

PROTECTING MARKS OF OWNERSHIP

INTELLECTUAL PROPERTY FOR BUSINESS
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iPROTECT PHILIPPINES

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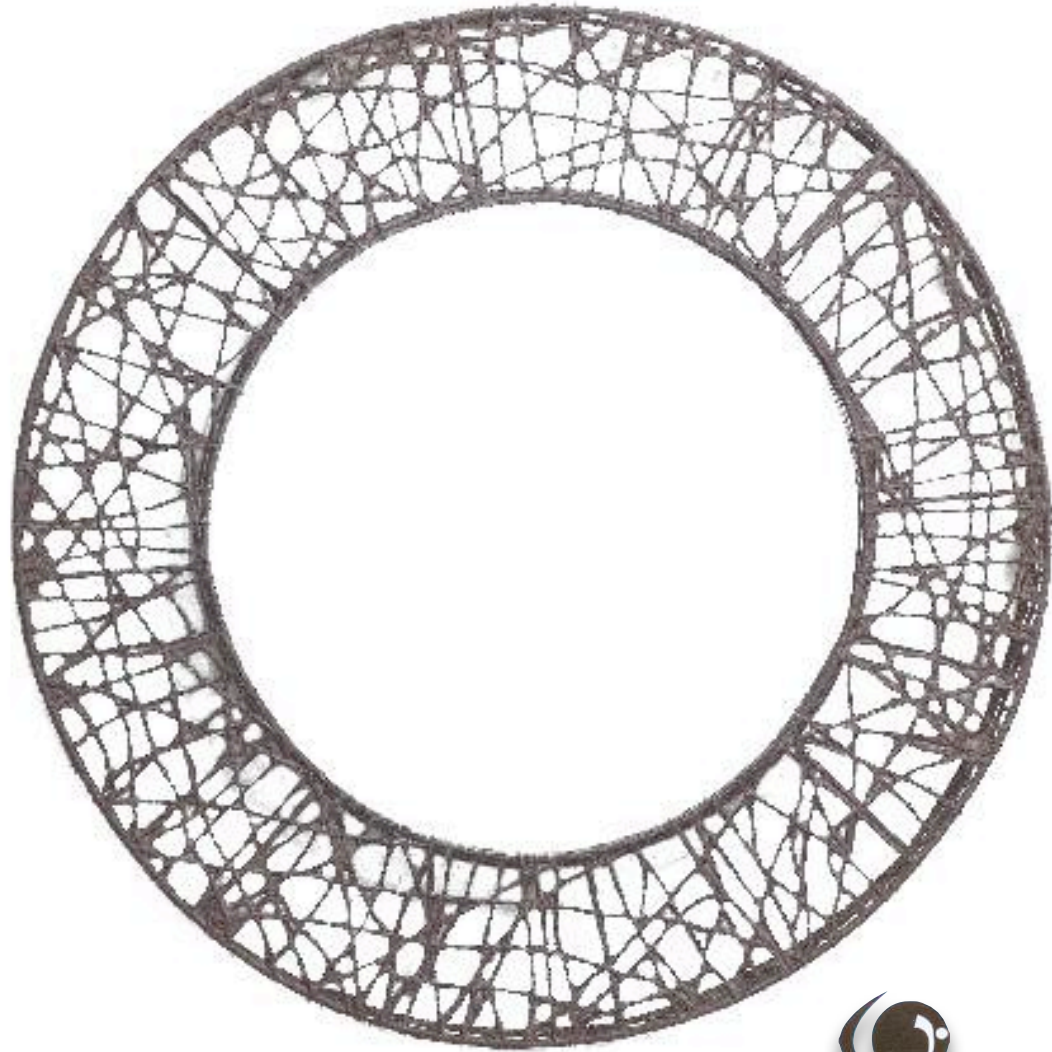


KENNETH COBONPUE



IP PRO

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COLA



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WHAT'S IN A NAME?



WHAT'S IN A NAME?

- ▶ It is what the customers look for when doing a repeat purchase/order
- ▶ It embodies the goodwill and reputation of the product/service (some desired benefit)
- ▶ Customers develop an emotional attachment to the trademark.

Serves as a Marketing tool!



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WHAT'S IN A NAME?



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WHAT'S IN A NAME?

- ▶ It informs the public of the **COMMERCIAL ORIGIN** of the product or service which is responsible for the product or service
- ▶ It captures the **TOTAL INFORMATION** about a product or service (quality, characteristic and distinctive feature)
- ▶ It assures product /

Serves as a Tangible Link!



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MARKS IN VARIED SIZES & SHAPES

WHAT GOOD IS A NAME IF...



**everyone is using the
same name?**



**anyone can use the same
name?**

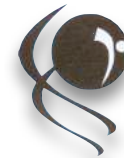
Harnessing the Power of the Brand

A MARK BECOMES A

PROPERTY ASSET

ONLY IF THE OWNER CAN LEGALLY EXCLUDE OTHERS FROM USING IT

A MARK IS ONLY AS VALUABLE AS THE OWNER'S WILLINGNESS TO APPROPRIATE IT



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Harnessing the Power of the Brand **TRADEMARK REGISTRATION**

THE EXCLUSIVE RIGHTS TO A
TRADEMARK & SERVICE MARK IS
ACQUIRED THROUGH REGISTRATION
MADE IN ACCORDANCE WITH THE
INTELLECTUAL PROPERTY CODE
AND CONTINUOUS COMMERCIAL USE
OF THE MARK IN THE PHILIPPINES.

Registration with DTI and SEC and other
regulatory agencies does not give
proprietary rights.



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The Value of a

TRADEMARK

Registration

Brand Equity

**BRANDS IMBUED WITH THE
STATUS OF A “PROPERTY ASSET”
THAT CAN BE OWNED, ASSIGNED,
FRANCHISED, LICENSED, SOLD
AND GIVEN MONETARY VALUE.**

TRADEMARK Appropriation

REGISTRATION FACTS:

- ▶ Registration is per class of goods / services
- ▶ Registration is awarded only after examination and publication
- ▶ Examination –
 - (a) First-to-file Rule
 - (b) Capability to Distinguish
 - (c) Wordmark or Stylized Mark
 - (d) Class of goods / services
- ▶ Publication – invite others to oppose registration



PRODUCT *Classification*

CLASS 1: **Chemicals**

CLASS 2: **Paints**

CLASS 3: **Cosmetics, Cleaning Preparations**

CLASS 4: **Lubricants & Fuels**

CLASS 5: **Pharmaceuticals**

CLASS 6: **Metal Goods**

CLASS 7: **Machinery**

CLASS 8: **Hand Tools**



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PRODUCT *Classification*

CLASS 9: **Various apparatus** (photography, cinema, photo, etc.)

CLASS 10: **Medical instruments & equipment**

CLASS 11: **Lighting, heating, cooking apparatus**

CLASS 12: **Vehicle, locomotion by land, air or water**

CLASS 13: **Fire arms, explosives**

CLASS 14: **Precious metals**

CLASS 15: **Musical instruments**

CLASS 16: **Paper and printed materials**



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PRODUCT *Classification*

CLASS 17: **Rubber, plastic materials**

CLASS 18: **Leather goods**

CLASS 19: **Building materials**

CLASS 20: **Furniture**

CLASS 21: **Household or kitchen utensils, etc.**

CLASS 22: **Ropes, nets, strings, etc.**

CLASS 23: **Yarns and threads**

CLASS 24: **Textile goods**



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PRODUCT *Classification*

CLASS 25: **Clothing, footwear, headgear**

CLASS 26: **Ribbons, lace, pins, buttons**

CLASS 27: **Carpets, mats, linoleum**

CLASS 28: **Games and Playthings**

CLASS 29: **Meat, fish, poultry**

CLASS 30: **Coffee, Tea, Cocoa, Sugar, Flour**

CLASS 31: **Agricultural, Horticultural goods**

CLASS 32: **Beer, water, fruit juices**



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CLASS 33: **Alcoholic beverages**

CLASS 34: **Tobacco, matches, smoker's articles**

SERVICE *Classification*

CLASS 35: **Advertising, general businesses**

CLASS 36: **Finance, Real Estate Services**

CLASS 37: **Construction Services**

CLASS 38: **Telecommunications**

CLASS 39: **Transport, travel Services**



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The Value of a **TRADEMARK** *Registration*

PRESUMPTION OF VALIDITY & OWNERSHIP

REGISTRATION MILESTONES:

- 1. FORMAL EXAMINATION**
- 2. SUBSTANTIVE EXAMINATION**
- 3. PUBLICATION FOR
OPPOSITION**
- 4. ISSUANCE OF CERTIFICATE**



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The Value of a

TRADEMARK
Registration

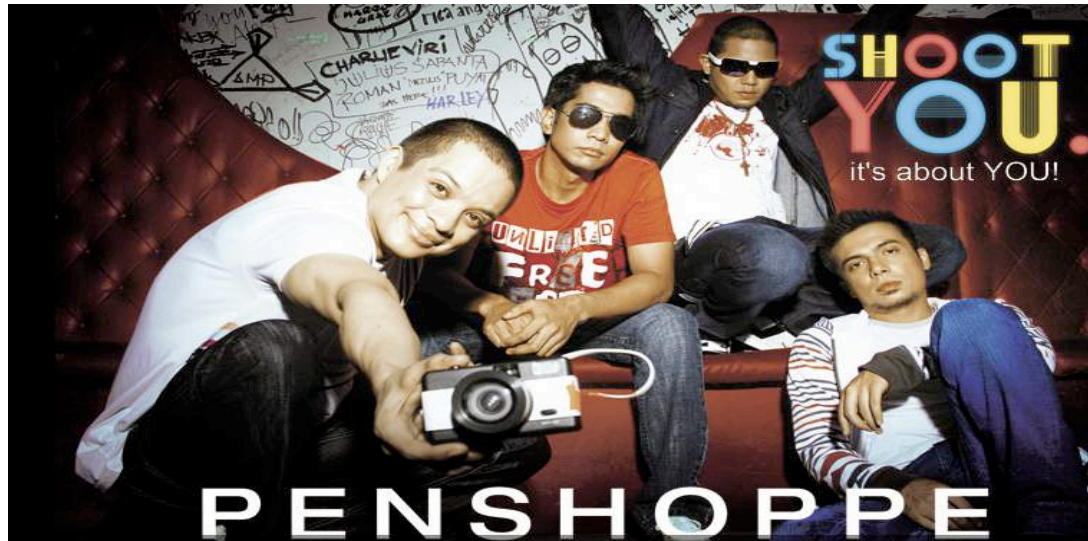
Presumption of Distinctiveness

Registered trademarks have passed examination to show they are not generic or descriptive.

**..Because not all marks are equal!!
There are strong marks & weak marks.**



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CAVEAT

AVOID USING MARKS THAT ARE GENERIC OR DESCRIPTIVE TO THE GOODS OR SERVICES FOR WHICH THE MARKS ARE USED



Potentially Strong marks
ARBITRARY/FANCIFUL



MEMO

GENERIC MARK



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First To File Rule

TRADEMARK LITIGATION

A mark cannot be registered if it is identical or similar to a registered mark or a mark with an earlier filing or priority date belonging to a different proprietor when used in related goods or services



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Consumer Protection

TRADEMARK LITIGATION

**No piggy-backing on the goodwill
and reputation of others.**

The law does not allow the
COMMERCIAL USE
of identical or confusingly similar
marks on related goods or
services.



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NOT JUST IDENTICAL MARKS....

Colorful Imitation **TRADEMARK LITIGATION**

“Usually the (guilty party) does not normally copy but makes only colorable changes.....

The most successful form of copying is to employ enough points of similarity to confuse the public, but with enough points of difference to confuse the courts”



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Unfair Competition **TRADEMARK LITIGATION**

“Such semblance.. as to deceive an ordinary purchaser giving such attention as a purchaser usually gives, and to cause him to purchase the one supposing it to be the other.”



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Use of the name “**L.C. Big Mak Burger, Inc.**” in a restaurant business which serves siopao, noodles, pizza, and sandwiches which appears in food packages and signage (written in silhouette red-orange letters with the “b” and “m” in upper case letters and accompanied by the company mascot, a young chubby boy named Maky.. therein and a blue lower garment) was declared infringing upon the trademark, **BIG MAC**, of McDonalds



"IDEM SONAN" TEST



MIKE CROW'S LOFT INTERNET CAFE

- "GOLD TOP" and "GOLD TOE"
- "SALONPAS" and "LIONPAS"
- "Celdura" and "Cordura"
- "Cutex" and "Cuticlean"
- "Kotex" and "Femetex"
- "CASCARETE" and "Celborite"
- "Celluloid" and "Cellonite"
- "Hebe" and "Meje"
- "Zuso" and "Hoo Hoo"



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Colorful Imitation

TRADEMARK LITIGATION

...confusing similarity is to be determined on the basis of *visual, aural & connotative* comparisons as well as the overall impressions engendered by the marks in controversy as they are encountered in the realities of the marketplace.

BAD FAITH USE OF TRADEMARK

One who has imitated the trademark of another cannot bring an action for infringement, particularly against the true owner of the mark, because he would be coming to court with unclean hands.

Priority is of no avail to the bad faith plaintiff. Good faith is required in order to ensure that a second user may not merely take advantage of the goodwill



TRADEMARK LANDMARK CASE

The **DOMINANT FEATURE** is the phrase 'San Miguel' written horizontally at the upper portion. Below are the words 'Pale Pilsen' written diagonally across the middle of the rectangular design. In between is a coat of arms and the phrase 'Expertly Brewed.' The 'S' in 'San' and the 'M' of 'Miguel,' 'P' of 'Pale' and 'Pilsen' are written in Gothic letters with fine strokes of serifs





TRADEMARK LANDMARK CASE

"Pale Pilsen" are **generic** words descriptive of the color ("pale"), of a type of beer ("pilsen"), which is a light bohemian beer with a strong hops flavor that originated in the City of Pilsen in Czechoslovakia and became famous in the Middle Ages.



TRADEMARK becoming generic

THERMOS Vacuum flask

LINOLEUM Floor coverings

ZIPPER Slide fastener

VETSIN Mono-Sodium Glutamate

ESCALATOR moving stairs

CLOROX Bleaching preparation

CELLOPHANE Plastics

ELEVATOR lift

ASPIRIN Acetylsalicylic Acid



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TRADEMARK LANDMARK CASE

Amber Steinie Bottle - is a container dictated by function in a form, size and character commonly used in beers (industry standard). Amber color is selected to protect beer from light rays and white prints is to contrast with amber color.



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TRADEMARK LANDMARK CASE

Point of Purchase – Unlike catsup, which is bought off the store shelves by housewives and house help who may not to identify the product by name or brand and would very likely identify it by mere recollection of its appearance, beer is ordered from the storekeeper or waiter in a pub or restaurant by the beer drinker who knows his brand.



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Dilution

TRADEMARK LITIGATION



Trademark dilution is the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of competition or likelihood of confusion, mistake or deception.



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Dilution

INTERNATIONALLY WELL-KNOWN MARKS

Not allowing the use and registration of marks that are identical or confusingly similar to, or translations of, registered WELL-KNOWN MARKS even on dissimilar goods/ services.

If not registered, protection extends only to related goods.



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PRODUCT *Classification*

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INTERNATIONALLY WELL-KNOWN MARKS

CRITERIA for WELL-KNOWN MARK

- * DURATION, EXTENT & GEOGRAPHICAL AREA OF USE & PROMOTION OF THE MARK
- * MARKET SHARE OF THE MARK IN THE PHILIPPINES & OTHER COUNTRIES
- * DEGREE OF ACQUIRED/INHERENT DISTINCTION, IMAGE & REPUTATION IN THE MINDS OF RELEVANT SECTOR
- * SUCCESSFUL EXCLUSIVE REGISTRATION & USE OF THE MARK IN THE WORLD



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Trademark STRATEGY

Suggested Process

1. CHOOSE A CATCHY & DISTINCTIVE MARK
2. CONDUCT TRADEMARK SEARCH BEFORE USING THE MARK
3. FORMULATE A STRATEGY FOR PROTECTION
4. FILE APPLICATIONS WITH IP PHILS.
5. PROSECUTE THE APPLICATIONS
6. DEFEND AGAINST OPPOSITIONS (IF ANY)
7. MAINTAIN THE REGISTRATIONS



Intellectual Property STRATEGY

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Protecting Marks of Ownership



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MACAU MUSEUM



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THANK YOU

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