



PERANI & PARTNERS

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Trade Marks overview

Basic guide about trademarks validity requirements,
registration and protection

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Definition of Trademark

- ▶ Trade marks are signs used in trade to identify products and services.
- ▶ The trade mark is the symbol customers use to pick out goods and services originating from one company. It distinguishes products and services provided by a subject from competitors.
- ▶ Registration of a trademark allows to protect it and build upon it. In some countries, protection on a mark can be obtained even if the mark is not registered, as long as it is used. However, it is always advisable to register it in order to obtain the best protection.
- ▶ The only condition imposed on a registered trade mark is that it must be clearly defined; otherwise neither the relevant owner nor competitors will be certain of what it covers.

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Signs of which a trade mark may consist

A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- (a) distinguishing the goods or services of one undertaking from those of other undertakings; and*
- (b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.*

[DIRECTIVE \(EU\) 2015/2436 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 16 December 2015 to approximate the laws of the Member States relating to trade marks](#)

Therefore a registered trade mark must be clearly defined; otherwise neither you nor your competitors will be certain of what it covers.

In practice, it means that...



You can register - 1 / 2

▶ Word mark

A word is represented using words, letters, numbers or any other characters that can be typed

▶ Figurative mark

A figurative mark is represented using pictures, graphics or images

▶ Figurative mark with letter

A figurative mark containing letters combines the use of pictures, graphics or images with words or letters

▶ 3D Mark

A three-dimensional mark is represented using a three-dimensional shape such as the actual product or its packaging

▶ Colour per se mark

A colour per se mark is used only to register an actual colour to distinguish products or services

▶ Sound mark

A sound mark must be represented graphically using, for example, musical notation 🎵



You can register - 2/2

▶ Hologram

A hologram trademark is a non-conventional trademark where a hologram is used to perform the trademark function of uniquely identifying the commercial origin of products or services. In recent times holograms have been increasingly used as trade marks in the marketplace.

▶ Motion mark

A trade mark consisting of, or extending to, a movement or a change in the position of the elements of the mark. Means of representation. The mark shall be represented by submitting a video file or by a series of sequential still images showing the movement or change of position

▶ Multimedia trademark

A mark that consists of a combination of sound and picture. The mark can be represented by an audio-visual file that shows the combination of sound and picture

▶ Olfactory mark

An olfactory mark is perceived by means of the nose.

▶ Pattern

Marks consisting of a pattern which are capable of identifying the goods or services as originating from a particular undertaking, and thus distinguishing it from those of other undertakings are registrable as trade marks

▶ Position

A **position mark** consists of a specific placement of a trademark on a product. A **position mark** can be represented by an image that shows how the **mark** is positioned and what size and proportion it has compared to the product it is placed on.

Some trade marks examples

Word mark

ADIDAS

EUTM 002288355

PHILIPS

EUTM 000205971

LEVI'S

EUTM 000033159

VOLVO

EUTM 002361087

Herbalife

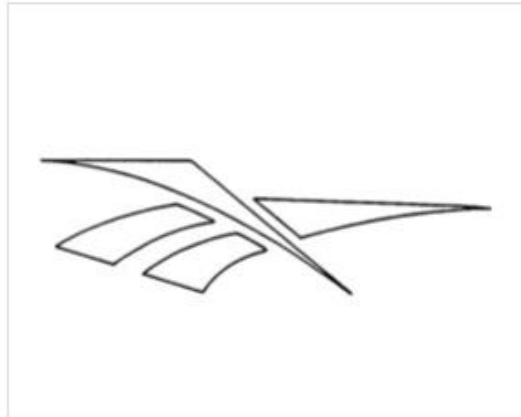
EUTM 005332234

JUST DO IT

EUTM 000514984

Some trade marks examples

Figurative mark



EUTM 000000456



EUTM 000106948



EUTM 005271598

The Office accepts the following file format: JPEG

Some trade marks examples

Figurative mark containing word elements *



EUTM 009687336



EUTM 002009298



EUTM 011029477

The Office accepts the following file format: JPEG

Some trade marks examples

Shape mark



EUTM 000146704



EUTM 010532653



EUTM 012492393

The Office accepts the following file formats: JPEG, OBJ, STL, X3D

Some trade marks examples

Shape mark containing word elements*



EUTM 00649339



EUTM 000031336



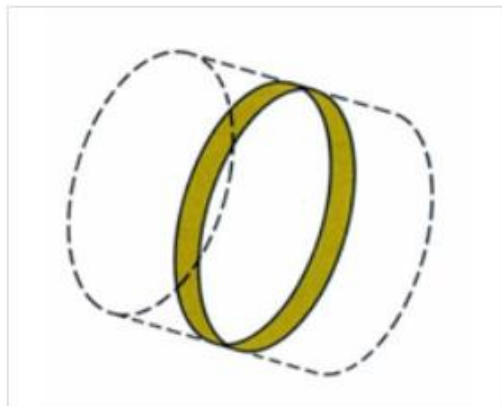
EUTM 014141113

The Office accepts the following file formats: JPEG, OBJ, STL, X3D

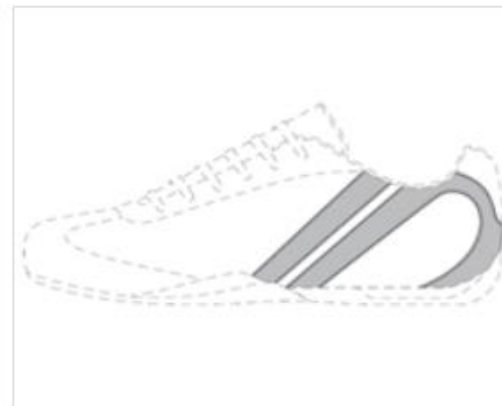
Position mark



EUTM 001027747



EUTM 001180231

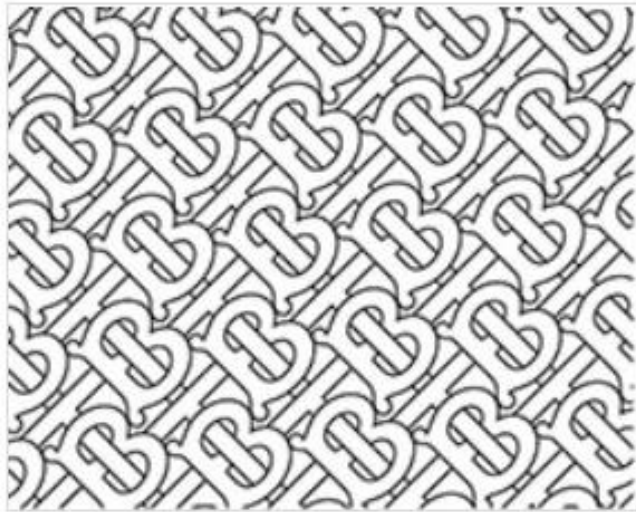


EUTM 008586489

The Office accepts the following file format: JPEG

Some trade marks examples

Pattern mark



EUTM 017993008



EUTM 000015602



EUTM 005365754

The Office accepts the following file format: JPEG

Some trade marks examples

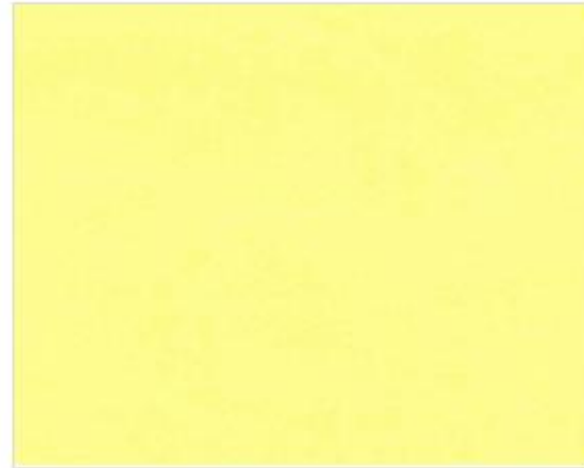
Colour (single) mark



EUTM 002087005



EUTM 000031336



EUTM 000655019

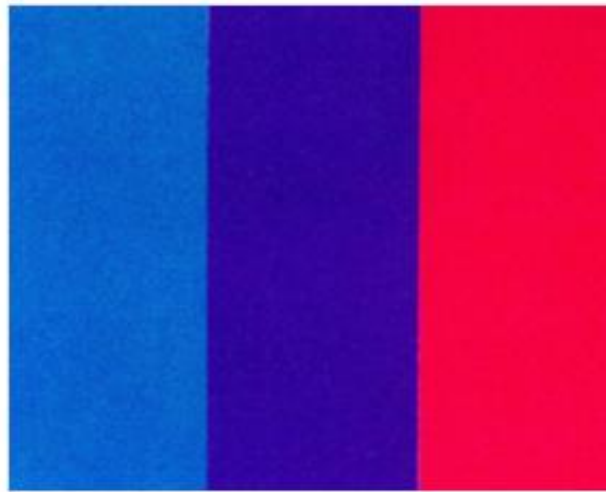
The Office accepts the following file format: JPEG

Some trade marks examples

Colour (combination) mark



EUTM 000463174



EUTM 002467876



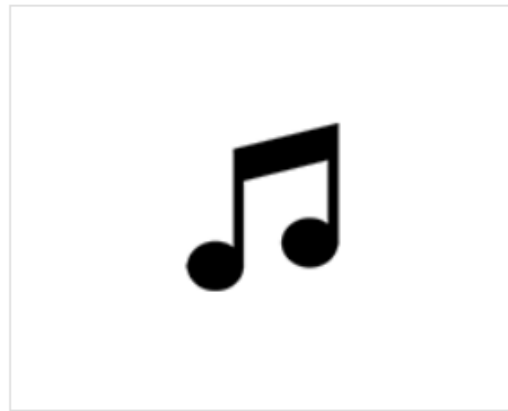
EUTM 003286614

The Office accepts the following file format: JPEG

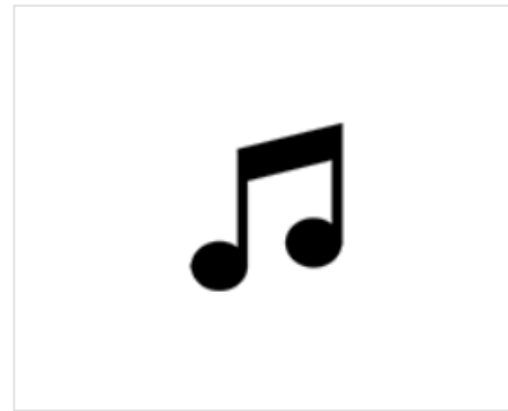
Some trade marks examples

Sound mark

With the abolition of the graphical representation requirement, as and from 1 October 2017, EUTM applications for sound marks can only be an audio file reproducing the sound or an accurate representation of the sound in musical notation.



EUTM 017975948



EUTM 017592031



EUTM 001480805

The Office accepts the following file formats: JPEG, MP3 (maximum 2 Mb)

Some trade marks examples

Motion mark



EUTM 005338629



EUTM 008581977



EUTM 017894840

The Office accepts the following file format: MP4 (video), JPEG (for series of still sequential images).

Some trade marks examples

Multimedia mark

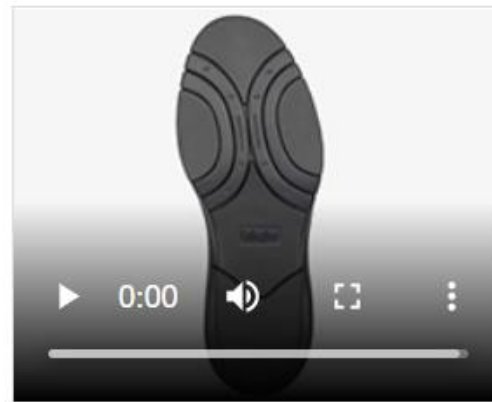
This is a new category of trade mark (as and from 1 October 2017).



EUTM 017451816



EUTM 017635293



EUTM 017941596

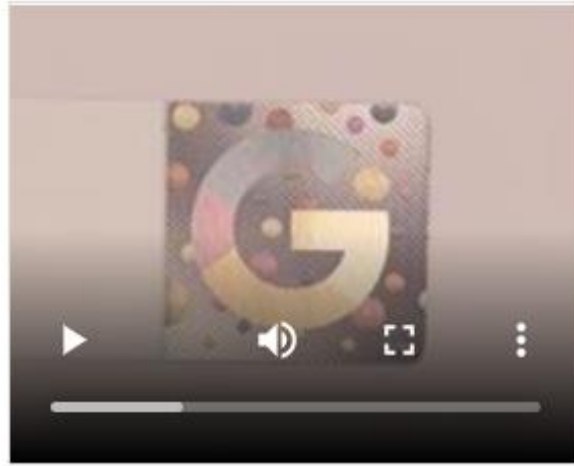
The Office accepts the following file format: MP4 (maximum 20 Mb)

Some trade marks examples

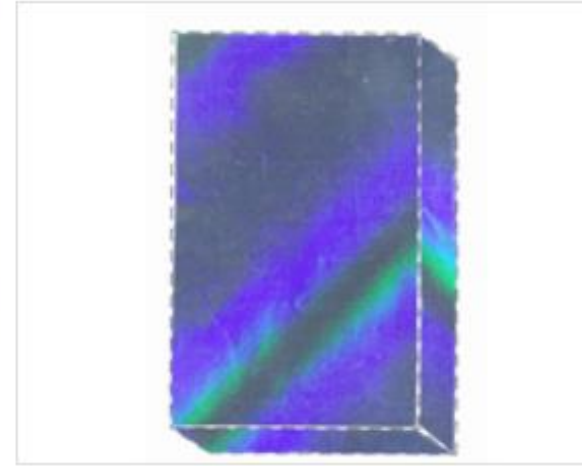
Hologram mark



EUTM 012383171



EUTM 017993401



EUTM 002559144

The Office accepts the following file formats: JPEG, MP4 (maximum 20 Mb)

What prerequisites a mark must satisfy in order to serve as a trademark?

▶ DISTINCTIVE CHARACTER

In order to serve as a trademark, a mark must be distinctive -- that is, it must be capable of identifying the source of a particular good.

▶ NOVELTY CHARACTER

A valid trademark is supposed to be new. If there exist a prior trademark whose similarity to the adopted mark may cause confusion for the public, the more recent trademark may be declared void. Procedures may vary in different jurisdictions.

The distinctive character of a trademark

A mark can not fulfil a distinctive function and therefore is invalid if it is merely **descriptive**, i.e. if it consists exclusively of signs or indications which may serve in trade to describe significant characteristics of the goods or services (kind, quality, quantity, intended purpose, value, geographical origin, etc.), or if it consists exclusively of signs or indications which have become **customary** in the current language or in established practices of the trade.

The degree of legal protection afforded by a trademark will depend upon the level of distinctiveness. A very distinctive mark can enjoy a higher level of protection against similar trademarks

For sake of simplicity, we can group marks into 4 categories, based on the relationship between the mark and the underlying product, i.e.:

(1) arbitrary or fanciful, (2) suggestive, (3) descriptive, or (4) generic.

The distinctive character of a trademark

- ▶ An arbitrary or fanciful mark is a mark that bears no logical relationship to the underlying product. For example, the words "[Exxon](#)," "[Kodak](#)," and "[Apple](#)" bear no inherent relationship to their underlying products (respectively, gasoline, cameras, or computers). Similarly, the Nike "swoosh" bears no inherent relationship to athletic shoes. Arbitrary or fanciful marks are inherently distinctive -- i.e. capable of identifying an underlying product -- and are given a high degree of protection.
- ▶ A suggestive mark is a mark that evokes or suggests a characteristic of the underlying good. For example, the word "Jaguar" is suggestive of fast cars, but does not specifically describe the underlying product. Some exercise of imagination is needed to associate the word with the underlying product. At the same time, however, the word is not totally unrelated to the underlying product. Like arbitrary or fanciful marks, suggestive marks are inherently distinctive and are given a high degree of protection.

The distinctive character of a trademark

- ▶ A descriptive mark is a mark that directly describes, rather than suggests, a characteristic or quality of the underlying product (e.g. its color, odor, function, dimensions, or ingredients). For example, "[Holiday Inn](#)," "[All Bran](#)," and "Vision Center" all describe some aspect of the underlying product or service (respectively, hotel rooms, breakfast cereal, optical services). They tell us something about the product. Unlike arbitrary or suggestive marks, descriptive marks are not inherently distinctive and are protected only if they have acquired "secondary meaning."

The distinctive character of a trademark

- ▶ A descriptive mark acquires secondary meaning when the consuming public primarily associates that mark with a particular producer, rather than the underlying product. Thus, for example, the term "Holiday Inn" has acquired secondary meaning because the consuming public associates that term with a particular provider of hotel services, and not with hotel services in general. The public need not be able to identify the specific producer; only that the product or service comes from a single producer. When trying to determine whether a given term has acquired secondary meaning, courts will often look to the following factors: (1) the amount and manner of advertising; (2) the volume of sales; (3) the length and manner of the term's use; (4) results of consumer surveys.

The trademark registration

Assuming that a trademark qualifies for protection, rights to a trademark can be acquired in one of two ways:

- (1) by being the first to use the mark in commerce. The use of a mark generally means the actual sale of a product to the public with the mark attached.; or
- (2) (2) by being the first to register the mark ([as to descriptive marks](#) they can be registered only after they have acquired [secondary meaning](#))

The trademark registration - advantages

- ▶ Obtaining a registration number to the benefit of the owner.
- ▶ Avoiding being forced to show the prior rights on the basis of use, with a huge amount of documents (moreover not all countries provide protection to non registered marks).
- ▶ TM registration: national (or EU) identified right, wider to the right that could be shown if the use is limited to a specific area or geographic region;
- ▶ Discouraging other traders from using trademarks that are similar or identical to yours in relation to goods and services like yours (referred to here as “conflicting trademarks”). This benefit manifests itself in a number of ways:
 - a. **Before other traders choose their brand names:**
 - b. **When other traders seek to register their brand names as trademarks:**
 - c. **When you discover another trader using a conflicting mark in the market place:**

The trademark registration

- ▶ A trademark can be registered at different levels:
- ▶ 1) Local level: Each nation has a specific office in charge with the filing and granting of TM application (Italy: UIBM - Ufficio Italiano Brevetti e Marchi - Spain - Oficina Española de Patentes y Marcas)
- ▶ 2) Worldwide level: WIPO is an intergovernmental organization which gives the possibility to have your trademarks registered in all the countries members of the so called Madrid System. One mark designating different countries that can be chosen.
- ▶ 3) European Union level: The European Union Intellectual Property Office (EUIPO) receives and examines EUTM Application. One mark valid in 28 countries (27 after Brexit, set for December 31, 2020).