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## **GENERAL ASPECTS**

### **WHAT IS A TRADE MARK?**

We understand by mark any sign that can be represented graphically and which is used to differentiate in the market products or services from different companies.

The mark is a market tool, which allows consumers to identify and recognise the products and services offered by a certain trader.

Mark legislations in the different countries determine specifically the signs that may or may not be a mark. In most countries, the mark must fulfil two requirements in order to obtain a valid registration:

- Having a distinctive power and
- Being graphically representable.

### **WHAT SIGNS CAN CONSTITUTE A MARK?**

The following signs can be protected as a mark:

- Words or word combinations.
- Images, figures, symbols, graphics and drawings.
- Letters, numbers and their combinations.
- Three-dimensional forms, including wrappings, packages and the shape of the product and its presentation.
- Colour or a combination of colours.
- Signs perceived by the senses (sound, smell, taste and touch), as long as they overcome the obstacle of the graphic representation requirement.
- Any combination of the aforementioned signs.

### **WHAT IS A MARK FOR?**

The main function of marks is to identify the commercial origin of the products or services they refer to.

The mark also passes on to the consumers the idea that all products or services identified with the same mark are provided with the same quality and, therefore, are superior or inferior to other products or services of the same kind.

The main aim for the holder of a mark is that this mark reaches goodwill in the market. Goodwill presupposes the preference that consumers will grant to the products or services provided with this mark.

### **WHY IS IT ADVISABLE TO PROTECT A MARK?**

Taking into consideration the important amounts of money invested to create a mark (naming), and for the advertising and promotion of products and services (marketing) identified with it,

the non-authorized use of the mark would entail an important damage of the rights, business and prestige of the legitimate owner.

Hence the importance of giving the necessary protection to marks.

The only effective way for the company to protect the asset represented by the mark is registration.

The registration of the mark provides the holder with the exclusive right to use it and with an effective protection against copy, imitation, misappropriation, forgery of the mark or use of its reputation.

Submitting an application for a mark and its registration legitimises the holder of the mark to carry out the necessary legal actions against those who commit misappropriation of the sign or use the sign without the holder's consent.

Likewise, it is important to protect the mark in accordance with the business and economic attraction it represents for the holder, who will be able to make deals and investments or obtain credits with the support of the commercial value of the mark or the potential future benefits.

### WHAT SORT OF MARKS ARE THERE?

There are different sorts of marks:

#### I. DEPENDING ON THE SIGN THAT CONSTITUTES THE MARK

##### Denominative marks

Marks that identify a product or service with one or more words. They must be phonetically distinguishable from other products or services of the same sort.

Example\*:

NIKE	MERCEDES - BENZ	Mc DONALD'S
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**\* All marks are Registered Trade Marks**

##### Graphic marks

Marks made of figures, drawings or logotypes which differentiate visually a mark. They are distinctive figures that cannot be recognised phonetically or auditorily, but only visually.

Example\*:

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**\* All marks are Registered Trade Marks**

##### Mixed marks

They are the result of the combination of two or more signs of different kind. They are generally combinations of words with drawings, designs or logotypes.

Example\*:

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**\* All marks are Registered Trade Marks**

**Three-dimensional marks**

It includes objects represented in three dimensions, such as packages, wrappings, bottles, boxes.

Example\*:

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**\* All marks are Registered Trade Marks**

**II. DEPENDING ON THEIR POPULARITY**

**Common marks**

All signs that identify in the market certain products or services but that do not enjoy a significant or relevant popularity among consumers.

Example\*:

Zttrike	Lotdun	Khex	Landic
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**Well-known marks**

It refers to marks that are known by the general public. Besides, for a mark to be considered well-known, there must be a generalised opinion that the products or services under that mark are top-quality products or services.

Example\*:

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**\* All marks are Registered Trade Marks**

The well-known mark imposes itself to the principle of speciality of marks, therefore, the use by third parties of the marks Coca-Cola, Rolex and Ferrari will not be allowed, even it is about distinguishing products or services which are not directly related to the products or services included under the well-known mark.

Some legislations distinguish as well **Renowned marks**: those which thanks to the turnover of products or services they include, the intensity or geographic scope of their use, the assessment or prestige reached in the market or any other cause, are generally well-known by the specific sector of the public to which the products or services under that mark are directed to.

**III. DEPENDING ON THE HOLDER**

**Individual marks**

Those that are exclusively held by a specific individual or legal entity.

Example\*:

www.ipr-helpdesk.org  
ipr-helpdesk@ua.es

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**\* All marks are Registered Trade Marks**

**Collective marks**

Those marks registered by an association that wants to differentiate the products or services of its members from those of the persons who do not belong to the association. The holder of the mark is the association and there are several persons who are members of the association and are authorised to use the mark.

Example\*:

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**\* All marks are Registered Trade Marks**

**IV. DEPENDING ON THE OBJECT THEY REPRESENT**

**Product marks**

Signs that only represent products.

Example\*:

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**\* All marks are Registered Trade Marks**

**Service marks**

Signs used to represent services offered by a specific individual or legal entity.

Example\*:

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**\* All marks are Registered Trade Marks**

**Guarantee marks**

Those that guarantee common characteristics, especially the quality, the components and the origin of the products produced or distributed or the services offered by individuals or legal entities who are duly authorised and monitored by the holder of the mark.

Example\*:

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**\* All marks are Registered Trade Marks**

## V. DEPENDING ON THE SENSE THAT PERCEIVES THEM

### Smell marks

Those that are made up of a smell. The smell must be so characteristic and distinctive that it cannot be mistaken or associated with another. For instance, a cherry smell mark for lubricants. The main obstacle for the registration of a smell mark is to fulfil the requirement of graphic representation.

### Sound marks

Those signs that are perceived by the hearing sense. There are signs that are distinguishable by their distinctive and exclusive sound. The main obstacle for the registration of a sound mark is to fulfil the requirement of graphic representation.

### Taste marks

Those made up by the signs perceived by the taste sense. Although there is no taste mark registered nowadays, there is a possibility that at some point the registration of this sort of mark will be accepted. Their main obstacle is to fulfil the requirement of the graphic representation of the mark.

### Touch marks

Signs that are perceived by the touch sense. Like taste marks, there is no registered touch mark yet. Their main obstacle is the requirement of the graphic representation of the mark.

## REGISTRATION

### HOW CAN THE RIGHT TO A TRADE MARK BE OBTAINED?

The right to a trade mark may be obtained in two ways:

#### 1) By use:

The right to a mark belongs to whoever uses a specific sign for the first time in an effective way to designate products or services on the market.

[Some legislation](#) includes the protection of non-registered marks if they have a certain popularity in the market and are recognised by consumers.

#### 2) By registration:

The creation of the exclusive right to a mark is obtained by registering the sign at a Mark Office.

Through registration, the holder obtains the right to exclusive use of the mark, as well as the right to forbid third parties to use identical or similar signs.

The protection granted by the registration of a mark is broader than the protection conferred by its simple use. Hence, the enforcement options associated with a trade mark are more effective because it is easier to prove who the holder is.

## WHEN IS IT FORBIDDEN TO REGISTER A MARK?

### 1. Absolute prohibitions

There are certain circumstances that make a mark inappropriate to operate in the market and prevent their access to registration.

The following signs can never be registered as a mark:

1. **Signs that cannot be represented graphically.**
2. **Signs that have no distinctive nature; that is, they cannot differentiate one product or service from another.**
3. **Marks made up exclusively of signs that have become usual or common to designate the products or services they refer to.**

Example: the word INTERNET cannot be registered for computer network services.

4. **Marks made up exclusively of signs used in trade to designate a sort, the quality, quantity, destination, value, geographic origin or the time of production of the product or the provision of the service, or any other feature of the product or service.**

Therefore, one cannot register names such as "extra" or "supreme" or geographical names to differentiate products or services from the area designated by the mark.

The prohibitions included in sections b) and d) will not be applied if the marks implied have acquired, for the products or services they want to register, a distinctive character as a result of the use of the mark. This happens when, as a result of intense use in trade, advertising, etc., the mark reaches such a degree of popularity among consumers that they identify fully and without mistake the product or the service. Example: TETRAPACK.

5. **Marks that consist of a shape imposed by the nature of the product, which is necessary to obtain the technical result or which gives a substantial value to the product or service.**

This includes three different prohibition cases that refer to three-dimensional marks.

With the first prohibition (shapes imposed by the nature of the product), the aim is to avoid the protection as a mark of common or generic simple shapes of products.

For example: the common shape of a toothbrush.

The second prohibition refers to the necessary shape to obtain a technical result. In this case, the aim is to prevent the protection with a mark right of a shape whose aim is to obtain technical advances in relation to the previous product, that is, a formal change that should be protected by a patent or utility model.

Example: the hexagonal shape of a screw head.

The third prohibition concerning the shapes that give a substantial value to the product wants to prevent the protection with a mark right of a three-dimensional form that has all the characteristics and is aimed at fulfilling the function of an industrial design.

For example:



**6. Marks made up of signs against the law, public order or good manners.**

For instance, those supporting terrorism or including degrading or racist names.

**7. Marks made up of signs that may lead the public into error, for example, about the nature, the quality or geographic origin of the product or service.**

This includes misleading signs that provide erroneous information about the products or services that want to be registered and can create confusion among consumers about the nature or the origin of the products or services it designates;

Example: Bordeaux for all sorts of wine.

**8. Marks that reproduce or imitate the name, coat of arms, flag, medals or other symbols of the countries or intergovernmental organisations.**

The aim is to prevent a company from using the signs that are a symbol of the state. However, they can be part of a mark but always as a secondary element.

Example:



**2. Relative prohibitions**

Relative prohibitions are addressed to the protection of third persons' previous rights that could be affected by the registration of the subsequent mark. For its application, it is necessary for the priority holder to present his objection.

**- Existence of a previous mark.**

A mark cannot be registered:

1. When it is identical to a previous mark and the products or services for which the mark is applied for or registered are identical to those protected under the previous mark;  
Example: trying to register the mark Mc Donald's for food when a mark Mc Donald's for food is already registered.

2. When, because it is identical or similar to the previous mark and the products or services under both marks are identical or similar, there is a risk of confusion among the public. The risk of confusion also includes the risk of association with the previous mark.

Example: trying to register the mark LAKOSTEE for shoes when there is a registration for a mark LACOSTE for clothes.

3. When it is identical or similar to a previous mark that is renowned or well-known, even if the products or services the mark designates are different to the ones designated by the previous mark.

Example: trying to register the mark NIKE for cars.

**- Existence of an Intellectual or Industrial Property right different from the mark.**

No mark registration is possible of literary or artistic creations protected by copyright (for instance, a slogan or a drawing) or of creations protected by an industrial property right (for instance, an industrial design).



**- Existence of a non-registered mark or another previous distinctive sign.**

The registration of a mark will not be possible when there are previous rights protecting a non-registered mark or another distinctive sign used in trade.

**- Existence of right related to personality.**

No mark registration is possible of a name, surname or any other sign related to the own image of an individual, registered name, trade name or designation of a legal entity different from the person applying without their consent. The aim is to prevent the exploitation of other persons' name and image.

**- Agent mark.**

The agent or representative of a third person who is the holder of a mark in a member state of the Union Agreement of Paris or of the World Trade Organisation cannot register the same mark under his own name without the consent of the holder.

**WHAT TERRITORY IS COVERED BY THE PROTECTION OF MY MARK?**

The protection of the mark covers the geographic territory of the country or community where its protection is requested.

Therefore, depending on the territory, the mark can be a:

1. National mark. Valid only in the country where it has been requested in accordance with [national legislations](#).
2. Community mark. Single register granted by the Office for Harmonization in the Internal Market ([OHIM](#)), valid for the whole territory of the European Union regulated by the [Regulation CE 40/94](#) on the community mark.
3. International mark. Protection granted by the World Intellectual Property Organization ([WIPO](#)), in accordance with the [Madrid Agreement](#) (1891, act in force: Stockholm 1967) and with the [Madrid Protocol](#) (1989), to the signatory countries of the treaty. It does not consist of a single mark but of a group of national marks with a common application procedure.

**WHAT DOCUMENTS DO I HAVE TO SUBMIT?**

In order to proceed to the registration of a mark, you need to submit an application form addressed to the [competent organization](#) and indicating the following data:

- Holder or holders details.
- Representation of the mark exactly as you want it registered
- Products and/or services the mark is going to identify in accordance with the [International Directory](#).
- Receipt of payment of the required fee.
- Other documents (depending on the requirements of the competent organization):
  - Authorization of the representative
  - Priority certificate
  - Company incorporation
  - Consent declaration

### HOW MUCH DOES IT COST TO REGISTER A TRADE MARK?

For the acquisition, defence and maintenance of the trade mark, competent organizations require the payment of [a fee](#), which varies depending on the service.

### WHAT RIGHTS ARE GRANTED BY THE REGISTRATION OF THE MARK?

The exclusive rights granted by the registration of the mark consist of the following faculties:

- Right of exclusive use of the mark in the market, and in particular:
  - To designate with the mark the corresponding products and services.

- To use the mark for advertising purposes.

- To prevent non-authorized third parties from using an identical or similar mark for products or services similar to the ones under the registered mark.
- To prevent by administrative proceedings the registration of marks that can be confused with you own.
- To request before the Courts the cancellation of subsequent marks that become confused with yours.
- To transfer, sell, licence the mark as any other asset of the company.

#### Limits of the mark rights

Although it is true that the registration of the mark grants the holder the faculty to prohibit the use of the mark by third parties, this faculty has some limitations.

The holder of a mark cannot prohibit:

- The use of a mark by a third person when it is necessary to indicate the destination of the product or service, such as accessories or spare parts.
- The use by a third person of the name and address.
- The use of indications related to the sort, quality, quantity, destination, value, geographic origin, the time of obtaining of the product or offering of the service or other characteristics, as long as this use is in good faith (according to honest uses in industry and trade).
- The use of a previous right of local scope (when that right is recognised by the relevant national laws).

### HOW MUCH DOES THE EXCLUSIVITY RIGHT GRANTED BY THE MARK LAST?

In most countries, the registration of a mark lasts 10 years, which are renewable indefinitely for 10-year periods.

[Duration of the registration in different countries](#)

### WHAT IS THE PROTECTION SYMBOL OF A REGISTERED TRADE MARK?

The symbol # is the sign commonly used to show consumers that the mark has been registered.

In order to identify that a mark has been registered, EU countries identify registered signs with the symbol mentioned or with the following captions:

www.ipr-helpdesk.org  
ipr-helpdesk@ua.es

- **Ireland:** Registered trade mark N#
- **Italy:** Marchio registrato, Marchio reg. or #
- **Sweden:** Registrerat Varum#rke or #
- **Portugal:** "Marcas registrada", the letters "MR" or #
- **United Kingdom:** Registered Trade Mark or #
- **Austria:** Registrierte Marke or #
- **Finland and Benelux countries:** #
- **Germany:** Eingetragene Marke or #
- **Denmark:** Indreg. Varemaerke or #
- **Spain:** "Marcas Registradas" or MR
- **France:** Marques d#pos#es
- **Greece:** The Registered Mark caption in Greek

#### IS IT COMPULSORY TO USE THE TRADE MARK?

Most national legislations regulate the principle of the trade mark use. In accordance with that principle, the holder of a trade mark must use the mark in trade in a real and effective way.

The [European Directive 89/104](#) stipulates that the holder of the trade mark must "...make an effective use of the mark in the Member state in question, for the products or services for which it has been registered...".

Although the directive does not give a precise definition of the concept "effective use", it is assumed that that concept includes at least bringing to the market products and services, in a way that the simple preparation to bring them to the market will not be considered an effective use.

The use of the trade mark must not be confused with its commercial success, as the only thing that matters is the use of the mark as a distinctive sign.

Likewise, the required "effective use", will have to be made in relation to the products and services for which the mark has been registered.

##### a) Use by the Holder

It is normally the holder who makes use of the mark. However, there are many other ways to use a mark.

The [Directive](#) considers that the holder is making an effective use in the following cases:

- The use of the mark in a way that it differs in elements that do not alter the distinctive character of the mark in the form under which it has been registered;
- Using the community mark in products or their presentation in the Member state in question only for exportation purposes.

##### b) Use by an Authorised Third Person

Often, the holders of a trade mark grant its use to a third person, especially by means of a [licence](#).

According to that, if a third person, with the holder's consent, is the one who uses the mark, that use will be enough to fulfil the obligation of effective use of the mark required by the [Directive](#).

## ARE THERE ANY SANCTIONS FOR NOT USING A TRADE MARK?

The holder of a registered trade mark who is not using it is preventing third persons from using the sign used as a mark. In order to prevent this from happening, the directive establishes certain sanctions in case of "non-use" of the trade mark.

### a) Expiry

The main sanction for the cases of "non-use" of the mark is the expiry of the registration. The expiry of a mark will be declared if the mark has not been used for an uninterrupted five-year period with no justified causes. (Article [12](#) of the Directive).

### b) Impossibility of Objection

Another sanction in case of "non-use" of the mark, is the impossibility to use objection against the registration of new marks.

That is, if a registered trade mark has not been "used effectively" in trade, this mark can never be invoked to object to a registration or to apply for the cancellation of the registration of a subsequent mark (Article [11](#) of the Directive).

## TOLERANCE OF THE USE OF A SUBSEQUENT MARK

When the holder of a registered trade mark tolerates for some time (normally five years) the use of a subsequent mark, he cannot apply for the cancellation of that mark nor prevent its use by the holder, unless he has acted in bad faith.

This provision was created to guarantee the highest security for the new applicant who wants to exploit a mark and, at the same time, to ask mark holders for some diligence in the defence of marks.

The limitations to mark rights, as a consequence of tolerance, depend on the behaviour of the previous mark holder as well as the subsequent mark holder. The limitations will become effective if the previous holder *tolerates* the use of the subsequent mark and if the holder of the latter does not act in *bad faith*.

### a) Tolerance Conduct

This conduct can only come from the previous mark holder, who tolerates the use of the mark even if aware of it. It must be for an uninterrupted five-year period.

This concept only affects registered trade marks, whether they are [National](#), [International](#) or [Community marks](#).

### b) Absence of Bad Faith

The limitations of the mark rights in the case of tolerance, will only become effective if the subsequent mark has not been applied for in bad faith.

Bad faith has to be assessed in relation to the moment when the registered mark application was submitted.

Problem: the Directive does not define, in any of its provisions, the concept of "bad faith", which can provoke many interpretations.

## HOW CAN A MARK OWNED BY A THIRD PERSON BE USED?

Marks can be the object of different sorts of contracts, some of them used to authorise third parties for the use of the protected sign.

### a) Cession of a mark

Like patents, the mark is an exclusive right that can be the object of legal deals, including cession.

Cession can be total or partial; there is no restriction concerning the products or services that can be included under the mark, nor concerning the way in which the mark has to be used (in time as well as in space).

For the cession of a mark to be effective for third parties, most countries require the cession to be carried out in writing and that the change of ownership is recorded at the relevant marks register.

### b) Mark Licence

The mark licence is the contract by which the holder of a trade mark gives to a third person the right to exploit the mark in exchange of an economic consideration. The licence can be exclusive or not, granting it for the whole or part of the products and services, and for the whole country of part thereof.

The mark licence must be agreed upon in writing and normally its registration is necessary.

### c) Other Contracts

The mark can also be the object of a mortgage, bond or other real property rights, the object of seizure or other measures resulting from an enforcement procedure.

## WHAT CIRCUMSTANCES PROVOKE THE CANCELLATION OF MY MARK?

A mark can be cancelled for the following reasons:

### a) Expiry

- Non-renovation of the mark registration.
- Resignation of the mark holder: it must be in writing and submitted to the relevant marks organisation.
- [Lack of effective use](#) of the mark during an uninterrupted five-year period for the products or services for which it has been registered.
- Vulgarisation of the mark: it happens when the mark becomes the common designation of the products or services it designates.
- When the mark, as a consequence of the used made of it by the holder or with his consent, may lead the public into error about the nature, quality or geographic origin of the products or services it designates.
- Most of the expiry causes mentioned are regulated in most national mark legislations.

### b) Nullity

- For registering the mark by infringing the absolute or relative prohibitions of registration.



## TRADE MARKS GUIDE

[www.ipr-helpdesk.org](http://www.ipr-helpdesk.org)  
[ipr-helpdesk@ua.es](mailto:ipr-helpdesk@ua.es)

- When the application is made in bad faith.