



**WEBINARS ON
TRADE MARKS**

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ANSWERS TO SELECTED QUESTIONS

WEBINAR SERIES ON TRADE MARKS

Latest Developments in the Protection of Non-Traditional Trade Marks (23 June 2020)

Examination of Non-Traditional Trade Marks (25 June 2020)

Measures to Prevent Bad Faith Registrations And Protection of Well-Known Marks (29 June 2020)

<p>What is the difference between (a) industrial design and 3D mark and (b) a hologram and a 3D mark?</p> <p>Is there any advantage to registering a design as a 3D mark rather than as an industrial design?</p>	<p>Industrial design pertains to the aesthetic or ornamental aspect of a product while a shape or 3D mark is associated with goods or services. A 3D mark pertains to the shape, including that of the container or packaging, or the product itself while a hologram consists of holographic elements.</p> <p>A registered industrial design can be protected for up to a maximum of 25 years in Europe while marks, including 3D or shape marks, can be protected perpetually for as long as registration is renewed every 10 years and the mark is continued to be used in commerce to identify the products to which it refers. However, the protection of a design can be stronger in the sense that there is no need to prove likelihood of confusion if it is infringed, unlike in the case of trade mark infringement.</p>
<p>How can a mark that is not inherently distinctive show distinctiveness acquired through use?</p>	<p>One way to establish acquired distinctiveness is a relevant amount of use, consumer surveys, advertising, proof on the degree of recognition of the mark and its use on the part of consumers. We know for instance that certain shapes are famous because they have been used consistently for a long time. The more evidence of use in various advertising channels, product displays, among others can be used to show acquired distinctiveness. Strict guidelines have been enacted by IP Offices to ensure that evidence of acquired distinctiveness or secondary meaning is provided both to register a mark in several instances as well as to prevent the mark from being cancelled once it has been registered and is in use.</p>
<p>What tools are used by trade mark examiners in their examination of non-traditional trade marks? Is there a database that contains sound marks? Is there an examination guide for non-traditional trade marks in the EU?</p>	<p>The tools used by trade mark examiners in their examination of non-traditional trade marks are, to a large extent, the same tools they use for the examination of all forms of marks. These are trade mark databases, such as TMview, which contains information trade marks from European and non-European countries. Non-traditional trade marks, including sound marks, are all included in TMview, which is accessible here. However, the threshold to registered non-traditional trade marks is now higher than other marks in practice due to legitimate concerns to</p>

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	<p>market competition, and thus the more evidence an applicant can provide to prove acquired distinctiveness, use, and recognition as a mark on the part of the public, the better.</p> <p>Examiners at the EUIPO use the Guidelines for Examination of European Union Trade Marks. There are specific parts dealing with mark type and description of representation. There are also examples within the section on absolute grounds on descriptiveness and distinctiveness. The Common Practice on new types of marks currently being developed in collaboration with EU National IP Offices and users' associations will also be included in the guidelines. The guidelines can be accessed here.</p>
<p>If description is not mandatory in an application for a sound mark and only the mp3 is required, how can the examiners search for similar marks?</p>	<p>It is more difficult to provide a description for sounds marks today, as the nature of mark is the sound itself. However, in case there is a verbal element that is included as part of the sound, examiners generally introduce the verbal element in the mark field on the relevant databases so it can be searched. However, given that it is very difficult to transliterate the sound mark, there is no obligation to do this at this time. Obviously, marks still need to be described to the best of applicant's abilities and the mark needs to still comply with the requirement that it is "being represented ... 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."</p>
<p>How is a color mark represented? What are criteria applied in the examination of color marks? How can the distinctiveness of color marks be evaluated?</p>	<p>The colour must be shown and there has to be a colour code with it. Pantone colour codes are usually used. There shouldn't be any contours to the colour, i.e., it should not be in any shape (unless the application is for the colour combined with a specific shape).</p> <p>Colour marks, like shape marks, are the most difficult marks because they are both scarce and are used in many products. This becomes much more a burden for applicants to prove the distinctiveness of their mark. This is a fair trade-off so the applicant must show enough evidence to prove distinctiveness.</p> <p>A colour mark will be evaluated according to how specific it is, and the more specific, the better. The description is extremely strict, and the application must specify the</p>

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	<p>specific shade as applied to a specific type of product on a specific type of material. This is very important because to register colour with no point of reference is difficult because it creates a monopoly for an owner. Enforcement is also very difficult unless the colour is extremely specific.</p> <p>It can be a bit problematic when there many different shades of colour because of the difficulty of giving all the colour codes, but if a sufficient number of colour codes are given, it may be accepted. Colour marks are difficult to protect because they are not particularly distinctive, but it would depend on the goods and services because some colours can be distinctive when it comes to certain goods and services. Thus again, the more evidence an applicant can present of acquired distinctives through use, the better.</p>
<p>Does the EUIPO check for relative grounds of refusal for non-traditional trade mark examination or only for absolute grounds of refusal?</p>	<p>The EUIPO conducts examination of applications for all types of marks based on absolute grounds. If an opposition is filed to the registration of any mark, relative ground examination will then be undertaken.</p>
<p>What the requirements for registering multimedia trade marks (file format, length of video) and can an application be rejected based on audio similarity or based on the image only or both?</p>	<p>The EUIPO requires the submission of an audio-visual file to represent the multimedia mark as part of the application. The audio-visual file should be in MP4 format and may not exceed 8000 kbps and 20 MB. The application will be evaluated based on absolute grounds, and the similarity to prior marks will only be done in the event that an opposition to the registration of the mark is filed with the EUIPO.</p>
<p>Can a 3D shape registered in a country be refused in another jurisdiction on the ground of lack of distinctiveness?</p>	<p>Yes, trade mark registration is territorial in nature, and the registration in one jurisdiction is not persuasive in another. Trade mark registration is also highly dependent on the regulations, guidelines, and practice of a particular IP Office.</p>
<p>Will there be confusion in the minds of the public as to the origin or source of products if a domain name is registered as a trade mark?</p>	<p>Trade mark owners register their domain name as trade mark to better protect their trade mark rights online and prevent the use of a similar domain name that will likely cause confusion online. The registration of a domain name as trade mark requires that it meets the distinctiveness criterion.</p>
<p>Is there a relationship between patent and trade mark in the case of colour and scent marks in the sense that</p>	<p>No. Patent and trade mark are different IP rights. A patent is granted for an invention which is new, involves an inventive step, and is industrially applicable. A trade mark, on the other hand, distinguishes the goods or</p>

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<p>both colour and scent result from some chemical reaction?</p>	<p>services of an enterprise. The scent or colour mark, if distinctive, will be used to identify goods or services of the owner of the mark.</p>
<p>How can owners of non-traditional trade marks take legal action if it is difficult to define what part of the mark has been infringed?</p>	<p>A non-traditional mark that has been registered is presumed to have passed the distinctiveness threshold. The owner of a non-traditional trade mark whose rights have been infringed can take the same action that can be taken by the owner of any other type of mark.</p>
<p>Can the assessment of distinctiveness be subjective on the part of the trade mark examiner?</p>	<p>The examination of whether or not a mark is distinctive depends on the assessment of the examiner who is guided by the trade mark law and regulations and examination practice and guidelines, if available, of the IP Office.</p>
<p>How do you balance the protection well-known marks and the need to promote local brands?</p>	<p>There is no incompatibility in the protection of well-known marks and local brands. We need to protect well-known marks based on the law and because it is fair competition. The protection of well-known marks does not in any way affect the protection of local marks and the development of local industries because we do not want local businesses to copy marks that are already well-known. It benefits local industries to be innovative and to create and develop their own original brands, especially when the businesses expand and export their products in foreign markets.</p>
<p>Can bad faith be proven on account of non-use of a trade mark for at least three (3) years?</p>	<p>Bad faith can be proven based on a confluence of factors, which may include non-use by the trade mark owner without justifiable reasons for a considerable amount of time. Non-use by itself may not necessarily prove bad faith.</p>