

INTELLECTUAL
PROPERTY RIGHTS
IN A NUTSHELL

Trade marks



01. What do trade marks protect?



The types of signs that can be protected as trade marks are **very diverse** and range from words (e.g. “Nike”, “Adidas”, “Chanel”) to drawings, letters, numbers, colours, shapes of goods, packaging and even sounds. For example, the computer voice of Stephen Hawking and the well-known tune for Ricola sweets were registered as a trade mark.

To be eligible for registration and protection, the signs must be able to distinguish the goods and services of a company from those of another company and it must be possible to display the sign in a register in such a way that the competent authorities and the public are able to determine precisely and clearly what the trade mark is.

This will not be a problem for most signs. As far as sounds are concerned for example, musical staves or an audio file can be used. However, this becomes more difficult if you want to register a smell or a taste as a trade mark. Currently trade mark registrars generally do not accept smells and tastes to be registered since the available technology today cannot represent smells and tastes in a precise and clear way.²

A trade mark can fulfil different **functions**, e.g. enable a company to:

- guarantee the **origin** of its products and/or services to consumers (the **essential function of a trade mark**)
- Inform and persuade consumers (the **advertising function of a trade mark**)
- use the sign in order to acquire or preserve a **reputation** capable of attracting consumers and retaining their loyalty, by means of various commercial techniques (the **investment function of a trade mark**)

Tip: Trade marks are subject to an obligation of use after five years. If the trade mark holder has not put the trade mark to genuine use in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, an interested party may obtain the cancellation of the trade mark for non-use (unless proper reasons for non-use can be established, which is rather exceptional).

Trade marks are to be distinguished from trade names. A trade name is the designation used by a natural or legal person to participate in commerce and to distinguish his trade in commerce from other commercial enterprises. The purpose of a trade name is, on the one hand, to identify the enterprise and allow the public to know the enterprise to a greater or lesser extent and, on the other hand, to advertise the enterprise.³

02. What are the requirements for trade mark protection?

There are three conditions a sign must fulfil in order to be able to enjoy trade mark protection, i.e. the sign must be distinctive, admissible and available.

The most important condition is that the sign must be **distinctive** and non-descriptive. The sign must be able to distinguish the origin of products and/or services, so that consumers can know from which company the products and/or services originate. A sign that is purely descriptive or that is only used to describe or indicate a characteristic of the goods/services

in question is not sufficiently distinctive. For example, if a pear seller would use the logo of a pear as a trade mark, this sign would normally be considered as not distinctive. However, if the same pear logo were used for products such as cars or cosmetics, the trade mark might be considered distinctive. Much depends on the concrete circumstances of the situation.

E.g. in this sense the word “Acoustic lighting” for inter alia lighting fixtures was considered as an invalid trade mark.⁴

The sign must furthermore also be **admissible**. This means that it may not appear in the (exhaustive) list of legally excluded signs, i.e.:

- signs consisting exclusively of a shape or other characteristic which is **specific to the nature of the goods** (e.g. the 'normal' form of soap)
- signs which consist exclusively of a shape or other characteristic necessary to obtain a technical result (purely functional shapes) (e.g. Lego cubes)



- signs which consist exclusively of a shape or other characteristic which gives substantial value to the goods (e.g. the shape of a crystal dinner service)
- signs which are contrary to public order and morality (e.g. the sign "La Mafia Se Sienta a La Mesa", which means "The Mafia is sitting at the table" in Spanish, was refused because it was found to glorify a criminal organisation, which is contrary to the fundamental values of the EU)
- Flags, coats of arms and other emblems of states or intergovernmental organisations



- Signs that create a misleading link with the goods (e.g. use of a pear sign for grape juice, since this may cause consumers to think that the goods contain pear juice instead of grape juice)
- Other signs (e.g. protected geographical indications and variety designations)

The final condition is the **availability** of the sign: no identical or similar sign in the relevant product/service sector, or sometimes even outside it, may have been previously applied for or registered or used under certain conditions. Unlike the other requirements, the availability requirement cannot be invoked ex officio, but only by the party who is the holder of the prior right.

Tip: Always check the trade mark registers for similar trade marks before filing a new trade mark!

03. How can you obtain trade mark protection?

In the European trade mark system, trade mark protection can in principle only be obtained through the **filing and registration of the sign** with the competent authority and not through the mere use of it. There is however an **exception** for **well-known trade marks** (e.g. Apple, Volvo, Coca-Cola).

Contrary to popular belief, the mere mention of the symbol ® – which stands for 'registered trade mark' – can thus not create a trade mark right and has no legal value or meaning in the EU.

When filing a trade mark, the **goods and services for which the trade mark is intended to be used** must be identified. The Nice Classification⁵ is an international classification of goods and services that trade mark applicants can use to identify these goods and services.

The **filing and registration** of a trade mark can be done with **various authorities** depending on the territorial scope of protection you wish to obtain, namely:

- with the **Benelux Office for Intellectual Property (BOIP⁶)** to obtain a Benelux trade mark which offers protection within the Benelux (protection for Belgium, the Netherlands or Luxembourg separately is not possible!).⁷



- with the **European Union Intellectual Property Office (EUIPO⁸)** to obtain a European Union Trade mark (EUTM) which offers protection within the EU.⁹



- with the **competent national authorities** to obtain a national trade mark which offers protection in that country (e.g. for protection¹⁰ in France you can file a trademark with the INPI¹¹, the Institut national de la Propriété Industrielle).



- After a national/Benelux/European application, a further application can be made to expand the protection to other countries of the Madrid Union¹², which will then be forwarded by the local/regional authorities to the **WIPO International Bureau**.¹³



The **duration of the registration** is 10 years, but it can be renewed without limitation.

Tip: Within the first 6 months after filing a trade mark, it is possible to expand protection to new territories while keeping the original filing date for such new territories (the so-called “right of priority”).

The **registration cost** of a trade mark depends on a number of factors, such as:

- Territory
- Number of classes of goods and/or services for which registration is sought
- Speed of registration
- Description of distinguishing features

Tip: We highly recommend using a professional trade mark agency for filing a trade mark given the technicality of the registration process and the maintenance required.

04. What rights do you have as a trade mark holder?

The trade mark holder has the **exclusive right to use the trade mark** himself on the products and/or services he manufactures or commercialises, and therefore the right **to prevent third parties from using**:

- a **sign identical** to the registered trade mark for **identical goods and services** for which the trade mark is registered in the course of trade.
- a **sign (or a similar sign)** for the **goods and services (or similar goods and services)** for which the trade mark is registered if there is a **likelihood of confusion** for the consumer (e.g. *Napapijri v. Northvalley*¹⁴).

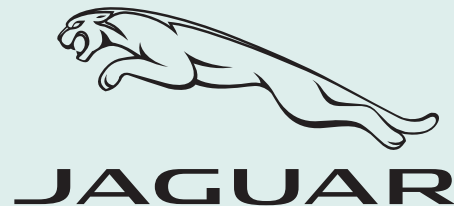


NAPAPIJRI
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NORTHVALLEY

- a sign (or a similar sign) **even for non-similar goods or services**, if the trade mark has a **reputation** and if the use of that sign without due cause takes **unfair advantage** of, or is **detrimental to the distinctive character or repute** of the trade mark (e.g. *“Jaguar” v. “Jaguar – the art of cycling”* for bikes¹⁵)



THE ART OF CYCLING

05. Examples

a. EUIPO – figurative mark

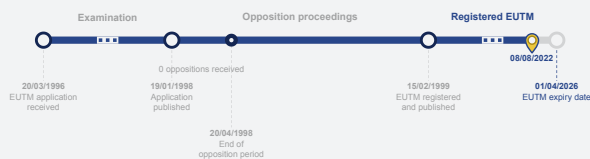


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EUTM file information

LEGO
000039834

Timeline



Trade mark information

Name	LEGO	Filing date	01/04/1996
Filing number	000039834	Registration date	09/11/1998
Basis	EUTM	Expiry date	01/04/2026
Date of receipt	20/03/1996	Designation date	
Type	Figurative	Filing language	English
Nature	Individual	Second language	German
Nice classes	3, 9, 16, 20, 24, 25, 28, 42 (Nice Classification)	Application reference	VB/C14.3.1
Vienna Classification	26.04.01, 26.04.05, 26.04.22 (Vienna Classification)	Trade mark status	Registered
		Acquired distinctiveness	No

Graphic representation



b. EUIPO – colour mark (Milka chocolates)



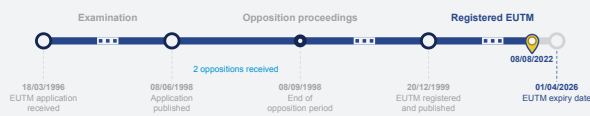
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EUTM file information

(Trade mark without text)

000031336

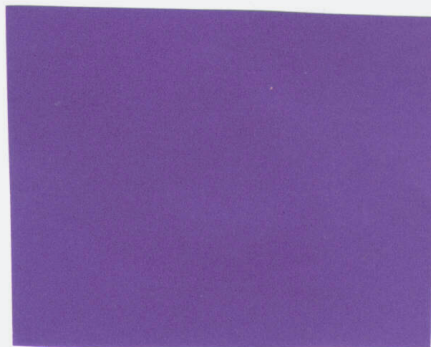
Timeline



Trade mark information

Name	(Trade mark without text)	Filing date	01/04/1996
Filing number	000031336	Registration date	27/10/1999
Basis	EUTM	Expiry date	01/04/2026
Date of receipt	18/03/1996	Designation date	
Type	Colour	Filing language	Dutch
Nature	Individual	Second language	English
Nice classes	30 (Nice Classification)	Application reference	290449
Vienna Classification	29.01.05, 29.01.11 (Vienna Classification)	Trade mark status	Registered
		Acquired distinctiveness	Yes

Graphic representation



c. BOIP – word mark



Afschrift uit het Benelux merkenregister

Merk informatie

Depotnummer	875512
Inschrijvingsnummer	601064
Basis	Benelux
Dagtekening (dag en uur) van het depot	23-07-1996 , 23.59
Vervaldatum	23-07-2026
Publicatiedatum van de inschrijving	01-08-1997
Publicatiedatum van de vernieuwing	12-04-2016
Status	Merk ingeschreven

Merk

Weergave van het merk	TELENET
Type	Woordmerk
Soort	Individueel merk

Waren en diensten

Opgave van de waren en diensten

KI 9 Apparaten voor het opnemen, het overbrengen en het weergeven van geluid of beeld.

KI 35 Advertentiebemiddeling en reclame; verspreiding van reclamemateriaal.

KI 37 Aanleg, onderhoud en reparatie van telecommunicatie-inrichtingen; leggen van kabels en pijpleidingen.

KI 38 Uitzenden van radio- en televisieprogramma's; overbrengen van geluid en beeld via satelliet; telex-, telegraaf-, telefoon-, radiotelefonie- en -telegrafiediensten.

KI 41 Schoolradio en -televisie; filmverhuur; uitvoeren van muziek en van amusementsprogramma's, ook via radio en televisie; verhuur van radio- en televisietoestellen.

Klasse-opsomming

9, 35, 37, 38, 41

Houder

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- 2 See e.g. more information at: https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/Draft_Guidelines_WP_1_2017/06_part_b_examination_section_4_AG_chap_2_Article_7-1-a_clean_2017_en.pdf
 - 3 For more information on the difference between trade marks and trade names see: <https://economie.fgov.be/en/themes/intellectual-property/intellectual-property-rights/specific-protection-regimes/trade-name-and-company-name#:~:text=A%20trade%20name%20should%20not,goods%20or%20services%20of%20companies>.
 - 4 See EUIPO, 22 November 2011, R-010027464.
 - 5 <https://www.wipo.int/classifications/nice/en/>
 - 6 <https://www.boip.int/nl>
 - 7 Find out more information about filing and registering a Benelux trade mark at <https://www.boip.int/nl/ie-professionals/registratie-onderhoud/registreren>.
 - 8 <https://euipo.europa.eu/ohimportal/nl/home>
 - 9 Find out more information about filing and registering an EU trade mark at <https://euipo.europa.eu/ohimportal/en/application-procedure> and <https://www.boip.int/en/entrepreneurs/registration-maintenance/outside-benelux/eu-trademark>.
 - 10 <https://www.inpi.fr/fr/protoger-vos-creations/protoger-votre-marque/les-etapes-cles-du-depot-de-marque>
 - 11 <https://www.inpi.fr/fr>
 - 12 <https://www.wipo.int/madrid/en/members/>
 - 13 Find out more information at <https://www.wipo.int/madrid/en/>.
 - 14 French-speaking Commercial Court of Brussels, 14 October 2020, A/20/00893 and A/20/01109, available on darts-ip.
 - 15 Dutch-speaking Commercial Court of Brussels, 27 June 2019, A/18/02888, available on darts-ip.

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