

Abel+Imray

Enterprise Nation StartUp 2019

Whose Brand Is It Anyway?

Saturday, 19 January 2019

Launching in a New Market?

There may be pre-existing rights to consider..



Forced to Abandon Trade Mark

- + Burger King became Hungry Jack's in Australia



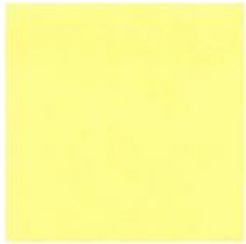
Agenda

- + What is a trade mark?
- + Distinctiveness: why it matters
- + Clearance searches
- + Strategies for dealing with Earlier Marks
- + Take Away Message
- + Questions

What is a Trade Mark?

- + A sign that you can use to distinguish your goods/services from those of other traders.
- + Often perceived in a traditional sense as a two-dimensional word or symbol. But, **a trade mark is not limited to words or a symbol.**
- + ‘Non-traditional’ marks, include sound, colour, shape, motion / hologram marks.

That's a Trade Mark!



Every little helps



Audi



What's that sound?



Distinctiveness: why does it matter?

- + **Fanciful:** no meaning, do not suggest the g/s that they are used in association with.
- + **Arbitrary:** have a meaning, but not a meaning that describes the relevant g/s.
- + **Allusive:** suggest a quality or characteristic but do not describe the g/s that they are used in association with.
- + **Descriptive or generic:** describe a quality or characteristic of the g/s that they are used in association with.

Examples

Google



AIRBUS



The Spectrum of Distinctiveness

**WEAK OR NO LEGAL
PROTECTION**

**STRONG LEGAL
PROTECTION**



Establishing Rights in a Trade Mark

- + Through use or registration of a trade mark.
- + Requirements for obtaining, substantiating and retaining protections, as well as geographical limits of rights, differ.
- + Statutory rights result from registration: right to prevent others from use of the identical / confusingly similar mark for the same / confusingly similar goods/services.
- + Unregistered rights a useful supplement to registered trade mark protection, **but no substitute!**

Clearance Searching

- + Check for *obstacles* to use and/or registration of a mark before spending large sums of money!
- + Primarily, identical or confusingly similar trade marks registered (or unregistered) for identical and/or similar goods/services.
 - E.g. FOCUS v PHOKUS
- + Do you really need to search?
- + **Risks:**
 - + Opposition against TM Application
 - + Infringement, if use in the marketplace has commenced

Strategies for dealing with Obstacles

Where potentially relevant third party rights are identified, you need to consider strategy carefully

Some options:

- + Abandon/Adapt Trade Mark
- + Attack Earlier Mark
- + Co-Existence
- + Acquisition of Earlier Mark
- + Consent
- + Licensing Opportunity



Abandon Trade Mark

- + AXE became LYNX in the UK, Ireland, Australia, New Zealand and China



Abandon / Alter Trade Mark

+ T.J. Maxx became T.K. Maxx in the UK



T.J. Maxx[®]

The logo for T.J. Maxx is displayed in a bold, red, sans-serif font. The letters 'T', 'J', and 'M' are significantly larger than the other characters. The 'x' is stylized with a horizontal bar that extends to the right and then curves downwards. A registered trademark symbol (®) is located at the top right of the 'x'.

T.K. Maxx

The logo for T.K. Maxx is displayed in a bold, red, sans-serif font. The letters 'T', 'K', and 'M' are significantly larger than the other characters. The 'x' is stylized with a horizontal bar that extends to the right and then curves downwards. This logo is identical in style to the T.J. Maxx logo but uses the letters 'T.K.' instead of 'T.J.'.

Abandon / Alter Trade Mark

+ Weet-Bix v Weetabix in New Zealand



Attack Earlier Mark

Various Cancellation/Revocation Options:

- + Vulnerable to Non-Use?
- + Earlier Mark filed in bad faith?
- + Do you have earlier use?
- + Is Earlier Mark non-distinctive or descriptive?

Negotiations with Owner of Earlier Mark

- + Various Options:
- + Co-Existence?
- + Consent?
- + Licensing Opportunity?
- + Acquisition of Earlier Mark? E.g.
Gmail in Germany – Google eventually
acquired earlier G-mail
Trade Mark



Take Away Message

- + Best way to protect your Brand against others is to register it
- + Conduct searches to reveal possible issues early
- + If Earlier Mark appears to be an obstacle, there are a number of ways of trying to overcome it

Any Questions?

Visit us in the Exhibition and Adviser
zones to arrange your
FREE 15 minute
brand protection consultation

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Thank you!

If you would like to discuss your trade marks, please
feel free to contact us directly

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