



EUROPEAN PATENT AND
TRADEMARK ATTORNEYS

Intellectual Property

Trademark Law





Trademark law

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You have developed a trademark and are now wondering what you should do to protect it. Or you have already registered a trademark, and now you want to protect it in other countries as well. Can you use your trademark risk free, for example? Regardless, you want to find out more about trademark law.

QUESTION 1

What is a trademark?

A trademark distinguishes a company's products and/or services from those of another company. A trademark can be anything: words, character or number combinations, logos, packaging and the shape of a product. Some examples of trademarks are: NIKE, NUTRICIA, NLO's logo. Under certain circumstances, colours (such as T-Mobilemagenta), colour combinations, melodies, sounds and shapes (such as the shape of a Coca Cola bottle) can be protected as a trademark.

Trademarks are therefore used to distinguish products and services. A trademark identifies the origin of the goods and/or services. A word trademark may not be purely descriptive. Some of the trademarks which the courts considered to be highly descriptive are 'Biomild' (for dairy products) and 'Doublemint' (for chewing gum). A single colour is almost never immediately accepted as a trademark. The same goes for shapes. For reasons of general interest, certain shapes, such as dishwasher tablets and BIC lighters, were not registered as trademarks.

Trademarks that consist of fantasy names, revealing nothing about the destination or quality, the type or other features of the goods and/or services, comply best with the distinctiveness requirements. Combining a word with figurative elements, using colours or otherwise, is another way to ensure that a trademark meets the distinctiveness requirements. In some cases, a trademark which was initially believed to be non-distinctive can nonetheless be registered after being intensively used for a number of years. There must be some degree of acquired distinctiveness. Acquired distinctiveness means that the public perceives the brand as an indication of origin.

QUESTION 2

How do I protect a trademark?

To protect a trademark, it has to be registered in the official trademark register. You may submit a trademark registration in any country. But you can also obtain the same trademark right in different countries by filing one application.

Here are some possibilities:

- › The Benelux countries.
- › The European Union, where registration offers protection in all member states (the EU trademark).
- › A so-called international registration at WIPO. This allows you to get protection in many countries worldwide, such as Japan, the United States and China.

The best registration option for you and your trademark also depends on the countries in which you operate. After consultation with you, our advisors will draft and file your application and monitor the further procedure.

QUESTION 3

Why should I register a trademark?

Trademark law states that the right to a trademark follows from registration. A trademark registration gives the holder an exclusive right to a trademark, the trademark registration is published in the trademark register. This register is public and may be accessed by all, which means that people must also take your trademark registration into account. Your trademark may consequently come to light during an availability search.

QUESTION 4

What does the registration procedure involve?

The procedure starts by filing an application for trademark registration with the selected official authority. To this end, NLO Shieldmark provides the following information on your behalf:

- › The name of the trademark owner: the trademark owner must be a natural or a legal person;
- › The address of the trademark owner;

Classification

In order to ensure the accessibility of the register, goods and services have been categorised into classes. There are 45 classes. Based on the goods and/or services reported by you, we will determine the class or classes for which your registration must be requested. In doing so, we bear in mind the fact that the description of the goods and/or services cannot be supplemented once the application has been filed.

Example: If the trademark involves games, then the description would not only include board games, but also computer games and organising games. The list of goods and/or services can be limited at all times. This usually happens to solve a conflict.

- › When it concerns a logo: a good-quality image;
- › A description of the goods and/or services for which the trademark owner wishes to use the trademark (the classification, see text box).

The official authority will then assess the application. This will include verifying whether all the necessary details are included and whether the description and classification of the goods and services are acceptable. The official authority will subsequently decide whether the trademark qualifies for registration.

The criteria for this differ from country to country. In general, a trademark is assessed on the following:

- › It must be distinctive;
- › It should not be descriptive;
- › It should not mislead the public.
- › It should not be contrary to public morality or public order.

If a trademark does not meet one of these criteria, it will be rejected. You may appeal against this rejection. If the ground for rejection is lifted, the application will be published. This publication aims to inform others about the application. If anyone objects to the registration of your trademark, they may file an opposition (objection) with the official authority.

Trademark registration in the register concerned depends on the outcome of the opposition proceeding. A trademark registration is usually valid for ten years; renewal is possible for periods of ten years at a time. In order to maintain that right, you must use the trademark.

In most countries, the trademark right can be invoked after the trademark has been registered. During the filing and registration procedure, you may inform third parties about your right, but you cannot yet enforce a ban on use. In most countries, you may invoke the priority of the first application of your trademark. You will then be protected with retrospective effect

as from the date on which you filed your first application. However, you will need to submit the subsequent applications within six months of the date of your first application. After that, it is still possible to extend your trademark to other countries, but no longer with retention of the first application date.

QUESTION 5

What does a trademark registration cost?

NLO Shieldmark applies fixed rates for trademark registration. This avoids any unpleasant surprises. The costs of a trademark application depend on which country or country group is chosen and in how many categories a trademark is registered. A Benelux trademark application can start from around €650 and an EU application from around €1,600 for a 10-year registration. Please contact us for customisation.

These rates include all activities performed to register your trademark, such as the preparation and if necessary translation of the description of the goods and/or services, the filing of the application, verifying and sending the proof of registration and monitoring the expiry date in our renewal database.

Additional costs might be incurred if your trademark is provisionally denied and you wish to set up a defence, or if you ask us to handle an opposition or objection on your behalf. As the above costs are merely an indication, please contact us for a cost specification.

QUESTION 6

How do I know whether a trademark already exists?

To find out whether there are any registrations which will interfere with your trademark, we can conduct availability searches to see prior trademark registrations. This search will reveal identical and similar trademarks that have been registered for similar products and/or services. You may also choose to exclusively investigate identical trademarks, in which case the result will merely indicate the availability of a trademark, because similar and non-identical trademarks will not be revealed. Together, we will decide on the most efficient investigation.

QUESTION 7

My trademark has been registered, so what's next?

The fact that your trademark is registered does not mean it will be protected forever. As the trademark holder, it is your duty to use the trademark for the goods and/or services involved. If you fail to use the trademark for a longer period of time, you may no longer be entitled to it.

Please contact our advisors in the following cases:

- › Your trademark has changed slightly.
- › The goods and/or services which you offer under your trademark have been changed or expanded.
- › The trademark owner's name or address has changed;
- › You wish to license your trademark to someone else.
- › You export products to countries other than those in which your trademark is registered.

On request, our advisors will study your portfolio together with you to check that you are still appropriately protected.

QUESTION 8

What do I do if others infringe my trademark right?

If anyone infringes your trademark right, then together we will find a solution. First, we will send the infringer a notice seeking to negotiate. If that fails, further legal action may be taken. In many countries you may already object during the trademark registration procedure. This is the so-called opposition proceeding. Please see the next question in this respect.

In order to proceed on time, we advise you to:

- › Take out our watch subscription, which means we will contact you the moment similar trademarks are submitted for registration for the same type of goods and/or services.
- › Keep a close eye on the market and engage us at the earliest possible opportunity.

What do these commonly used symbols mean?

What do the common symbols ®, ©, ® and ™ mean?

- ® is often used to indicate that a registered design is involved. This is also indicated using 'filed design' or 'registered design'.
- © is used to indicate that copyright is claimed.
- ® is used to indicate that a registered trademark is involved; the trademark owner warns parties that through registration they have obtained the exclusive right to the trademark. Use this symbol only if you have a registered trademark in the country concerned.
- ™ usually indicates that a request to register a trademark has been submitted. In countries where using a trademark leads to a limited right, this symbol refers to this right. This is the case in the United States, for example.

QUESTION 9

What is an opposition proceeding and how can I use it?

In many countries you may object already during the trademark registration procedure. This is called the opposition proceeding. The official authority involved will decide whether the objection is justified. Objecting to a trademark that is similar to yours and which has been filed for similar goods and/or services at this stage could be advantageous. In order to find out about new applications in good time, it is a good idea to identify applications for new trademark registrations as soon as possible. To this end, you could take out our watch subscription.

You can request us to monitor your trademark. This means that we draw your attention to new trademark applications that resemble your trademark and which have been requested for the same goods and/or services. In your name, we can then file an opposition on time or contact the trademark holder to see if we can find an amicable solution together. Our watch subscriptions start at approximately € 170 annually.



QUESTION 10

How can I protect my trademark on the internet?

When registering a trademark you would be wise to directly check the online availability of your trademark. Where possible, also register it as a domain name immediately. With domain names, it is a matter of 'first come, first served'. Anyone can register a random domain name.

Have you experienced any misuse of your trademark online? For instance, has someone else claimed your trademark as a domain name? In such circumstances, we can provide support and if necessary instigate arbitration proceedings at the World Intellectual Property Organization (WIPO) in order to transfer or remove the infringing domain name. Your trademark could be used to influence the search results of search engines, e.g. by means of Google AdWords. Whether this is permitted depends on the circumstances. Is your trademark being used in social media without your consent? The possibilities to abuse your trademark on the Internet are constantly changing. As are the opportunities to act against this abuse. We will be happy to advise you in such cases.



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