

# LEXIA GROWTH

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Trademarks

**LEXIA**  
Legal Excellence



# CONTENT OF TODAY'S WEBINAR

- What is a trademark?
- The scope of a registered trademark
- Registrability
- Applying for a trademark in Finland (PRH)/ EU (EUIPO) / Worldwide (WIPO)
- Trademark infringements
- Trademark infringements abroad
- Case examples
- Licensing

# WHAT IS A TRADEMARK?

- **Distinctive symbol and commercial logo**
  - A trademark enables its proprietor to distinguish its own products from those of others on the market.
- **A trademark creates an exclusive right for its proprietor**
  - The proprietor of a trademark has the right to prohibit others from using a mark that causes a risk of confusion with similar products.
- **A trademark can be:**
  - A word, name, pattern, a combination of letters, slogan, a three-dimensional mark (for ex. the shape of a products or its packaging), a sound, a multimedia mark or, in exceptional cases, even a colour.

# THE SCOPE OF A REGISTERED TRADEMARK

- The scope of protection of a trademark is limited by time, territory and subject matter.
  - Valid for a limited period in a limited geographical area.
  - It is limited to commercial activities and usually only to certain "classes" of trademarks.
- Trademark classes play a key role in the trademark system.
  - The proprietors exclusive right applies only to the categories in which the mark is registered.
- A trademark can always be renewed every ten years and it can be held in force indefinitely.

# REGISTRABILITY

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- A trademark must be distinctive.
  - Is evaluated in relation to the goods & services for which the mark is sought.
  - Is evaluated as a whole (overall impression).
  - A mere word is not distinctive, if it, as such or with minor modifications, describes the nature, quality, intended use, origin, price or quantity of the goods or services.
- A trademark must not create a risk of confusion with rights that have been granted earlier (trademarks/trade names).
  - The trademark that is being applied for is examined in relation to the prior rights of others.
  - Risk of confusion exists, if identical or similar, or if they cover the same / similar goods & services.
- Absolute barriers to registration:
  - The mark cannot be contrary to law, public order or good manners.
  - The mark is not allowed to be misleading, for example, as to the geographical origin of the product.

# REGISTRABILITY

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- More examples of barriers:
  - A trademark may not include the flag of a state, a coat of arms or other similar symbol without approval from the relevant authority.
  - A trademark may not include the last names of others or give an impression of another's name.
  - A trademark may not infringe on another's copyrighted work.
  - A trademark may not be confused with the name of a registered plant variety.
  - A trademark must not infringe upon the Council Regulation on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

# APPLYING FOR A TRADEMARK AT PRH

- In Finland, the right to a trademark can be obtained by registration or consolidation.
  - PRH is responsible for the registration of trademarks, due to which PRH examines all the requirements for registration ex officio.
- If no barriers to registration are found, the trademark will be accepted, i.e. registered and announced in the Trademark Journal.
  - A 2-month opposition period starts after a public notice has been given, during which anyone can object to the registration.
  - The protection offered by a registered trademark can be considered to be active from the date of the application.
- A trademark applied for in Finland is valid for 10 years from the date of application.
- Examples of pricing:
  - Trademark application, 1 category being applied for, EUR 225.00 (official costs).



# APPLYING FOR A TRADEMARK IN THE EU

- An EU-wide registration is sought from the EUIPO (excluding UK since 31.12.2020).
- The registration consists of three main parts, which are:
  - Examining the application
  - Opposition proceedings (if the EU-wide trademark application becomes the subject of an opposition)
  - Registration
- EUIPO examines whether the application meets the so-called absolute requirements (eg whether the mark is distinctive or that the mark is not contrary to law and order) → Will not examine other barriers ex officio, like PRH does in Finland.
- In force for 10 years from the date of application in all EU countries.
- Examples of pricing:
  - Trademark application, 2 categories being applied for, EUR 900.00 (official costs)



# APPLYING FOR A TRADEMARK WORLDWIDE- WIPO

- An international registration under the Madrid Protocol is sought from WIPO.
  - Allows for an applicant to receive trademark protection in multiple countries with a single application.
  - The Madrid system can only be used by countries that have acceded to the Madrid Protocol.
- WIPO checks out formalities of the application.
  - A notice is also sent to all of the registration authorities of the countries named in the application.
  - In Finland, PRH checks that the application corresponds to the applicant's Finnish registration / application and PRH examines the barriers to registration ex officio.
  - Registration can be applied for after the mark has already been registered elsewhere / registration has been applied for in a state party to the Madrid Protocol.
  - After registration, the trademark is valid in the member states of the Madrid Protocol that were mentioned in the application.
  - Valid for 10 years and can be renewed for ten years at a time as many times as desired.
- Examples of pricing:
  - Application fees vary depending on the designated country.

# TRADEMARK INFRINGEMENTS

- Enforcement actions can be divided into initial measures (cease and desist-letter), online enforcement, civil enforcement, criminal enforcement and customs enforcement.
- In order to establish what enforcement mechanism is the most effective in each case, you must consider the following:
  - Do you have registered and enforceable intellectual property in the jurisdiction where the infringement happened?
  - Is your intellectual property applicable to this infringement?
  - What is the infringement in question?
- Example:
  - **Infringement in Finland:** A third party begins to use a very similar logo (compared to your registered trademark) as the symbol of its own products.
  - **Measures:** Sending a cease & desist –letter. If the letter has no effect → start court proceedings against the infringer before the Market Court.

# TRADEMARK INFRINGEMENTS ABROAD

- Example:
  - **Infringement:** Products bearing the same or a similar name (as your registered trademark) appear on Amazon/Alibaba etc, but the products are not genuine.
  - **Measures:** Make sure, that you have, as the proprietors of the trademark, registered your status with Amazon's Brand Registry ("Enrollment in Amazon Brand Registry gives rights owners access to powerful tools including proprietary text and image search in addition to increased authority over product listings that have your brand name") or Alibaba's IP Brand Protection system. This is the most effective system as for example Amazon is rather quick taking products down from its website.

# CASE EXAMPLES

- Two companies carrying the same name, one has a registered trademark and a registered trade name and one has none but extensive use of the (secondary) mark → Case in process in the Market Court.
- Two companies that carry very similar trade names and very similar logos. One has registered trademark, both have registered trade names. → still under negotiation.
- Two companies with similar trademarks for their products (difference is one letter and the goods and services are almost identical). Finnish patent and registration office stated that there are no risk of confusion amongst the consumers but the other party took the case to the Market Court asking the case to be returned back to the Finnish trademark office.

# LICENSING

- When is it a good idea to consider licensing your trademark?
  - As soon as you have a valuable brand and potential licensee!
- How to go about and license your trademark?
  - If you have a potential licensee, next step would be to draft a license agreement, where you both agree on certain rights and obligations. The next 3 points are important when negotiating your license agreement.
- Some of the problems you might face when licensing your trademark?
  - It is important to define the scope in which the licensee can use your trademark and also to make sure that licensee doesn't diminish or dilute the brand value of your trademark with the activities that the licensee uses your trademark in.
    - Also it should be made clear for what purposes the trademark may be used for ie in connection to certain products or services
    - Are there any territorial limits or other limits of use
  - It is also important to define how the fees should be paid and on what basis can the licensor raise the fees.
    - Fee per month
    - Revenue share
  - It should be established that the licensee has no right to make changes to the licensed trademark and that the licensee has no intellectual property rights to the trademark beside the right to use the trademark according to the license agreement.



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