

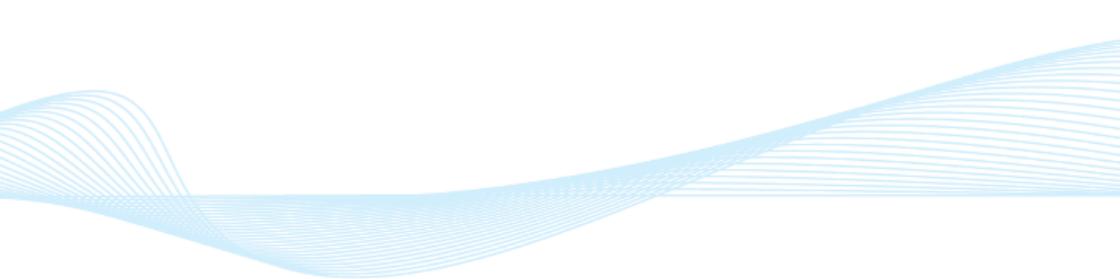


MAKING A MARK

An Introduction to Trademarks
for Small and Medium-sized
Enterprises



WORLD
INTELLECTUAL
PROPERTY
ORGANIZATION



Publications in the “Intellectual Property for Business” series:

1. Making a Mark: An Introduction to Trademarks for Small and Medium-sized Enterprises. WIPO publication No. 900.
2. Looking Good: An introduction to Industrial Designs for Small and Medium-sized Enterprises. WIPO publication No. 498.
3. Inventing the Future: An introduction to Patents for Small and Medium-sized Enterprises. WIPO publication No. 917.
4. Creative Expression: An introduction to Copyright for Small and Medium-sized Enterprises. WIPO publication No. 918 (forthcoming).

All publications available from the WIPO e-bookshop at: www.wipo.int/ebookshop

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Preface

This guide is the first in a series of guides on “Intellectual Property for Business.” It is devoted to trademarks, a central element in the marketing and branding strategy of any company.

This guide seeks to explain trademarks from a business perspective. Its approach is practical and explanations are illustrated with examples and pictures to enhance the reader’s understanding. Small and Medium-sized Entreprises (SMEs) are encouraged to use the guide with a view to integrating their trademark strategy into their overall business strategy. WIPO welcomes feedback to further refine the guide to ensure that it adequately meets the needs of SMEs worldwide.

Nationally customized versions of the guide could be developed in cooperation with national institutions and local partners, which are encouraged to contact WIPO to obtain a copy of the guidelines on customization.

Kamil Idris,
Director General, WIPO





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1. Trademarks

What is a Trademark?

A trademark is a sign capable of distinguishing the goods or services produced or provided by one enterprise from those of other enterprises.

Any distinctive **words, letters, numerals, drawings, pictures, shapes, colors, logotypes, labels or combinations** used to distinguish goods or services may be considered a trademark. In some countries, **advertising slogans** are also considered trademarks and may be registered as such at national trademark offices. An increasing number of countries also allow for the registration of less traditional forms of trademarks, such as single colors, three-dimensional signs (shapes of products or packaging), audible signs (sounds) or olfactory signs (smells). However, many countries have set limits on what can be registered as a trademark, generally only allowing for signs that are visually perceptible or that can be represented graphically.

Examples

Word:



Courtesy: Yahoo!

Logotype:



Reproduced with the permission of Penguin Books Limited

Combination of letters with logotype:



© 1986 WWF–World Wide Fund for Nature (Formerly World Wildlife Fund)
®WWF Registered Trademark Owner

Three-dimensional mark (shape of product):



Toblerone® is a trademark registered by the Kraft Foods Group ©1986

What are trademarks for?

The main function of a trademark is to enable consumers to **identify a product** (whether a good or a service) of a particular company so as to **distinguish it from other identical or similar products** provided by competitors. Consumers who are satisfied with a given product are likely to buy or use the product again in the future. For this, they need to be able to distinguish easily between identical or similar products.

By enabling companies to differentiate themselves and their products from those of the competition, trademarks play a pivotal role in the **branding and marketing strategies** of companies, contributing to the definition of the **image**, and **reputation** of the company's products in the eyes of consumers. The image and reputation of a company create **trust** which is the basis for establishing a **loyal clientele** and enhancing a **company's goodwill**. Consumers often develop an **emotional attachment** to certain trademarks, based on a set of desired qualities or features embodied in the products bearing such trademarks.

Trademarks also provide an incentive for companies to invest in maintaining or improving the quality of their products in order to ensure that products bearing their trademark have a positive reputation.

The Value of Trademarks

A carefully selected and nurtured trademark is a **valuable business asset** for most companies. For some, it may be the most valuable asset they own. Estimates of the value of some of the world's most famous trademarks such as Coca-Cola or IBM exceed 50 billion dollars each. This is because consumers value trademarks, their reputation, their image and a set of desired qualities they associate with the mark, and are willing to pay more for a product bearing a trademark that they recognize and which meets their expectations. Therefore, the very ownership of a trademark with a good image and reputation provides a company with a competitive edge.



Courtesy: IBM Deutschland GmbH

Why should your company protect its trademark(s)?

While most businesses realize the importance of using trademarks to differentiate their products from those of their competitors, not all realize the importance of protecting them through **registration**.

Registration, under the relevant trademark law, gives your company the **exclusive right to prevent others from marketing identical or similar products under the same or a confusingly similar mark.**

Without trademark registration, your investments in marketing a product may become wasteful as rival companies may use the same or a confusingly similar trademark for identical or similar products. If a competitor adopts a similar or identical trademark, customers could be misled into buying the competitor's product thinking it is your company's product. This could not only decrease your company's profits and confuse your customers, but may also damage the reputation and image of your company, particularly if the rival product is of inferior quality.

Given the value of trademarks and the importance that a trademark may have in determining the success of a product in the marketplace, it is critical to make sure that it is registered in the relevant market(s).

In addition, **it is much easier to license a registered trademark to other companies,** thus providing an additional source of revenue for your company, or may be the basis for a **franchising agreement.**

On occasion, a registered trademark with a good reputation among consumers may also be used to obtain funding from financial institutions that are increasingly aware of the importance of brands for business success.

Trademarks:

- ensure that consumers can distinguish between products;
- enable companies to differentiate their products;
- are a marketing tool and the basis for building a brand image and reputation;
- may be licensed to provide a direct source of revenue through royalties;
- are a crucial component of franchising agreements;
- may be a valuable business asset;
- encourage companies to invest in maintaining or improving product quality;
- may be useful for obtaining financing.

2. Protecting Trademarks

How can your company protect its trademark(s)?

Trademark protection can be obtained through **registration** or, in some countries, also through **use**. Even where trademarks can be protected through use, you are well advised to register the trademark by filing the appropriate application form at the national trademark office (some trademark offices have online registration forms). Registering a trademark will provide stronger protection, particularly in case of conflict with an identical or confusingly similar trademark. The services of a trademark agent are often very useful (and sometimes compulsory) for the registration of a trademark.

Is the registration of the trade name of your company sufficient?

Many people believe that by registering their business and its **trade name** at the business registry, this name would also be automatically protected as a trademark. This is a rather common misconception. It is important to understand the difference between trade names and trade marks.

A trade name is the full name of your business, such as: “Blackmark International Ltd” and it **identifies your company**.

It often ends with Ltd, Inc. or other similar abbreviations that denote the legal character of the company.

A trademark, however, is the sign that distinguishes the product(s) of your company.

A company may have various trademarks. For instance, Blackmark International Ltd may sell one of its products as BLACKMARK but another as REDMARK. Companies may use a specific trademark to identify all their products, a particular range of products or one specific type of product. Some companies may also use their trade name, or a part of it, as a trademark. They should, in that case, register it as a trademark.

Who is authorized to apply for trademark registration?

In general, any person who intends to use a trademark or to have it used by third parties can apply for registration. It can be either an individual or a legal entity.

Is it compulsory to register a company's trademarks?

While it is not compulsory, it is highly advisable, as registration provides the exclusive right to prevent unauthorized use of the **trademark**.

What are the main reasons for rejecting an application?

While selecting a trademark it is helpful to know which categories of signs are usually not acceptable for registration. Applications for trademark registration are usually rejected on what are commonly referred to as “absolute grounds” in the following cases:

- **Generic terms.** For example, if your company intends to register the trademark CHAIR to sell chairs, the mark would be rejected since “chair” is the generic term for the product.
- **Descriptive terms.** These are words that are usually used in trade to describe the product in question. For example, the mark SWEET is likely to be rejected for marketing chocolates as being descriptive. In fact, it would be considered unfair to give any single chocolate manufacturer exclusivity over the word “sweet” for marketing its products. Similarly, qualitative or laudatory terms such as RAPID, BEST, CLASSIC or INNOVATIVE are likely to give rise to similar objections unless they are part of an otherwise distinctive mark. In such cases, it may be necessary to include a disclaimer clarifying that no exclusivity is sought for that particular part of the mark.
- **Deceptive trademarks.** These are trademarks that are likely to deceive or mislead consumers as to the nature, quality or geographical origin of the product. For example, marketing margarine under a trademark featuring a COW would probably be rejected, as it would be considered misleading for consumers, who are likely to associate the mark with dairy products (i.e. butter).
- **Marks considered to be contrary to public order or morality.** Words and illustrations that are considered to violate commonly-accepted norms of morality and religion are generally not allowed to be registered as trademarks.
- **Flags, armorial bearings, official hallmarks and emblems of states and international organizations** which have been communicated to the International Bureau of WIPO are usually excluded from registration.

Applications are rejected on “relative grounds” when the trademark conflicts with **prior trademark rights**. Having two identical (or very similar) trademarks for the same type of product could cause confusion among consumers. Some trademark offices check for conflict with existing marks, including unregistered well-known marks, as a regular part of the registration process, while many others only do so when the trademark is challenged by a third party after publication of the trademark. In either case, if the trademark is considered to be identical or confusingly similar to an existing one for identical or similar products, it will be rejected or cancelled, as the case may be.

It would, therefore, be wise to avoid using trademarks that risk being considered confusingly similar to existing marks.

What should be kept in mind when selecting or creating a trademark?

Selecting or creating an appropriate trademark is a critical step, as it is an important element of the marketing strategy of your business. So what is an appropriate trademark for your product(s)? Evidently, there are no hard and fast rules. But the following five-point checklist may be useful.

Five Point Checklist for Selecting Your Trademark

- Check that your trademark of choice meets all the **legal requirements** for registration (see reasons for rejecting applications on page 7).
- Do a **trademark search** to make sure that it is not identical or confusingly similar to existing trademarks (see page 11).
- Make sure the trademark is **easy to read, write, spell and remember** and is suitable to all types of advertising media.
- Make sure the mark does not have any **undesired connotations** in your own language or in any of the languages of potential export markets.
- Check that the corresponding **domain name** (i.e. Internet address) is available for registration (for more on the relationship between trademarks and domain names see page 19).

While selecting one or more words as your trademark you should also take into consideration the implications of selecting certain types of words:

- **Coined or “fanciful” words.** These are invented words without any intrinsic or real meaning. Coined words have the advantage of being easy to protect, as they are more likely to be considered inherently distinctive. On the negative side, however, they may be more difficult to remember for consumers, requiring greater effort to advertise the products.

Example:

Kodak is a Registered Trademark of Eastman Kodak Company.



Kodak

Courtesy: Eastman Kodak Company

- **Arbitrary marks:** These are words that have a meaning that has no relation to the product they advertise. While these types of marks will also be easy to protect, they may also require heavy advertising to create the association between the mark and the product in the minds of consumers.

Example: The trademark ELEPHANT for marketing mobile phones.

- **Suggestive marks.** These are marks that hint at one or some of the attributes of the product. The appeal of suggestive marks is that they act as a form of advertising. A slight risk, however, is that some countries may consider a suggestive mark to be too descriptive of the product.

Example: The trademark SUNNY for marketing electric heaters would hint at the fact that the product is meant to radiate heat and keep your house warm. However, some trademark registries may find the mark too descriptive and thus may not register it.

Irrespective of the type of mark you choose, it is important to avoid imitating existing trademarks. A slightly altered competitor’s trademark or a misspelt well-known or famous mark is unlikely to be registered.

Example: EASY WEAR is a registered trademark for teenage clothing. It would be unwise to try to sell the same or similar products using the trademark EEZYWARE as it would probably be considered confusingly similar to the existing mark and is unlikely to be registered.

Registering a Trademark - Step by Step

The Applicant

As a first step, you have to send or hand in a duly completed trademark application form, which will include the contact details of your company, a graphic illustration of its mark (a specific format may be required) a description of the goods and services and/or class(es) for which your business wishes to obtain trademark registration, and pay the required fees.

Note that some trademark offices (e.g. US and Canada) may also require proof of use or a declaration that your company intends to use the trademark. The relevant trademark office will give you more precise information concerning the application process.

The Trademark Office

The steps taken by the trademark office to register a trademark vary from country to country but, broadly speaking, follow a similar pattern:

Formal examination: the trademark office examines the application to make sure that it complies with the administrative requirements or formalities (i.e., whether the application fee has been paid and the application form is properly filled in).

Substantive examination: in some countries, the trademark office also examines the application to verify whether it complies with all the substantive requirements (e.g., whether it belongs to a category which is excluded from registration by the trademark law and whether the trademark is in conflict with an existing mark on the register in the relevant class(es)).

Publication and opposition: in many countries, the trademark is published in a journal with a set period of time for third parties to oppose its registration. In a number of other countries the trademark is only published once it has been registered, with a subsequent period for petitions to cancel the registration.

Registration: once it has been decided that there are no grounds for refusal, the trademark is registered, and a registration certificate is issued which is generally valid for 10 years.

Renewal: the mark may be renewed indefinitely by paying the required renewal fees, but the registration may be canceled entirely for certain goods or services if the trademark has not been used for a certain period of time specified in the relevant trademark law.

How long does it take to register a trademark?

The time required for the registration of a trademark will vary significantly from country to country, generally ranging from three months to two years, depending, among other things, on whether the trademark office conducts substantive examination. Make sure that you apply for registration of a trademark well in advance so that its registration is secured in time for its use in the advertising and marketing of the relevant products.

What are the costs associated with trademark creation, protection and use?

It is important to keep in mind, and properly budget, the costs related to trademark creation and registration:

- There may be costs associated with the creation of a logo or word to be used as a trademark, as many companies outsource this task.
- There may be costs for conducting a trademark search (see below).
- There are costs associated with the registration process, which vary depending on the number of countries and the categories of products (or trademark classes, see page 12). The national trademark office will provide you with the detailed costs of trademark registration in your country.
- Companies choosing to use a professional trademark agent to assist in the registration process would face additional costs but would probably save significant time and energy in following the registration process.

How can you find out if your chosen trademark might conflict with other registered trademarks? What is a trademark search?

Before submitting an application for registering a trademark, you should ensure that a proper **trademark search** has been carried out. This is done to make sure that the trademark you intend to use, or a similar one, is not already registered by another company for identical or similar products.

You can either make a trademark search yourself or hire the services of a trademark agent. Either of you can do the search through your national trademark office (which may be free or require payment of a fee) or through a commercially operated trademark database. In whatever manner it is done, bear in mind that any such trademark search is only preliminary. It may be difficult to make sure that your trademark of choice is not “confusingly similar” to existing validly-registered trademarks. This is why the guidance of an experienced trademark agent, who is familiar with the practice of the trademark office and court decisions, may be very helpful.

Before going to an agent you may wish to check whether your national trademark office (or a commercial database company) has a free online trademark database that you may use to conduct a preliminary search. A list of trademark databases is available on WIPO's website at www.arbiter.wipo.int/trademark/.

Trademarks are grouped into "classes" according to the goods or services they serve to identify (see the international classification system in Annex III). You may therefore begin by familiarizing yourself with the 45 different trademark classes.

A Well-classified System

While filling in your trademark application form you are required, in most countries, to indicate the goods and/or services for which you wish to register your trademark and to group them according to classes. These refer to the classes in the **trademark classification system**.

The trademark classification system allows for the storage of data on registered trademarks in an orderly manner in relation to the types of goods or services. This makes it easier to retrieve information from trademark databases. It is critical to register your trademark in all classes in which you intend to use your trademark.

The most widely used classification system is the International Trademark Classification system (the so-called Nice system for classification of word marks), which has 34 classes for goods and a further 11 for services. More information on the Nice classification

system is available in Annex III. See also: www.wipo.int/classifications/en/nice/about/.

Example:

How are products classified? Let us take an example. If your company is producing knives and forks, then your trademark application should be made for the corresponding goods in class 8. If, however, you wish to market other kitchen utensils (such as containers, pans or pots) using the same trademark you will also have to register the mark for the corresponding goods in class 21. In some countries you would have to make a separate application for each class of product whereas in other countries you may cover a number of classes with a single application.



Do you need a trademark agent to file a trademark application?

As a general rule, most countries do not require you to hire a trademark agent to file an application; you may file the application yourself. However, the services of a trademark agent skilled in conducting trademark searches and familiar with the detailed procedure for trademark registration may be used to save time, ensure that you apply for protection in the appropriate trademark class(es) and avoid refusal on absolute grounds. If you apply for trademark registration abroad you may be required to have a trademark agent who is resident in the relevant country.

The relevant IP office (see Annex II) will be able to advise you on the need, if any, to be represented by an agent and provide you with a list of officially approved trademark agents.

For how long is your registered trademark protected?

While the term of protection may vary, in a large number of countries, registered trademarks are protected for 10 years. Registration may be renewed indefinitely (usually, for consecutive periods of 10 years) provided renewal fees are paid in time. Make sure that someone in your company is made responsible for ensuring timely renewal of trademark registrations in all countries of continuing interest to your business.

Outsourcing Trademark Creation

Designing a trademark is a creative process. In most countries, a creator automatically owns the copyright over creative or artistic works, such as the artwork of a trademark. Therefore, when the creation of a trademark is outsourced, it is usually best to clarify issues of copyright ownership in the original agreement and/or to make sure the copyright over the trademark is formally assigned to your company.

Is trademark registration in your home country valid internationally?

The legal rights arising out of a trademark registration are normally limited to the territory to which they pertain; so, ordinarily, valid registration of a trademark in your home country gives you rights only in your own country unless your mark is considered to be a well-known mark. (For information on well-known marks see page 16.)

Should you consider protecting your trademark abroad?

All the main reasons for registering your trademark in your home country also apply to the commercialization of your products in foreign markets. It is, therefore, highly advisable to **register your trademark abroad** if you wish to grant a license to use in other countries. Exporting goods bearing a distinctive

trademark will enable your products to be recognized in foreign markets, allowing your company to build a reputation and image among foreign consumers, which may result in higher profits.

How can you register the trademark of your company abroad?

Once you have registered the trademark of your company in the country where it is located (home country) there are three main ways to register the trademark in other countries:

The National Route: your business may apply to the trademark office of each country in which it is seeking protection by filing the corresponding application in the required language and paying the required fees. As indicated earlier, a country may require you to use the services of a locally-based trademark agent for this purpose.

The Regional Route: if you wish to apply for protection in countries which are members of a regional trademark system you may apply for registration, with effect in the territories of all Member countries, by filing an application at the relevant regional office. The regional trademark offices are:

- The African Regional Industrial Property Office
- The Benelux Trademark Office
- The Office for the Harmonization of the Internal Market of the European Union
- The *Organisation Africaine de la Propriété Intellectuelle*.

The International Route: If your home country is a member of the Madrid system and your trademark has been registered or applied for in or with effect in that country, you may use the Madrid system (administered by WIPO) to register your trademark in the more than 70 countries that are party to the system.

Advantages of using the Madrid system

The principal advantages of using the Madrid system are that the trademark owner can register his trademark in all the countries party to the system by filing:

- a single international application;
- in one language;
- subject to one set of fees and deadlines.

Thereafter, the international registration can be maintained and renewed through a single procedure.

You can find more information on international registration of marks either at your national trademark office or on the WIPO website: www.wipo.int/madrid/. A list of the Member countries of the Madrid system is available in Annex IV.

3. Types of Trademark

Trade marks	Marks used to distinguish certain goods as those produced by a specific enterprise.
Service marks	Marks used to distinguish certain services as those provided by a specific enterprise.
Collective marks	Marks used to distinguish goods or services produced or provided by members of an association.
Certification marks	Marks used to distinguish goods or services that comply with a set of standards and have been certified by a certifying authority.
Well-known marks	Marks that are considered to be well-known in the market and as a result benefit from stronger protection.

What are service marks?

A **service mark** is very similar in nature to a trademark. Both are distinctive signs; trademarks distinguish the goods of one enterprise from those of others, while service marks fulfil the same function in relation to services. Services may be of any kind, such as financial, banking, travel, advertising or catering, to name a few. Service marks can be registered, renewed, cancelled, assigned and licensed under the same conditions as trademarks.

Example:



What are collective marks?

A **collective mark** is generally owned by an association or cooperative whose members may use the collective mark to market their products. The association generally establishes a set of criteria for using the collective mark (e.g., quality standards) and permits individual companies to use the mark if they comply with such standards. Collective marks may be an effective way of jointly marketing the products of a group of enterprises which may find it more difficult for their individual marks to be recognized by consumers and/or handled by the main distributors.

Example: The Melinda collective mark is used by the 5200 members of the 16 apple-producing cooperatives working in Valle di Non and Valle di Sole (Italy) who established the Melinda Consortium in 1989.



Courtesy: Melinda Consortium

What are certification marks?

Certification marks are given for compliance with defined standards, but are not confined to any membership. They may be used by anyone whose products meet certain established standards. In many countries, the main difference between collective marks and certification marks is that the former may only be used by a specific group of enterprises, e.g., members of an association, while certification marks may be used by anybody who complies with the standards defined by the owner of the certification mark.

An important requirement for certification marks is that the entity which applies for registration is considered "competent to certify" the products concerned.

Example: The Woolmark symbol is the registered trade (certification) mark of the Woolmark Company. The Woolmark is a quality assurance symbol denoting that the products on which it is applied, are made from 100% new wool and comply with strict performance specifications set down by the Woolmark Company. It is registered in over 140 countries and is licensed to manufacturers who are able to meet these quality standards in 65 countries.



Courtesy: The Woolmark Company

What are well-known marks?

Well-known marks are marks that are considered to be well-known by the competent authority of the country where protection for the mark is sought. Well-known marks generally benefit from stronger protection. For example, well-known marks may be protected even if they are not registered (or have not even been used) in a given territory.

In addition, while marks are generally protected against confusingly similar marks only if used for *identical or similar* products, well-known marks are protected against confusingly similar marks for even *dissimilar* products, if certain conditions are met. The main purpose of this stronger protection is to prevent companies from free-riding on the reputation of a well-known mark and/or causing damage to its reputation or goodwill.

Example: Let us assume that WONDERCOLA is the famous trademark of a soft drink. Wondercola Inc. would then benefit from automatic protection in those countries where well-known marks enjoy stronger protection and where the mark is well-known for soft drinks. The protection would also be available for unrelated goods and services. That is to say that if another company decides to market other products, ranging from T-shirts to sunglasses, using the WONDERCOLA mark, it will have to seek the authorization of Wondercola Inc. or risk being sued for infringement of trademark rights.

4. Using Trademarks

Can you register a trademark without having used it?

You may apply for registration before you have used the trademark but some countries will not officially register it until you have shown proof of use (e.g., the United States). Also, in most cases, a trademark that has not been used for a given period of time (generally three to five years) following registration may be taken off the trademark register. This means you could **lose** your rights in your trademark.

TM or ®?

The use of ®, TM, SM or equivalent symbols next to a trademark is not a requirement and generally provides no further legal protection. Nevertheless, it may be a convenient way of informing others that a given sign is a trademark, thus warning possible infringers and counterfeiters. The ® symbol is used once the trademark has been registered, whereas TM denotes that a given sign is a trademark; SM is sometimes used for service marks.

How should you use trademarks in advertising?

If your mark is registered with a specific design or font, make sure that the trademark is used exactly as it is registered. Monitor its use closely as it is crucial for the image of your company's products. It is also important to avoid using the trademark as a verb or noun so that it does not come to be perceived by consumers as a generic term.

Can your company use the same trademark for different products?

Different trademarks may be used for the different products lines of a company. Depending on its branding strategy, each company will decide whether to use the same trademark for its products, extending the brand every time a new product is released, or to use a different mark for each product line.

Extending an existing brand to new products enables the new product to benefit from the image and reputation of the mark. However, the use of a new mark, more specific and relevant to the new product, may also prove advantageous and enable the company to target the new product to a specific customer group (e.g. children, teenagers, etc.) or to create a specific image for the new product line. Many companies also choose to use a new brand in conjunction with an existing brand (e.g., NUTELLA® generally used with FERRERO).



NUTELLA® courtesy of Ferrero S.p.A.

Different companies adopt different strategies. Whatever your choice, you should make sure that your trademark is registered for all categories of goods and/or services for which it is, or will be, used.

What should be kept in mind when using trademarks on the Internet?

The use of trademarks on the Internet has raised a number of controversial legal problems with no easy or uniform solution. One important problem stems from the fact that trademark rights are territorial (that is, they are only protected in the country or region where the mark has been registered or used), whereas the reach of the Internet is global. This creates problems when it comes to settling disputes between persons or companies legitimately owning identical or confusingly similar trademarks for identical or similar goods or services in different countries. Legislation in this area is still developing and treatment may differ from one country to another.



What is a domain name and how does it relate to trademarks?

An important problem concerns the conflict between trademarks and domain names.

Domain names are Internet addresses, and are commonly used to find websites. For example, the domain name 'wipo.int' is used to locate the WIPO website at www.wipo.int.

Over time, domain names have come to constitute business identifiers thus often coming into conflict with trademarks. Often national laws, or courts, treat the registration of the trademark of another company or person as a domain name as trademark infringement, popularly known as cybersquatting. If this happens, then, your business may not only have to transfer or cancel the domain name, but it may also have to pay damages or a heavy fine. Therefore, it is important that you choose a domain name which is not the trademark of another company, particularly a well-known trademark.

In order to find out whether a particular trademark is already protected, you can directly contact the national or regional trademark offices, many of which operate Internet-searchable trademark databases. A list of such databases is available on WIPO's website at: www.arbiter.wipo.int/trademark/.

On the other hand, if the trademark of your company is being used in a domain name or is being cybersquatted by another individual or company then you may take action to stop such misuse/infringement of the rights of your company. In such a case, one option would be to use WIPO's very popular online administrative procedure for domain name dispute resolution at: www.arbiter.wipo.int/domains/. This WIPO website includes a model complaint as well as a legal index to the thousands of WIPO domain name cases that have already been decided.

Can you license your trademark to other companies?

Trademarks can be licensed to other companies. In such cases, the trademark owner retains ownership and merely agrees to the use of the trademark by one or more other companies. This is usually done on payment of royalties and involves the consent of the trademark owner, which is usually specified in a formal licensing agreement. Depending on the nature of the

agreement, the licensor often retains some degree of **control** over the licensee to guarantee that a certain quality is maintained.

In practice, trademark licenses are frequently granted within broader licensing agreements, for example, franchising agreements or agreements including the licensing of other intellectual property rights such as patents, know-how and some degree of technical assistance for the production of a given product.

What does a franchising agreement have to do with trademarks?

The licensing of a trademark is central to a franchising agreement. In franchising agreements the degree of control of the trademark owner over the franchisee is generally greater than is the case for standard trademark licensing agreements. In the case of franchising, the franchiser allows another person (the franchisee) to use his way of doing business (including trademarks, know-how, customer service, software, shop decoration, etc.) in accordance with a set of prescriptions and in exchange for compensation or royalty.

Example: A restaurant selling chicken meals operates under the trademark NANDO'S. It has developed a system for preparing and selling these products, which are sold in large volumes and in a uniform manner. The system includes various

factors that contribute to the success of NANDO'S restaurants, including recipes and methods of preparing meals that result in a product of consistent quality, the design of employees' uniforms, the design of the buildings, the design of packaging, and management and accounting systems. NANDO'S imparts its knowledge and experience to its franchisees and retains the right to supervise and control local franchises. As a crucial component of the franchising agreement the franchisees will also be authorized and obliged to use the NANDO'S trademark.



Courtesy: Nando's Group Holdings Ltd

Is there any restriction in selling or assigning the trademark of your company to another company?

It is increasingly possible to sell or assign a trademark independently from the business that currently owns it. In the case of sale or assignment of a trademark, it may be required to deposit a copy of the agreement, or parts of it, at the trademark office.

Do you need to register all small modifications to your trademark?

Many trademarks, including some of the most famous, have slightly changed or evolved over the years in order to modernize the image of a company or adapt to new advertising media. Marks may be changed or adapted, but your company will have to be careful and consult with the trademark office(s) concerned or a competent trademark agent as to whether a specific change will require the submission of a new application and payment of relevant fees.



1900



1904



1909



1930



1948



1955



1961



1971



1995



1999

©Shell

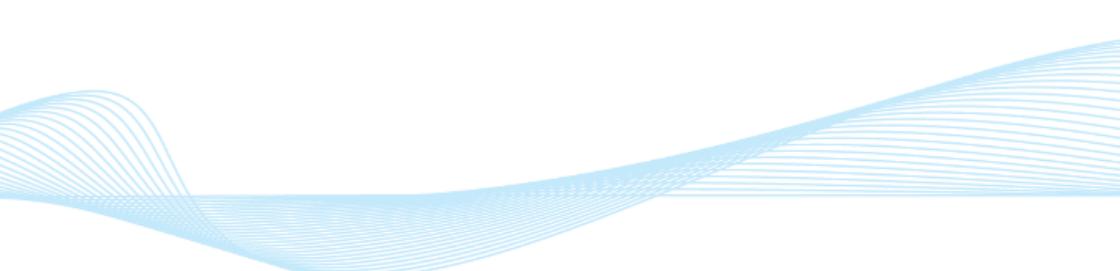
5. Enforcing Trademarks

What should your business do if its trademark is being used by others without authorization?

The burden of enforcing a trademark is mainly on the trademark owner. It is up to your company as a trademark owner to identify any infringement and to decide what measures should be taken to enforce trademark rights.

It is always useful to seek expert advice if you believe that someone is infringing your trademark. An intellectual property lawyer would be the right person to give you information on the existing options in your country and, presumably, also in neighboring countries to initiate action against counterfeiting and infringement and will provide you with advice on how to enforce your rights.

If you are faced with **infringement** of your trademark rights, then you may choose to begin by sending a letter (commonly known as a “cease and desist letter”) to the alleged infringer informing him/her of the possible existence of a conflict. In writing such a letter, the assistance of a trademark lawyer is recommended.



If your business considers the infringement to be **willful** and knows the location of the infringing activity, then it may wish to take surprise action by obtaining, with the help of a trademark lawyer, a search and seize order (usually, from a competent court or the police) to conduct a raid without prior notice to the allegedly offending company/person.

The infringer may be compelled by the judicial authorities to inform you of the identity of persons involved in the production and distribution of the infringing goods or services and their channels of distribution. As an effective deterrent to infringement, the judicial authorities may order, upon your request, that infringing goods and materials be destroyed or disposed of outside the channels of commerce without compensation of any sort.

In order to prevent the **importation of counterfeit trademark goods**, measures at the international border are available to trademark owners in many countries through the national customs authorities. As a trademark owner, your company may seek the assistance of the customs authorities at the border, that is, before the counterfeit goods have been distributed in the country concerned. The assistance of customs would generally

require payment of prescribed fees, for which you will have to contact the relevant customs authorities.

In some instances, an effective way of dealing with infringement is through **arbitration or mediation**. Arbitration generally has the advantage of being a less formal, shorter and cheaper procedure than court proceedings, and an arbitral award is more easily enforceable internationally. An advantage of mediation is that the parties retain control of the dispute resolution process. As such, it can help to preserve good business relations with another enterprise with which your company may like to collaborate in the future. For more information on arbitration and mediation, see the website of the WIPO Arbitration and Mediation Center at www.arbiter.wipo.int.

Annex I – Useful websites

For more information on:

- intellectual property issues from a business perspective
www.wipo.int/sme
- trademarks in general
www.wipo.int/about-ip
www.inta.org (International Trademark Association)
- the practical aspects relating to the registration of trademarks see Annex II or
www.wipo.int/directory/en/urls.jsp
- Madrid system for the International Registration of Marks
www.wipo.int/madrid
- International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement
www.wipo.int/classifications (under Nice Agreement)
- International Classification of the Figurative Elements of Marks under the Vienna Agreement
www.wipo.int/classifications (under Vienna Agreement)
- the conflict between trademarks and domain names and on alternative dispute resolution procedures for domain names
www.arbiter.wipo.int/domains
www.icann.org.

A list of the online trademark databases maintained by industrial property offices throughout the world is available at *www.arbiter.wipo.int/trademark*

ANNEX II - Internet Addresses

National and Regional Intellectual Property Offices

African Intellectual Property Organization	www.oapi.wipo.net
Algeria	www.inapi.org
Albania	www.alpto.gov.al
Andorra	www.omp.a.ad
Argentina	www.inpi.gov.ar
Armenia	www.armpatent.org
Australia	www.ipaustralia.gov.au
Austria	www.patent.bmvit.gv.at
Bahrain	www.gulf-patent-office.org.sa/bahrainframe.htm
Barbados	www.caipo.org
Belarus	www.belgopatent.org/english/about/history.html
Belgium	www.mineco.fgov.be
Belize	www.belipo.bz
Benelux	www.boip.int
Benin	www.oapi.wipo.net
Bolivia	www.senapi.gov.bo
Botswana	www.aripo.org
Brazil	www.inpi.gov.br
Bulgaria	www.bpo.bg
Burkina Faso	www.oapi.wipo.net
Burundi	www.oapi.wipo.net
Cambodia	www.moc.gov.kh
Cameroon	www.oapi.wipo.net
Canada	www.opic.gc.ca
Central African Republic	www.oapi.wipo.net
Chad	www.oapi.wipo.net
Chile	www.dpi.cl
China	www.sipo.gov.cn
China (Hong Kong -SAR)	www.ipd.gov.hk
China (Macao)	www.economia.gov.mo
China (Marks)	www.saic.gov.cn
Colombia	www.sic.gov.co
Congo	www.oapi.wipo.net
Costa Rica	www.registracional.go.cr



Côte d'Ivoire	www.oapi.wipo.net
Croatia	www.dziv.hr
Cuba	www.ocpi.cu
Cyprus	www.mcit.gov.cy/mcit/drcor/drcor.nsf
Czech Republic	www.upv.cz
Democratic Republic of the Congo	www.oapi.wipo.net
Denmark	www.dkpto.dk
Dominican Republic	www.seic.gov.do/onapi
Egypt	www.egypo.gov.eg
El Salvador	www.cnr.gobs.sv
Estonia	www.epa.ee
Eurasian Patent Office	www.eapo.org
European Union (Office for Harmonization in the Internal Market – OHIM)	www.oami.eu.int
Finland	www.prh.fi
France	www.inpi.fr
Gabon	www.oapi.wipo.net
Gambia	www.aripo.org
Georgia	www.sakpatenti.org.ge
Germany	www.dpma.de
Ghana	www.aripo.org
Greece	www.obl.gr
Honduras	www.sic.gob.hn/pintelec/indice.htm
Hungary	www.mszh.hu/english/index.html
Iceland	www.patent.is/focal/webguard.nsf/key2/indexeng.html
India	www.ipindia.nic.in
Indonesia	www.dgip.go.id
Ireland	www.patentsoffice.ie
Israel	www.justice.gov.il
Italy	www.uibm.gov.it
Jamaica	www.jipo.gov.jm
Japan	www.jpo.go.jp
Jordan	www.mit.gov.jo
Kazakhstan	www.kazpatent.org/english
Kenya	www.aripo.org
Kuwait	www.gulf-patent-office.org.sa
Lao People's Democratic Republic	www.stea.la.wipo.net

Latvia	www.lrpv.lv
Lebanon	www.economy.gov.lb
Lesotho	www.aripo.org
Liechtenstein	www.european-patent-office.org
Lithuania	www.vpb.lt
Luxembourg	www.etat.lu/ec
Malawi	www.aripo.org
Malaysia	www.mipc.gov.my
Mali	www.oapi.wipo.net
Mexico	www.impi.gob.mx
Monaco	www.european-patent-office.org/patlib/country/monaco
Montenegro	www.yupat.sv.gov.yu
Morocco	www.ompic.org.ma
Mozambique	www.aripo.org
Namibia	www.aripo.org
Nepal	www.ip.np.wipo.net
Netherlands	www.octroicentrum.nl
New Zealand	www.iponz.govt.nz
Niger	www.oapi.wipo.net
Norway	www.patentstyret.no
Oman	www.gulf-patent-office.org.sa
Panama	www.digerpi.gob.pa
Peru	www.indecopi.gob.pe
Philippines	www.ipophil.gov.ph
Poland	www.business.gov.pl/Intellectual,property,protection,90.html
Portugal	www.inpi.pt
Qatar	www.gulf-patent-office.org.sa
Republic of Korea	www.kipo.go.kr
Republic of Moldova	www.agepi.md
Romania	www.osim.ro
Russian Federation	www.rupto.ru
Saint Vincent and the Grenadines	196.1.161.62/govt/cipo/index.asp
Saudi Arabia	www.gulf-patent-office.org.sa
Senegal	www.oapi.wipo.net
Serbia	www.yupat.sv.gov.yu
Sierra Leone	www.aripo.org
Singapore	www.ipos.gov.sg



Slovak Republic	www.indprop.gov.sk
Slovenia	www.uil-sipo.si/Default.htm
Somalia	www.aripo.org
South Africa	www.cipro.gov.za
Spain	www.oepm.es
Sudan	www.aripo.org
Swaziland	www.aripo.org
Sweden	www.prv.se
Switzerland	www.ige.ch
Syrian Arab Republic	www.himaya.net
Tajikistan	www.tipat.org
Thailand	www.ipthailand.org
The Former Yugoslav Republic of Macedonia	www.ippo.gov.mk
Togo	www.oapi.wipo.net
Trinidad and Tobago	www.ipo.gov.tt/home.asp
Tunisia	www.inorpi.ind.tn
Turkey	www.turkpatent.gov.tr
Turkmenistan	www.eapo.org
Uganda	www.aripo.org
Ukraine	www.sdip.gov.ua
United Arab Emirates	www.gulf-patent-office.org.sa
United Kingdom	www.patent.gov.uk
United Republic of Tanzania	www.aripo.org
United States	www.uspto.gov
Uruguay	www.dnpi.gub.uy
Uzbekistan	www.patent.uz
Venezuela	www.sapi.gov.ve
Yemen	www.most.org.ye
Zambia	www.aripo.org
Zimbabwe	www.aripo.org

Note:

For up-to-date information visit website at the following urls: www.wipo.int/members/en/ and www.wipo.int/directory/en/urls.jsp

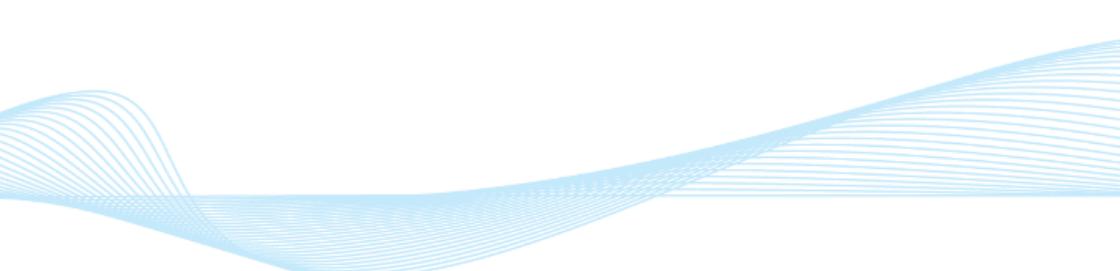
Annex III – Nice Classification

International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement

Goods

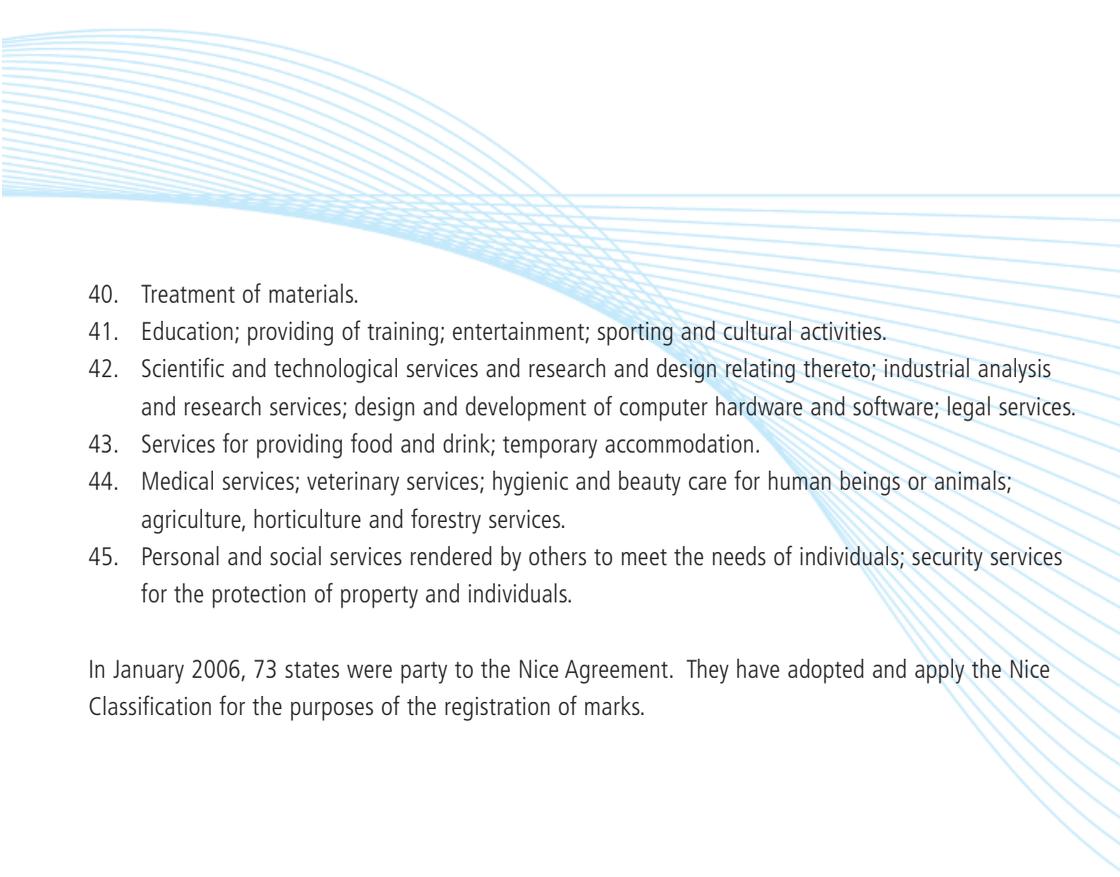
1. Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordents; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrice.
4. Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
5. Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
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.
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.
8. Hand tools and implements (hand-operated); cutlery; side arms; razors.
9. Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, 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; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.
10. Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
 11. Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
 12. Vehicles; apparatus for locomotion by land, air or water.
 13. Firearms; ammunition and projectiles; explosives; fireworks.
 14. Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, precious stones; horological and chronometric instruments.
 15. Musical instruments.
 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.
 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.
 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, parasols and walking sticks; whips, harness and saddlery.
 19. Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.
 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.
 21. Household or kitchen utensils and containers (not of precious metal or coated therewith); 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.

- 
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.
 23. Yarns and threads, for textile use.
 24. Textiles and textile goods, not included in other classes; bed and table covers.
 25. Clothing, footwear, headgear.
 26. Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
 27. Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
 28. Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
 29. Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
 30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
 31. Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.
 32. Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
 33. Alcoholic beverages (except beers).
 34. Tobacco; smokers' articles; matches.

Services

35. Advertising; business management; business administration; office functions.
36. Insurance; financial affairs; monetary affairs; real estate affairs.
37. Building construction; repair; installation services.
38. Telecommunications.
39. Transport; packaging and storage of goods; travel arrangement.

- 
40. Treatment of materials.
 41. Education; providing of training; entertainment; sporting and cultural activities.
 42. Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.
 43. Services for providing food and drink; temporary accommodation.
 44. Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
 45. Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

In January 2006, 73 states were party to the Nice Agreement. They have adopted and apply the Nice Classification for the purposes of the registration of marks.

Note:

For up-to-date information, visit website at the following urls: www.wipo.int/classifications/fulltext/nice8/enmain.htm and www.wipo.int/madrid/en/contact.html

Annex IV

Members of the Madrid Union

(As of January 2006)

Albania (A&P)	Greece (P)
Algeria (A)	Hungary (A&P)
Antigua and Barbuda (P)	Iceland (P)
Armenia (A&P)	Iran (Islamic Republic of) (A&P)
Australia (P)	Ireland (P)
Austria (A&P)	Italy (A&P)
Azerbaijan (A)	Japan (P)
Bahrain (P)	Kazakhstan (A)
Belarus (A&P1)	Kenya (A&P)
Belgium* (A&P)	Kyrgyzstan (A)
Bhutan (A&P)	Latvia (A&P)
Bosnia and Herzegovina (A)	Lesotho (A&P)
Bulgaria (A&P)	Liberia (A)
China (A&P)	Liechtenstein (A&P)
Croatia (A)	Lithuania (P)
Cuba (A&P)	Luxembourg* (A&P)
Cyprus (A&P)	Monaco (A&P)
Czech Republic (A&P)	Mongolia (A&P)
Democratic People's Republic of Korea (A&P)	Montenegro (A&P)
Denmark (P)	Morocco (A&P)
Egypt (A)	Mozambique (A&P)
Estonia (P)	Namibia (A&P)
European Community (P)	Netherlands* (A&P)
Finland (P)	Norway (P)
France (A&P)	Poland (A&P)
Georgia (P)	Portugal (A&P)
Germany (A&P)	Republic of Korea (P)

Republic of Moldova (A&P)
Romania (A&P)
Russian Federation (A&P)
San Marino (A)
Serbia (A&P)
Sierra Leone (A&P)
Singapore (P)
Slovakia (A&P)
Slovenia (A&P)
Spain (A&P)
Sudan (A)
Swaziland (A&P)
Sweden (P)

Switzerland (A&P)
Syrian Arab Republic (A&P)
Tajikistan (A)
The former Yugoslav Republic of Macedonia (A&P)
Turkey (P)
Turkmenistan (P)
Ukraine (A&P)
United Kingdom (P)
United States of America (P)
Uzbekistan (A)
Viet Nam (A)
Zambia (P)

(A) indicates a party to the Agreement

(P) indicates a party to the Protocol

* Protection may not be requested separately for Belgium, Luxembourg or the Netherlands, but only for all three countries as a whole (Benelux), subject to payment of a single complementary or individual fee.

Note :

For up-to-date information, visit website at the following url: www.wipo.int/madrid/en/members/

For more information contact the
World Intellectual Property Organization

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