

Trademark law

[Design](#)



Type of industrial property what does a trademark do? Provides protection to the owner of a mark by ensuring the exclusive right to use It to identify goods or services or to authorize another to use it in return for payment. Retention enforced by the Courts what kind of trademarks can be registered? Any consist of one or a combination of words, letters, numerals, drawings, symbol, three dimensional signs such as the shape and packaging of goods, audible signs or colors; three main types: simple (Dior, Channel, Pravda...), collective (Lughole) or certification mark (hallmark ; pure virgin wool). How is a trademark searched and registered? Redeemer search: even If It Is not required, It Is better to see If any mark has already been registered or applied for that is similar to your mark and used on related products or for related services. A complete search is one that will uncover all similar marks, not just those that are identical. Then, application for registration filed with the appropriate trademark office; application must contain: clear reproduction of the sign, list of goods and services to which the sign would apply. To be valid, a trademark must not infringe prior rights, not be deceptive or misleading (nature, quality, origin of goods or services), not constitute the necessary, generic or usual designation of the goods or services must be distinctive), not be contrary to public policy or morality. Examples of valid trademarks: shape of a lock for bags (Louis Button), drawing of a Scottish terrier for Jewels (Ghats), a D-shaped sign for glasses/ sunglasses (Dior). How extensive is a trademark protection? Almost all countries in the world register and protect trademarks; limited territorial Opposition, duration and renewal of trademarks under French law, third parties may use opposition proceedings to "oppose" the acceptance of a trademark application during two months after publication of the application;

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This is a litigation before the national trademark office concerned by the trademark; Such opposition proceedings can only be brought by certain earlier right holders, including owners of earlier registered or filed trademarks having effect in the same territory (France, EX.... , which are either identical to the trade mark application opposed and designate identical goods and services; or identical or similar to the trade mark application opposed and designate identical or similar goods and services provided that there is a likelihood of confusion on the part of the public.

If an opposition is defeated the trademark will proceed to registration.

Trademarks duration depends on the Country - Mainly 10 years renewed for further eroded of 10 years on payment of fees to the Trademark office concerned by the trademark; the sign cannot change by renewal; you renew exactly the same trademark or you fill another application for a new trademark. Seibel transfers of trademarks (license and assignment contracts) a trademark can be transferred totally or partially; a trademark may be assigned in whole or in part; written document and registered in the National register trademarks to have effect towards third party; a trademark may be the subject of a license to use; the license can be exclusive or non exclusive; it can be geographically limited. Science will pay some royalties to the licensor.

TRADEMARK INFRINGEMENT definition reminder: provides protection to the owner of a mark by ensuring the exclusive right to use it to identify goods or services or to authorize another to use it in return for payment as soon as a trademark is becoming fashionable, third parties try to reproduce it without any authorization. Trademark infringement is a violation of the exclusive

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rights attaching to a trademark without the authorization of the trademark owner or any licensees (provided that such authorization was within the scope of the license).

Infringement may occur when one party, the " infringer", uses a trademark which is identical or confusingly similar to a trademark owned by another party, in relation to products or services which are identical or similar to the products or services which the registration covers. An owner of a trademark may commence legal proceedings against a party which infringes its registration.

In many countries, (but not in the United States, which recognizes common law trademark rights), a trademark which is not registered cannot be " infringed" as such, and the trademark owner cannot bring infringement proceedings. Instead, the owner may be able to or under legislation which prohibits unfair business practices. Where the respective marks or products or services are not identical, similarity will generally be assessed by reference to whether there is a likelihood of confusion that consumers will believe the products or services originated from the trademark owner.

Preliminary injunctions A request for preliminary injunction can be accepted by the court if the owner can make probable the commitment of trademark infringement and can verify his fair and equitable interests concerning the cessation of the infringement. If the plaintiff has supported his claims to the satisfaction of the court, upon his request the defendant can be obliged by the court to present his documents, evidences, enable inspections on site or

to provide the plaintiff with financial, commercial and bank data, present documents thereof.

The right holder may request the court to order, under the conditions applicable to provisional measures: protective measures, if able to check that any subsequent attempt for the recovery of profits made by the infringement or the payment of damages is in jeopardy; the infringer to notify of and to present bank, financial or immemorial information and documents; possible to obtain accounting documents concerning the litigious goods in order to determine origin, nature, quantity of counterfeited goods. Tedious/counterfeited goods can be seized during infringement proceedings; the provision of security if, in exchange, the trademark proprietor agrees for the infringer to continue the alleged acts of infringement. The court upon the petition of the defendant may oblige the plaintiff to provide a security deposit before ordering the preliminary injunction. Elements of trademark infringement claim To prevail on a claim of trademark infringement, a plaintiff must establish that: 1. It has a valid mark entitled to protection; 2. He defendant used the same or a similar mark in commerce in connection with the sale or advertising of goods or services without the plaintiffs consent. 3. The plaintiff must also show that defendant's use of the mark is likely to cause confusion as to the affiliation, connection or association of defendant with plaintiff, or as to the origin, sponsorship, or approval of defendant's goods, services or commercial activities by plaintiff. Thus, "use," "in commerce," and "likelihood of confusion" are here distinct elements necessary to establish a trademark infringement claim.

Likelihood of confusion is not necessarily measured by actual consumer confusion, though normally one of the elements, but by a series of criteria Courts have established like similarity of the marks, proximity of the goods, defendant's intent in selecting the mark, type of goods and degree of care likely to be exercised by the purchaser. If the respective marks and products or services are entirely dissimilar, trademark infringement may still be established if the registered mark is well known pursuant to the Paris Convention.

In the United States, a cause of action for use of a mark for such dissimilar services is called trademark dilution (see after). In some Jurisdictions a party other than the owner (e. G. A licensee) may be able to pursue trademark infringement proceedings against an infringer if the owner fails to do so. The party accused of infringement may be able to defeat infringement proceedings if it can establish a valid exception (e. G. Comparative advertising) or defense to infringement, or attack and cancel the underlying registration (e. G. Or non-use) upon which the proceedings are based.

DAMAGES: If a trademark has been infringed upon, the plaintiff may be granted an injunction and monetary damages. An injunction ensures that the infringing party must stop using the trademark. The court may also seize/destroy the infringing goods. The plaintiff may also be awarded monetary damages depending on the case. The plaintiff can be awarded profits lost during the infringement period, or the profits wrongfully obtained by the infringer, which is decided upon which one is greater.

II. INDUSTRIAL DESIGNS What is an industrial design? An industrial design is that aspect of a useful article which is ornamental or esthetics. It may consist

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of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or color. This means that protection is given to the way a product looks. The appearance of your product may result from a combination of elements such as shapes, colors and materials.

Industrial designs are applied to a wide variety of products of industry and handicraft: from watches, jewelry, fashion and other luxury items, to industrial and medical instruments; from house ware, furniture and electrical appliances to vehicles and architectural structures; from practical goods and textile designs to leisure items, such as toys and pet accessories. An industrial design is primarily, if not exclusively, of an aesthetic nature; the actual design itself, as opposed to the article to which it is applied, cannot be dictated, at least solely or essentially, by technical or functional considerations.

In general, an industrial design must be reproducible by industrial means. Otherwise it would constitute a "work of art", prosecutable by copyright. By protecting an industrial design, the owner is ensured an exclusive right against its unauthorized copying or imitation by third parties. What rights are conferred by industrial design protection? When an industrial design is registered, the holder receives the right to prevent all unauthorized parties from making, selling or importing any product in which the design is incorporated or to which it is applied.

Because industrial design rights are territorial in nature, this right is limited to the territory for which the design is registered. Conditions and exceptions:

How can industrial designs be protected? In general, an industrial design must be registered in order to be protected under the industrial design law. A design may be two or three-dimensional based and shall present the shape the surface of the object, or part of it. A design or model shall only be protected if : - it is new I. E. N the date of the filing of the application for registration no identical design or model has been disclosed; (under some laws, " original"); it has individual character, I. E. If the overall visual impression it produces on the informed observer differs from that produced by any design or model disclosed before the date of the filing of the application for registration. This is assessed from the view of the informed user", a person who is familiar with the kind of product in question, and the amount of design freedom will be taken into account.

You may not be able to register your design if: It is not a design by legal definition as described above It is offensive It consists of, or includes, certain protected flags and international emblems It is solely dictated by the product's technical function Protection is granted for 5 years and is renewable up to 25 years Depending on the particular national law and the kind of design, a design may also be protected as a work of art under copyright law. In some countries, industrial sign and copyright protection can be " cumulative"; that is, these two kinds of protection can exist concurrently.

In other countries, they are mutually exclusive: once the owner chooses one kind of protection, he can no longer invoke the other. What is the grace period? The existence of a grace period and the corresponding requirements can be provided by national or regional laws applicable in some countries. If <https://assignbuster.com/trademark-law/>

so, the law can allow the filing of an application for registration of an industrial design after its disclosure, within a limited time period from the date of disclosure (generally six months or a year).

During the grace period, the product which constitutes the industrial design or in relation to which the industrial design is used could in particular be commercially used without destroying the novelty of the industrial design and it could still be possible to file an application for registration in the country concerned before the expiry of the grace period. What is the scope of protection for territory: As a general rule, industrial design protection is limited to the territory of the country or the region where protection is sought and granted.

Instead of filing separate national and/or regional applications according to different sectional/regional procedures, it is possible to file an international registration of industrial designs. Reproductions/views: The scope of protection is defined by the reproductions (representations/views) provided of the design when filing an application. If maximum protection is sought for a design then the design should be fully represented, as only aspects visible in the reproduction will be protected.

It may be necessary, therefore, to represent a single article from many angles and submit several different reproductions. An applicant may choose to submit different views of the same design, in order either to illustrate all the characteristic features of a three-dimensional design or to comply with the requirement of the law of a designated Contracted Party which has made a declaration whereby it requires certain specified views of the product

concerned. How can you enforce your rights when your industrial design is being infringed?

In case of infringement, the holder of industrial design rights could, firstly, decide to send a "cease or desist letter" to the alleged infringer, informing him of a possible conflict between his industrial design rights and the alleged infringing product and asking him to cease said infringement. If the infringement persists, the holder of the industrial design rights could decide to take all appropriate legal measures against the infringer, as provided for by the applicable law.

The enforcement of industrial design rights may be a complex issue for which it is usually advisable to seek professional assistance from a lawyer who would in principle be the competent person to provide you with advice on how to settle any dispute. The owner of the infringed design must prove that there are some substantial similarities between his/ its industrial design and the infringes product. His/its industrial design and the infringes product.