mark owners and domain name applicants if an application is filed for a domain name corresponding to a trade mark in the TMCH during a Claims Period (at or shortly after the launch of a new extension) in any of the new gTLDs (new extensions). The Claims Period will be the first 90 days following the launch of a new extension.

If a gTLD application matches a trade mark registered in the TMCH, the gTLD applicant will be sent a warning notice to this effect. Should the gTLD applicant decide to proceed with the application, the trade mark proprietor will be notified of the existence of the gTLD, so that s/he can take appropriate action.

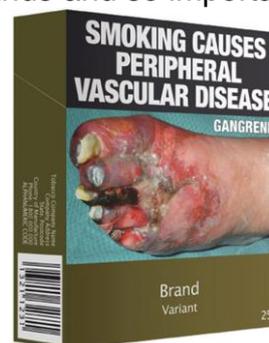
Someone described the TMCH as the *nice-trademark-you've-got-here,-wouldn't-want-anything-to-happen-to-it* Dept., in that it appears to be a way to shake down trade mark owners into buying every conceivable domain. It's hard not to see the point of the comment. How this will all work out in practice remains to be seen, but there will probably be much work for ICANN's and WIPO's disputes settlement people (and the courts) to do. As one commentator delightfully put it, "Many elements of the TMCH are still under construction and it remains unclear how well it will all work. For those who like moving into houses while they are still being built, you will feel right at home. For the rest of us, we'll need to watch for construction debris."

(xi) Plain packaging

This is a **new problem for trade mark owners in areas involving potential health problems**. The major problem area is the tobacco industry, but it is feared that, with the current problems with obesity, it could spread to the food and beverage industry.

Like Captain Kirk, Australians have always been prepared to go boldly where no one has gone before. To the horror of advocates for the freedom to leave cars via the windscreen at high speed, the Australian State of Victoria was the first place in the world to introduce the compulsory wearing of seat belts in cars. The rest of the country soon followed suit and the rest of the world then followed. Australia has a particularly active and successful anti-cancer movement, which has long had the tobacco industry in its sights. It was highly influential in promoting the introduction of large warning labels on cigarette packets. However, the familiar colours and logos differentiating the various brands and so important to the overall image were still there.

The next step was to advocate their complete removal – cigarettes would be packed in plain uniform wrapping in a particularly unappealing colour, with ghastly pictures of damage caused by cigarette smoking predominating, and with the brand name (not logo) occupying only a small part of the label. The Australian tobacco industry (most of it consisting of offshoots of large US companies) took this to court, arguing that the legislation violated the Australian Constitution by appropriating its intellectual property. The industry lost decisively in the High Court, which said that the legislation didn't violate the Constitution and that the Government did indeed have the power to order this <http://tinyurl.com/cancerstix>



© Commonwealth of Australia
Not going to put that foot in it any more...

The Australian industry has no choice but to comply. Other countries are now looking seriously at the Australian example and are contemplating similar measures. Apparently US lobbying organisation ALEC (American Legislative Exchange Council, notorious for US State minority voter disenfranchising laws and Florida's "stand your ground" gun law), is targeting overseas governments that are considering plain packaging laws.

Given the increasing levels of obesity in the world, a logical next target might be the food and beverage industry, with its myriad salt- and sugar-loaded products. The industry has already started worrying (and has no doubt already started vigorously lobbying behind the scenes).

Now there's no doubt that these products are genuinely harmful (even the tobacco industry no longer denies the overwhelming evidence of the harmfulness of its products). However, they are legitimately on sale and people are not compelled to buy them. In this case, does the plain packaging law not infringe the rights of the proprietors in their legitimately-acquired trade mark and trade dress rights? Where should Government responsibility stop and individual responsibility start, and why should the manufacturers suffer for people's poor choices? Is this taking the "Nanny State" too far, and should we follow the US lead in permitting people to smoke themselves to death and blow each other's brains out? There is no definitive answer to this – it will all depend on individual conceptions of freedom and as to how much Government regulation should intrude on people's lives.

To me, the case against Big Tobacco's attempt to frustrate plain packaging on the basis of intellectual property rights, as put by Professor Mark Davison of Melbourne's Monash

University Law Dept. (and quoted here with Prof. Davison's kind permission), is unanswerable:

Ultimately, the question becomes whether there are any products whose sale should not be promoted in any meaningful manner. If so, perhaps that product would be one which, when used in accordance with the manufacturer's intentions, leads to death as a direct consequence of usage (<http://tinyurl.com/6factgp>, the mortality rate from use of the product is 10 times the national road toll, (<http://tinyurl.com/d8qzlz> and <http://tinyurl.com/chu9jy5>), 15 times the mortality rate for alcohol abuse (<http://tinyurl.com/6factgp>), the product is addictive, the addiction is on a par with cocaine and heroin (<http://tinyurl.com/ccofnng>), the age of the majority when they become so addicted is less than 18, (<http://tinyurl.com/cogs7kz>) and (<http://tinyurl.com/83qyz9j>) and the packaging is clearly attractive to the young (<http://tinyurl.com/cjsnfsx>). Arguments about 'individual responsibility' may diminish in the light of the latter facts except when made by the most ardent libertarians. The difficulty with arguments about balancing intellectual property rights with public health considerations is that the arguments become meaningless when right holders fail to identify with precision the nature of those rights and fail to engage with the details of the evidence of the nature and extent of the tobacco problem. The tobacco industry does not have a distinguished record of engaging in meaningful discussion of such issues.

In my opinion, the tobacco industry should realise that the game is up, and that the world's greatest preventable cause of illness and death will just have to live with the continuing limiting of its horizons until its hopeful complete extinction.

Should other industries get the same treatment? Perhaps not at the moment, but perhaps as attitudes as to what's socially acceptable develop and change, their time may also come. The introduction of compulsory helmets for motorcyclists was fiercely resisted in the UK by the leather flying helmet/flat cap brigade, in spite of the evidence of horrendous head injuries. Now no self-respecting motorcyclist would be without his/her skid lid. In the development of public health and safety, intellectual property rights must always take second place.

In the latest developments, Ireland has decided to follow the Australian lead, the UK, having first said it would, is now saying that it will see what happens Downunder (but Scotland is talking about doing it independently), and the EU has decided not to implement it, but to require instead bigger health warnings.

(xii) Do-it-yourself trade mark searching

On p.11, I mentioned the various searching organisations and possibilities for searching trade marks prior to application. But, in this Internet age, what possibilities exist for the individual? And most importantly, what are free?

The obvious candidates are the various websites of the patent offices themselves. Here are some examples:

USPTO <http://tmsearch.uspto.gov/bin/gate.exe?f=tess&state=4805:kn13k0.1.1>

EUIPO (EU Trade Marks) <https://euipo.europa.eu/ohimportal/en/search-availability>

WIPO (International (Madrid) Trade Marks) <https://www3.wipo.int/branddb/en/>

UK <https://www.gov.uk/search-for-trademark>

Germany https://www.dpma.de/english/trade_marks/trade_mark_search/index.html

France <http://bases-marques.inpi.fr/>

Australia <https://www.ipaustralia.gov.au/trade-marks/applying-for-a-trade-mark/searching-trade-marks>

Switzerland <https://www.swissreg.ch/srclient/faces/jsp/start.jsp>

A useful free service for US trade marks is Trademarkia

https://www.trademarkia.com/?gclid=CjwKCAjwi975BRBUEiwA4whRB9Bt0eC9-TFXI_O2p7_0MaRG8WNVUjp9mQMKCe2WMW6Kjk_GwZPChoCkrcQAvD_BwE

These are fine for word marks, but what about devices and logos? Some, e.g. the USPTO's TESS system, can find them, using the TESS design code:

<http://tess2.uspto.gov/tmdb/dscm/index.htm>

The problem with these for word searching is that they will only find exactly what you put in. For example, if you put in PONGO, you will find PONGON and PONGORAMA, but not the near-phonetic equivalents BONGO or PUNGO (remember, when choosing a mark, you have to think about imperfect recollection and mispronunciation over the telephone, rather than side-by-side comparisons). Or, if your mark is WHITE BULL, you have to worry about whether someone else already has BLACK BULL, or even just BULL, for the same or similar goods or services.

The BULL one is relatively easy – you search for BULL alone, and go through a whole load of BULL. However, for the single-word phonetic near-equivalent case, you have to search for all those possible equivalents, hoping that Murphy's Law won't dictate that the only one of which you don't think is the one that's sitting there like an unexploded bomb, waiting for you.

One possibility is the MARKIFY site:

<http://www.markify.com/>

This is probably the best as it also does phonetic equivalents, but, sadly, it's no longer free (indeed quite expensive).

SERION is a service from major IP service provider Thomson Reuters service, using the well-tried SAEGIS system)

<http://trademarks.thomsonreuters.com/online-trademark-tools/serion>

Once you've signed up for this service and got your user name and password, the search is free, but you'll have to pay for the results – the costs are not hideous.

Trademarkia

<http://www.trademarkia.com/>

offers trade mark searching services. I have some reservations about its accuracy, as it didn't find the EUTM I looked for. The TMView service

<https://www.tmdn.org/tmview/#/tmview>

offers access to individual EU offices, OHIM and WIPO.

The moral of the story is, try to think of all the possible equivalents and use a number of data sources.

(xiii) Trade dress and deceptive conduct

It is possible to indulge in deceptive conduct, sometimes accidentally, **without copying or infringing anyone's trade mark**.



Consider the two products on the left. Seen side by side, there's no problem, they're clearly different, different names, different overall appearance. But what if they were on their own? What if you, an Australian resident, had been despatched to the supermarket by your Significant Other Half, with the instruction to get some of "that nice Nutri-grain corn/oats/wheat breakfast cereal, brown box, milk and cereal on it, you can't miss it". You go into Coles, a major Australian supermarket chain, and you are

confronted by the product on the right. Corn/oats/wheat breakfast cereal? Check. Brown box? Check. Milk and cereal? Check. You don't quite recall the name – something "grain", wasn't it? Has to be it. So you buy the wrong thing and get into endless trouble for your general incompetence and total unreliability.

Now this is not to say that Coles had intended to be deceptive in any way. It wanted to make a breakfast cereal with various grains, healthy-looking, so it went for a typical presentation, the sort of thing that one normally sees on breakfast cereal boxes. So, what's the problem? The problem is one of imperfect recollection, the phenomenon mentioned back on p.5, plus packaging sufficiently similar to tick all the vaguely-remembered boxes. The Coles product might be held to be damaging to the Kellogg's business. If so, it could be actionable under Australian trade practices law for misleading or deceptive conduct.

There have been cases where people have deliberately sought to copy the packaging of competitors, in order to improve their own sales by leaning on the reputation of established brands. In some cases, people who have actually seen Brand A buy Brand B, so similar is the packaging – most of us don't have photographic memories for labels.

The trade dress of a product, the overall appearance of the packaging, can be distinctive of the product, and deceptively-similar packaging can be stopped. The US Lanham Trademark Act actually protects trade dress. In common law countries, protection may be by passing-off action. Many countries also have Trade Practices laws, which outlaw misleading and deceptive conduct.

(xiv) Famous Trade marks

There are **trade marks that are so well known that any use of them, even use outside the field for which they're known, would imply a connection in the course of trade** or at least some sort of licensing or franchising deal. What if you were in the local DIY store and you saw an electric drill that looked like this?



What would you say? (a) "I see that the Coca-Cola people are making electric tools now! That's diversification for you!", or (b) "My goodness, those drill people are using the same mark as The Coca-Cola Company! They're asking for

(3S,6S,9S,12R,15S,18S,21S,24S,30S,33S)-30-ethyl-33-[(1R,2R,4E)-1-hydroxy-2-methyl-4-hexen-1-yl]-6,9,18,24-tetraisobutyl-3,21-diisopropyl-1,4,7,10,12,15,19,25,28-nonamethyl-1,4,7,10,13,16,19,22,25,28,31-undecaazacyclotritriacontane-2,5,8,11,14,17,20,23,26,29,32-undecone

Got that? In other words, by the time the doctor has prescribed it, the patient has died. Obviously it has to have another rather less long-winded and more pronounceable name. Moreover, given that, in the nature of the pharmaceutical business, other companies can produce it when the relevant patents have expired, it has to have a name that everyone can use. So, it has a generic name that everyone can use – ciclosporin – and the company selling it, Novartis (formerly Sandoz) registered the names Sandimmun™ and Neoral™ for the exclusive use of Novartis. Once ciclosporin was off patent, other manufacturers could call their equivalents ciclosporin, but not Sandimmun™/Neoral™. So, everyone's happy – the doctors/patients know what's in the medication and the manufacturers can give it their own name.

These pharmaceutical generic names are not chosen randomly. Since 1953, they have been allocated by the World Health Organisation, which keeps a list of so-called International Nonproprietary Names (INNs) for all pharmaceuticals sold internationally. Some countries have their own names registries, but these usually work with the WHO to ensure uniform usage. The intention of the INN system is to help health professionals identify drugs for particular pharmacological purposes. This is done by the use of a common "stem", which all INNs for a particular use will carry. For example, all cholesterol-reducing medicines bear the stem "-vastatin" - the well-known Lipitor™ is atorvastatin. Other examples include -olol for beta-blockers, -caine for local anaesthetics and -vir for antivirals.

In the case of agrochemicals, such as pesticides, generic names are established by the International Standards Organisation and the rules for selection are set out in ISO 257:2004. As *per* the pharmaceutical industry, the manufacturers can give their products registered trade marks to distinguish them from other people making and selling the same chemical. Thus, now that the patent has expired, everyone who wants can make and sell glyphosate, but only Monsanto can make and sell Roundup™.

In the unusual case where a chemical compound is both a pharmaceutical and an agrochemical, it has two different generic names. Thus, the compound known to INN as enilconazole and used as an antifungal medicine for the treatment of, for example, ringworm and athlete's foot, is also used as an agro fungicide and is known to the ISO as imazilil.

(xvi) Brexit

On 23 June, 1916 the UK voted in a referendum to leave the EU, and left on 31 January 2020. What are the implications for intellectual property?

The position of the UK as a signatory of the European Patent Convention is unaffected – the EPC is not restricted to EU members (Switzerland, Norway and Turkey are EPC members) – but it meant the end for the proposed UK membership of the Unified Patent Court (the UK withdrew its ratification), and the proposed UK part of the Central Division (to handle chemistry and pharmaceuticals) would be relocated elsewhere – assuming, of course, that the German failure to ratify after a constitutional challenge doesn't mean the end of the whole thing.

With respect to trade marks and designs, the position was more complicated. The European Union Trade Mark and Registered Community Design are unitary rights, covering all EU member states. What happens to the UK parts of such registrations? They ceased to have effect, and the UK parts of the EU registrations came into being as separate national rights, without the proprietors having to reapply.

Index, or where to find what...

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Glossary of Trade Mark Terms used in this booklet, plus some others

absolute grounds for refusal of a trade mark registration application That a trade mark that is the subject of a registration application is inherently unsuited for registration, for example, by being a descriptive word that others could reasonably wish to use without improper motives. See **relative grounds**.

acceptance Happens when a Trade Marks Office in **examination**, accepts that a trade mark which is the subject of a registration application is entitled to **registration**. In many countries, acceptance is advertised in an Official Gazette, and this advertisement may mark the beginning of an **opposition** period.

acquired distinctiveness Some marks that are not inherently distinctive can become so by means of extensive use, such that the mark can serve as an indication of commercial origin. Much will depend on the nature of the mark and the clientele.

adjective, use of trade mark as Always use a trade mark as an adjective ("Pongo" flavorising agent is used...), never, ever as a **noun** ("Pongo" is used...) or (worse) a **verb** "Pongo your soup mix...").

AdWords A Google advertising product that is Google's main source of revenue. It allows Internet advertising to be directed at potential customers identified according to the things for which they search on Google. Some customers have included competitors' trade marks in their Google advertisements. The argument as to whether this constitutes trade mark **infringement** continues worldwide.

ambush marketing Advertisers who capitalise on a particular event (e.g. a major sporting event) without paying any sponsorship fee.

amicus brief A legal brief on a point of law not from a participant in the proceedings. Such briefs are often invited from third parties on contentious matters.

Anton Piller order Court order in English and English-derived legal jurisdictions allowing the searching and seizing of evidence without prior warning. A similar order in France is the *saisie-contrefaçon*.

AOC *appellation d'origine contrôlée* – see next entry.

appellation d'origine Requirement, especially in France, that the use of the names of particular geographical regions famous for particular produce (notably wine, but also other regional agricultural produce) be restricted only to produce emanating from that region, e.g., that "champagne" can only come from the Champagne region of France, and lookalikes must find another name. Ditto Beaujolais, Bordeaux, etc. In France, the official designation is *appellation d'origine contrôlée* (AOC) and is regulated by the Institut national de l'origine et de la qualité.

assignment As property, trade marks can be assigned to a new owner. This is a frequent occurrence as businesses take over other businesses and incorporate the acquired lines into their existing lines. So, when Nestlé acquired Rowntree Mackintosh, the UK's biggest-selling chocolate bar went from this:



to this



Benelux Abbreviation of **B**elgium - **N**etherlands - **L**uxembourg. The three countries have a **unitary trade marks** system - it is not possible to register trade marks in the individual countries. This applies only to trade marks - the patents laws are still national.

Berne Convention 1891 International convention covering **copyright**. Provides for the automatic existence of copyright in an artistic work on creation, and for a minimum duration.

brand Often used interchangeably with “trade mark”, but actually has a rather broader meaning. While “trade mark” applies to the word or symbol used to distinguish goods and services, the implications of branding extend to the overall business and marketing strategy within which the particular trade mark(s) is/are used.

“Brexit” Popular name for the UK’s leaving the **EU** in the aftermath of a referendum vote on 23 June 2016, taking effect on 31 January 2020. A Brexit will have major effects on IP matters – it means that the UK can no longer be part of the **EU trade mark** system. Presumably there will be transition provisions that would allow the UK part of an EU mark to be separately registered as a UK national mark, but this is all unknown.

certification trade marks Trade marks applied to goods and services not to distinguish ownership but to certify the goods and services in some respect, e.g., quality, accuracy, origin. A good example is the “Woolmark” of the International Wool Secretariat. The person entitled to apply the mark must not trade in the goods. Similar in concept to **collective trade marks**. The **EU trade marks system** has introduced protection of certification marks.

certiorari See **writ**. Also **Latin**.

civil law Legal system in which laws are codified into a system and form a primary source of law, in contrast to **common law**, which is based on judicial precedent. It began with Roman law and is now the most widespread legal system in the world, followed by about 150 countries, including most of continental Europe, Russia, China and most of Latin America (Scottish law is a hybrid of the two systems). In civil law jurisdictions, case law is secondary to, and subject to, the written code. The differences can result in differences as to how intellectual property cases on the same subject-matter are decided in different countries.

“Clapham omnibus” According to an old English case, the man (sorry, girls, it was always men in those days) who was the yardstick by which **distinctiveness** was judged. S/he was an ordinary wo/man in the street, possessed of no special knowledge, and of ordinary education and intelligence. However, this can vary, depending on the nature of the neighbourhood visited by the aforesaid omnibus en route. See **public**.

classification of goods and services A system of dividing up all goods and services into defined numerical classes. The best-known and most frequently-encountered is the **International (Nice) Classification**, but there remain a (diminishing) number of national classification systems. Canada doesn’t use any classification system.

collective trade marks Trade marks used by an association of traders, usually certifying that the goods or services comply with some characteristic (geographical origin, accuracy, quality, etc.).

Similar in concept to **certification trade marks**, but differing in that in the latter case, any trader meeting the standards can use the mark.

colour can be taken into account in determining **distinctiveness** of a trade mark and colour itself can, in some cases, itself be registered as a trade mark.

Previously, a trade mark registered without reference to colour was generally deemed registered for all colours, but **OHIM** is proposing to change this, even though it is settled law in some European countries. The new OHIM European Common Practice says that a B/W or greyscale mark only covers the same mark in colour if there is an insignificant difference. The scope of a B/W mark in countries in which it is deemed to cover all colours has this been narrowed, and trade mark owners who previously relied on their B/W marks covering their otherwise identical colour marks will need to be more careful – and perhaps even register more marks.

common law Legal principles covering individual rights, some of which date back to before the Norman conquest of England (1066) and based entirely on precedent. Common law is one of the major bases of the legal systems of the British Commonwealth and the USA, and it remains an influence on the interpretation of documents. See also **equity**. Unregistered marks in common law countries have substantial rights (see next entry).

common law marks Use of an unregistered trade mark in a country with common law (non-statute law, entirely reliant on precedent, countries include British Commonwealth, Ireland, USA) gives rights in the mark. A subsequent registration of the mark by another party cannot take away the rights of the common law owner, but action for **infringement** of a common law mark is more difficult than with a registered mark, and usually involves a type of **passing off action**.

In a recent US case (*Dorpan, S.L. v. Hotel Melià, Inc*, involving two hotels) travel-related and other trademarks that seek to attract physically distant customers were held to extend the reach of common law trade marks beyond the geographic area in which companies typically operate.

Community Trade Mark A **unitary trade mark** covering all member states of the European Union. Administered by the Office for Harmonization of the Internal Market (OHIM) based in Alicante, Spain.

Community Trade Mark Office Officially **OHIM**, location, Alicante, Spain. Processing authority for **Community Trade Mark** applications under the **Community Trade Mark Regulation**. Receiving, searching, examining, opposition and appeal functions are all located in Alicante.

Community Trade Mark Regulation Officially, European Union Council Regulation (EC) No. 40/94 of 20th. December, 1993, as amended by CR No. 3288/94 of 22nd. December, 1994. The law governing the registration of **Community Trade Marks**.

confusion See **deception or confusion of the public**.

consumer protection legislation Many countries now have laws protecting consumers from unscrupulous trade practices. These can be a useful addition to trade mark laws for the protection of trade marks.

Convention priority See **priority, Convention**.

court A court is the ultimate arbiter in all matters of trade mark registration and infringement. However, it is an expensive one, and therefore to be avoided, if at all possible.

Court of Justice of the European Union (CJEU) Ultimate arbiter in EUTM trade mark matters

copyright Intellectual property right covering works of literary and artistic merit – now includes design drawings, architectural plans and even perfumes. Lasts in most places throughout the life of the author and to the last day of the year 70 years from the death of the author. (In some cases, e.g. recorded music in the USA, it is longer). Under the Berne Convention, copyright automatically subsists on creation of a work, although in the USA registration (through the Library of Congress) gives some advantages. Does NOT extend to words and symbols, so no point in thinking you're going to get a free ride for your trade mark, because you're not.

customs On provision of proof from a trade mark proprietor or licensee, customs officers are entitled to raid warehouses in which falsely-marked or "grey market" goods are stored and seize them. See also **transit**.

cybersquatting The practice of registering a well-known name as a **domain name** in the expectation that the owner of the name will want it and be prepared to pay for the privilege. Developments in the law and in Internet dispute resolution have reduced its effectiveness.

deception or confusion of the public The cardinal sin of a trade mark application/registration, and one that can get it invalidated. A number of factors are involved. Here is one US Court's list of criteria in determining whether a mark is deceptive or confusing:

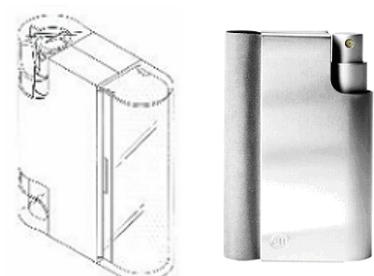
1. the strength or distinctiveness of the plaintiff's mark as actually used in the marketplace;
2. the similarity of the two marks to consumers;
3. the similarity of the goods or services that the marks identify;
4. the similarity of the facilities used by the mark holders;
5. the similarity of advertising used by the mark holders;
6. the defendant's intent;
7. actual confusion;
8. the quality of the defendant's product; and
9. the sophistication of the consuming public.

defensive registration A type of registration available in "old British" systems (and Japan) for famous trade marks whose use on any type of goods, even those not remotely connected with the proprietor, would be taken to mean involvement in or at least approval by the proprietor (e.g. "Coca-Cola" on machine tools). Such registrations were not liable for removal from the Register on the ground of **non-use**. Now largely supplanted by specific provisions covering **famous trade marks**, but still exist in Australia.

de minimis rule for surnames In some countries, rare surnames can be registrable, provided they do not appear more than a particular number of times in major local telephone directories or electoral rolls.

descriptive words As a trade mark must distinguish, it follows that a descriptive word (which another trader could legitimately wish to use) cannot be registered. However, if the word merely alludes or hints at the character or quality of the goods, it is probably registrable. See "**skilful and covert allusion**".

design, infringement of trade mark by Is this possible? Yes. In a recent case, the **General Court** held that the design on the left (for cleaning products) infringed the shape trade mark on the right (ditto)



dilution A ground of objection available to proprietors of **famous trade marks**, to prevent third parties from using the marks for goods other than those for which they are best known. For example, the Coca-Cola Company would be able to prevent a third party using COCA-COLA® on epoxy resin adhesive or machine tools, even though the Coca-Cola Company does not make such things and probably never will. It will argue that such use dilutes its reputation and goodwill in its famous mark.

The USA introduced the *Trademark Dilution Revision Act* (2006) to counter dilution. A plaintiff must show:

1. It owns a famous mark that is distinctive;
2. Use in commerce by the defendant that allegedly is diluting the famous mark;
3. similarity between the defendant's mark and the famous mark gives rise to an association between the marks; AND
4. The association is likely to impair the distinctiveness of the famous mark or likely to harm the reputation of the famous mark.

To determine whether a junior mark is likely to dilute a famous mark, courts consider all relevant factors, including:

- i. The degree of similarity between the mark or trade name and the famous mark;
- ii. The degree of inherent or acquired distinctiveness of the famous mark;
- iii. The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark;
- iv. The degree of recognition of the famous mark;
- v. Whether the user of the mark or trade name intended to create an association with the famous mark;
- vi. Any actual association between the mark or trade name and the famous mark.

A recent **CJEU** decision held that dilution had to be proved by a change in economic behaviour of the average consumer – it was not sufficient merely to show that dilution could occur.

disclaimer A statement that the applicant for trade mark registration disclaims exclusive rights to some aspect of his/her mark, for example, to descriptive matter in the mark, to a surname which forms part of the mark, etc. Frequently required in **examination**.

distinctiveness is to trade marks as novelty is to patents, the essential ingredient for registration. As a trade mark must distinguish the goods and services of the proprietor from those of other traders, it must be capable of doing this. Distinctiveness can be inherent, or it can be acquired by reason of use. In the latter case, it may have to be proved during **examination**.

It is not judged by a side-by-side comparison of the marks, but by also considering factors such as the possibility of **imperfect recollection** of mispronunciation over the telephone. One famous example is *Aristoc* and *Rysta*, both in respect of ladies' stockings, both easily distinguishable side-by-side, but not so distinguishable when seen in isolation and imperfectly recollected.

domain names Internet addresses for websites. They actually correspond to a series of numbers (called Internet Protocol numbers) that serve as routing addresses on the Internet.

The most important domain names are the global **Top Level Domain** Names (TLDs), originally .com (for commercial enterprises), .net (for Internet providers) and .org (for non-profit organisations), also .gov (US government organisations), .edu (certain educational establishments) and .int (organisations established by international treaty). Now joined by .aero (for the air transport industry), .biz (for businesses), .coop (for cooperative societies), .info (for universal application)

.name (for personal websites), .museum (you could never guess) and .pro (for professionals). Many more are expected to be registered in the coming years.

There are also country code TLDs (ccTLDs). It is possible to register a domain name both globally (e.g., "www.teemac.com") and nationally (e.g., "www.teemac.us.com"). As domain names are given on a first-come, first served basis, different companies could own these two domain names. There are now disputes procedures in place to sort out clashes and attempted piracy. See **ICANN**.

A new category is that of generic Top Level Domains (gTLDs), which allows individuals and organisations to register (very expensively) their choice of names as domain names. So, it would be possible to have, say, .ibm or .bmw or .apple or .microsoft. One does NOT have to be the owner of the equivalent trade marks to register these names, and the trade mark owners cannot block them. To counter this, ICANN has set up the **Trademark Clearinghouse**. However, there is now the **Uniform Rapid Suspension** mechanism for blatant trade mark infringement.

Enforcement Directive In full, EU Directive 2004/48/EC on the enforcement of intellectual property rights. The Directive requires all Member States to apply effective, dissuasive and proportionate remedies and penalties against those engaged in counterfeiting and piracy and so create a level playing field for right holders in the EU. It means that all Member States should have a similar set of measures, procedures and remedies available for rightholders to defend their intellectual property rights (be they copyright or related rights, trademarks, patents, designs, etc) if they are infringed.

In the recent UK case *Cartier and Others v BskyB and Others*, the question arose as to the use of the Enforcement Directive to require internet service providers to block, or at least impede, access by their subscribers to websites that advertise and sell counterfeit goods. The judge concluded that blocking orders were appropriate.

equity Ancient principles of law arising in England and encompassing principles of natural justice and fairness, and modifying the harshness of some aspects of **common law**. (If your cow strayed on to your neighbour's land, common law said it was now his cow, but equity overrode this and required him to return the cow, or reasonable compensation if the cow had already been invited to dinner). It applied to property transactions such as correction of property lines, taking possession of assets, dividing assets, or injunctive relief, and so it impinges on **intellectual property** law. The principles still exist in common law countries (UK, Ireland, British Commonwealth, USA).

In general, the terms "law" and "equity" have almost completely merged, as courts deal with both legal and equitable issues, but certain aspects of equity often remain (e.g., no jury in equity cases – the USA can be an exception here). An important principle is that a person comes to equity "with clean hands".

EU trade mark See **European Union Trade Mark**

Eurasian trade mark Proposed new trade mark system covering the members of the Eurasian Economic Union (Russia, Armenia, Belarus, Kazakhstan, Kyrgyzstan) a free-trade union similar to the EU. It is proposed that there be no centralised trade marks office and no basic registration *à la Madrid*, but that the application may be filed in any Member State trade mark office. Language will be Russian and a short registration period (6 months) is envisaged. Possibly in force in 2020. Potentially interesting to any country filing trade marks in Cyrillic characters.

European Court of Justice (ECJ) Now Court of Justice of the European Union

European Union trade mark (formerly **Community Trade Mark**). A **unitary trade mark** covering all member states of the European Union. Administered by the **European Union Intellectual Property Office** (formerly Office for Harmonization of the Internal Market (OHIM)) based in Alicante, Spain.

European Union Intellectual Property Office See previous entry. Also responsible for the examining of Community designs.

evidence of acquired distinctiveness A mark may be inherently distinctive, or it may become distinctive by reason of considerable use and acquired reputation. To prove this distinctiveness, it may be necessary to produce evidence, often in the form of questionnaires filled in by members of the public. In some cases, no amount of evidence will suffice (LIVERPOOL cables were renowned throughout the industry, and the name was distinctiveness, but the primary geographical significance of the name was overwhelming).

A former employer of mine was the agent for the US company Foster, the name in insulation coatings, but enormous evidence of distinctiveness had to be provided to overcome the fact that FOSTER is a common surname.

Evidence becomes critically important if the mark is an unusual one, e.g., a shape, smell, sound or touch trade mark.

examination Official procedure carried out by Trade Marks Offices to ascertain whether a trade mark application is entitled to be registered. Standards and criteria vary enormously from country to country.

exhaustion of rights The right to exercise trade mark rights ends with the sale to the final purchaser of the goods or services – if that purchaser sells it on to someone else, it is not considered “use in the course of trade”. However, this does not work in the case of **parallel importation**, as most countries consider exhaustion of rights on a national basis, i.e., buying branded goods legitimately in one country and importing them into a second country outside the normal distribution chain of the trade mark proprietor constitutes infringement. Some countries have international exhaustion of rights, i.e., putting goods on the market anywhere in the world exhausts the right in the mark.

fair use A concept more usually associated with copyright (e.g. to allow limited copying of printed works for educational purposes). In the case of US trade marks in particular, it is associated with First Amendment rights of free speech and the right to use a trade mark to compare, criticise or parody, without being stopped by the trade mark owner for trade mark infringement. Naturally, it is not permitted to cross the boundary into defamation or insult.

famous trade marks Trade marks which are so well known that use in connection with any goods would be taken to mean involvement in or at least approval by the proprietor (e.g. “Coca-Cola” on machine tools). Many countries now have legislation to protect such marks.

first-sale doctrine US legal concept in trade mark and copyright law, which allows an individual purchaser to sell his or her legitimately-acquired article to a third party without there being any infringement of copyright or trade mark laws. Recently seen in the US trade mark case *Costco v. Omega*, where the Swiss watch maker was not allowed to invoke the trade mark rights in its logo to prevent Costco from selling discounted Omega watches.

first to register The system of **priority** which applies to most of the world - the first registrant has the right to the mark.

first to use The system of **priority** which applies mainly to countries with a common law. First user has the right to the mark. This does not stop someone else from registering the mark, but it may prevent the registrant from using it.

forbidden marks Most countries forbid registration of marks whose content is scandalous or improper. In addition, certain symbols cannot be registered, e.g., national flags, symbols of international organisations, such as the Red Cross/Crescent, the Olympic emblem, etc. Many countries have specific prohibitions, e.g. the Royal Family in the UK and the chrysanthemum crest in Japan.

In the USA, some recent case law has confirmed the supremacy of the US Constitution's First Amendment right to free speech over the **Lanham Act's** prohibition of obscene or scandalous marks. First, there was the Supreme Court case of *Matal v. Tam* in which the Supreme Court said that THE SLANTS (in respect of a Chinese-American rock band) could not be denied registration because "slant" was a derogatory term for a person of Oriental origin. This was emphasised when the **CAFC** said that FUCT in respect of clothing could not be denied because it looked like That Other Word. More to come on this one, I think

function A relevant consideration in **shape trade marks**. Functional shapes are regarded as unregistrable. Where does functionality end and registrable distinctiveness begin? It depends on the circumstances of the case.

General Court Division of the **CJEU** which hears, among other things, appeals from decisions by **OHIM**.

generic use Sometimes referred to as "genericide". What happens to trade marks when they become so well known and the owner does not take sufficient care to see that an alternative descriptive word is provided, so that the mark effectively passes into the language. The result may be a loss of the mark. The English language is full of them (gramophone, escalator, pyrex, linoleum). See also **dilution**.

geographical indications There have been several ways of protecting the names of regional agricultural specialties and foodstuffs, starting with **certification trade marks** under the old British system. Geographical indications are now universally recognised. These are not trade marks, but are guarantees that products thus designated comply with certain geographical standards. The best known are the *appellations d'origine* of French wines. More recently, they have included "Darjeeling" for tea (the quantity of tea sold as "Darjeeling" far outweighs the quantity actually grown in the Darjeeling region). The **EU** has three schemes, the **protected designation of origin** (PDO), the **protected geographical indication** (PGI) and the **traditional specialty guaranteed** (TSG).

geographical names If the primary significance of a word is geographical, it is almost impossible to register it. There are exceptions (e.g., NORTH POLE for bananas).

goods in transit – infringement? See **transit – infringement?**

"goods of the same description" Goods having the same or a similar mark as those of a trade mark applicant, which are not the same as the goods of a trade mark applicant, but which are sold through the same trade outlets to the same group of customers. Can be a basis for objection during **examination** in some countries.

goodwill An essential, but also difficult to quantify, component of all trade marks. Once defined as “the magnet that attracts custom”, one of the purposes of having a trade mark is to accumulate goodwill in it, so that satisfied customers will buy the same again, and even consider buying different goods bearing the same brand, as they previously have been happy. One only has to look at the willingness of folk to buy stuff with this



or this



or this



appended to them, to realise the

value of goodwill.

Goodwill often forms an important part of trade mark **assignments** and a monetary value placed on it.

Recent decisions in common law countries have indicated a divergence of opinion as to whether reputation alone is sufficient to establish goodwill, or whether actual customers in the country were necessary. The Australian Federal Court in *ConAgra Inc v McCain Foods (Aust) Pty Ltd* held that, in the age of the Internet, reputation alone could be sufficient. However, the UK Supreme Court, in *Starbucks (HK) Limited v British Sky Broadcasting Group plc* (a **passing off** action relating to a Hong Kong-based pay TV channel known - but unavailable - in the UK), did not accept this.

gTLD see **domain name**.

“grey market goods” see **parallel importation**.

guarantee trade mark A Swiss equivalent of a **certification trade mark**.

Gulf Cooperation Council (GCC) Alliance of Arab monarchies (Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and the United Arab Emirates) around the Arabian/Persian Gulf. After much consideration, a unified trade marks law covering all states appears about to come into force. It will not be a single supranational mark, like the **EUTM**; individual applications will still be required in each state for coverage.

honest concurrent user It is possible that two trade marks that would otherwise be regarded as being deceptively similar could both be permitted to be used if the use was a long one, no deception was intended and there was no blameworthy conduct on the part of either proprietor. A major case was the *GE* case in the UK, involving the US GE company and the English GEC company:



More recently, it was central in the long running war over the trade mark **BUDWEISER**, between Budějovický Budvar, národní podnik and Anheuser-Busch, Inc. (I could say that, as a result, everyone is sadder Budweiser, but of course I won't...)

ICANN The Internet Corporation for Assigned Names and Numbers (website, www.icann.org). ICANN is specifically responsible for the registration of **Top Level Domains**, and has resolution procedures for handling disputes.

imperfect recollection One of the great standard tests for **distinctiveness** in a trade mark. Distinctiveness is not judged by a side-by-side comparison of the relevant marks, but by seeing the marks in isolation, the later sighting with the sometimes vague memory of the former. A good

example is the old Australian case of *Jafferjee v. Scarlett*, in which one trader had a mark with two runners, the other with two javelin throwers. The judge found this confusing, saying that the public would tend only to remember “the one with the two men on it”.

infringement The use without permission of a trade mark that is identical or deceptively similar to a registered trade mark. A variety of legal remedies is available (injunction, seizure of goods bearing infringing marks, damages).

INN See **International Nonproprietary Name**

International Bureau Part of **WIPO** which deals with the **International (Madrid) Registration System**.

International (Nice) Classification (The French town, not its attractiveness). The most commonly-encountered **classification** system for goods and services. Consists of 34 goods and 11 services classes. See Appendix 2.

International Nonproprietary Name (INN). Names free for use by everyone as generic names for pharmaceutical ingredients. They are allocated by the World Health Organisation, which keeps a list. A similar list of names, maintained by the International Standards Organisation, exists for agrochemicals.

International Registration See **Madrid System**.

IP Translator aka Case C-307/10 *Chartered Institute of Patent Attorneys* of the **CJEU**. A case seeking to resolve (and not really succeeding) the question of whether the use of the class headings of the **Nice Classification** (those are they in Appendix 2) to define the goods or services in an application covers all goods or services in the class. For example, Class 15, class heading “musical instruments” also includes music stands – but does it? The moral of the story appears to be to apply for those goods and services which you actually want or which you might reasonably want in the future.

Part of the problem lay with **OHIM**’s policy of putting in the entire alphabetical list of goods or services for the particular class (it goes on forever) if the option of all goods or services in the class was selected. This practice has now changed. The class headings as well as the alphabetical list of the goods and services of the Nice Classification in the respective class will be published as part of the application, if the applicant declares all goods/services of the respective class to be part of the application. To make the application easier **OHIM** has implemented a tool into its e-filing system that allows all class headings and all goods and services of the respective class to be included in the list of goods and services by just clicking a box.

Lanham Act US federal legislation covering trade marks. It is still possible in the US to file individual **state trade mark** applications, but this is relatively rare. Only US federally-registered trade marks have the right to use the ® symbol.

Latin A dead language, which, instead of being allowed to rest in its grave with dignity, is frequently disinterred in some odd fields of human endeavour, examples being the Swiss school system, medicine and the law, presumably as a way for some folk to show that they’re **so** much cleverer than you are. Thankfully, in patent law, it is relatively rare, but it does occur. Some odd examples of this oddity:

a fortiori – “from the stronger”. Denotes proof of a claim by reference to an already decided stronger claim.

a priori – “from what is before”. Deductive reasoning (proceeding from causes to effects).

ab initio - “from the beginning”. A revoked patent is revoked *ab initio*, that is, there was never any time at which it was valid (i.e., it was not valid up to the point at which it was held invalid).

amicus curiae – “friend of the court”. Normally given to a legal brief on a point of law not from a participant in the proceedings. Such briefs are often invited on contentious matters from third parties.

certiorari – “to be searched”. Writ seeking the legal review of the judgement of a lower court by a higher court.

ex nunc – “from now”. Something that has effect for the future and is not retroactive. For example, the amendment of a patent application is valid only from the time that it is made.

ex parte – “from one party”. Legal proceedings brought by one party and without reference to any other parties.

ex post facto – “after the fact”. Often, with hindsight. *Ex post facto* analysis by patent offices is forbidden.

ex tunc – “from then”. Something that has retroactive effect. A document corrected *ex tunc* is deemed always to have been in this corrected state.

in re – “in the matter of”. Generally refers to a case which is not contested by third parties.

inter partes – “between parties”. Legal proceedings, in which a third party has the right to make observations or otherwise intervene or be involved (e.g., opposition and infringement proceedings).

ipso facto – “by the deed itself”. Often used to say that something that is contrary to law is automatically void.

locus standi – “place of standing”. A right to be heard by a court in a legal matter. There are certain matters in patent law where only persons with a specific interest have the right to be heard.

mandamus – “we command”. A common law writ from a higher court to a lower court or government officer requiring him/her/it to perform an action that he/she/it is required by law to do.

mens rea (state of mind) Consideration as to what was in the mind of the accused.

mutatis mutandis – “changes changed”. Often seen in relation to articles of a law, which are to be applied with any necessary changes with respect to a known article and known set of changes.

obiter dictum – “said by the way”. A remark made in a judgement that is not central to the judgement, and that is therefore not legally binding.

ratio decidendi – “the reason for the decision”. ←What he said.

sui generis – “of its own kind”. In IP matters, it refers to subjects meriting protection, but that do not fit into the usual categories. Examples include protection for integrated circuits and databases.

letters Small groups of letters are generally not registrable as a trade mark, without considerable evidence of use, but it is not impossible (IBM, BMW).

licensing The permitting another party to use your trade mark, under specified conditions and usually for financial return.

Madrid Agreement 1891 International Treaty which provides for the obtaining of a number of trade mark registrations based on a prior registration in a home country.

Madrid Protocol 1989 International Treaty which provides for the obtaining of a number of trade mark registrations based on a prior application in a home country. This change allowed countries with stringent **examination** systems (UK, Nordic countries) to join the Madrid system. Now includes many major countries and systems such as the USA and **OHIM**.

Madrid System Mechanism for filing a single trade mark application and obtaining registrations in a number of countries. Consists of two parallel Agreements, the **Madrid Agreement** and the **Madrid Protocol**, with a common set of regulations. Language for International applications filed under the Agreement alone is French, language for Protocol alone or Agreement + Protocol is French or English.

mandamus See **writ**. Also **Latin**

Mareva injunction British law injunction freezing a respondent's assets, stopping them from being dissipated. Often used in combination with an **Anton Piller order**.

marking A registered trade mark should be indicated as registered in some suitable way, e.g., by the ® symbol, by "reg'd" or by some mark such as an asterisk (*) and a legend somewhere to the effect "* registered trade mark". A mark which is not registered **must never, EVER** be indicated as registered. Here it is appropriate to use the TM symbol. So, PONGO®, but TRADEMARK™.

metatag A keyword, invisible to the user, used to describe the contents of a website, so that Internet search engines can find the website. Inclusion of a competitor's trade mark as a metatag (in one notorious case, in the heading in the same colour as the heading) in an attempt to lure prospective customers there has been held to constitute both trade mark infringement and passing off in the UK.

national flags See **prohibited marks**

Nice Classification See **International (Nice) Classification**

non-use A mark can be removed from the Register for non-use. This can come about in two main ways (a) the proprietor of the mark fails to enter an affidavit of use in time in those countries which demand one periodically (e.g., USA, Canada), or (b) a third party takes action against the proprietor after a period of non-use (3 and 5 years are common periods).

noun, use of trade mark as One of the greatest of trade mark sins. Persons doing it should be rapped hard over the knuckles. See **adjective, verb**.

numbers Generally difficult to register alone, but with suitable evidence, not impossible ("4711").

OAPI See **Organisation Africaine de la Propriété Intellectuelle**

obscene marks See **scandalous or improper matter**

Office for Harmonization in the Internal Market (OHIM) See **European Union Intellectual Property Office**.

OHIM See previous entry.

Olympic symbols see **prohibited marks**

ONEL v. OMEL In full, *Leno Merken v Hagelkruis Beheer B.V.* It posed the question as to whether use in a single **EUTM** Contracting State constitutes sufficient use for continued registration. (An Austrian court previously held that use in Austria alone constituted sufficient use). The **CJEU** decided that it depends on the individual market and circumstances, and that there could be circumstances in which use in a single state constituted sufficient use, and others where it wouldn't. In other words, back to the court that asked the question in the first place.

opposition Action before a Trade Marks Office by a third party to stop the registration of a trade mark advertised as allowed or registered.

Organisation Africaine de la Propriété Intellectuelle (OAPI) IP Office (headquarters, Yaoundé, Cameroon) for a grouping of mainly Francophone African states (Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoro Islands, Congo, Equatorial Guinea, Gabon, Guinea-

Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo). Grants **unitary trade mark** and patent rights.

parallel importation The import into a country of authentic goods legitimately bought outside the country by a third party, without going through the trade mark owner's own distribution network (often at considerably reduced prices). These goods are sometimes known as "grey market goods". Customers love it, trade mark owners hate it and want it stopped. At the time of writing, the owners appear to be winning.

Paris Convention 1883 International Treaty which covers international aspects of patents, trade marks and designs. Basic principle; foreign applicants should not be disadvantaged in comparison with domestic applicants. Enshrines the right of **Convention priority**.

parody A close copy of a famous trade mark, generally for the purposes of entertainment and criticism, but also for profit. It has become more common to produce such parodies and their brand images. Infringement? It depends on the circumstances. As many parodies are so obviously and deliberately NOT the famous mark (for example, the one that replaced the "ar" letters of "Cartier" with two others, to produce something much, much cruder), there is no deception or confusion, even when the Cartier script style is used. However, if the parody designer is clearly making a profit by riding on the coat-tails of the originator (and dragging down its reputation at the same time), it may be actionable.

US law has a broad acceptance of parody use as "fair use", based on the Constitutional right to free speech. In a recent US case, Louis Vuitton failed to have this tote bag (right) by My Other Bag that carries a reproduction of a Louis Vuitton bag declared an infringement. Louis Vuitton may appeal.



The situation in other jurisdictions is not so clear, but the new EU trade marks legislation has moved to give more room for parody use. Exactly how much room is not known.

Part of Register In old British practice, the Trade Marks **Register** was divided into four parts. These were:

Part A – inherently distinctive trade marks

Part B – marks initially not so distinctive of the proprietor as those of Part A, but which had become distinctive, for example, by means of extensive use.

Part C – **certification** trade marks

Part D – **defensive** trade marks

passing off Action at **common law** to restrain person A from damaging the business or reputation of person B by "passing off" A's goods (or services) as those of B. Requires proof that (a) B actually had a reputation in the goods, (b) that A has made a misrepresentation that A's goods are B's and (c) that the action by A has caused or is likely to cause damage to the goodwill of B. Flexible and adaptable, but can be difficult and expensive. Nevertheless, such actions do occur in common law countries to this day. Recently, the UK Supreme Court, in *Starbucks (HK) Limited v British Sky Broadcasting Group plc* (relating to a Hong Kong-based pay TV channel known - but unavailable - in the UK), held that, for passing off, there had to be customers in the jurisdiction – reputation alone was not sufficient.

perfume Generally unregistrable – see **smells**.

personality rights see **right of publicity**

phishing Attempting to acquire information by masquerading as a trustworthy entity in an electronic communication. Users are often lured to websites that look like legitimate ones. It often involves the hijacking of reputable brands.

pictorial elements in word mark Can add distinctiveness, but not always. Such elements are often common to a particular trade, and therefore can be difficult to distinguish, especially given **imperfect recollection**. For example, Scotch whiskies often include heraldic elements, and one such element can look similar to another. This means that similar word marks may not be saved by similar-looking pictorial elements.

plain packaging This has been suggested for some products as a means of making harmful products, such as cigarettes, less attractive. This was first mooted in Australia, and a challenge to the legislation by the tobacco industry was rejected by the Australian High Court. The manufacturers will be able to put their brands on the packets, but only as words on a label dominated by gruesome photos of tobacco damage – the fancier get-up and colours to which we're used will be history. Several other countries are contemplating such measures, and the practice may spread to other industries, e.g. pharmaceuticals and food.

position trade marks The placing of some element on goods in a particular position. Examples of successful registrations include the tags on Levi's jeans and the red soles of Christian Louboutin shoes. Failures include the studs and/or tags in the ears of Steif teddy bears. The general principle seems to be that substantial evidence of **acquired distinctiveness** is needed for success

priority Property in a trade mark belongs to whoever got there first. "Whoever got there first" is determined differently in different parts of the world - some countries are **first to register**, others are **first to use**. In the first-to-register case, **Convention priority** can be claimed.

priority, Convention Under the **Paris Convention**, a trade mark applicant in a Convention country can have his/her date of application recognised in another Convention country, provided s/he applies within six months of that date. Convention priority must be formally claimed on application and a certified copy of the home application provided.

prohibited mark The use of certain words and symbols is off-limits. These can be on a national or an international basis. For example, representations of UK Royalty cannot be used in the UK, and in Japan the Chrysanthemum crest cannot be used. Examples of internationally-banned symbols include national flags, the Red Cross and Red Crescent emblems, the emblems of the Olympic movement (including the rings) and the emblems of the United Nations and its various specialised organisations (ILO, UNESCO, WHO, WIPO, etc.).



protected designation of origin (PDO) EU designation that covers agricultural products and foodstuffs, which are produced, processed and prepared in a given geographical area using recognised know-how. The EU logo (UK version) is on the right.



protected geographical status (PGS) Under EU law, the ability to restrict the use of the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff (a) originating in that region, specific place or country, (b) which possesses a specific quality, reputation or other characteristics attributable to that geographical origin, and (c) the production and/or processing and/or preparation of which take place in the defined geographical area. It is less restrictive than the PDO (previous entry).



public What exactly constitutes “the public” from a trade marks **distinctiveness** point of view depends on the nature of the market. The “public” in respect of laundry detergent or other common supermarket items is very different from “the public” in respect of industrial chemicals or automated machinery the size of the average house. The latter “public” is deemed to be much more knowledgeable and therefore much less easily confused than the former “public”, and therefore marks that are apparently much closer can often be tolerated.

This is true also of the general public. In an old UK case, NEOLA and PIANOLA, both for pianos, were held distinctive, because the purchase of an expensive instrument was not a casual daily transaction, and it would be made by educated persons who would take their time and study what was available prior to purchase.

right of publicity (sometimes called personality rights) The rights of individuals, especially those in the public eye, to prohibit misuse of their images in connection with commercial activities in which they are not involved, and to which they have not given permission. This issue has exploded with the increase in use of digital technology. It can continue after death (e.g., a recent case in which General Motors was taken to court by the Hebrew University of Jerusalem because of the former’s use of the image of Albert Einstein, the latter being the inheritor of Einstein’s literary rights and property). However, it is not governed by either trade mark or copyright laws, and there is no official expiry date (although some US states use the old copyright term of 50 years from the date of death).. In the USA, in which the whole business has taken off on a large scale, it is largely governed by **common law** and may be the subject of a **passing off action**. However, the various US states have their own interpretations.

It is generally considered to consist of two types of rights: the right of publicity, or to keep one's image and likeness from being commercially exploited without permission or contractual compensation, which is similar to the use of a trade mark; and the right to privacy, or the right to be left alone and not have one's personality represented publicly without permission.

It works differently in civil law jurisdictions, e.g. Germany, where the right is written into the law. Curiously, the world's only registrable personality and image rights legislation has been enacted in Guernsey (Channel Islands).

® This symbol has legal significance in only a few countries, e.g., the USA (for federal registrations, not state registrations) and Sweden, but it is now universally accepted as an indication of registration.

Register The official national record of registered trade marks. Registers contain all relevant details, including assignments and transfers.

registered trade mark A **trade mark** which has been registered with a Trade Marks Office.

registered user Old British-type law provision which still exists in some Commonwealth countries (e.g. India, Singapore, Hong Kong). The proprietor and the user entered into an agreement, whereby the user undertook to maintain quality standards of goods or services. Use by a registered user was considered use by the proprietor, and the mark could not be removed for **non-use**.

registration Official procedure whereby a **trade mark** is formally entered on to a Trade Marks Register and a certificate to that effect issued. From the date of registration, the proprietor of the trade mark has property in the mark and can sell or assign it. S/he can also take action against infringers. In most countries, registration is taken as *prima facie* evidence of **distinctiveness**.

relative grounds for refusal of trade mark registration application That there exist registered trade marks that are identical or similar in respect of goods or services that are identical or similar. See also **absolute grounds**.

renewal Trade marks must be renewed periodically. This is typically done every 10 years. A renewal fee is payable. In most countries, it is possible to pay this up to 6 months late, with payment of a supplementary fee. In some countries, in order to renew a registration, it must be shown that the trade mark has been used.

saisie-contrefaçon See **Anton Piller order**.

scandalous or improper matter Generally not registrable. JESUS was once refused registration because of its potential to offend a substantial number of people. More recently, we have had the COCKSUCKER refusal in the USA (in respect of a chocolate lollipop/popsickle in the shape of the cock mascot of a US football team). And more recently still, there has been the enduring affair of the name of the Washington Redskins (American) football team and whether it had become disparaging of a particular ethnic group. The **TTAB** ordered the marks concerned removed from the Register. The owners have appealed. Political correctness gone mad or long-overdue recognition of a racial slight of the continent's original inhabitants?



*feather in cap
of TTAB?*

A US Supreme Court decision held that the USPTO refusal of THE SLANTS for a Chinese-American rock band ("slant" is a derogatory name for Asians) was a violation of the First Amendment right to free speech and this superseded the Lanham Act's prohibition on scandalous or improper marks. More recently, it has said that FUCT in respect of clothing cannot be disallowed for the same reason. It may mean that skins may again be red and, er, poultry dissolved in the mouth.

search and seizure order A court order that allows a trade mark proprietor to raid the premises of an alleged infringer to seize incriminating evidence of **infringement** before the alleged infringer can dispose of it. The British law variety is known as an *Anton Piller* order, after a famous case. Generally only granted on presentation of a *prima facie* case of infringement. Refusal to comply may be considered a serious contempt of court.

seniority A concept in the **EU Trade Mark** system, not to be confused with **priority**. The owner of an earlier trade mark in an EU Contracting State can claim seniority in that earlier mark, provided (a) the EUTM is filed in the same name as the earlier mark, (b) the trade marks are identical, and (c) the goods and services of the EUTM are identical to, or lie within, those of the earlier mark. The national mark may be allowed to lapse, but the right will live on in the EUTM.

services, bringing together other people's for comparison and selection Such a service is registrable as a trade mark. The application of Netto Marken-Discount for such a registration had been refused by the German Trade Marks Office, but this was overruled by the **CJEU**.

services marks It is now possible to register a trade mark in respect of services nearly everywhere.

shapes These are now registrable in most countries. However, not all shapes are registrable – those which are purely functional (for example, a chocolate bar with moulded grooves to allow easy breakage) are unlikely to be registrable. In this regard, UK High Court judgement on the Cadbury v. Nestlé case over the latter's attempt to register the shape of the KitKat bar is awaited. Cadbury said it was functional, Nestlé said it was distinctive. The **CJEU** ruling succeeded in giving encouragement and discouragement in equal measure to both parties.

Singapore Treaty In full, the Singapore Treaty on the Law of Trademarks. 2006 Treaty that entered into force in 2009. It establishes common standards of trade mark registration and licensing. 32 current members.

”skilful and covert allusion” Old British phrase from a famous House of Lords case ((”Solio”) *Eastman Photographic Chemicals v. Comptroller*), indicating the permitted degree of descriptiveness of a trade mark. Standards of non-descriptiveness are not so high nowadays.

Sleekcraft test Test devised by the US **CAFC** to judge likelihood of confusion between two marks. The elements are:

- Strength of the mark
- Proximity of the goods
- Similarity of the marks
- Evidence of actual confusion
- Marketing channels used
- Type of goods and the degree of care likely to be exercised by the purchaser
- Defendant’s intent in selecting the mark
- Likelihood of expansion of the product lines

There are other variants of the test, such as the *Polaroid* Factors and the *DuPont* Factors.

smells These are now registrable in most countries. However, perfumes have been held as unregistrable as (a) being the essence of the goods and not a distinguishing mark thereof, and (b) having different effects on different people, and therefore not being characteristic of the character or quality of the goods and unable to act as a unique indication of source.

sounds These are now registrable in most countries.

state trade mark It is possible in the USA to register a trade mark in an individual state. The requirements are less onerous, but the benefits are also less, the major drawback being a prohibition of use of the ® symbol, which is reserved for US federal registrations.

store layout Registrable as a trade mark? Yes, provided it is capable of distinguishing the services of the applicant. The best known example is that of Apple stores. In a recent decision *Apple v. DPMA*, the **CJEU** ruled against the German Trade Marks Office’s refusal of the application.

“sucks” sites Internet sites existing for the purpose of criticising a company or organisation by using its name or its trade mark as an Internet address with “sucks” [US slang for “is contemptible or disgusting”] attached to it, i.e., people who have problems with Company X register “Xsucks.com” for a site that can act as a focus for others with similar issues with X. Attempts by the trade mark owners to counter on the grounds of misuse of trade marks have generally failed on the ground that there is no deception or confusion involved between the official site and the “sucks” site – it is usually completely clear which one is which. However, crossing the line from parody or legitimate protest into the defamatory or the purely insulting may bring problems.

“Sunrise period” See **Trademark Clearinghouse**

surnames Surnames are difficult to register in most countries (impossible in some). In those where it is allowed, considerable evidence of use is generally needed. When a trade mark contains a surname, a **disclaimer** to the use of the name *per se* is usually required.

survey evidence Often needed in the case of trade marks that have allegedly become distinctive by reason of use to show that this is indeed the case. The surveys need to be drawn up with great care, otherwise a court may reject them as worthless.

tactile marks The registration of how something feels. These are now registrable in most countries.

temporary importation on, e.g., a ship or an aircraft of a country where the mark is legitimately used into another country where it technically constitutes an infringement is permitted.

text, use of trade marks in The proper way to do this is to (a) ensure that the special status of the mark is made clear by (a) making it stand out from the surrounding text every time it appears, and (b) indicating its registered or trade mark status, e.g., by using ® or ™.

TLD see **Top Level Domain**

™ In many countries, this against a mark is taken to signify only that the mark belongs to someone, not that it is officially registered. While this is true of many countries, it is not universally true. In some countries, e.g., France and Germany, it may be regarded as equivalent to ®, and if the mark is not in fact registered, its use may be regarded as misleading advertising. Therefore, to be used with caution. In such cases, it may be better to put an asterisk against the mark at its first appearance and qualify it as “* trade mark of...”.

TMCH see **Trademark Clearinghouse**

Top Level Domain An Internet domain name is part of the address or URL (Uniform Resource Locator) of a web page. In a typical web address, **www.teemacs.com**, the “www” is the name of the host, the “teemacs” is the second level of the name identifying the entity using the address and the “com” is the so-called top level. The TLD often signifies the type of organisation, so the best known **.com** (“dot com”) signifies a commercial organisation. See also under **domain name**.

trade dress The overall visual appearance of a product or its packaging. Use of similar trade dress, even with completely different trade marks, is considered deceptive. It has statutory protection in the USA under the **Lanham Act**, in the UK it falls under **passing off**.

trade mark A distinguishing mark which is capable of indicating a connection in the course of trade with a particular trader and to distinguish his/her goods and services from those of other traders.

“Trade mark” or trademark”? You say “po-tay-to”, I say “po-tah-to”... The single word variant is the common US usage, and has become widespread among countries whose first language is not English. The British/Commonwealth usage is “trade mark”. However, the two may be regarded as interchangeable, so let’s call the whole thing off.

Trademark Clearinghouse (TMCH) A database of trade marks administered by **ICANN** to protect trade mark owners as the number of **gTLDs** rises (there soon could be hundreds). TMCH, which commenced operations on 26 March 2013, allows trade mark owners to submit their trademark data into this database, prior to and during the launch of new **gTLDs**. After verification, the trademark holder has fulfilled the basic (most important) condition to be able to register its corresponding domain name during the pre-registration period of multiple **gTLDs** (called the “Sunrise Period”). Trade mark holders will also have the option to be notified when someone registers a domain name that matches their record in TMCH.

Trademark Law Treaty Treaty whose signatories have agreed to standardise procedural aspects of the trade mark application process. Current (Aug.2014) membership, 53 states.

Trademark Modernization Act (TMA) US legislation modifying the US Trademark (**Lanham**) Act, due to come fully into force in December 2021. It seeks to provide mechanisms to prevent bogus US registrations. These include giving the USPTO the authority to shorten deadlines and providing new cancellation proceedings for unused trade marks.

trade practices legislation See **consumer protection legislation**.

Traditional Specialty Guaranteed (TSG) A designation for a foodstuff as a traditional specialty under EU Council Regulation 509/2006. It covers products made from traditional raw materials and/or characterised by a traditional composition or method of processing. Application for TSG status may be made by a group of processors or producers. A register of TSGs is maintained by the EU Commission. An example of a TSG is “single Gloucester” for cheese or “Orkney beef” for, er, Orkney beef.



transit – infringement? Is it allowable to transport falsely-marked goods across a country in which they would constitute an infringement to a final destination in which they wouldn't? Such goods are apparently immune to customs seizure. However, new **EU** legislation will forbid the practice.

TTAB Trademarks Trials and Appeal Board, the **USPTO** Board that hears trade marks cases.

UDRP The Uniform Dispute Resolution Policy of **ICANN**, for settling disputes over **domain name** ownership.

Uniform Rapid Suspension Rights protection mechanism for new **gTLDs** intended to facilitate the rapid suspension of domain names in clear-cut cases of trademark infringement. In the first case, Facebook was able to stop “.facebok.pw”.

unitary trade mark Trade mark registration that covers a number of states. The original one was the **Benelux** registration – it is not possible to obtain a separate Dutch, Belgian or Luxembourgish trade mark registration. Another example is the **OAPI** mark. The **Community Trade Mark** covering the EU countries is a unitary registration, but most of the EU member states have retained national trade mark laws.

use A registered trade mark must be used. Failure to use can lead to the loss of the registration. See next item. In some countries, e.g., USA, use in the course of trade must be proven, e.g., by submitting a label, between 5th and 6th anniversaries after registration, and again at renewal.

use requirements to avoid removal for non-use These vary considerably throughout the world. Generally a mark becomes liable for removal by action by a third party if it has not been used for a period of time (3 and 5 years are common periods). In some countries, statements or affidavits of use must be provided at regular intervals (typically every 5 years).

verb, use of a trade mark as (“You should pongo your soup mix”). The eighth deadly sin. It must **NEVER** occur. Persons doing it to be taken out and immediately shot. See **adjective**.

Vienna Classification aka the International Classification of the Figurative Elements of Marks is a classification that seeks to bring uniformity to the description of non-word marks. It may be found here:

<http://www.wipo.int/classifications/nivilo/vienna/index.htm?lang=EN>

Although only 32 countries have ratified it, it is more widely used.

WIPO (World Intellectual Property Organisation) Geneva-based UN agency which deals with all intellectual property matters (patents, trade marks, designs, copyright, plant variety rights, etc.). It is the custodian of the **Paris Convention**. Its **International Bureau** is responsible for the PCT patents treaty and the **Madrid System** for the International Registration of trade marks. Its Arbitration and Mediation Service can hear **domain name** ownership disputes on behalf of **ICANN**.

writ. Old term for an official order under English **common law**, directing the behavior of another arm of government, such as an agency, official, or other court. The two most commonly encountered in the world of intellectual property are:

certiorari - a court process to seek judicial review of a decision of a lower court or administrative agency.

mandamus – an order issued by a higher court to compel or to direct a lower court or a government officer to perform mandatory duties correctly

APPENDIX 1

CHOOSING A GOOD TRADE MARK

1. The cardinal rule of a good trade mark is that it **must be distinctive**. That is, it must be capable of distinguishing the goods or services of the proprietor from the same or similar goods and services of competitors. This requirement rules out anything that other traders might reasonably wish to use, without improper motives. Therefore, **things to be avoided** include:
 - Words that are in any way **descriptive of the character or quality of the goods and services**.
 - **Surnames** – people have the right to the use of their surnames. In many places, rare surnames are registrable (as evidenced, for example, by their rarity in the 'phone book or electoral roll), but this is not universal.
 - **Geographical names** – these can be descriptive or misdescriptive. Fanciful uses are usually OK (e.g. *North Pole* for bananas).
 - **Small groups of letters** – the smaller they are, the harder to register. It can be done, but requires massive evidence of distinctiveness.
 - **Numbers** – only in rare cases (e.g., *4711*) are they registrable. Again massive evidence of distinctiveness may be required.
2. Next thing – your mark **must not be deceptively similar to anyone else's trade mark** in respect of the same or similar goods and services. The greatest offence that a trade mark can commit is causing deception or confusion to the public. Trade marks offices are primarily custodians of the public interest, and those who examine trade mark applications will not allow the registration of such marks.

How similar is “deceptively similar”? This depends on a whole battery of factors, including the nature of the “public” for the goods and services. The public for tunnel boring machines costing millions is not the same as the public for dishwashing liquid – the former is deemed to be much more knowledgeable, and therefore less likely to be confused by a similar name than is the latter.

Similarity should not be judged by a side-by-side comparison. You should consider mispronunciation over the telephone or imperfect recollection. In a famous old case, RYSTA was refused in the light of the previously-existing ARISTOC.

This applies also to logos and pictorial representations. In the old Australian case *Jafferjee v. Scarlett*, a logo showing two runners breasting a tape was held to be deceptively similar to a logo with two javelin throwers, both in respect of flour – the judge said that the average person would remember only “the package with the two men on it”.

How similar do the goods and services have to be to be problematic? The old British law term was “goods and services of the same description”, which meant goods and services sold to the same customers through the same trade outlets. Thus, in an old Australian case, *Southern Cross* for refrigerators was deemed deceptively similar to *Southern Cross* for artesian windmills, because both were sold side by side in country stores. So, if you sell PLONKO hand tools and Trader X sells PLONKO cabinet fittings, available several aisles further down in the same hardware store, will a person, who was very happy with his cabinet fittings and in the market for hand tools, assume that X has moved into hand tools and buy yours, based on a reputation that is not yours? This should be avoided.

Your trade mark attorney can advise you on these matters and conduct the necessary searches to make sure that no unpleasant surprises await you.

APPENDIX 2

The International (Nice) Classification of goods and services (10 Ed.)

<https://www.wipo.int/classifications/nice/nclpub/en/fr/>

GOODS

- Class 1** Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
- Class 2** Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
- Class 3** Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
- Class 4** Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
- Class 5** Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
- Class 6** Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
- Class 7** Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs; automatic vending machines.
- Class 8** Hand tools and implements (hand-operated); cutlery; side arms; razors.
- Class 9** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus.
- Class 10** Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
- Class 11** Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
- Class 12** Vehicles; apparatus for locomotion by land, air or water.
- Class 13** Firearms; ammunition and projectiles; explosives; fireworks.
- Class 14** Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
- Class 15** Musical instruments.
- Class 16** Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included

in other classes); printers' type; printing blocks.

Class 17 Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.

Class 18 Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips, harness and saddlery.

Class 19 Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

Class 20 Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.

Class 21 Household or kitchen utensils and containers; combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.

Class 22 Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.

Class 23 Yarns and threads, for textile use.

Class 24 Textiles and textile goods, not included in other classes; bed covers; table covers.

Class 25 Clothing, footwear, headgear.

Class 26 Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.

Class 27 Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).

Class 28 Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

Class 29 Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.

Class 30 Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice.

Class 31 Grains and agricultural, horticultural and forestry products not included in other classes; live animals; fresh fruits and vegetables; seeds; natural plants and flowers; foodstuffs for animals; malt.

Class 32 Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

Class 33 Alcoholic beverages (except beers).

Class 34 Tobacco; smokers' articles; matches.

SERVICES

Class 35 Advertising; business management; business administration; office functions.

Class 36 Insurance; financial affairs; monetary affairs; real estate affairs.

Class 37 Building construction; repair; installation services.

Class 38 Telecommunications.

Class 39 Transport; packaging and storage of goods; travel arrangement.

Class 40 Treatment of materials.

Class 41

Education; providing of training; entertainment; sporting and cultural activities.

Class 42

Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

Class 43

Services for providing food and drink; temporary accommodation.

Class 44

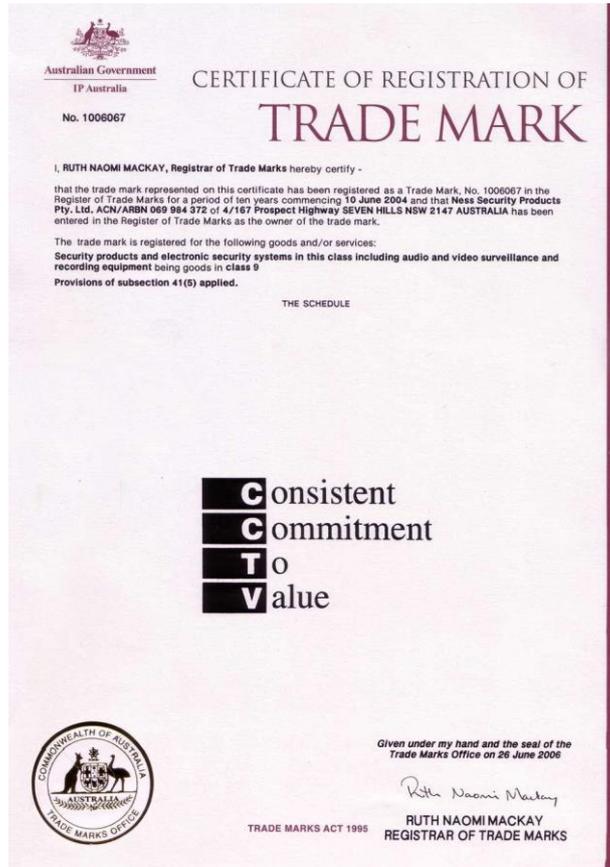
Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

Class 45

Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.

APPENDIX 3

EXAMPLES OF TRADE MARKS REGISTRATION CERTIFICATES




 第 7244644 号
商标注册证
 森盛
SENSHENG

核定使用商品(第 12 类)
 车辆轮胎; 车轮胎; 车辆实心轮胎; 卡车; 起重车; 大客车; 公共汽车; 运货车; 货车(车辆); 叉车(截止)

注册人 盐城森光橡胶制品有限公司
注册地址 江苏省建湖县城滨河北路 38 号
注册有效期限 自公元 2010 年 08 月 07 日 至 2020 年 08 月 06 日止
局长签发 李 建 昌



प्ररूप ओ - 2
 FORM O-2


 भारत सरकार
GOVERNMENT OF INDIA
 व्यापार चिन्ह रजिस्ट्री
 TRADE MARKS REGISTRY
 क्रमांक
 No. **492196**

व्यापार चिन्ह अधिनियम, 1999
TRADE MARKS ACT, 1999

व्यापार चिन्ह के रजिस्ट्रीकरण का प्रमाणपत्र, धारा 23 (2) नियम 62 (I)
 Certificate of Registration of Trade Mark, Section 23 (2), Rule 62 (I)

व्यापार चिन्ह संख्या/ Trade Mark No. **1294091** दिनांक/ Date **05-07-2004** जचक्र/ J.No. **1328(क-1)**

यह प्रमाणित किया जाता है कि जिस प्रकार चिन्ह की समाकृति इसके साथ संलग्न है, वह नाम से रजिस्ट्रीकृत हो चुका है।
 के बारे में दिनांक

Certified that the Trade Mark / a representation is annexed hereto, has been registered in the name(s) of
RAHUL SINGH TRADING AS XACT, MODI COMPLEX BUILDING NO. 11, PHASE - 11, ASHOK VIHAR, NEW DELHI - 110 052, MANUFACTURER AND MERCHANT.

In Class **39** Under No. **1294091** as of the Date **05-Jul-2004** In respect of
PACKAGING OF BOOKS.




मेरे दिशेष पर आज मास के दिनांक को इस पर मुद्रा लगायी गई।
 Sealed at my direction, this **December 20,** day of **2005**

व्यापार चिन्ह रजिस्ट्री, मुम्बई 1
 Trade Marks Registry, Mumbai

व्यापार चिन्ह रजिस्ट्रार
 Registrar of Trade Marks

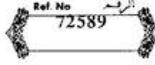
रजिस्ट्रीकरण आवेदन की तारीख से 10 वर्ष के लिए है और तदनुसार वह 10 वर्ष की कालावधि के लिए और प्रत्येक 10 वर्ष की कालावधि के अन्तान पर भी नवीनीकृत किया जा सकता है।
 Registration is for 10 years from the date of application and may then be renewed for a period of 10 years and also at the expiration of each period of 10 years.
 यह प्रमाणपत्र सिर्फ कानूनी कार्य में प्रयोग के लिये या विदेश में रजिस्ट्रीकरण अधिप्राप्त करने के लिये नहीं है।
 This certificate is not for use in Legal proceedings or for obtaining Registration abroad.

टिप्पणी - इस व्यापार चिन्ह के स्वामित्व में कोई परिवर्तन होने पर, या कोषाख के मुख्य स्थान के पते में या भारत में वास्तविक स्थान के लिये पते में परिवर्तन होने पर रजिस्ट्रार के लिये आवेदन करने किया जाना चाहिए।
 Note: Upon any change of ownership of this Trade Mark, or change in address, of the principal place of business or address for service in India a request should AT ONCE be made to register the change.



شهادة تسجيل علامة تجارية

Trade Mark Certificate of Registration



عمان في 2005/10/17

الى : شركة اسامة ابو غربية وشركاه/المتخصصة لمواد البناء

عملا بالمادة 15 من قانون العلامات التجارية رقم 33 لسنة 1952 وتعديلاته، اشهد ان العلامة التجارية المبينة في طلبكم رقم 72589 قد تم نشرها في عدد الجريدة الرسمية رقم 283 بتاريخ 2004/03/04 وسجلت باسمكم في الصنف 19 من أجل القبايل المنجزة في طلبكم . وسيظل التسجيل ساري المفعول مدة عشر سنوات اعتبارا من 2003/11/03 ، ويجوز تجديد التسجيل عند انقضاء هذه المدة وفقا لاحكام القانون . وقد الصفقت صورة لهذه العلامة التجارية خلف هذه الشهادة.

Date: 17/10/2005

To : OSAMA ABU GHARBEYEH & PARTNERS CO.
SPECIALIZED FOR BUILDING MATERIALS

Pursuant to section 15 of the Trade Mark Law No. 33 for the year 1952 and its amendment, I hereby certify that the trade mark attached to your application No. 72589 was duly published in the Official Gazette No. 283 of 04/03/2004 and has been registered in your name in Class 19 for the purposes described in your application.

The Registration will remain in force for a period of ten years from the date of 03/11/2003. And may be renewed thereafter in accordance with the provisions of Law. A representation of the said Trade Mark is affixed overleaf.

صدرت بتاريخ: السابع عشر من تشرين الثاني 2005

Issued on: 17th of, October 2005



Registered / Eingetragen 27/07/2010

No 008831729

OHIM – OFFICE FOR HARMONIZATION IN THE
INTERNAL MARKET
TRADE MARKS AND DESIGNS

CERTIFICATE OF REGISTRATION

This Certificate of Registration is hereby issued for the Community Trade Mark identified below. The corresponding entries have been recorded in the Register of Community Trade Marks.

HABM – HARMONISIERUNGSAMT FÜR DEN
BINNENMARKT
MARKEN, MUSTER UND MODELLE

EINTRAGUNGSRUKUNDE

Diese Eintragungsurkunde wird für die unten angegebene Gemeinschaftsmarke ausgestellt. Die betreffenden Angaben sind in das Register für Gemeinschaftsmarken eingetragen worden.

EC Science

The President / Der Präsident

Wubbo de Boer

United States of America
United States Patent and Trademark Office

FPeLearning

Reg. No. 3,794,726

Registered May 25, 2010

Int. Cl.: 41

SERVICE MARK

PRINCIPAL REGISTER

EBERWEIN, DALE HEROLD (UNITED STATES INDIVIDUAL), DBA FPELEARNING,
5986 NORTH STAFFORD RD
COEUR D'ALENE, ID 83815

FOR: EDUCATIONAL SERVICES, NAMELY, CONDUCTING CLASSES, SEMINARS AND
WORKSHOPS IN THE NATURE OF PROVIDING INSTRUCTION IN THE USE OF A
TEACHABLE STRATEGY FOR USE IN ELECTRONIC PRESENTATIONS OF DESIGNED
CURRICULUM TO ALLOW TEACHERS TO USE THE DESIGN FOR INTEGRATION INTO
MODERN EDUCATION, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 2-20-2010; IN COMMERCE 2-20-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PAR-
TICULAR FONT, STYLE, SIZE, OR COLOR.

SN 77-743,782, FILED 5-24-2009.

MARK T. MULLEN, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

РОССИЙСКАЯ ФЕДЕРАЦИЯ



СВИДЕТЕЛЬСТВО

на товарный знак (знак обслуживания)

№ 302250

НАШ ДОМ
ПРИМОРЬЕ

Правообладатель: *Открытое акционерное общество
«Наш дом-Приморье», 690091, г. Владивосток,
ул. Луцкого, 21 (RU)*

Заявка № 2004728730

Приоритет товарного знака 10 декабря 2004 г.

Зарегистрировано в Государственном реестре

товарных знаков и знаков обслуживания

Российской Федерации 07 марта 2006 г.

Срок действия регистрации истекает 10 декабря 2014 г.

Руководитель Федеральной службы по интеллектуальной
собственности, патентам и товарным знакам

Б.И. Симонов

APPENDIX 4

CONTRACTING STATES OF THE MADRID SYSTEM

(Countries in **bold** are parties to the Protocol only, everyone else is party to both Agreement and Protocol)

Afghanistan (AF)	Iceland (IS)	Oman (OM)
Albania (AL)	India (IN)	Pakistan (PK)
Algeria (DZ)	Indonesia (ID)	Philippines (PH)
Antigua & Barbuda (AG)	Iran (IR)	Poland (PL)
Armenia (AM)	Ireland (IE)	Portugal (PT)
Australia (AU)	Israel (IL)	Romania (RO)
Austria (AT)	Italy (IT)	Russian Federation (RU)
Azerbaijan (AZ)	Jamaica (JM)	Rwanda (RW)
Bahrain (BH)	Japan (JP)	Samoa (WS)
Belarus (BY)	Kazakhstan (KZ)	San Marino (SM)
Belize (BZ)**	Kenya	Sao Tome & Principe (ST)
Belgium (BE)*	Korea (North) (KP)	Serbia (RS)
Bhtuan (BT)	Korea (South) (KR)	Sierra Leone (SL)
Bosnia & Herzegovina (BA)	Kyrgystan (KG)	Singapore (SG)
Botswana (BW)	Lao PDR (LA)	Slovakia (SK)
Brazil (BR)	Latvia (LV)	Slovenia (SI)
Brunei Darussalam (BN)	Lesthoto (LS)	Spain (ES)
Bulgaria (BG)	Liberia (LR)	Sudan (SD)
Cabo Verde (CV)	Liechtenstein (LI)	Swaziland (SZ)
China (CN)	Lithuania (LT)	Sweden (SE)
Cambodia (KH)	Luxembourg (LU)*	Switzerland (CH)
Canada (CA)	Madagascar (MG)	Syria (SY)
Chile (CL)	Macedonia (MK)	Tajikistan (TJ)
Colombia (CO)	Malawi (MW)	Thailand (TH)
Croatia (HR)	Malaysia (MY)	Trinidad and Tobago (TT)
Cuba (CU)	Mauritius (MU)***	Turkey (TR)
Cyprus (CY)	Mexico (MX)	Turkmenistan (TM)
Czech Republic (CZ)	Moldova (MD)	UK (GB)
Denmark (DK)	Monaco (MC)	Ukraine (UA)
Estonia (EE)	Mongolia (MN)	United Arab Emirates (AE)
European Union (EM)	Montenegro (ME)	USA (US)
Egypt (EG)	Morocco (MA)	Uzbekistan (UZ)
Finland (FI)	Mozambique (MZ)	Vietnam (VN)
France (FR)	Namibia (NA)	Zambia (ZM)
Gambia(GM)	Netherlands (NL)*	Zimbabwe (ZW)
Georgia (GE)	New Zealand (NZ)	
Germany (DE)	Norway (NO)	
Ghana (GH)	OAPI (OA)	
Greece (GR)		
Hungary (HU)		

* International registration in Belgium, Luxembourg and the Netherlands is considered registration via Benelux.

** From 24 February 2023

*** From 6 May 2023

APPENDIX 5

The 2022 list of the top 20 brands and their values from “Brand Finance”

2022	2021	Logo	Name	Country	2022
1 =	1		Apple		\$355,080M
2 =	2		Amazon		\$350,273M
3 =	3		Google		\$263,425M
4 =	4		Microsoft		\$184,245M
5 ^	6		Walmart		\$111,918M
6 v	5		Samsung Group		\$107,284M
7 =	7		Facebook		\$101,201M
8 =	8		ICBC		\$75,119M
9 ^	15		Huawei		\$71,233M
10 v	9		Verizon		\$69,639M
11 =	11		China Construction Bank		\$65,546M
12 =	12		Toyota		\$64,283M
13 v	10		WeChat		\$62,303M
14 ^	19		Agricultural Bank Of China		\$62,031M
15 v	13		Mercedes-Benz		\$60,760M
16 =	16		State Grid		\$60,175M
17 ^	23		Deutsche Telekom		\$60,169M
18			TikTok/Douyin		\$58,980M
19 ^	22		Disney		\$57,059M
20 =	20		Home Depot		\$56,312M